OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS)
AlicanteNEWS EUROPEAN TRADE MARKS & DESIGNS NEWSLETTER

Contents

The James Nurton interview
with **Roline Bergsma, Tommy Hilfiger**
Page 2

Community Trade Mark
Nike loses "90" trade mark for clothing

Page 3

Country overview: Denmark Community Trade Mark
Page 4

Registered Community Design
Design amendment fails to prevent total defeat
Page 5

Country overview: Denmark Registered Community Design
Page 5

E-business at OHIM
New CTM e-Filing on the way
Page 6

E-business roundup (2009)
Page 7

More news
User Satisfaction Survey under way
Page 7

Fee change for national searches
Page 7

Monthly statistical highlights December 2008
Page 7

Case-Law
Latest trade mark and design news from Luxembourg
Page 8

New Decisions from the Boards of Appeal
Page 21

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Registrations and e-Business up

As indicated in the December edition of Alicante News, demand for the Community trade marks was adversely affected by the chaos on the international financial markets in the latter part of the year. While, the full figures for last year are still being analysed, two interesting trends are already clear. Trade mark applications were slightly down, but the number of CTMs registered rose substantially, and the proportion of customers opting to do business using our online tools went up also.

CTM registrations	
2004	34 000
2005	60 000
2006	62 000
2007	67 000
2008	81 000

Since the CTM was introduced in 1996 registrations have risen consistently every year and 2008 was no exception. A total of 81 000 Community trade marks were registered including the symbolic 500 000 th CTM which went to the small Italian company, Handy Dandy Design. The total has now topped 507 000 CTMs – a remarkable tribute to the popularity of Community-wide IP protection.

The picture for registered Community design (RCD) registrations was also positive with more than 78 000 designs published and registered last year – around 4 000 more than in 2007.

During 2008 the proportion of users opting to use e-filing also rose, with more than 80% of CTMs now filed electronically and 40% of RCDs coming via the Internet.

Towards the end of last year OHIM introduced improvements in the electronic communication tool, E-Communication, that is embedded in the MyPage personalised web space. E-Communication allows the reception and sending of official notifications from and to OHIM via the MyPage mailbox. The additional functions are currently being phased in and all MyPage users are strongly encouraged to take advantage of this service.

Over the coming months the Office will be introducing further developments in e-Business tools as the office continues to modernise and improve. The first major development will be the introduction of the new CTM E-Filing tool, which is detailed in a separate article in the e-Business section, and a new and much improved version of RCD E-Filing is also on the way.

In all, despite some setbacks on the demand side due to world events, 2008 will be remembered as a year in which OHIM continued to produce improvements in productivity and laid the groundwork for some significant developments in e-Business.

The James Nurton interview with Roline Bergsma, Tommy Hilfiger

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 the trade mark counsel for Tommy Hilfiger in Amsterdam about fashion brands, famous marks in Europe and the impact of the credit crunch on trade mark protection

When did you become interested in trade marks?
I started as an attorney in private practice specialising in insurance law, and in 1997 I moved to the IP department. In 1999 I moved to the global IP department of adidas, and in November 2006 I joined Tommy Hilfiger.

My job title is Trademark Counsel and I manage the global trade mark portfolio of both Tommy Hilfiger and Karl Lagerfeld, including the respective domain name portfolios.

We outsource all the administrative work to a trade mark agency, Novagraaf, so I mainly deal with the strategy. It is manageable as, compared to some other international companies, we don't have too many trade marks. We have about 2 750 Tommy Hilfiger marks and about 1 000 Karl Lagerfeld marks.

What are your important markets?
We should be covered worldwide now. The US and Europe have always been important, but Asia is a growing market, especially Japan and China. For the apparel collections, our main brands are well established and include the word marks and the flag. But we also frequently launch fragrances – such as Hilfiger for men and Dreaming for women – which require new trade mark applications.

Tommy Hilfiger originates from the US and it is an American brand, with American heritage. Tommy Hilfiger himself still lives in the US and is closely involved in the representation and direction of the brand.

What are the advantages and disadvantages of protecting fashion trade marks?
Obviously, we don't have any choice about the name of the designer so I can't change the brand if it is hard to register. In our case, Hilfiger is a good, distinctive name but Tommy is less distinctive. However, the combination Tommy Hilfiger is very strong, there is no brand similar to that. One of the disadvantages of the fashion industry is that fashion changes all the time and designers always look for new ways to present the brand and from a trade mark perspective this can pose difficulties.

Is it difficult to protect the word Tommy?
It depends on the region. Especially in Asia we face problems. In Japan we came across Tomy toys, which raised some interesting issues. Also in other countries in Asia we sometimes struggle with the Tommy part of our trade mark, such as Korea, where it is hard to get a registration even if you have a coexistence agreement with a brand that is cited against yours. In general we try to reach worldwide settlements.

Do you use the CTM for protection in Europe?
Nowadays the CTM is our preferred route, as in one go we cover 27 countries. Having said that, we always take into consideration whether we need the CTM or prefer using national regimes. Our favourite option now is to use the Madrid Protocol to designate the EU, US, Japan etc.

The development of the Madrid systems has been one of the most significant changes recently, particularly with the expansion including the US, the EU and Japan. It's almost as though the world becomes one trade mark application. It would be a benefit to have the Latin American countries join now and I think WIPO could speed up the processing a bit, but overall it is a very good system.

Do you welcome proposals to cut CTM costs?
Of course. All trade mark owners agree it's quite expensive and cost cuts are certainly a benefit.

The speed at OHIM has improved a lot. The Benelux system is quite fast, and ideally we would like to see OHIM have faster examination, publication and handling of opposition procedures. In the fashion industry, turnover is so quick that we have to ask ourselves: is it worth having the mark if it takes more than a year to register?

Are you happy with the examination?
Yes, though we do see some strange refusals from time to time. But Tommy Hilfiger didn't have any problems really, nor have I during my career in IP.

What unusual marks have you filed?
Nothing really unusual. For Karl Lagerfeld, we filed a stylised K – which was accepted. The OHIM examination was straightforward. The very first CTM marks we filed were the Tommy Hilfiger word mark and flag logo, the core trade marks, which were registered quickly as we claimed all national seniorities.

Do you use the Community design?
We don't really register designs as we do not face many product infringements. And, in our area, unregistered design rights give sufficient protection, since most of our designs are of a seasonal nature. If people do copy us, they tend to use the name or logo so we can rely on our trade mark rights. Also, we have four collections a year with over 5 000 styles so it would be impossible to protect all of those with registered designs.

Is it difficult to protect famous marks in Europe?
What I find hard is to prove you have a famous mark at OHIM: the burden is enormous. The amount of proof you have to provide puts a huge burden on trade mark owners. I would like to see something to make this easier for owners of famous marks. At the moment, we have to provide details of sales, turnover, advertising and marketing expenditure and sometimes surveys of as many EU countries as possible. That takes such a lot of time for the company as a whole.

For some brands, it's obvious that they're famous. For example, if they are included in the popular surveys of valuable brands that is a good indicator and maybe could be used by the office. You have to start from scratch, which is what makes it so difficult.

What do you think the impact of the credit crunch will be on trade marks?
If people have less money to spend, they're more likely to buy counterfeits and there will be more parallel goods floating around. It is even more important to protect your brand in times like this against people who try to make an easy buck at our expense. We have always been vigilant in this respect and that won't change.

Budgets are tight, so we have to do more work with less money, but I see this as an interesting challenge.

In this climate, we look at proposed applications and say: do we really need these now? Can we postpone them until we know the financial situation? I think applicants will be looking at what is most important and will prioritise their filings. And, when it comes to renewals, they will also look at their registrations and whether or not they are necessary.

In the fashion industry, we expect a bit of a shakeout as consumer spending is dropping, and as a result some brands may disappear. However, we have always been a trustworthy partner for our customers and we are in good shape, with strong brands and healthy sales.

The challenge for brand owners is to keep focussed: protect, maintain and strengthen your brand, don't cut back on enforcement now – there will be more counterfeits and parallel imports. It's not easy to repair a diluted brand, so budgeting to protect your brand is more important than ever as there are more threats. And if budgets are tight, set goals: focus on the problem areas, don't spend a little all over the place, but dedicate budgets where they are needed most.

Community Trade Mark

Nike loses "90" trade mark for clothing

The Community trade mark "90" registered by the sporting goods and clothing manufacturer, Nike, in 2005 has been ruled invalid for clothing following an objection that "90" was a common size for men's and women's clothing and thus falling foul of Article 7(1)(c) CTMR.

Opposing the invalidity application, Nike argued that there were several numbers and codes to identify sizes worldwide and the size "90" might just be one of them.

Nike submitted that Size "90" was not the only way of identifying women's or men's sizes. Furthermore, the mark "90" had been intensively used on the relevant market and had therefore acquired a distinctive character. In support of its arguments, Nike presented the following documents:

- Several copies of other Community trade marks including numbers
- A copy of international clothing size information
- An affidavit from a director of Nike in Brazil
- Copies from newspapers showing Nike's "TOTAL 90" trade mark
- Various "Google" search print-outs.

The invalidity applicant Jörn Hilger from Moers in Germany contested the argument that the Community trade mark had acquired distinctive character since the submitted evidence did not show the Community trade mark as it was registered, i.e. "90", and some of the evidence, such as the affidavit, had no relevance for the territory of the European Union.

The invalidity application was made on the basis of absolute grounds, namely Article 7(1)(b) and (c) CTMR in conjunction with Article 51(1)(a) CTMR.

Article 7(1)(c) CTMR, states that the following shall not be registered: trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service.

OHIM's Cancellation Division found that the Community trade mark was made up exclusively of the number "90", which in the clothing sector stood for a size of clothing for tall men and also as a common size for women's clothing such as underwear. Consequently, the Community trade mark consisted exclusively of a number which was commonly used for the indication of clothing sizes and described an attribute of the contested goods – their size.

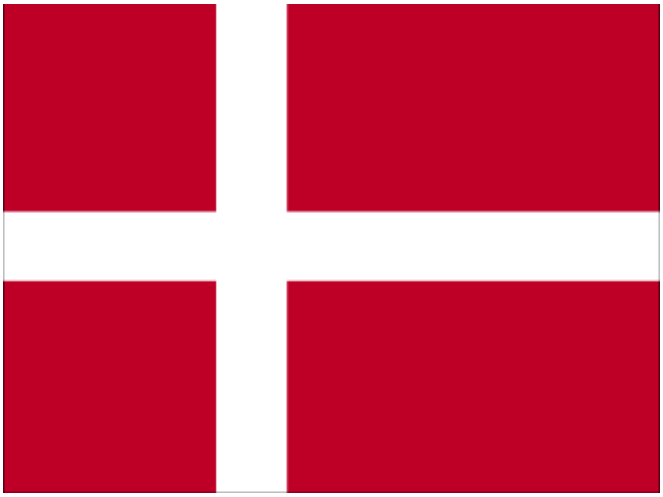
With regard to the Community trade mark proprietor's claim based on Article 51(2) CTMR that its contested Community trade mark had acquired distinctive character in consequence of the use which had been made of it and could therefore not be declared invalid, the Cancellation Division found that the evidence submitted in support of this claim did not show acquired distinctiveness of the contested Community trade mark "90" for the contested goods, clothing in class 25.

In particular, some of the evidence related to the use of the trade mark "Total 90", which was different to the contested one, and also showed the use of this mark on footballs, for example, not on clothing.

The Cancellation Division noted that the statement that "TOTAL 90 is the official *soccer ball* of the English Premier League, Spanish Premier League, etc." was not sufficient in order to show that the contested Community trade mark "90" had acquired distinctiveness through use in the European Union or one of its member states for *clothing*.

The Office found that the invalidity request was well founded. In the light of the evidence before it, the Office considered that the Community trade mark as far as the goods clothing in class 25 were concerned, had been registered in breach of Article 7(1) CTMR. Article 51(1)(a) CTMR was applicable.

Country overview: Denmark & the Community Trade Mark

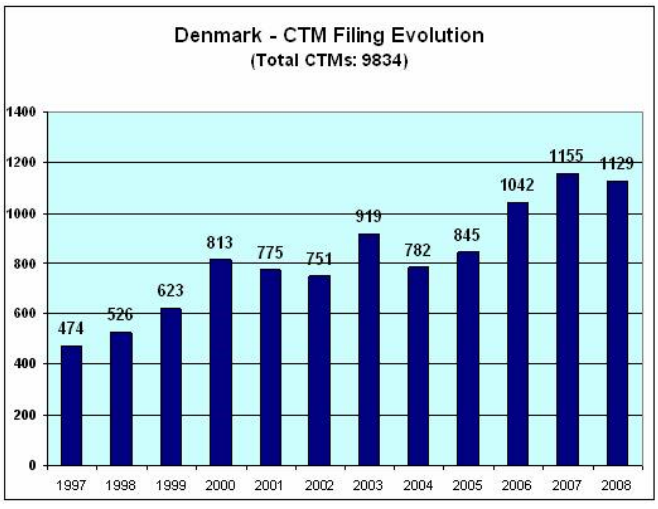


Denmark, with a population of 5.4, joined the EU in 1973. Fishing is an important industry and Denmark possesses a merchant fleet of considerable size. The manufacturing sector's main areas of activity include food products, chemicals, machinery, metal products, electronic and transport equipment, beer and paper and wood products. Tourism is also an important economic activity.

Danish figures for GDP show that growth in the third quarter of last year was down by 0.4% compared with previous quarter.

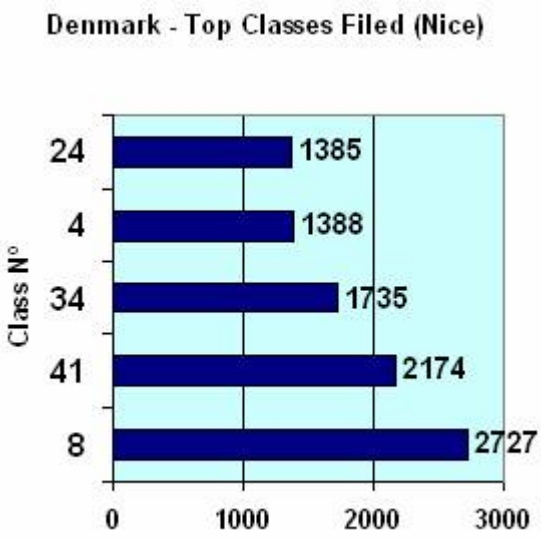
The service sector accounts for 73% of GDP followed by industry (26%), and agriculture (1%).

Danish undertakings have been supporters of the CTM system since the beginning with the first registrations in 1997. More than 9 800 Danish CTMs have been registered to date, including 1129 last year.

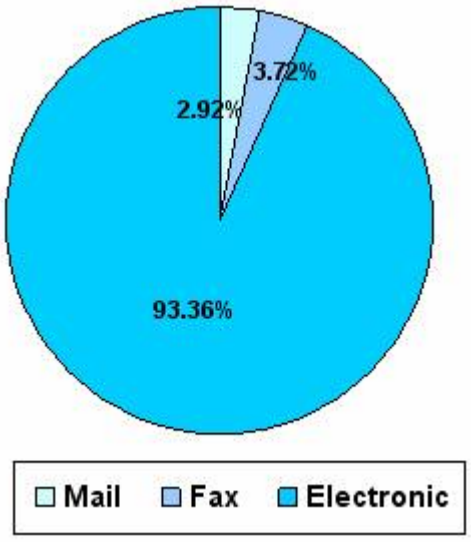


Word	Figurative	3-D	Colour	Other
66.75 %	32.68 %	0.54 %	0.01 %	0.03 %

Word marks are the most popular with Danish enterprises and account for two-thirds of applications, followed by figurative marks (33%). The most popular goods and services applied for are in classes 8, 41 and 34.



The vast majority of Danish trade marks (93%) are filed electronically, with fax accounting for 4% and mail for 3%.



Top 10 Denmark -based owners by number of CTMs filed	
Company	CTMs
H. Lundbeck A/S	171
Novo Nordisk A/S	112
Arla Foods amba	85
Danisco A/S	82
LEGO Juris A/S	79
DFDS A/S	61
Aktieselskabet af 21. november 2001	60
BOREALIS A/S	58
ECCO SKO A/S	55
VKR Holding A/S	55

Top 10 representatives by number of CTMs received from Denmark-based applicants	
Representative	CTMs
ZACCO DENMARK A/S	1 086
CHAS. HUDE A/S	946
SANDEL, LØJE & WALLBERG	762
PATRADE A/S	616
INTERNATIONALT PATENT-BUREAU A/S	538
JOHAN SCHLÜTER	515
BUDDE SCHOU A/S	506
LARSEN & BIRKEHOLM A/S	226
BECH-BRUUN LAW FIRM	225
GORRISSEN FEDERSPIEL KIERKEGAARD	173

Community Design

Design amendment fails to prevent total defeat

For the first time ever, a holder of a registered Community design (RCD) under the fire of an invalidity attack made an attempt to salvage his contested design, at least partially, with the help of Article 25(6) CDR, which allows maintenance of the registered Community design in amended form where it is invalid in the original form.

The case concerned RCD 000794870-0004 registered for shoes (below, left), which has been contested on the ground of Article 25(1)(e) CDR for alleged infringement of the earlier Community trademark CTM 3783073 in the class 25 (below, right):

RCD 000794870-0004 CTM 3783073

In response to the application for a declaration of invalidity the holder of the contested RCD made reference to Article 25(6) CDR and requested maintenance of the RCD in amended form without the 'H' forming part of the design.

By having made the request during the invalidity proceedings, i.e. before a decision on the merits has been taken, the holder complied with a condition set forth in Section 5.3 of the Invalidity Guidelines[1]. As regards another condition, namely that the request for maintenance in amended form must include the amended form, it is not clear whether the holder has actually complied with it. Article 25(6) CDR says that maintenance in amended form may include "registration accompanied by a partial disclaimer". The statement of the holder to maintain the RCD "without the 'H" could be understood as a partial disclaimer and hence be considered as an inclusion of the amended form.

In the end, the request of the holder failed not because of non-compliance with the rules set forth in the Guidelines, but because of failure to meet a pre-requisite stipulated in Article 25(6) CDR: maintenance in amended form is possible only where "the identity of the design is retained". In Article 25 CDR no further explanations are given as to what means "identity of the design". However, in Article 5(2) CDR it is defined that "designs shall be deemed to be identical if their features differ only in immaterial details". In the present case, the Invalidity Division found[2] that the "H" is not an immaterial detail but a feature of the shoe design as originally registered and hence the elimination of that feature would change the identity of the design. Consequently, the request of the holder to maintain the contested RCD in amended form was rejected and the RCD declared invalid.

Although in the present case his grasp at Article 25(6) CDR did not help the holder, there are a number of cases where it may offer an escape from total defeat in invalidity proceedings. For instance, where a contested feature is contained in the views of an RCD not as a part of the claimed design but as an element of the background or as illustration (e.g. bottles shown in a design of a bottle rack), the feature could be eliminated from the views without affecting the identity of the design.

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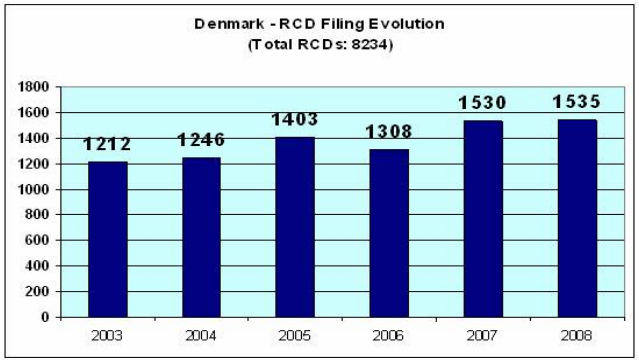
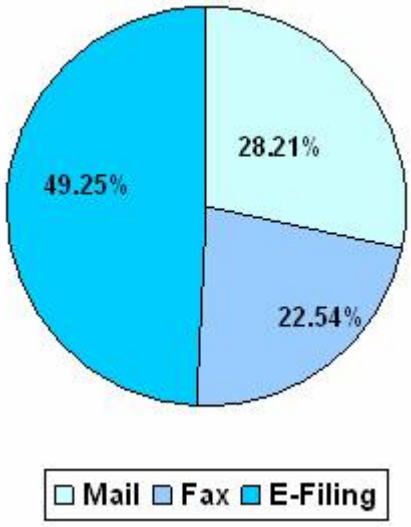
[1]Guidelines for the Proceedings Relating to a Declaration of Invalidity of a Registered Community Design, adopted by the Decision of the President No EX-04-1 of 26 April 2004
[2]Decision of the Invalidity Division of 16/12/2008 in case ICD 5080

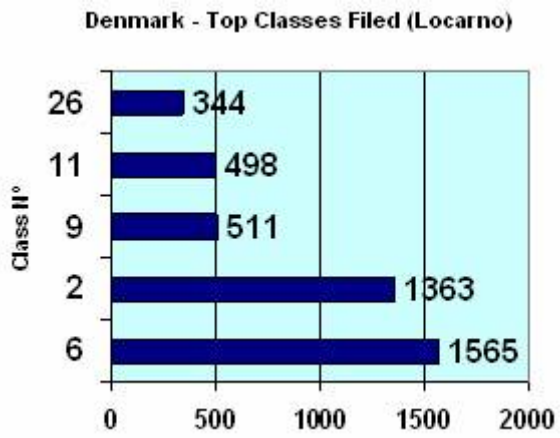
Country overview: Denmark & the Registered Community Design

The first Danish filings of Community designs were made in 2003, and there have been over 8 200 to date, including more than 1 500 last year.

The most popular classes for RCDs are 6, 2 and 9. E-filing is the most popular filing route, accounting for almost half of the total, with mail the next most popular at 28%. Filings by fax account for 23% of the total.







Top 10 Denmark -based owners by number of RCDs filed

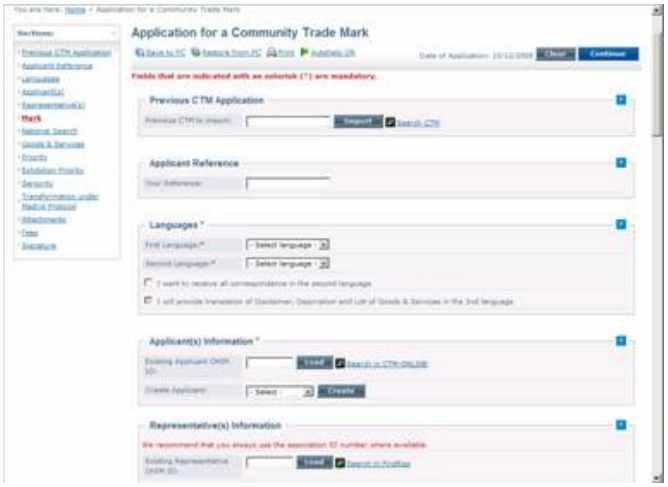
Owner	RCDs
ECCO SKO A/S	925
Scancom International A/S	643
Pilgrim A/S	497
MASCOT INTERNATIONAL A/S	326
Zone Company Denmark A/S	142
Eva Denmark A/S	106
Flexa Møbler, Hornsyld A/S	99
DA'CORE A/S	88
VKR Holding A/S	82
Flora Labels A/S	78

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

Representative	RCDs
PATRADE A/S	756
AWAPATENT A/S	740
Rahbek-Clemmensen	688
ZACCO DENMARK A/S	645
CHAS. HUDE A/S	575
BECH-BRUUN LAW FIRM	404
BUDDE SCHOU A/S	345
SANDEL, LØJE & WALLBERG	335
BUSSE & PARTNER	326
LARSEN & BIRKEHOLM A/S	310

E-business at OHIM

New CTM e-Filing on the way



At present, an average of 80% of CTM applications are received online, making CTM e-filing one of OHIM's most used e-business solutions. The current system was launched in 2004 and despite regular upgrades it requires some important improvements requested by users.

Over the past few months, in consultation with users and in particular with the OHIM e-business users group, OHIM has been designing a new CTM e-filing solution.

This new system is intended to improve the user experience when filing CTM applications online. It should be both easier to use and perform better. Several features will contribute to achieving this objective:

- The form will be in a single page with a simple left menu to facilitate navigation.
- Fewer mouse clicks are needed to introduce Goods and Services.
- An online self-help system can be activated to support users when completing the form.

- Draft forms can easily be saved locally or in the MyPage personalised web platform, and can be restored on demand.
- The official receipt will be generated automatically on making the final submission.

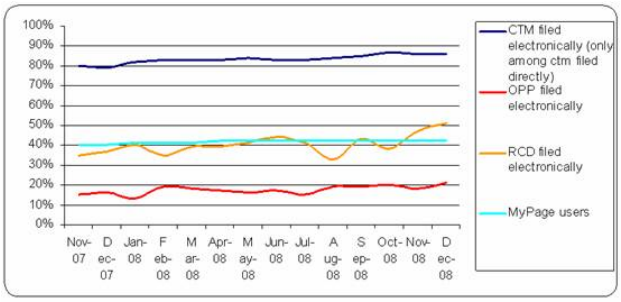
This new and improved CTM e-filing solution is scheduled to go live shortly. OHIM will publish further information about it on the website in the coming weeks.

For any further information, please do not hesitate to contact us at Information@oami.europa.eu.

OHIM e-business roundup (2009)

Statistical summary

- The use of the CTM e-filing web form is steadily above 80 %.
- The use of RCD e-filing has increased to over 50%
- Oppositions against CTM applications received electronically is 21%.
- MyPage users represent around 42% of CTM Applications filed.



State of play of future projects

Service - New version of CTM E-filing:
The current CTM e-filing service will be significantly improved.

Status - OHIM is testing the system.

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 specific CTM status changes.

Status - OHIM is going to start the testing phase

More News

User Satisfaction Survey under way

OHIM's fourth annual User Satisfaction Survey, carried out by the independent survey organisation, GfK, is now under way. Users who did business with the Office in 2008 are being contacted by e-mail with details on how to take part.

The survey is used as a management tool to focus change on the areas that are most important to users and the Office is hoping that this year even more people with take the opportunity to have their say. The e-mail invitation to users contains a personal link that launches the questionnaire. A report on the results is expected to be available at the end of February or the beginning of March 2009.

Fee change for national searches

Following the decision of four national offices to stop taking part in the optional national searches that may be requested at the time of filing a Community trade mark, the fee for these searches has fallen to €144.

National searches - carried out in all participating offices for a single fee – have been optional since March 2008.The 12 national offices continuing to participate are: Bulgaria, Czech Republic, Denmark, Greece, Spain, Lithuania, Hungary, Austria, Poland, Romania, Slovak Republic and Finland .

Further details are included in an Information Note: http://oami.europa.eu/ows/rw/resource/documents/CTM/optionalSearches_en.pdf.

Monthly statistical highlights December 2008

Community trade mark applications received	6 751
Community trade mark applications published	6 194
Community trade marks registered (certificates issued)	7 237
Community trade mark renewal applications	1 078
Registered Community designs received	3 521
Registered Community designs published	3 779

- *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

Index

ECJ Judgments and Orders
Patterned Glass-II or Glaverbel-II: C-513/07-P
Pentagon or Pentagon Label: C-508/07-P

ECJ Developments in pending cases
NONE

ECJ Preliminary Rulings
NONE

ECJ Preliminary Rulings: Developments in pending case

Zovirax or The Wellcome
Silberquelle/Maselli: C-495/07

CFI Judgments and Orders
Atoz/Artoz: T-100/06
Surfcard: T-325/07
Medtec: T-173/08
CMD Clinic: T-241/06
Light Life: T-222/08
Monkey Puzzle: T-303/07
Nanolat/Tannolact: T-6/07
Tai Cros: T-315/06
Rautaruukki: T-269/06
Laura Ashley: T-301/08
Easycover: T-346/07
PrimeCast: T-373/07
QWeb: T-242/07
Affilene: T-87/07
Honeycomb: T-256/06
Kenitex: T-322/07
Factory Finish: T-487/07
Ecoblue: T-281/07
Limoncello-II or Limoncello di Capri: T-210/05
Lego Brick or Red Lego Brick: T 270/06
Farben in Quadraten: T-400/07
Arc Noir or Camper: T-304/07
Coyote Ugly: T-161/07
Gerivital: T-163/07
Flex: T-158/06

CFI Judgments and Orders: Developments in pending cases
Visual Map: T-260/08
Oli/Olay: T-240/08
BioMonitor: T-257/08
Seroslim: T-201/08
Livensa: T-159/08
Roi Analyzer: T-233708
Diacor/Diacol: T-258/08

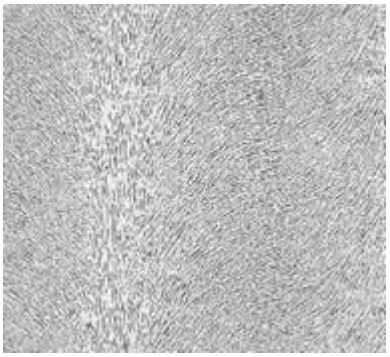
A: ECJ European Court of Justice (ECJ): Appeals from decisions of the Court of First Instance, Article 63 CTMR

A-1: ECJ Judgments and Orders

Patterned Glass-II or **Glaverbel-II**: C-513/07-P – Appeal from T-141/06 - Order of 17 October 2008 (rejected *a limine*; CFI and Office practice confirmed).

Keywords: ECJ proceedings: trade mark ('TM') issues and points of law – Types of signs: surface of the product – Absolute grounds for refusal: distinctiveness – Distinctiveness: relevant public – Distinctiveness: acquired on the market, Article 7(3) CTMR – Acquired distinctiveness: criteria in the case of a mixed relevant public (general/experts) – Acquired distinctiveness: territorial scope.

In this case, the CTM applicant had been seeking the annulment of the judgment of the 2nd Chamber of the CFI of 12.9.2007 in Case T-141/06, the background of which had been the following: by its application Glaverbel SA (now acting under the name "AGC Flat Glass Europe SA") had sought to register as a figurative trade mark a design applied to the surface of the goods (as shown below).



It had been applied in Class 19 for building glass; patterned glass; glazing; glass sheets for building; glass screens and partitions, and in Class 21 for unworked or semi-worked glass (except glass used in building); patterned glass (except glass used in building); glass sheets (except glass used in building); glass sheets for use in the manufacture of sanitary installations, showers, shower walls, shower enclosures, refrigerator shelves, glazing, double glazing, building partitions, building screens, doors, cupboard doors, furniture, and kitchen cutting boards.

In response to doubts raised by the examiner, the CTM applicant maintained that, notwithstanding the fact that it considered the mark to be prima facie registerable, the mark had become distinctive in consequence of the use which had been made of it. The applicant also submitted a number of documents and declarations in support of that argument, in particular, declarations from professionals in the glass sector (trade journalists, glass processors, wholesalers and competing manufacturers) who asserted, essentially, that, upon seeing the design in dispute, the person making the declaration immediately recognised a specific glass design originating from Glaverbel. It also produced declarations from an employee of its intellectual property department stating that the sign has been used in the territory of the European Community since approximately 1970 and showing the volume of sales between 1993 and 2001. In addition, the applicant provided examples of advertising material.

The CTM application was refused on the ground of Article 7(1)(b) CTMR. The 4th Board (Case R 0986/2004-4), in addition, had stated that the evidence produced by the CTM applicant did not warrant the conclusion that the mark applied for had distinctive character acquired through use within the meaning of Article 7(3) CTMR. The Board had observed that, since the evidence submitted was restricted to the opinion of a specialised public, it could not be regarded as sufficient since the target market for the goods in question was not made up exclusively of a specialised public.

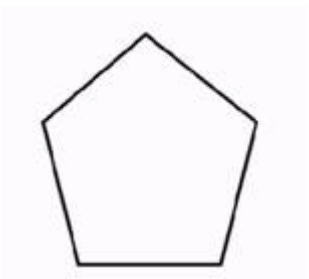
In its challenged judgment, the CFI had dismissed the action. As regards the determination of the target public, the CFI had stated that some of the goods in question, namely 'patterned glass (except glass used in building)' and 'glass sheets (except glass used in building)` were not solely intended to be sold to professionals, but they were also likely to be bought and used by end consumers. Consequently, such consumers are part of the relevant public. For the remaining goods, namely 'glass sheets for use in the manufacture of showers, shower walls, shower enclosures, glazing, double glazing, building partitions, building screens, doors, cupboard doors and furniture', it pointed out that, even supposing that such

goods are sold only to professionals, that finding is not sufficient, by itself, to warrant the conclusion that the target public is made up exclusively of professionals. End consumers may be involved in the choice of the goods. In relation to the CTM applicant's argument of acquired distinctiveness, the CFI had held that the evidence did not show relevant information in respect of 5 countries of the Community. It stressed that in the case at issue, the impression which the sign, consisting of a pattern applied to the goods themselves, may create in the mind of the consumer was in principle likely to be the same throughout the Community. It was thus inferred that it was in the Community as a whole that that mark must have become distinctive through use in order to be registerable under Article 7(3) CTMR. The 6th Chamber of the ECJ (Bonichot; Küris, rapporteur; Bay Larsen) dismissed the appeal as manifestly unfounded.

Pentagon or **Pentagon Label**: C-508/07-P – Case closed; Order of 8 October 2008 (DE).

Keywords: Types of signs: simple geometrical shape – Absolute grounds for refusal: distinctiveness.

The case had been an appeal from a judgment of the CFI of 12.9.2007 in Case T-304/05 by which the CFI had confirmed rejection of the representation of a pentagon, applied for wine in Class 33.



The plaintiff in the action, the CTM applicant, withdrew the action pending proceedings and, thus, the case was closed.

A-2: ECJ: Developments in pending cases

NONE

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

NONE

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

Silberquelle/Maselli : C-495/07 – Opinion of the Advocate General of 18 November 2008 (only in DE, ES, IT).

Keywords: First Council Directive 89/104/EEC ('Trade Marks Directive'), Articles 10(1) and 12(1): genuine use – Genuine use: where the good is given as a free gift in relation to the sale of another product.

The case is a reference from the *Oberster Patent und Markensenat* of Austria relating to a revocation case in which Maselli's trade mark "Wellness" had been partially challenged as regards goods in Class 32 for alleged non-genuine use. The TM owner is a textile trade and had given 800 bottles of lemonade under the brand "Wellness Drink" as a free gift to customers when they had bought clothing. AG Ruiz-Jarabo Colomer proposed finding that such use does not constitute genuine use within the meaning of trade mark law since the trade mark holder had not been aiming at building up a market, or acquiring a market share, respectively, in the sector of non-alcoholic beverages.

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

Atoz/Artoz : T-100/06 – Judgment of 26 November 2008 (dismissed; Office confirmed).

Keywords: Opposition: proof of use (POU) – POU: in the case of an international registration – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 11.1.2006 in Case R 1126/2004-2 relating to CTM application "ATOZ", word mark, which had been applied for for a range of services in Classes 35 and 41, namely for 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; bookkeeping; 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; computerised file management; systemisation, 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; personnel management consultancy; payroll preparation; publication of publicity texts; secretarial services; statistical information; word processing (Class 35).

In Class 41, it had been applied for for exhibitions for particular purposes and in the nature of specific events especially in the area of education, culture, sports and entertainment; cultural and club services; educational and entertainment services; electronic publishing services; news shows (entertainment, namely, television); organisation of shows events; congress; symposiums and conferences; television programmes 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 an earlier right in "ARTOZ", word mark, registered *inter alia* in Germany for services in Class 35, namely advertising, divulging, renting and distribution of advertisements, of advertising material, of leaflets, prospectus, printed matters, 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, and in Class 41 for teaching, entertainment and education.

The opposition had been allowed, in essence on the grounds that, in Germany, the international registration was not subject to a use requirement; that the services covered by the trade marks at issue were identical; that the signs were similar; and that there was a likelihood of confusion on the part of German consumers. The Board had noted, *inter alia*, that a request for proof of use can be accepted only if, at the time of publication of the trade mark application, the earlier international trade mark has been registered for not less than five years. It then had noted that it followed from a teleological interpretation of Article 43(2) CTMR, read in conjunction with Article 10 of First Council Directive 89/104/EEC that the date on which that five-year period began to run was the date of the actual completion of the registration procedure. In the Board's view, that interpretation is necessary in order to ensure equal treatment between earlier national trade marks which originate from a legal system in which any opposition proceedings take place after the trade mark is entered in the register and those which originate from a legal system in which opposition proceedings take place before registration. Moreover, an international registration does not become final until, at the earliest, the expiry of the period specified in Article 5(2) of the Madrid Agreement Concerning the International Registration of Marks of 14 April 1891 (the 'Madrid Agreement'), since it merely provides a procedural short-cut enabling a number of national trade mark applications to be filed through one application. In essence, the 8th Chamber of the CFI (Martin s Ribeiro; Papasavvas, rapporteur; Wahl) confirmed these findings.

Surfcard : T-325/07 – Judgment of 25 November 2008 (only in FR; action partially allowed; law of the case).

Keywords: Absolute grounds for refusal: descriptiveness – Descriptiveness: "partial descriptiveness", namely regarding only part of the claimed goods and services.

The action had been initiated against a decision of the 1st Board of 14.6.2007 in Case R 1130/2006-1 relating to CTM application "SURFCARD", word mark, which had covered a range of goods and services in Classes 9, 36 and 38. It had been partially rejected on the ground that the sign would be descriptive of the respective goods and services. The 3rd Chamber of the CFI (Azizi, rapporteur; Cremona , Frimodt Nielsen) took a slightly more liberal view and, while rejecting the remainder of the appeal, allowed support of magnetic and optical discs in Class 9 and credit card services in Class 36.

Medtec : T-173/08 - Case closed; Order of 19 November 2008 .

Keywords: Opposition: likelihood of confusion (LOC).

The case had been an appeal against a decision of the 1st Board of 6.3.2008 in Case R 0989/2005-1 relating to a conflict between CTM application "MEDTEC" (figurative trade mark) and earlier rights in "Metec", word mark.

CTM application	
	Metec

The CTM had been applied for instructional and teaching material (except apparatus) in Class 16; in Class 35 for advertising; business management; business administration; office functions; arranging and conducting trade shows, exhibitions and congresses for commercial purposes, all the afore mentioned services relating to the field of medical instruments, and in Class 41 for education; providing of training; entertainment; sporting and cultural activities; publishing services; arranging and conducting trade shows, exhibitions and congresses for educational purposes, all the afore mentioned services relating to the field of medical instruments.

The earlier rights cover, *inter alia*, printed matter in Class 16; in Class 35 planning, arranging and conducting of fairs, exhibitions and presentations for economic and advertising purposes; compilation of information into data bases; systematization of data into computer data bases; advertising; management consultancy, and in Class 41 planning, arranging and conducting of fairs, exhibitions and presentations for cultural or educational purposes; planning and arranging congresses, conferences and teaching seminars; entertainment.

Whereas the Opposition Division had allowed the opposition, the Board had rejected it. Since the plaintiff (opponent) had declared that it wishes to discontinue proceedings, the case was closed.

CMD Clinic : T-241/06 – Case closed; Order of 17 November 2008 .

Keywords: Absolute grounds for refusal: distinctiveness.

The case had been an appeal from a decision of the 4th Board of 6.7.2008 in R 0372/2006-4 relating to CTM application No 3 661 337, “CMD-CLINIC”, word mark, which had been applied for for a range of goods and services in Classes 5, 10 and 44. It had been partially rejected, namely as regards Classes 10 and 44, on the ground that, in German, CMD is the abbreviation of the technical term *Cranio-mandibuläre Dysfunktion*, and the goods and services in the rejected classes are evidently linked to the respective treatment. Upon withdrawal of the action, the case was closed.

Light Life : T-222/08 – Case closed; Order of 17 November 2008 .

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 6.3.2008 in R 1257/2006-1 relating to CTM application 3 192 481, word mark “life light”, which had been applied for for a range of goods in Class 32.

CTM application	
life light	

It had been opposed on the basis of “Light live” (figurative trade mark) registered also in Class 32. The Opposition Division had rejected the opposition on the basis of dissimilarity of the marks notwithstanding that the goods are identical. The Board had revoked that decision and had allowed the opposition. Upon withdrawal of the opposition pending proceedings, the case was closed.

Monkey Puzzle : T-303/07 – Case closed; Order of 12 November 2008 .

Keywords: Opposition: likelihood of confusion (LOC).

The action had been brought against a decision of the 2nd Board of 5.6.2007 in R 0911/2006-2 relating to CTM application No 3 674 561, “PUZZLE”, word mark, which had been applied for in Classes 16, 32 and 33. It had been opposed on the basis of “MONKEY PUZZLE”, a Spanish trade mark registered for alcoholic beverages in Class 33. The CTM had been partially rejected as regards beer in Class 32 and the goods claimed in Class 33. The Board had revoked the decision as regards “beer” in Class 32. Upon withdrawal of the action by the plaintiff (CTM applicant), the case was closed.

Nanolat/Tannolact : T-6/07 – Judgment of 19 November 2008 (only in DE, FR; action dismissed, Office practice confirmed).

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

The case is an appeal from a decision of the 4th Board of 25.10.2006 in R 0146/2006-4 relating to CTM application “NANOLAT,” word mark, which had been applied for in Classes 1, 3 and 5. It had been opposed on the basis of an earlier German right in “TANNOLACT”, word mark, which is registered in Class 5 *inter alia* for pharmaceutical products. The opposition had been rejected, and the 6th Chamber of the CFI agreed (Meij; Vadapalas, rapporteur; Jürimäe).

Tai Cros : T-315/06 – Judgment of 19 November 2008 (only in DE, FR; action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of signs/marks – LOC: relevant public.

The case had been an appeal from a decision of the 1st Board of 20.9.2006 in R 0029/2006-1 relating to CTM application “Tai Cros” (figurative trade mark) which had been applied for for a range of products in Class 1.

CTM application	
	CROS SOCIEDAD ANONIMA CROS

It had been opposed on the basis of several earlier rights in the word “CROS”, also as incorporated in figurative marks, registered in Class 1. The opposition had been rejected, and the 7th Chamber of the CFI confirmed these findings, relying

on standard criteria (Forwood; Sváby, rapporteur; Moavero Milanesi).

Rautaruukki : T-269/06 – Judgment of 19 November 2008 (dismissed; Office confirmed).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: acquired on the market.

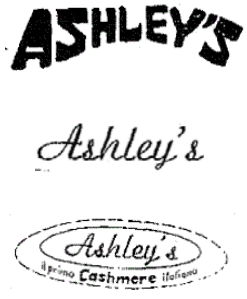
The action had been an appeal from a decision of the 4th Board of 20.7.2006 in Case R 0048/2006-4 relating to CTM application “RAUTARUUKKI”, word mark, which had been applied for in Class 6 for common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; metal plates, sheets and coils; metal tubes and profiles; non-coated or coated.

The Finnish word ‘rautaruukki’ means iron works, and the CTM application had accordingly been rejected as being descriptive and devoid of individualising capacity. The Board had further stated that the evidence filed to bolster the argument of acquired distinctiveness referred to the company and did not show that the generic term was perceived as a trade mark for the goods in question. The 8th Chamber of the CFI (Martin s Ribeiro, rapporteur; Papasavvas; Dittrich) confirmed these findings, relying on standard criteria and case-law.

Laura Ashley : T-301/08 – Case closed; Order of 4 November 2008 .

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 28.5.2008 in Case R 1237/2007-1 (IT) relating to CTM application LAURA ASHLEY, word mark, applied for by Laura Ashley Manufacturing B. V. The CTM had been applied for in Classes 3, 18, 24 and 25.

CTM application	
LAURA ASHLEY	

Subsequently, Ms Tiziana Bucci, an Italian national trading as Ashley’s Di Tiziana Bucci, had filed a notice of opposition based on an international registration from 1974 (“ASHLEY´S”; stylised) with effect in Italy, Germany, France and the Benelux, for golf wear, in particular made of cashmere, in Class 25. The other invoked marks cover goods in Classes 3, 18, 24 and 25. The opposition had been allowed. Since the plaintiff (CTM applicant) had notified the court that it wished to discontinue proceedings, the case was closed.

Easycover : T-346/07 - Judgment of 13 November 2008 (partially allowed; law of the case).

Keywords: Absolute grounds for refusal: distinctiveness.

The action had been brought against a decision of the 4th Board of 3.7.2007 in Case R 1065/2005-4 relating to CTM application “Easycover”, word mark, which had been applied for in Class 19 for building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal; in Class 24 for textile and textile goods, not included in other classes; and in Class 27 for mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile). It had been rejected on the ground that the sign is descriptive for the claimed goods. The 8th Chamber of the CFI allowed it for “monuments, not of metal” (Martin s Ribeiro; Papasavvas, rapporteur; Wahl).

PrimeCast : T-373/07 – Judgment of 12 November 2008 (only DE, FR; action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness.

The case had been brought against a decision of the 4th Board of 20.7.2007 in Case R 0333/2005-4 relating to CTM application “PrimeCast”, word mark, which had been applied for for a range of goods and services in Classes 1, 19, 40 and 42. It had been rejected as regards Class 19 products on the ground that the term would be directly descriptive, for example, conveying the meaning of “material of first class”; further, “cast” is a technical term in the iron and steel industry. The 1st Chamber of the CFI agreed, relying on standard criteria (Tiili; Dehousse; Wiszniewska-Bialecka, rapporteur).

QWeb : T-242/07 – Judgment of 12 November 2008 (dismissed; Office practice confirmed).

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

The action had been brought by Mr Dieter Weiler, a German national, against a decision of the 1st Board of 29.3.2007 in Case R 0893/2005-1 relating to the plaintiff’s CTM No 2 418 150, word mark “Q2WEB”, registered in Classes 9, 35, 38 and 42.

Challenged CTM	
Q2WEB	QWEB

The CTM had been challenged by way of a request for invalidation based on several earlier rights in “QWEB”, word mark and figurative marks, which are registered in Classes 35, 38 and 42. The invalidation request had been allowed, and the 1st Chamber of the CFI agreed, relying on standard criteria (Tiili; Dehousse; Wiszniewska-Bialecka, rapporteur).

Affilene : T-87/07 – Judgment of 12 November 2008 (action allowed; law of the case).

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

The case had been initiated against a decision of the 2nd Board of 23.1.2007 in Case R 0010/2006-2 relating to a conflict between CTM application “Affilene” (figurative trade mark) and the earlier CTM “Affilin”, word mark. The action had been brought by the opponent.

CTM application	
affilene	Affilin

The CTM had been applied for in Class 1 for extracts of medicinal plants for use in the pharmaceutical, cosmetic and food industries, not for diagnostic purposes. The earlier right is registered in Class 1 for chemicals used in industry, science as well as in agriculture, horticulture and forestry; analysis and diagnostic preparations; biological preparations for laboratory analysis and diagnostics; all the aforesaid goods in particular containing antibodies or antibody-type proteins or parts thereof, including for purifying and stripping substances from mixtures; except brightening agents for the preparation of synthetic and natural fibers; and in Class 5 for pharmaceutical and veterinary preparations, except anti-epileptics; diagnostic and analysis preparations for medical and veterinary purposes; re-agents for medical and veterinary purposes; all the aforesaid goods, in particular containing antibodies or antibody-type proteins or parts thereof, including for purifying and stripping substances from mixtures.

Whereas the Opposition Division had allowed the opposition in full, the Board had partially rejected it. The Board had noted that the goods for which registration was sought were intermediate goods sold to qualified professionals working in the pharmaceutical, cosmetic and food industries, who are particularly attentive. As regards a comparison of the goods, the Board had held, first of all, that ‘extracts of medicinal plants for use in the pharmaceutical industry, not for diagnostic purposes’ referred to in the application for registration could be included in ‘pharmaceutical and veterinary preparations’ designated by the earlier mark in Class 5 and that, therefore, the goods were similar. Since a pharmaceutical preparation may mention the trade mark of the medicinal plant extracts that it contains the Board had concluded that, in this respect, there was a likelihood of confusion.

In contrast, the Board had held, secondly, that there was no similarity between ‘extracts of medicinal plants for use in the cosmetic and food industries, not for diagnostic purposes’ mentioned in the CTM application and the goods designated by the earlier mark. In that connection, it had held that the plant extracts concerned had no connection to either ‘pharmaceutical and veterinary preparations’ designated by the earlier mark in Class 5, or to ‘chemicals used in industry, science as well as in agriculture, horticulture and forestry’ designated by the earlier mark in Class 1. It had stated that there was an obvious similarity between plant extracts and biological preparations. However, it had held that the similarity between the plant extracts concerned and ‘biological preparations for laboratory analysis and diagnostics’ designated by the earlier mark in Class 1 was neutralised by two factors, namely the exclusion of goods for diagnostic purposes from the designation of the goods covered by the application for registration and the fact that all the goods designated by the earlier mark ‘in particular contain antibodies or antibody-type proteins or parts thereof’.

Accordingly, the Board had allowed the appeal and dismissed the opposition as regards the application for registration with respect to the plant extracts concerned. The 1st Chamber of the CFI disagreed (Tiili; Dehousse; Wiszniewska-Bialecka, rapporteur) and revoked the Board decision.

Honeycomb : T-256/06 – Judgment of 5 November 2008 (only in DE, FR; action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: descriptiveness.

The action had been brought against a decision of the 4th Board of 17.7.2006 in Case R 1388/2005-4 relating to CTM application “HONEYCOMB”, word mark, which had been applied for for a specific category of goods in Class 11, an essential element of which looks like a honeycomb, i. e. like hexagonal cells. The application had been rejected under Article 7(1)(c) CTMR, and the 8th Chamber of the CFI (Martin s Ribeiro; Papasavvas; Wahl, rapporteur) agreed, relying on standard criteria.

Kenitex : T-322/07 – Case closed; Order of 16 October 2008 (PT).

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

The case had been initiated against a decision of the 4th Board of 19.1.2007 relating to invalidation proceedings on relative grounds between CTM "Kenitex" and several earlier rights in the stylised word "Kenitex".

Challenged CTM	
Kenitex TINTAS A qualidade da cor	Kenitex

The challenged CTM had been registered in Classes 1, 2 and 19 and the earlier rights are registered in Classes 1, 2, 17 and 19. The challenged CTM had been invalidated. Upon withdrawal of the court action, the case was closed.

Factory Finish : T-487/07 – Interim Order on procedural issues of 20 October 2008 .

Keywords: ECJ/CFI procedural law: Article 19 ECJ Statute – CFI procedural law: Article 114 RP – CFI proceedings: representation of a party – Representation/CFI: UK Patent Attorney Litigator (refused).

The plaintiff sought an Order to the end that one of its initial representatives before the Office, a UK Patent Attorney Litigator, would also be entitled to represent it before the CFI. The 5th Chamber (Vilaras; Prek; Ciuca, rapporteur) rejected the application on the ground that a patent attorney is not a lawyer, relying on Article 19 ECJ Statute and *inter alia* on Rockbass, CFI in T-315/03 and Veramonte, CFI in T-14/04.

Ecoblue : T-281/07 – Judgment of 12 November 2008 (dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of goods on the one hand and services on the other.

The action had been directed against a decision of the 1st Board of 25.4.2007 in Case R 0844/2006-1 relating to a conflict between CTM application "Ecoblue", word mark, and earlier CTM "BLUE".

CTM application	
Ecoblue	BLUE

The CTM had been applied for for a range of services, namely in Class 35 for business consultancy, organisation consultancy, professional business consultancy, arranging and concluding commercial transactions for others; in Class 36 for financial affairs, monetary affairs, capital investment, credit consultancy, credit bureaux; real estate affairs, real estate and mortgage brokerage, real estate management, consultancy with regard to the purchasing and financing of real estate, and in Class 38 for telecommunications services, except the transmission of radio and television programmes.

The earlier CTM is registered in Class 9 for computer operating programs, recorded; magnetic cards; encoded identity cards, magnetic; cards having microprocessors (chips); smart cards having microprocessors; cards for integrated circuits or for microprocessors; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; records; in Class 36 for insurance services; financial affairs; monetary affairs and real estate affairs, and in Class 38 for telecommunications services; services relating to communications by computer terminals; communications by fibre-optic networks; communications by worldwide computer networks.

The opposition had been allowed. By its contested decision, the Board had dismissed the appeal. As a preliminary point, it held that the relevant public was made up of both professionals and the general public in the European Union. With regard to the services in question, it found that those in respect of which registration of the mark Ecoblue is sought are in part similar and in part identical to those covered by the mark BLUE in Classes 36 and 38 of the Nice Agreement. With regard to the marks at issue, it found that the marks Ecoblue and BLUE were visually and phonetically similar to a certain extent. On a conceptual level, they both referred to the colour blue and the component 'ECO' was not sufficient to distinguish the two signs significantly. In the light of those findings and the fact that the term 'eco' can be considered to be descriptive of an essential quality of the services referred to in the application for registration of the Ecoblue mark, and therefore to have a rather low degree of distinctiveness, the likelihood of confusion was established. According to the Board, the relevant public could perceive the mark Ecoblue as a variation of the mark BLUE and, consequently, the services at issue as having the same commercial origin. The 1st Chamber of the CFI (Tiili; Dehousse; Wiszniewska-Bialecka, rapporteur) confirmed these findings.

Limoncello-II or **Limoncello di Capri**: T-210/05 – Judgment of 12 November 2008 (only in IT, FR); action dismissed, Office practice confirmed (see also Limoncello-I, CFI of 15 June 2005 in Case T-7/04).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been initiated against a decision of the 1st Board of 18.3.2005 in Case R 0646/2004-1 relating to a conflict between CTM application "Limoncello di Capri" (figurative trade mark) and an earlier Spanish right in the word "Limonchelo".

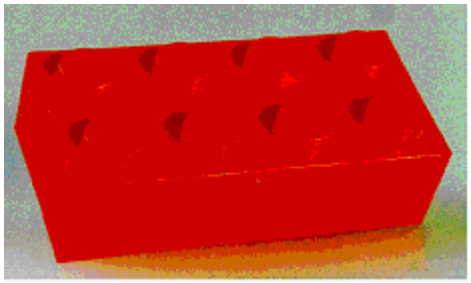
CTM application	
	Limonchelo

The CTM had been applied for in Classes 30, 32 and 33. The earlier Spanish right is registered for a range of goods in Class 33, and the opposition based on it had been directed against the goods in Classes 32 and 33 in the CTM application. The opposition had been allowed and the 1st Chamber of the CFI (Tiili, rapporteur; Dehousse; Wiszniewska-Bialecka) confirmed these findings. See also Limoncello-I, 3rd Chamber of the CFI of 15.6.2005 in Case T-7/04 (opposition rejected).

Lego Brick or **Red Lego Brick**: T-270/06 – Judgment of 12 November 2008 (action dismissed, Office practice confirmed).

Keywords: CFI proceedings: filing of legal material for the first time – Board proceedings: removal of a Member of the Board, Article 132 CTMR – Board proceedings: request for a hearing – OHIM proceedings/examination: opinion of experts – Types of signs: 3D – 3D signs: shape of the product itself – Absolute grounds for refusal: doctrine of technical functionality, Article 7(1)(e)(ii) CTMR – Article 7(1)(e) and Article 7(3) CTMR.

The action had been directed against a decision of the Grand Board of 10.7.2006 in R 0856/2004-G relating to a CTM application filed by Lego A/S on 1.4.1996, a 3D sign, consisting of a red Lego brick.



The goods in respect of which registration had been sought are in Classes 9 and 28, namely in Class 9 scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images; magnetic and electronic data carriers, recording discs; recorded computer programs and software; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; recorded computer programs and software; fire-extinguishing apparatus; and in Class 28 games and playthings; gymnastic and sporting articles, and decorations for Christmas trees.

On 19.10.1999, the sign had been registered as a CTM. On 21.10.1999, Ritvik Holdings Inc., the predecessor of Mega Brands, Inc., intervener in the present case, had applied for a declaration of invalidity pursuant to Article 51(1)(a) CTMR in relation to 'construction toys' in Class 28, on the ground that that registration is contrary to the absolute grounds for refusal laid down in Article 7(1)(a), (e)(ii) and (iii) and (f) CTMR. On 8.12.2000, the Cancellation Division had stayed the proceedings, pending delivery of the judgment of the ECJ in case C-299/99 Philips [2002] ECR I-5475. The proceedings before the division were resumed on 31.7.2002 and by decision of 30.7.2004 the Cancellation Division declared the registration invalid with respect to 'construction toys' in Class 28, on the basis of Article 7(1)(e)(ii) CTMR, finding that the mark at issue consisted exclusively of the shape of goods which was necessary to obtain a technical result.

On 20.9.2004, the CTM applicant filed an appeal which had been assigned to the 1st Board. On 15.11.2004, the CTM holder sought the removal of the chairperson of that Board for reasons of partiality, pursuant to Article 132(3) CTMR. By decision in Case R 0856/2004-1, the 1st Board decided that the chairperson originally designated should be replaced by her first alternate.

By fax of 30.9.2005, the CTM holder requested, in view of the complexity of the case, first, that the appeal be the subject of an oral hearing, pursuant to Article 75(1) CTMR, and, second, that the Grand Board be convened, in accordance with Article 130(2) and (3) CTMR. On 7.3.2006, on a proposal made by the President of the Boards, the Presidium of the Boards referred the case to the Grand Board, pursuant to Article 1b(3) of Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of OHIM (OJ 1996 L 28, p. 11). By decision of 10.7.2006 ('the contested decision'), the Grand Board of Appeal rejected the applicant's request for an oral hearing. It also dismissed the appeal as unfounded, holding that, under

Article 7(1)(e)(ii) CTMR, the mark at issue was not registerable in respect of 'construction toys' in Class 28.

The Grand Board considered that the acquisition of distinctive character, provided for in Article 7(3) CTMR, cannot prevent the application of Article 7(1)(e)(ii) CTMR. It also observed, at paragraph 34, that Article 7(1)(e)(ii) CTMR is designed to bar from registration shapes whose essential characteristics perform a technical function, hence allowing them to be freely used by all. At paragraph 36 of its decision, the Grand Board took the view that a shape does not escape that prohibition if it contains a minor arbitrary element such as a colour. At paragraph 58, it dismissed the relevance of the existence of other shapes which can achieve the same technical result. At paragraph 60, it considered that the word 'exclusively', used in Article 7(1)(e)(ii) CTMR means that the shape has no purpose other than that of achieving a technical result and that the word 'necessary', used in that same provision, means that the shape is required to achieve that technical result, but that it does not follow that other shapes cannot also perform the same task. Further, in paragraphs 54 and 55, the Grand Board identified the characteristics of the shape at issue which it considered essential and conducted an analysis of their functionality in paragraphs 41 to 63. The 8th Chamber of the CFI (Martin s Ribeiro; Papasavvas, rapporteur; Dittrich), in essence, confirmed these findings.

(a) CFI proceedings – Filing of legal material for the first time before the court

"(21) It should be noted at the outset that the orders of the German and Hungarian courts lodged by the intervener and the applicant *(plaintiff)* respectively are being relied upon for the first time before the Court.

(22) In that connection, it should be recalled that the purpose of the action before the CFI is to review the legality of decisions of the Boards of OHIM within the meaning of Article 63 CTMR. It is therefore not the Court's function to re-evaluate the factual circumstances in the light of evidence adduced for the first time before it. To admit such evidence is contrary to Article 135(4) of the Rules of Procedure of the CFI, according to which the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal (Case T-128/01 DaimlerChrysler v OHIM(Grille) [2003] ECR II-701, paragraph 18).

(23) It must therefore be held that the intervener and the applicant may not rely on those orders as evidence in relation to the facts of this case.

(24) It must, however, be pointed out that neither the parties nor the CFI itself can be precluded from drawing on Community, national or international case-law for the purposes of interpreting Community law. That possibility of referring to national judgments is not covered by the case-law referred to in paragraph 22 above where the plea is not that the Board failed to take the factual aspects of a specific national judgment into account but that it infringed a provision of Regulation No 40/94, with case-law cited in support of that plea (Case T-346/04 Sadas v OHIM – LTJ Diffusion (ARTHUR ET FELICIE) [2005] ECR II-4891, paragraph 20; Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 16; and Case T-277/04 Vitakraft-Werke Wührmann v OHIM – Johnson's Veterinary Products (VITACOAT) [2006] ECR II-2211, paragraph 71).

(25) It follows that the orders of the German and Hungarian courts lodged by the intervener and the applicant respectively are admissible to the extent that they may be useful in this case for the purposes of interpreting Article 7(1)(e)(ii) of Regulation No 40/94."

(b) Purpose and scope of Article 7(1)(e)(ii) CTMR

"(36) Article 7(1)(e)(ii) CTMR provides that 'signs which consist exclusively of … the shape of goods which is necessary to obtain a technical result … shall not be registered'. Similarly, according to the second indent of Article 3(1)(e) of First Council Directive 89/104/EEC; ´signs which consist exclusively of … the shape of goods which is necessary to obtain a technical result … shall not be registered or if registered shall be liable to be declared invalid'.

(37) In the present case, the applicant essentially complains that the Grand Board misinterpreted the scope of Article 7(1)(e)(ii) CTMR, and in particular the scope of the terms 'exclusively' and 'necessary', by considering that the existence of functionally equivalent alternative shapes using the same technical solution is irrelevant for the purposes of the application of that provision.

(38) In this respect, it should be noted, first, that the word 'exclusively', which appears both in Article 7(1)(e)(ii) of Regulation No 40/94 and the second indent of Article 3(1)(e) of the Directive, must be read in the light of the expression 'essential characteristics which perform a technical function', used in paragraphs 79, 80 and 83 of Philips. It is apparent from that expression that the addition of non-essential characteristics having no technical function does not prevent a shape from being caught by that absolute ground of refusal if all the essential characteristics of that shape perform such a function. Accordingly, the Grand Board of Appeal was right to analyse the functionality of the shape at issue by reference to the characteristics which it considered to be essential. It must therefore be held that it correctly interpreted the term 'exclusively'.

(39) Second, it follows from paragraphs 81 and 83 of Philips that the expression 'necessary to obtain a technical result', which appears both in Article 7(1)(e)(ii) CTMR and the second indent of Article 3(1)(e) of the Directive, does not mean that that absolute ground for refusal applies only if the shape at issue is the only one which could achieve the intended result. The Court held, at paragraph 81, that '[the existence] of other shapes which could achieve the same technical result can[not] overcome the ground for refusal' and, at paragraph 83, that 'registration of a sign consisting of [the] shape [in question is precluded], even if that technical result can be achieved by other shapes'. Accordingly, in order for that absolute ground for refusal to apply, it is sufficient that the essential characteristics of the shape combine the characteristics which are technically causal of, and sufficient to obtain, the intended technical result, and are therefore attributable to the technical result. It follows that the Grand Board did not err in considering that the term 'necessary' means that the shape is required to obtain a technical result, even if that result can be achieved by other shapes.

(40) Third, it should be noted that, contrary to what the applicant claims, the Court of Justice, at paragraphs 81 and 83 of Philips, dismissed the relevance of the existence of 'other shapes which could achieve the same technical result', without distinguishing shapes using another 'technical solution' from those using the same 'technical solution'.

(41) Further, according to the Court of Justice, Article 3(1)(e) of the Directive is intended 'to prevent trade mark protection from granting its proprietor a monopoly on … functional characteristics of a product' and to 'prevent the protection conferred by the trade mark from [forming] an obstacle preventing competitors from freely offering for sale products incorporating such … functional characteristics in competition with the proprietor of the trade mark' (paragraph 78 of Philips). It cannot be ruled out that the functional characteristics of a product which, according to the Court of Justice, must also be left available to competitors are specific to a precise shape."

(42) In addition, the Court stated at paragraph 80 of Philips that Article 3(1)(e) of the Directive 'pursues an aim which is in the public interest, namely that a shape whose essential characteristics perform a technical function … may be freely used by all'. That aim does not therefore relate solely to the technical solution incorporated in such a shape, but to the shape and its essential characteristics themselves. Since the shape as such must be capable of being freely used, the distinction advocated by the applicant cannot be accepted.

(43) It follows from all the foregoing that Article 7(1)(e)(ii) CTMR precludes registration of any shape consisting exclusively, in its essential characteristics, of the shape of the goods which is technically causal of, and sufficient to obtain, the intended technical result, even if that result can be achieved by other shapes using the same or another technical solution.

(44) It must therefore be held that the Grand Board did not err in its interpretation of Article 7(1)(e)(ii) of Regulation No 40/94.2

(45) That conclusion is not called into question by the other arguments put forward by the applicant.

(46) First, in so far as the applicant claims that it is not necessary to interpret Article 7(1)(e)(ii) CTMR extensively because the shape of a product will only rarely satisfy the conditions laid down in Article 7(1)(b) and Article 7(3) CTMR, it must be pointed out that those grounds for refusal pursue different objectives and their application presupposes that different conditions are satisfied. Accordingly, as the Court held at paragraph 77 of Philips, each of those grounds must be interpreted in the light of the public interest underlying it and not in relation to any practical effects resulting from the application of other grounds. That argument must therefore be rejected.

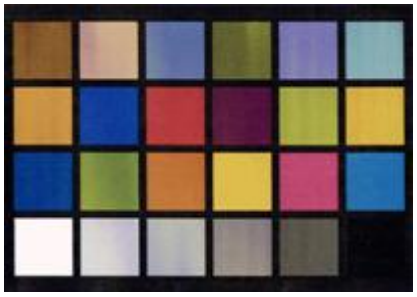
(47) Second, as regards the comparison between trade mark law and patent law, it should be noted that it is based on the distinction between shapes incorporating the same technical solution and those incorporating other technical solutions (see paragraph 33 above). However, it was held in paragraphs 40 to 43 above that such a distinction cannot be drawn. That argument must therefore also be rejected.

(48) Third, it must be pointed out that the argument based on the genesis of Article 7(1)(e)(ii) CTMR was put forward in the proceedings leading to Philips but did not affect the Court's analysis. Moreover, it was rejected by Advocate General Ruiz-Jarabo Colomer at point 41 of his Opinion in this case. That argument must therefore be rejected. "

Farben in Quadraten : T-400/07 – Judgment of 12 November 2008 (only DE, FR; action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness – Types of signs: colour (structured) – Types of signs: geometrical shapes (coloured).

The action had been directed against a decision of the 4th Board of 30.8.2007 in Case R 0030/2007-4 relating to a CTM application which consisted of 24 coloured squares. It had been claimed in Classes 9, 16 and 42.

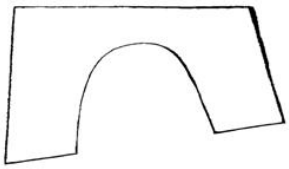


The application had been rejected under Article 7(1)(b) CTMR on the ground of lack of distinctiveness for the goods and services claimed. The 8th Chamber of the CFI (Martin s Ribeiro; Papasavvas, rapporteur; Dittrich) confirmed these findings.

Arc Noir or **Camper**: T-304/07 – Judgment of 5 November 2008 (only in FR, IT; action dismissed; Board decision confirmed).

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

The case had been a conflict between a stylised black arch and a stylised white arch. The CTM application (black arch) had been applied for for a range of goods in Classes 18 and 25.

CTM application	Earlier CTM
	

It had been opposed inter alia on the basis of an earlier UK right (white arch, in Class 25) and an earlier CTM consisting of a stylised white arch and registered for goods in Class 18. The Opposition Division had allowed the opposition as regards Class 25 based on the UK mark and had rejected it for Class 18 on the ground that the marks in question are not similar. In contrast, the Board had allowed the opposition in full, relying on the earlier CTM. The 6th Chamber of the CFI (Meij; Wiszniewska-Bialecka; Vadapalas, rapporteur) confirmed the Board's findings.

Coyote Ugly : T-161/07 – Judgment of 4 November 2008 (only in ES, FR; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of goods vis-à-vis services.

The action had been initiated against a decision of the 2nd Board of 2.3.2007 in Cases R 0165/2006-2 and R 0194/2006-2 relating to CTM application "Coyote Ugly" (figurative trade mark) which had been applied for for a range of goods and services in Classes 9, 41 and 42, amongst which, in Class 41, entertainment services, services for discos, night clubs and cultural activities, and in Class 42 cocktail lounge services, excluding any other services in this class. It had been opposed on the basis of CTM "COYOTE UGLY", word mark, registered in Class 32 for a range of beverages.

CTM application	
	COYOTE UGLY

The Opposition Division had allowed the opposition in respect of the services in Class 42. Both parties had subsequently appealed, and the Board had rejected the CTM applicant's appeal. In contrast, it had partially allowed the opponent's appeal as regards part of the services contained in Class 41 in the CTM application. The 3rd Chamber of the CFI (Azizi; Cremona ; Frimodt Nielsen) agreed.

Gerivital : T-163/07 – Case closed; Order of 27 October 2008

Keywords: Opposition/invalidation: earlier national right acquired in bad faith (no defence at EU level).

The case had been a cancellation case and the action had been brought against a decision of the 2nd Board of 27.2.2007 in Case R 0271/2006-2, relating to cancellation proceedings No 872 C 000986034/1 which had been directed against CTM "Gerovital" (figurative trade mark).

CTM	

The CTM had been registered in Classes 3 and 42. The request had been based on Danish trade mark registration No VR 1996 04962 which had been applied for on 24.4.1992 and which is registered in Class 3. The request for invalidation had been allowed. In its appeal, the CTM owner had requested that the decision of the Cancellation Division be set aside on the grounds that the earlier Danish registration had been acquired in bad faith and, hence, was itself invalid. The Board had dismissed the appeal, holding, in essence, that the validity of national registrations is exclusively governed by national law and, accordingly, it can only be challenged before the competent national authorities. Upon withdrawal of the cancellation request due to an out-of-court agreement, the case was closed.

Flex : T-158/06 – Judgment of 23 October 2008 (dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: descriptiveness.

The action had been directed against a decision of the 2nd Board of 11.4.2006 in Case R 1430/2005-2 relating to CTM application "Flex", word mark, which had been applied for for a range of goods and services in Classes 9, 38 and 42, namely for computer server software; presentation server software; enterprise server software; computer server software for web application development, deployment and execution; computer server software for the production, delivery and presentation of rich web applications; web application development software; computer software development programs; user manuals and instructional books in electronic form; computer software; interactive computer software; computer hardware; computer peripherals and data processing equipment; computer programs for accessing, browsing and searching on-line databases (in Class 9): for electronic transmission of messages, documents and data via computer networks; electronic transmission of audio, video, text, and multimedia content via computer networks; multimedia teleconferencing services provided over computer networks; real time multimedia communications services

provided over computer networks; electronic transmission services; communications services; webcasting services (in Class 38); and for hosting of digital content on computer networks; hosting computer software of others; computer software design, customisation, integration, and analysis for others; computer software consulting services; computer software installation, maintenance and updating services; computer consulting services related to presentation servers and web application development; customising server software for web application development, deployment and execution; computer-related services; computer network and computer systems design, customisation, integration, analysis and consulting services; computer consulting services; design, customisation, implementation and maintenance of network web pages and web sites for others; providing on-line databases; computer programming services (in Class 42).

It had been rejected on the ground that the sign is descriptive for the claimed goods and services. On appeal, the Board had annulled the examiner's decision in so far as the examiner had refused registration of the sign in respect of 'computer hardware; computer peripherals and data processing equipment' in Class 9 and all the services included in Class 38. The Board had held that the sign could be registered for those goods and services. It had dismissed the appeal as to the remainder. The 7th Chamber of the CFI (Forwood; Sváby, rapporteur; Truchot) agreed.

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

Visual Map : T-260/08 – Office response filed.

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

The case is directed against a decision of the 1st Board of 15.4.2008 in Case R 0700/2007-1, relating to opposition proceedings against CTM application No 3 932 936, "VISUAL MAP", word mark, which had been applied for in Class 44 for optical services, in particular design and adaptation of customized progressive lenses. It had been partially opposed on the basis of VISUAL, a French registration covering, in Class 44:

Optician's services: contactologie, optometry. Detection on anomalies eyepieces. Consulting in physiognomy, namely testing and adjustments of contact lenses, glasses and spectacle frames sight, artificial limbs and artificial implants (artificial eyes), cords and eyeglass chains, sun protection glasses, colour contact lenses (pen sponge, wash cloths, fabric cleaning, products for rinsing and decontaminating for contact lenses). Services of oculists and medical care in field of ophthalmology, medical health care and beauty. Consulting and information in field of health, consulting and information in field of optic; eye care services; services of fitting spectacles and sight testing; health care services and services of nursing home health; services of nursing homes medical and medical laboratories, and services of consulting in pharmacy.

The opposition had been allowed: the contested services in Class 44 were considered to be identical to the services of the earlier mark, given that they were contained in the broader specification of the earlier mark, and a close similarity of the marks, since the addition of "Map" is not capable of differentiating"Visual Map" from "Visual" as perceived by the French public.

Oli/Olay : T-240/08 - Office response filed.

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

The action has been brought against a decision of the 2nd Board of 2.4.2008 in Case R 1481/2007-2 concerning CTM application No 4 059 176, "Oli" (figurative trade mark), which had been applied for in respect of the following goods in Class 3 for perfumery and cosmetic products, cosmetic products which base is made of olive oil, toilet soaps, essential oils, hair restorers and dentifrices, and in Class 5 for pharmaceutical products, sanitary products for medical care, dietetic substances for medical use, baby food, materials for poultices, disinfectants.

CTM application	
	OLAY

It had been opposed on the basis of earlier rights in "OLAY", word mark, registered in Class 3 for bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices, preparations for the cleaning, care and beautification of the skin, scalp and hair, and in Class 5 for pharmaceutical preparations for medical use; pharmaceutical preparations for the treatment of menopausal symptoms; dietetic substances for medical use, dietetic beverages adapted for medical use, medicated herbal based beverages, medicated powder drinks for medical use; herbal preparations adapted for medical use, medicated skin care preparations, medicated essential oils; vitamins, minerals and nutritional supplements. The opposition had been dismissed in its entirety on account of differences between the signs such as to preclude likelihood of confusion, mainly on the following grounds:

The relevant public is made up of average consumers and also, as far as pharmaceuticals are concerned, health professionals. The degree of attentiveness of the relevant public may vary from average to high. In spite of the fact that the signs coincide in their two first letters, they are only similar to a low degree visually because of their endings and because of the figurative element in the mark applied for. These differences are all the more striking given that the signs are short. The signs are aurally dissimilar on account of their endings and no similarity can be found on the conceptual

level. In some Member States, the word 'oli' will be construed as referring to oil. The signs cannot be considered to be similar only because they share the two first letters 'OL'. Such a conclusion would result in recognising the right for the applicant to prohibit the use of any mark starting by the prefix 'OL' which is commonly used in a number of European languages to denote oil. The conflicting goods are often displayed in such a way that consumers are able to examine them visually. The differences between the signs are all the more striking, even in the perception of an averagely attentive public, in view of the fact that the signs are short: the shorter the signs are, the less imperfect their recollection is, because there are less elements that must be remembered.

BioMonitor : T-257/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board of 24.4.2008 in Case R 0466/2007-4 relating to CTM application No 4 556 023, "BioMonitor", word mark, which had been applied for in Class 10 for a range of medicinal apparatus. It had been rejected on the grounds that the sign would merely be descriptive of the goods at issue, given that the target consumers are specialists.

Seroslim : T-201/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action has been brought against a decision of the 2nd Board of 6.3.2008 in Case R 0805/2007-2 concerning CTM application No 4 113 321, word mark "SEROSLIM", which had been filed in respect of the following goods and services: Class 3: bleaching preparations and other substances for laundry use, soaps, perfumery, essential oils, cosmetics, hair lotions and dentifrices; Class 5: pharmaceutical and veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical use, preparations of trace elements for human and animal use, food supplements for medical use, mineral food supplements, vitamin preparations, and, in Class 35, advertising.

CTM application	
Seroslim	Serostim

It had been opposed on the basis of the earlier CTM No 2 405 694, word mark "SEROSTIM", registered in respect of the following goods 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; excluding all kinds of dermatological pharmaceutical products. The opposition had been partially upheld, namely for all the goods in Class 5, and for soaps, hair lotions and dentifrices in Class 3. In respect of the remainder of the goods in Class 3 (that is, bleaching preparations and other substances for laundry use, perfumery, essential oils, cosmetics) and the services in Class 35 (that is, advertising), the opposition had been rejected.

Livensa : T-159/08 – Office response filed.

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

The action has been brought against a decision of the 4th Board of 11.2.2008 in Case R 0960/2007-2, relating to CTM application No 4 062 725, in which the Procter & Gamble Company had applied to register as a CTM the word mark "Livensa" in respect of the following goods in Class 5: pharmaceutical, veterinary and sanitary preparations and substances; 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 *(in its subsequent appeal, the CTM applicant had restricted the list but the Board still had held that there was similarity of goods).*

CTM application	
LIVENSA	LYVELSA

That application had been opposed by Bayer AG, based on earlier CTM No 3 887 891, word mark "Lyvelsa", registered in respect of goods in Class 5, namely pharmaceutical products and substances; diagnostic preparations and reagents for medical use. The opposition had been upheld in its entirety, on the ground that there was a LOC between the marks, due to the identity and/or similarity of the respective goods and the close similarity of the signs.

Roi Analyzer : T-233708 – Office response filed (DE).

Keywords: Absolute grounds for refusal: descriptiveness.

The action is directed against a decision of the 4th Board of 15.4.2008 in Case R 1525/2006-4 relating to CTM application No 4 866 042, "ROI ANALYZER", word mark, which had been applied for for a range of goods and services in Class 9, *inter alia* for software, in Class 35, *inter alia* for consulting, and in Class 42, *inter alia* for consulting in relation to data processing in the area of production, staff management and quality management. It had been partially rejected on the ground that ROI stands for "Return on Investment" which is a technical term in the area of consulting and evaluation of investments.

Diacor/Diacol : T-258/08 – Office response filed.

Keywords: Opposition: proof of use (POU) – POU/language of the proceedings: when translation not necessary – Use: different from registration – Opposition: likelihood of confusion (LOC).

The action had been directed by Mr Matthias Rath, domiciled in Cape Town (South Africa), against a decision of the 2nd Board of 30.4.2008 in Case R 1630/2006-2 relating to opposition proceedings against CTM application No 688 929, "Diacor", word mark. It had been applied for by the plaintiff in Classes 5, 16 and 41 for food supplements, dietetic supplements, vitamins, minerals; books, newspapers, periodicals; printed matter; instructional and teaching material (except apparatus) and for providing of training, education, tuition, correspondence courses, further education, consultancy all in the field of healthcare and nutrition; publication of books, newspapers, and periodicals.

CTM application	
Diacor	Diacol PORTUGAL

It had been partially opposed, namely as regards Class 5, on the basis of "Diacol Portugal" (figurative trade mark), registered in 1936 for goods in Class 79 of the national classification of goods in effect at the time, which now corresponds to Class 5, covering pharmaceutical products, bandage materials, disinfectants and veterinary products. The opposition had been fully allowed, in essence on the following grounds:

The evidence of use of the earlier right shows that the opponent has marketed a pharmaceutical product under the name 'Diacol' in Portugal throughout the relevant period. Although the name of the medicine appears as a figurative mark on the leaflets, the evidence proves that the mark was also used as the word 'Diacol' and that the relevant pharmaceutical product became known under this name in Portugal . The absence of the word ' Portugal ' from the mark as used does not alter the distinctive character of the earlier mark in accordance with Article 15(2)(a) CTMR. It merely indicates the place of origin of the goods and does not add to the overall distinctive character of the earlier mark. The evidence, taken as a whole, proves long term and constant use of the earlier mark in Portugal , but only in relation to antitussive medicines. The fact that the opponent did not provide the English translations of the evidence of use cannot alter the above finding, as all the relevant information can be safely understood with English knowledge.

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See also the Boards of Appeals 2006 case-law overview; http://oami.europa.eu/ows/rw/pages/OHIM/OHIMPublications.en.do, which provides an annual overview of selected decisions grouped by type of decision.

Please note that the full number including slash has to be entered in our database under 'Appeal Nº', without the letter 'R'.

e.g. Case R 219/2004-1 has to be entered under 'Appeal Nº' as: 219/2004-1

Absolute Grounds – Article 7 CTMR

R 1414/2007-1 – ESA

The CTM applied for was rejected.

1354/2007-1 – Whisky Bottle

Relative Grounds – Article 8 CTMR

R 0404/2008-2 – CUORE BIANCO

Absolute Grounds – Article 7 CTMR

Absolute Grounds – Article 7(1)(h) CTMR – emblem – ratio legis

Decision of the First Board of Appeal of 19 November 2008 in Case R 1414/2007-1 – ESA (German)

R 1414/2007-1 – ESA – The application concerned chemicals for processing semi-finished products for semiconductors and silicon wafers in Class 1, apparatuses for the manufacture of semiconductors and micro-electronic semiconductors in Class 7 as well as planning and designing of apparatuses for the manufacture of said products.

The abbreviation ESA stands for 'European Space Agency' and is protected under Article 6 ter Paris Convention. One of the tasks of the Agency is the testing of semiconductors and semiconductor products. Consequently, there was found to be a link between the goods and services applied for and the tasks of the Agency. Thus, it was held that the registration of the letter combination ESA was therefore capable of creating the impression among the public of a link between the applicant and the Agency, or at least misleading the public as to the existing of a link between the applicant and the organisation.

Furthermore, the Board followed the outline of the judgment of the CFI in Case T-0127/02, ECA and not of the judgment of the CFI in Case T-0215/06, RW (figurative mark). The Board considered that the *ratio legis* of the CTMR is not to distinguish between trade marks for goods and trade marks for service, but to treat both in the same way. Consequently, Article 7(1)(h) CTMR applies also to service marks

The CTM applied for was rejected.

Absolute Grounds – Article 7(1)(b) CTMR – distinctiveness – disclaimer

Decision of the First Board of Appeal of 12 November 2008 in Case R 1354/2007-1 – Whisky Bottle (3D-Mark)

R 1354/2007-1 – Whisky Bottle (3D-Mark) – The Board accepted the disclaimer for the terms '12 YEARS OLD' and 'SINGLE MALT', both incorporated on the front side of the bottle.

The Board considered that the level of attention of the average consumer of whisky is rather high and orients itself, when purchasing whisky, on the mark; this applies also with respect to consumers of cheap whisky.

The Board held that the term 'BEN BRACKEN' which was incorporated on the bottom of the bottle, and thus will not be visible if the bottle stands in a shelf, is still able to give the trade mark applied for distinctive character. Consumers are not used to see a bottle of whisky with no trade mark at all; consequently, they will check the bottle and when taking in the hands, see the trade mark on the bottom of the bottle.

The CTM applied for was accepted for publication.

Relative Grounds – Article 8 CTMR

Relative Grounds – scope of opposition – ultra petita – substantial procedural violation – duty of the Boards of Appeal

Decision of the Second Board of Appeal of 3 December 2008 in Case R 0404/2008-2 – CUORE BIANCO (Fig. Mark)/BIANCO (English)

CTM applied for

R 0404/2008-2 – CUORE BIANCO (Fig. Mark)/BIANCO – The opposition was directed only against some goods in Class 9 and some services in Class 35 and not against all goods and services applied for in these classes. Consequently, the Opposition Division could not move beyond the matter in dispute and decide matters beyond the scope of the pleadings ultra petita. The Board was obliged to correct this substantial ex officio procedural violation.

With respect to the comparison of the signs, the Board held that signs are similar. The CTM applied for consisted also of some figurative elements, which could be neglected since they will be considered as merely decorative. Since the goods and services for which the earlier trade mark is registered and the goods and services of the CTM applied for, against which the opposition is directed, are identical or obviously similar, the common element 'BIANCO' gives the signs an overall phonetic, visual and conceptual similarity, which is such that the relevant public in Denmark confronted with the trade marks will be misled into thinking that the trade marks have a common commercial origin.

The contested decision was annulled and the opposition allowed in its entirety, and the CTM applied for was rejected as far as requested in the notice of opposition.