



Contents

The James Nurton interview with Gabriella Modiano, Managing Partner, Modiano & Associati, Milan

Page 2

Community Trade Mark
"DOLLY DONUT" CTM ruled invalid

Page 3

Country overview: Austria & the Community Trade Mark

Page 3

Registered Community Design

Japan – OHIM Meeting on Design

Page 4

Country overview: Austria & the Registered Community Design

Page 6

E-business at OHIM

E-business roundup (2008)

Page 6

More news

OHIM Service Charter

Page 7

How users can interact online with OHIM

Page 7

Monthly statistical highlights June 2008

Page 8

Case-Law

Latest trade mark and design news from Luxembourg

Page 8

New Decisions from the Boards of Appeal

Page 24

Editorial Team:

Reg Rea, Ian Harrington
Mikael Wesslegard

Contributors to this edition:

Nicasio Agustina, Alexandra Apostolakis, Christoph Bartos, Cayetana Borrego, Christian Jacob, Christian Jacob, Herbert Meister, James Nurton, Martin Schlotelburg, Wouter Verburg, Nicolas Vigneron

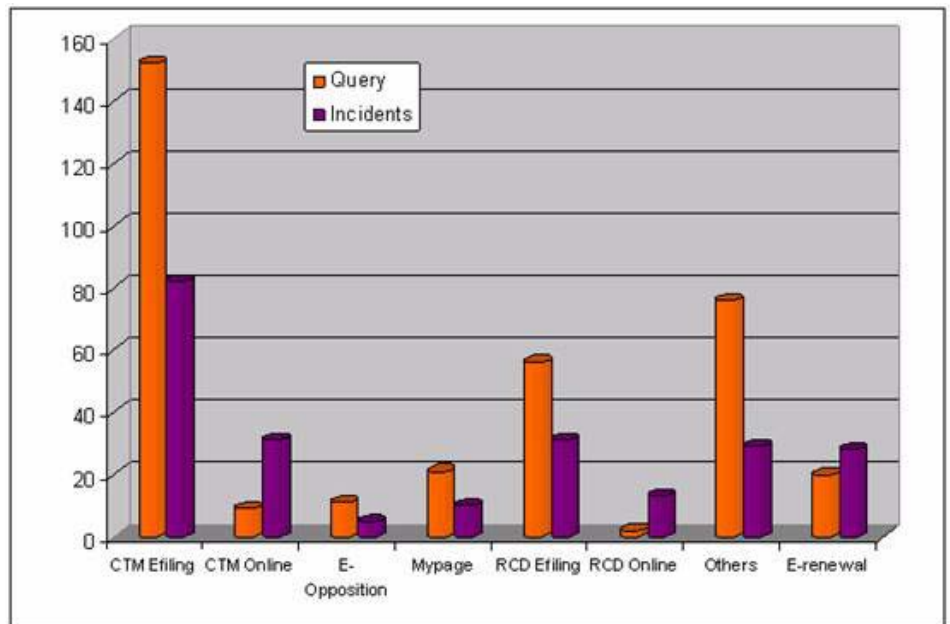
subscribe@oami.europa.eu
unsubscribe@oami.europa.eu

What support can you expect from the OHIM e-business hotline?

Since OHIM launched the e-business hotline more than 18 months ago, the service has become increasingly popular with the user community.

The hotline is available to anyone experiencing a problem when using OHIM's e-business services (from e-filing, to CTM-ONLINE). It is open every working day from 07.30 to 17.30 and can be reached by phone or e-mail.

The number of calls has increased over the past 18 months from around 200 to just over 600 per month. On average, 60% of calls are enquiries related to how the tools work or some practical aspects. The remaining 40% are technical incidents affecting the correct functioning of the e-business tools.



It is interesting to note that CTM e-filing accounts for 50% of queries and technical incidents. However, it is also OHIM's most popular e-business application, and the rate of instances was 1.5 per 100 CTM applications.

As indicated by the E-business Users' Group during the last meeting held in April 2008, it seems that users are tending to experience fewer incidents. However, the Users' Group also stressed that some improvements should be made in the performance and reliability of e-business tools, and in particular of e-filing and MyPage, which can be considered as OHIM's key e-business tools. OHIM is committed to improving these aspects and is continuing to monitor them closely via a shadow users scheme.

The main purpose of the e-business hotline remains to provide users with practical support to overcome the technical or other problems they may face when trying to submit a CTM application electronically or to access MyPage, for instance.

Most of the incidents can be solved very quickly by the e-business hotline experts and OHIM would encourage users to contact the hotline whenever they experience a problem with the e-business tools. The best solution is to contact us when you receive the first error message, rather than trying several times without success.

"Some users wait until they are frustrated by repeated failures before contacting us. Our help desk experts advise against wasting time fighting against the system – many problems can be solved in a couple of minutes," says OHIM e-business advisor Nicolas Vigneron.

OHIM is also committed to certain standards on the accessibility of e-business tools and for e-business hotline. Those standards and results are published on a quarterly basis as part of the Service Charter that may be consulted on the website. [See OHIM Service Charter.](#)



The James Nurton interview with Gabriella Modiano, Managing Partner, Modiano & Associati, Milan

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 Gabriella Modiano, an Italian attorney, about the CTM, IP changes in Italy and the popularity of geographical indications

When did you become interested in trade marks?

I'm the third generation of Modianos dealing with IP matters, so I was born into it. I was running round the office when I was five!

My father founded the firm with my grandmother in 1950 when he was a young patent attorney. It is still a very large family business. My two sisters, mother and cousin all work here as well as 200 other people.

The firm has always been focused on IP. Patents were more important in the early days but trade marks have become more and more prominent around the world as brands and marketing have grown in importance. The big change probably came in Europe in the 1980s, after the US.

Today patents and trade marks are both important for the firm. Even in heavy industry the trade mark is important if you look at a company like Boeing. So our work is half and half patents and trade marks, with designs also making up a small amount. Designs are not always taken into consideration by industry, maybe because they get old very quickly.

Around 75% of our clients are domestic and 25% are non-European clients who need a European trade mark attorney. The fashion and luxury goods industries are among the most active as they are very brand-oriented. But technology companies who sell hardware also face trade mark problems, especially in developing countries, so they want to get protection at home too.

We file about three to four hundred CTMs per year, and slightly more Italian national marks. The national marks are mainly for clients like small shops who do not export.

Do you recommend clients use the CTM?

Usually we suggest clients think about the CTM as it's the cheapest way to obtain the largest protection. The EU in that respect at least is united. Price is a factor that clients understand well.

So would you welcome an even lower price?

I have to say yes. But it is already so cheap that even if prices were reduced by 20% I don't think it would change the demand too much. A CTM costs the same as two or three national marks and covers almost 30 countries.

Aside from cost, what are the best aspects of the CTM system?

Having to deal with just one procedure is a plus. Leaving oppositions to third parties makes for a more streamlined examination – and people can say things directly in an

opposition. It is a good solution to balance the interests of the applicant and those of third parties.

In Italy, an opposition system is also going to be introduced. It is in the new law and the rules should be implemented in a few months: there is already a proposal in parliament.

Will that lead to many changes in Italy?

It will change a lot. Today the only way to cancel a trade mark is to file a nullity claim which is very expensive. We don't yet know how quickly the PTO will act on oppositions but they will hopefully be cheaper than litigation and they will also be dealt with by specialised examiners.

Domestic clients are not normally that aggressive – Italian companies don't file lawsuits as often as in some other countries. I don't know whether oppositions will change that: it may change in a few cases. IP has changed a lot in Italy in the past few years, with a new unifying code and specialist IP courts. It reflects the greater awareness of IP protection.

How can the CTM system be improved?

The main area where they can improve is speed, both in the speed to register and for oppositions: a very short procedure can take many months.

OHIM needs more staff but also better training for formality officers. The high level of work at the beginning has slipped now and I think the quality level is not where it should be. But there is a balance to be found between being quick and being thorough.

Do you use the Madrid Protocol?

It's difficult to explain to clients as they have to pay everything at the beginning, so they think it's more expensive even though it's not. Often we'll suggest filing two trade mark applications – one CTM and one International Application for other countries that are of interest. If the client is sufficiently international-oriented then we use the CTM as a basis for the International Registration, but that depends on the budget and sophistication of the client.

What is the most unusual CTM you have worked on?

There are many, but one that was interesting was for the words "Made In Italy", which was for a client that published a magazine where producers of Italian products advertised their products and it was distributed overseas. The name was registered in Italy and the client decided to file at CTM level. We filed a word version, which was rejected, and a slightly graphical version that went through. I remember we had to prove some use but we got it registered.

Geographical indications seem very popular in Italy. Why is that?

There are not many countries that are so sensitive to this issue as it affects wine, cheese, meat and other foods and beverages. GIs are very popular now in Italy and are a good way to promote originality and recognition and also give customers security. We have many clients who use these kinds of brands as a way of using IP in a more public way. It is not a private individual or company but a consortium and gives protection and security.



What are the big challenges for the future?

What we're increasingly seeing is the mixture of trade marks and the Internet. The latest example is the planned expansion of the domain name system, with more top-level domains. It shows again that the virtual world is becoming increasingly real. There are problems with domain and trade mark use, so the top-level domain being opened up will be very interesting. I expect it will be an evolution with some bumps. A lot will depend on the sophistication of the users. As attorneys, we're like doctors: we only ever see the patients who have illnesses, not the healthy ones. The healthy patients will avoid problems by registering their rights, but others won't be aware and will find things more difficult.

The most important thing is that trade mark practitioners become aware of the importance of the Internet – so we can advise clients and then it's their job to decide. Internet problems used to be treated as an IT issue but now everyone agrees it is a legal problem.

So will there be a fourth Modiano generation in IP?

Maybe, but we're still working on it. After all, I am not that old!

Community Trade Mark

“DOLLY DONUT” CTM ruled invalid

The figurative Community trade mark DOLLY DONUT has been declared invalid following an application by the owner of the DONUT trade mark, which is well-known in the Spanish bakery and pastry sectors.



The DOLLY DONUT CTM was registered in 1997 by an Austrian company, in classes covering a range of goods and services including bakery products, restaurants, beverages and clothing.

The applicant, Panrico S.A., filed an invalidity request on relative grounds in 2006, based on four earlier Spanish trade mark registrations of the word DONUT covering a similar range of goods and services, and a fifth International trade mark registration for DONUT applied with effect in Portugal.

The applicant asked for cancellation on the ground of likelihood of confusion due to the similarity of signs, and identity and similarity of the goods and services. It was also argued that insofar as the as the goods and services were not similar, Article 8(5) CTMR was applicable as the earlier marks enjoyed reputation and the use of the registered sign would result in a detriment or unfair advantage of their distinctiveness or repute.

Evidence submitted in support of the reputation of the earlier DONUT marks included market studies, certificates issued by several chambers of commerce and ANDEMA, and a report of Young & RUMICAM certifying that DONUT was a reputed trade mark.

The Cancellation Division found that the DONUT trade mark, used intensely since 1962, was according to the evidence provided “one of the most reputed trade marks in Spain in the bakery and pastry sectors”. It was known by over 99% of the public in general, and had enjoyed this reputation for years. While the market studies cited were not obtained before the CTM was filed, they clearly showed that the trade mark, DONUT, must have been reputed at the date of filing the CTM.

Ruling that the DOLLY DONUT trade mark (CTM N° 659904) was invalid, the Cancellation Division said that the marks were similar as both shared the element “DONUT” which was a reputed trade mark in Spain for “confectionery and pastry products, in particular a round shaped dough biscuit”. The challenged goods and services were all related to the foodstuff sector and the goods in class 25 (clothing, footwear, headgear) served usually as a promotional product for all kind of reputed trade marks. A mental association of the goods and services with the goods of the reputed mark, DONUT, was therefore unavoidable.

The Division concluded: “The Office considers it more likely than not that a substantial part of the general public knows the mark, DONUT, and associates it with the reputed trade mark, thus use of the challenged CTM would take unfair advantage or be detrimental to the distinctive character or repute of the earlier mark.”

Referring to past proceedings, the Cancellation Division noted that new evidence showing the repute of the trade mark DONUT in Spain justified that the assessment on Article 8(1) (b) CTMR and 8(5) CTMR was different to the one maintained in the decision No 519/2002, dated 28/02/2002, of the Opposition Division.

Furthermore the decision in the joined cases T-333/04 and T-334/04 dated 18/04/2007 of the Court of First Instance in Luxembourg stated in paragraph 48 that DONUTS was not generic in Spain and that average consumers perceived it as distinctive in relation to pastry. In the said decision of the CFI it was considered that DONUT was a dominant component in the challenged mark, despite other verbal and figurative elements.

Country overview: Austria & the Community Trade Mark

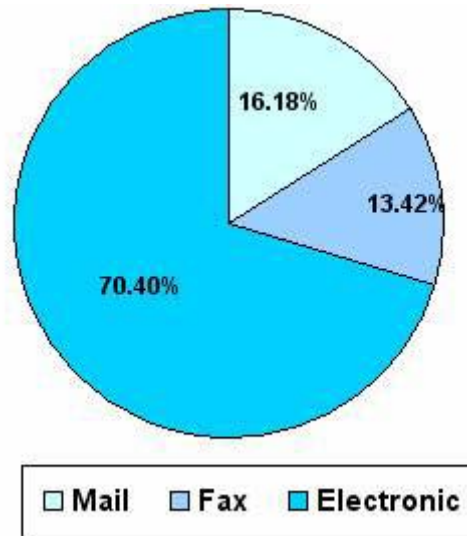




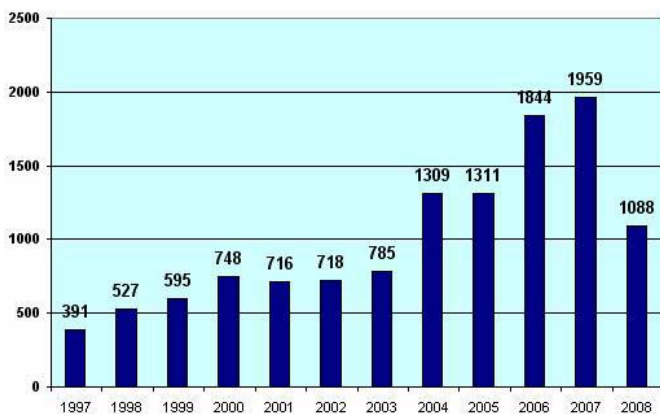
Austria joined the EU in 1995, and has a population of 8.3m. A federal republic consisting of nine states, Austria has a mixed industrial and agricultural economy, while tourism is also an important source of income.

GDP growth was 0.7 % higher in the first quarter of 2008 compared with the previous quarter, in line with the EU average. The service sector accounts for 68% of GDP followed by industry (30%) and agriculture (1.6%).

Austrian interest in the CTM is high, with 1 950 filed last year and a total of almost 12 000 filed to date.



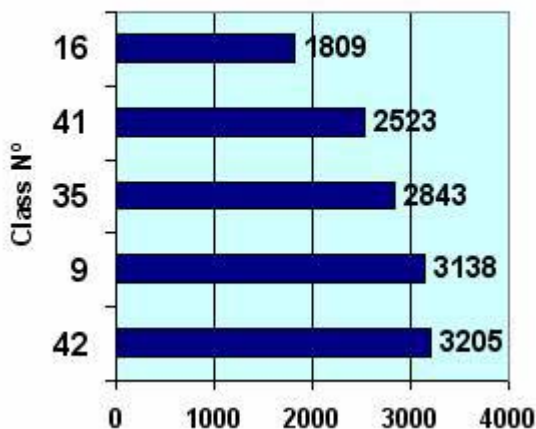
AUSTRIA - CTM Filing Evolution
(Total CTMs: 11 661)



| Word | Figurative | 3-D | Colour | Other |
|---------|------------|--------|--------|--------|
| 58.40 % | 40.75 % | 0.61 % | 0.13 % | 0.12 % |

Word marks are the most popular with Austrian enterprises and account for 58% of applications, followed by figurative marks (41%). The most popular goods and services applied for are in classes 42, 9 and 35.

AUSTRIA - Top Classes Filed (Nice)



E-filing is the most popular filing route for Austrian businesses and their intermediaries, accounting for more than 70% of all filings at present, followed by fax at 13% and mail at 16%.

Top 10 Austria-based owners by number of CTMs filed

| Company | CTMs |
|-----------------------------------|------|
| Auer | 438 |
| NOVOMATIC AG | 275 |
| Red Bull GmbH | 100 |
| Austria Tabak GmbH & Co KG | 75 |
| T-Online.at Internet Service GmbH | 70 |
| Fabasoft AG | 59 |
| Zumtobel Staff GmbH | 55 |
| XXXLutz Marken GmbH | 53 |
| 11er Nahrungsmittel GmbH | 51 |
| MARESI TRADEMARK GmbH & Co KG | 50 |

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

| Representative | CTMs |
|----------------------------------|------|
| SONN & PARTNER PATENTANWÄLTE | 391 |
| TORGGLER & HOFINGER | 378 |
| Hofmann | 301 |
| SCHÖNHERR RECHTSANWÄLTE GMBH | 247 |
| Atzwanger | 221 |
| SCHÜTZ & PARTNER | 209 |
| KOPECKY & SCHWARZ | 159 |
| BEER & PARTNER PATENTANWÄLTE KEG | 139 |
| WILDHACK JELLINEK | 138 |
| Gibler | 134 |

Community Design

Japan – OHIM Meeting on Design

Design experts from the Japanese Patent Office (JPO) and OHIM met for the fourth time earlier this month to exchange experience with regard to the procedural and substantive aspects in the registration of designs.

The annual bilateral meeting on design supplements the existing 'Trade Mark Trilateral' meetings as an institutional cooperation mechanism each year to discuss projects of mutual interest that would benefit OHIM's users. Just as in

trademark matters, the meeting on design has the fundamental objective of harmonizing working methods, procedures and practices so that applicants do not encounter divergent criteria when filing trade marks at each of the Offices.

The meetings are hosted by the JPO and OHIM in turn. The previous meeting was held in Tokyo in June 2007.

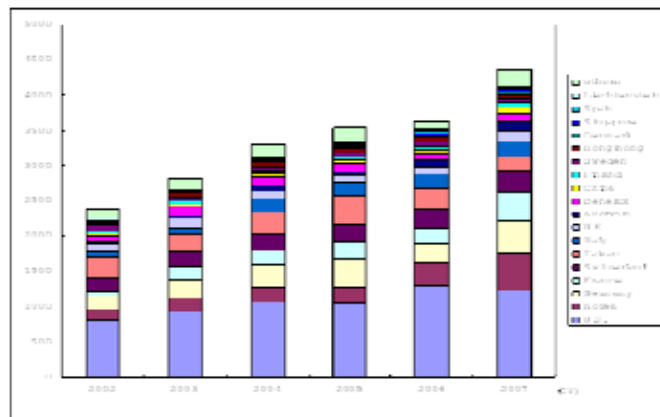
Statistical Information

In the latest meeting on 9 July 2008 in Alicante, the JPO delegation made a report on the recent statistical data of Japanese design applications, together with a brief review of the JPO organisational chart and the design examination procedures.

The following information was given by the Japanese delegation about the trends in 2007:

- Statistics: 2007 was the third year for the JPO with declining design filing figures (2004: 40 700; 2005: 39 300; 2006: 36 700; 2007: 36 500). While domestic filings are decreasing - one of the reasons given was the higher use of partial designs; another reason was that Japanese companies are now focusing IP investments more on the Chinese market - foreign filings are growing (1st USA, 2nd Korea and 3rd Germany).
- The top two classes of Japanese Classification for all the design applications received by the JPO were the following:
 - H (Electric and Electronic Machinery and Instruments, Communication Machinery and Instruments)
 - F (Office Supplies and Merchandising Goods)
 - D (Housing equipment)
- Partial design applications are increasing
- There is a gradual increase in design filings claiming a priority right based on an OHIM application, the top three were:
 - B (Clothing and Personal Goods) – 2nd place in 2006
 - J (Common machinery and instruments)
 - F (Office Supplies and Merchandising Goods) – 1st place in 2006
- Total staff involved in design examination: approximately 60 design examiners and less than 60 search examiners.

Interestingly, the geographical distribution of applications filed with the JPO by users from outside Japan shows the US as the most important contributor, followed by Korea and Germany as indicated in the next figure:



More than half of the applications originating from European users fall into three groups: clothing and personal goods; common machinery and instruments; and office supplies and merchandising goods. The three groups preferred by Europeans add up to only a quarter of all the design applications filed with the JPO. Non-European users are strongest in the field of electric and electronic machinery and instruments, communication machinery and instruments.

Performance and quality indicators

The JPO delegation reported that the average time for a first office action (FA) and second office action (SA) remained constant on levels of around seven months for FA and 12 months for SA. In contrast, OHIM, which carries out only an examination of formalities before registration, manages to have 75% of all designs registered and published within six weeks after receipt of the application.

When comparing JPO and OHIM practices the JPO delegation explained that:

- JPO is currently drawing up guidelines for screen design examination, which could also be of interest for OHIM, particularly in the field of animated icons. Both parties agreed to follow-up this issue.
- Certain problems may exist with OHIM priority documents that relate to designs that do not fully comply with the stricter JPO requirements on views, (the JPO accepts a priority if the RCD discloses the same features as the later Japanese design application, but if that one discloses more features than the RCD, the priority can be at risk). This issue could be a possible future discussion point for the next JPO-OHIM examiner meeting.

Future working program

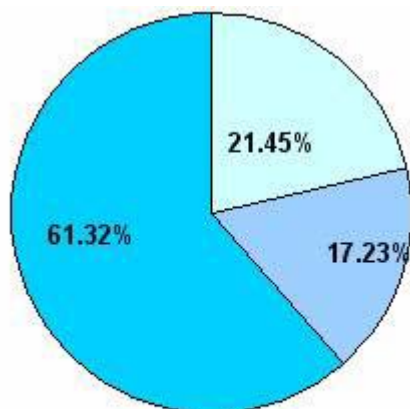
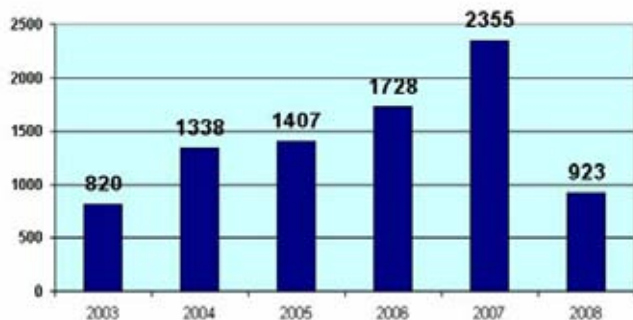
The next JPO-OHIM meeting on design, hosted by the JPO in Tokyo towards the end of 2009 or in 2010, will probably be combined with a series of seminars organised by OHIM together with partners in Japan and Korea. OHIM is also interested in enlarging the current bilateral set-up in order to include the USPTO for the benefit of users operating on a global scale.

Country overview: Austria & the Registered Community Design

The first Austrian filings of RCDs were made 2003, with over 800 designs registered when the Community design became available. Altogether, more than 8 500 Austrian designs have been registered. Last year the number topped 2 300 and in 2008 so far, there have been over 900 to date.

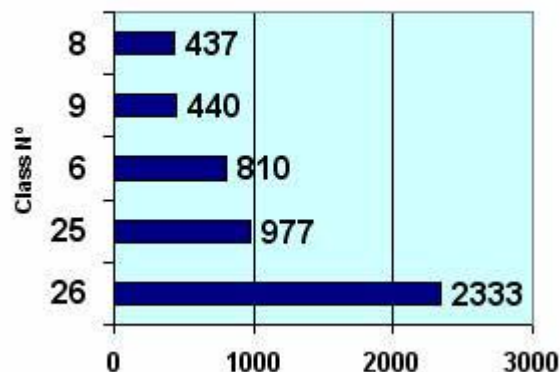
The most popular classes for design owners are 26, 25 and 6. The most popular filing route for Austrian owners is via the Internet, which accounts for 61%, followed by fax (17%) and mail (21%).

AUSTRIA - RCD Filing Evolution
(Total RCDs: 8 571)



Mail
 Fax
 E-Filing

AUSTRIA - Top Classes Filed (Locarno)



Top 10 Austria-based owners by number of RCDs filed

| Owner | RCDs |
|----------------------------------------------------|-------|
| EGLO LEUCHTEN GMBH | 1 949 |
| SIRO Beschläge- und Metallwarenfabrik GmbH | 256 |
| TOPIC GmbH | 224 |
| MK Illumination Handels GmbH | 179 |
| 'FREY WILLE' GmbH & Co. KG. | 168 |
| Giesswein Walkwaren AG | 159 |
| Neuhofer | 103 |
| SILHOUETTE International Schmied AG | 100 |
| EPA Europäische Plakat- und Außenwerbbehöding GmbH | 81 |
| DANA Türenindustrie Gesellschaft m.b.H | 78 |

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

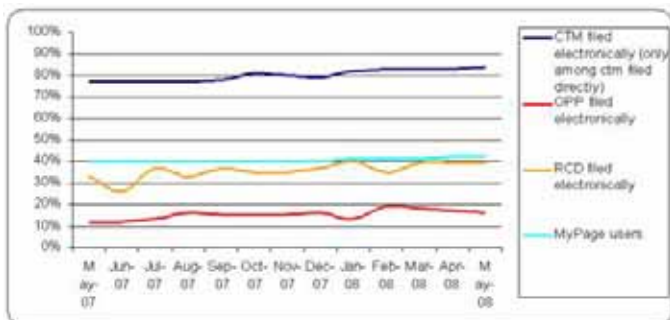
| Representative | RCDs |
|---------------------------------------|------|
| Lechner | 542 |
| TORGGLER & HOFINGER | 522 |
| WILDHACK JELLINEK | 367 |
| HÜBSCHER | 331 |
| BARGER, PISO & PARTNER | 232 |
| DR. LINDMAYR DR. BAUER DR. SECKLEHNER | 216 |
| SONN & PARTNER PATENTANWÄLTE | 203 |
| Fankhauser | 200 |
| SCHÖNHERR RECHTSANWÄLTE GMBH | 197 |
| KOPECKY & SCHWARZ | 152 |

E-business at OHIM

OHIM e-business roundup (2008)

Statistical summary

- The use of the CTM e-filing web form is steady at above 80%.
- The use of RCD e-filing has increased to over 40%
- Oppositions against CTM applications received electronically - 17%.
- MyPage users represent around 40% of CTM applications filed.



State of play of future projects

Service - New version of e-Communication:

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

Status - OHIM has started the final testing phase

Service - New version of CTM E-filing:

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

Status - OHIM has started the development phase

Service - New version of electronic filing of RCD applications

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

Status - OHIM has started the development phase

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

OHIM Service Charter

The figures for the Office's performance against the standards published in the OHIM Service Charter in the second quarter of 2008 are now available on the website. The figures show that during the quarter, 74% of CTM registrations were published within 25 weeks (30% of CTM applications lead to at least one objection in examination). In the second half of this year, for CTM applications where the optional national searches are not requested, the target is to have 70% of applications published within 11 weeks.

For full details of OHIM's performance on accessibility, timeliness and quality, [see the OHIM Service Charter](#)

How users can interact online with OHIM

The new OHIM website was launched as planned on 1 July, and in general has been well received by users. The site is intended to make the tools professional users need to register trade marks and designs more accessible, and at the same time welcome newcomers. OHIM is continuing to work to improve the user experience and a number of interactive services are now on offer.

E-mail alerts

A new service has been introduced allowing users to receive regular e-mail notices of changes in "news" and "legal references". The first website e-mail alert will be issued on Friday 1 August. From September, alerts will start to be issued on a weekly basis - every Friday afternoon.

Subscribe to the OHIM website e-mail alert service

It is very easy to sign up for this free service and to opt-out afterwards if you change your mind. The "subscription" link is: <http://oami.europa.eu/ows/emailalert/subscription/subscribe.do>

Select the topic(s) you are interested in

All topics

Legal references

News, Events and Multimedia

Select language

-Select-

Once on the "subscription" page, use the tick-boxes to select if you wish to sign up for one or both alerts, and then use the language selection box to set the language in which you wish to receive information.

Provide your email address

Email address:

Re-enter email address:

Confirm

Type the code shown below:

o f r e r e r

You need to enter your e-mail address twice – to guard against typing errors – and also copy a simple computer-generated codeword, which is case-sensitive. Once you click on the blue "subscribe" button, you will be sent an e-mail confirmation, which you need to reply to within three days. To unsubscribe, just select the "unsubscribe" link at the top of the subscription page.

OHIM online discussions

New OHIM website

Reg Rea : Welcome to the moderated discussion on "The New OHIM Website". As OHIM's Web Editor, I am hosting this first discussion in order to demonstrate the discussion tool and to get feedback on the new site. The discussion is open for advance questions now and I will be present for a "live" question and answer session from 1200 to 1300 (Central European Time) on Thursday 3 July. Some questions may be answered together if they deal with essentially the same issue, but we will try to deal with all the topics raised. Afterwards an edited version of the discussion will be posted on our website.

dian : hello Reg, when do you plan to open the forums?

Reg Rea : This discussion is open now for advance questions and there will be a "live" question and answer session on Thursday at the time indicated above.

amy : how often will you be holding these discussions? and on what topic?

Reg Rea : We are currently reviewing these questions. Users are welcome to suggest topics.

The first OHIM online discussion took place on 3 July on the topic of the new OHIM website. A total of 12 participants took the opportunity to ask questions, make comments or ask for corrections. An edited version of the first discussion is available on the website at:

<http://oami.europa.eu/ows/rw/pages/OHIM/news/discussion1.en.do>

A programme of future topics for discussion is being drawn up from September onwards and we will also be making use of the new online polling tools to consult users about what topics they would like to be tackled.

Monthly statistical highlights June 2008

| | |
|--------------------------------------------------------|--------|
| Community trade mark applications received | 7 149 |
| Community trade mark applications published | 13 418 |
| Community trade marks registered (certificates issued) | 7 007 |
| Community trade mark renewal applications | 1 334 |
| Registered Community designs received | 5 348 |
| Registered Community designs published | 6 927 |

- 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
Focus/Micro Focus C-344/07-P

ECJ Developments in pending cases

Corpo Livre: C-90/08-P
El Charcutero Artesano: C-81/08-P
Five Stripes or K-Swiss: C-144/07-P

ECJ Preliminary Rulings

O2 Bubbles: C-533/06

ECJ Preliminary Rulings: Developments in pending cases

Smirnoff Ice or UDV North America: C-62/08
Christian Dior/SIL: C-59/08 8

CFI Judgments and Orders

Boomerang: T-420/03
Gabel/Garel: T-85/07
Blue Soft: T-330/06
Oftasil: T-30/08
RS/RS: T-501/07
RadioCom: T-254/06
Bocksbeutel or Franconian Wine Bottle: T-180/06
Letter "E": T-329/06
Immunocell/Immunorell: T-368/06
Alira/Akira: T-315/07

CFI Judgments and Orders: Developments in pending cases

Famoxin/Lanoxin: T-27/08
Yoghurt Gums: T-25/08
Slim Line: T-36/08
Pinzette (3D): T-78/08
Proxima: T-71/08
Center Shock/Center: T-16/08
Diaquest: T-22/08
Bottle v Bottle or Snipp: T-24/08
Olive: T-485/07
Red Envelope-I: T-415/07
RedEnvelope-II: T-416/07

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**

Focus/Micro Focus : C-344/07-P – Appeal from Case T-491/04; Order of 11 April 2008 (only in FR, DE; appeal rejected).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: impact of a weak distinctive character of a part in the earlier mark.

The case was an appeal from a judgment of the CFI of 16.5.2007 in Case T-491/04 [2007] ECR II-45, initially relating to a decision of the 2nd Board of 18.10.2004 in R 0542/2002-2 by which the Board had revoked an opposition decision in favour of "Micro Focus" against "Focus". The CFI had found for the opponent, and had, in consequence, revoked the Board's decision. The 5th Chamber of the ECJ (Tizzano; Ilesic, rapporteur; Levits) confirmed the CFI judgment.

| | |
|-----------------|---------------------------|
| CTM application | |
| FOCUS | <u>MICRO FOCUS</u> |


The CTM application Focus had been made for a range of goods and services in Classes 3, 6, 7, 8, 9, 14, 15, 16, 20, 21, 24, 25, 26, 28, 29, 32, 33, 34, 35, 36, 38, 39, 41 and 42. It had been partially opposed on the basis of an earlier right in the figurative mark "Micro Focus", registered for a range of goods and services in Classes 9, 16, 41 and 42. Whereas the Opposition Division had found in favour of the opponent, the Board had held differently on the grounds that there was no LOC between the marks in relation to the goods and services in question. In contrast, the CFI had held that the dominant part in the earlier mark is "Focus", since "Micro" is somewhat generic, indicating something small or little. Thus, the relevant comparison must be based on "Focus", and the subsequent application could be understood as "Little Focus" on the relevant (German-speaking) market, i.e. those consumers might assume that the relevant goods or service would originate from the same undertaking.

A-2: ECJ: Developments in pending cases

Corpo Livre : C-90/08-P – Appeal from T-86/05; Office response filed (DE).

Keywords: OHIM formalities: time limits – Time limits: extension – Opposition: proof of use (POU).

The case is an appeal from a decision of the CFI of 12.12.2007 in T-86/05 relating to CTM application "Corpo Livre" (figurative mark) which had been applied for for a range of goods in Classes 18 and 25.

| | |
|-------------------------------------------------------------------------------------|--------------|
| CTM application | |
|  | Livre |

It had been opposed on the basis of "Livre", word mark, and the opponent had been requested to show proof of use. On the last day of that time limit, the opponent's representative requested an extension, but this request was rejected. Notwithstanding this, material had subsequently been submitted meant to demonstrate use; the representative had further indicated that it would appeal to all available instances if the material was not taken into account. The opposition had been rejected on the grounds of lack of evidence of use of the invoked earlier right.

El Charcutero Artesano : C-81/08-P – Appeal from Case T-242/06; Office response filed (ES).

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

The case is an appeal from a judgment of the CFI of 13.12.2007 in Case T-242/06 which related to a decision of the 1st Board of 16.6.2006 in R 0790/2005-1 concerning CTM application No. 2 823 193 (El Charcutero Artesano; figurative mark), applied for in Classes 29 and 30.

| | |
|------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------|
| CTM application | |
|  |  |

It had been opposed on the basis of the figurative trade mark "El Charcutero" ('the butcher' in Spanish), registered in Class 29. The opposition had been rejected on the grounds that the marks are dissimilar enough to exclude any risk of confusion. Given that the relevant public is the Spanish-speaking general public, the generic nature of the word part "El Charcutero" will be understood. Thus, the marks are each carried by the different additional elements.

Five Stripes or K-Swiss : C-144/07-P – Appeal from Case T-14/06; Opinion of the Advocate General of 8 May 2008.

Keywords: OHIM formalities: notification of parties – Notification: Rules 61(2); 62(1),(3) and 68 CTMIR – Notification of a decision of the Office: by express courier.

The case is an appeal from Case T-14/06, K-Swiss v OHIM (Five stripes or Parallel stripes on a shoe) of 14.12.2006, in which the CFI had held, first, that delivery of a decision of a Board of Appeal of the Office by express courier is not included in the means of notification listed in Rule 61(2) CTMIR and, consequently, that it is improper. It had also held that, pursuant to Rule 68 CTMIR, the period within which proceedings had to be brought began to run from the date of delivery by express courier, since the appellant expressly acknowledged that it had received the decision at issue in that way. The CFI thus had inferred that the period of two months and 10 days within which proceedings against such a decision had to be brought had expired, in the present case, on 9.1.2006 and that the action brought by the plaintiff on 16.1.2006 had to be dismissed as inadmissible.

The two main questions that arise in the present case are, first, whether delivery of a decision of the Office by express courier can be treated in the same way as notification by registered letter with receipt of delivery, within the meaning of Rule 62(1) CTMIR, and, second, whether the presumption in Rule 62(3) CTMIR also applies where it is shown that the addressee of the express delivery received it within 10 days of its posting by the Office.

Advocate General Bot took the view that the CFI had committed an error in law. In his opinion, he set out the reasons why he considers that, as the provisions of the CTMIR relating to notification of the Office's documents are worded, delivery of a decision by express courier must be treated in the same way as notification by registered letter with advice of delivery. He also set out the reasons why, in his opinion, the presumption provided for in Rule 62(3) CTMIR applies even where there is evidence that the document was received by the addressee within 10 days of its posting. He thus inferred that the action brought before the CFI had been admissible and that the order under appeal must be set aside. In the alternative he argued that Rule 68 CTMIR, which concerns irregularities in notification, cannot have the effect of shortening the time-limit for bringing an action that would have applied if notification had been effected properly. He thus inferred that, even if it were accepted that delivery of the decision by express courier cannot be treated like notification by registered letter with receipt of delivery and must, consequently, be considered to constitute improper notification, the order under appeal would, as regards the scope of Rule 68, still be vitiated by an error of law.

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

O2 Bubbles : C-533/06 – Judgment of 12 June 2008 (reference from the Court of Appeal/UK).

Keywords: Trade mark rights: defences - Defences in trade mark law: lawful comparative advertising? - First Council Directive 89/104/EEC : the EU Trade Marks Directive ('TMD'): Article 5(1) – Advertising Directive 84/450: Article 3a(1) – Trade mark infringement: simple comparison or taking into account specific factual circumstances?

The case is a reference from the Court of Appeal (UK); it relates to the interpretation of Article 5(1) TMD and Article 3a(1) of Council Directive 84/450/EEC concerning misleading and comparative advertising (OJ 1984 L 250, p. 17), as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 (OJ 1997 L 290, p. 18). The reference had been made in the context of a dispute between O2 Holdings Limited and O2 (UK) Limited ('plaintiffs') and Hutchison 3G UK Limited ('H3G') concerning the use by H3G, in comparative advertising, of marks belonging to O2 and O2 (UK). O2 and O2 (UK) carry on business as suppliers of mobile telephone services.

They use bubble images in a host of ways to advertise their services. It is established that, in the context of mobile phones, consumers associate images of bubbles in water (particularly against a graduated blue background) with O2 and O2 (UK). O2 and O2 (UK) are proprietors in particular of two national figurative trade marks, each of which consists of a static picture of bubbles, registered in the United Kingdom in respect of telecommunications apparatus and services. H3G is also a provider of mobile telephone services marketed under the sign '3'. It offers in particular a pay-as-you-go service known as 'Threepay'. During 2004, H3G launched an advertising campaign. To that end, it broadcast in particular a television advertisement in which it compared the price of its services with those of O2 and O2 (UK). This televised advertisement began by using the name 'O2' and moving black-and-white bubble imagery, followed by 'Threepay' and '3' imagery, together with a message that H3G's services were cheaper in a specific way. O2 and O2 (UK) brought proceedings against H3G for infringement of their bubbles trade marks before the High Court. They accepted, for the purposes of the main proceedings, that the price comparison in the disputed advertisement was true and that that advertisement, as a whole, was not misleading. In particular, it did not suggest any form of trade connection between O2 and O2 (UK), on the one hand, and H3G, on the other.

That action for infringement was dismissed by a judgment of 23.3.2006. Essentially, the High Court had held that the use of the bubbles images in the disputed advertisement fell within Article 5(1)(b) TMD, but since that advertisement complied with Article 3a of Directive 84/450, such compliance provided H3G with a defence under Article 6(1)(b) TMD. O2 and O2 (UK) brought an appeal against that judgment before the Court of Appeal. The referring court asks, in the first place, for an interpretation of Article 5(1) TMD. Secondly, it seeks to know, for the purposes of assessing the existence of a likelihood of confusion within the meaning of Article 5(1)(b) TMD, whether consideration should be limited exclusively to a comparison between the trade mark and the disputed sign and between the goods or services for which the mark is registered and those for which the sign is used, or whether, on the other hand, it is appropriate to take account of the factual context in which the sign is used.

(a) *The questions in detail*

"(1) Where a trader, in an advertisement for his own goods or services, uses a registered trade mark owned by a competitor for the purpose of comparing the characteristics (and in particular the price) of goods or services marketed by him with the characteristics (and in particular the price) of the goods or services marketed by the competitor under that mark in such a way that it does not cause confusion or otherwise jeopardise the essential function of the trade mark as an indication of origin, does his use fall within either (a) or (b) of Article 5[(1)] of Directive 89/104?"

(2) Where a trader uses, in a comparative advertisement, the registered trade mark of a competitor, in order to comply with Article 3a[(1)] of Directive 84/450 ... must that use be "indispensable" and if so what are the criteria by which indispensability is to be judged?

(3) In particular, if there is a requirement of indispensability, does the requirement preclude any use of a sign which is not



identical to the registered trade mark but is closely similar to it?"

(b) Preliminary Considerations of the ECJ on the relationship between the TMD and the Advertising Directive

"(32) In accordance with Article 5(1) and (2) of Directive 89/104, the registered trade mark is to confer on the proprietor exclusive rights therein, by virtue of which he is to be entitled, under certain conditions, to prevent all third parties not having his consent from using in the course of trade, any sign which is identical with, or similar to, his trade mark. Under Article 5(3)(d) of that directive, he may, inter alia, prevent all third parties from using such a sign in advertising.

(33) Use by an advertiser, in a comparative advertisement, of a sign identical with, or similar to, a competitor's mark may constitute use within the meaning of Article 5(1) and (2) of Directive 89/104.

(34) First, Article 5(1) and (2) of Directive 89/104 must be interpreted as covering the use of a sign identical with, or similar to, the trade mark in respect of goods marketed or services supplied by the third party (see, to that effect, as regards Article 5(1)(a) of Directive 89/104, Case C-48/05 Adam Opel [2007] ECR I-1017, paragraph 28).

(35) Second, an advertisement in which the advertiser compares the goods and services which he markets with those of a competitor is aimed, evidently, at promoting the goods and services of that advertiser. With such an advertisement the advertiser seeks to distinguish his goods and services by comparing their characteristics with those of competing goods and services. That analysis is confirmed by recital 15 in the preamble to Directive 97/55, in which the Community legislature pointed out that the aim of comparative advertising is to distinguish between the goods and services of the advertiser and those of his competitor (see Case C-112/99 Toshiba Europe [2001] ECR I-7945, paragraph 53).

(36) Therefore, the use by an advertiser, in a comparative advertisement, of a sign identical with, or similar to, the mark of a competitor for the purposes of identifying the goods and services offered by the latter can be regarded as use for the advertiser's own goods and services for the purposes of Article 5(1) and (2) of Directive 89/104.

(37) Such use may therefore be prevented, where necessary, by virtue of those provisions.

(38) However, as is apparent from recitals 2 to 6 in the preamble to Directive 97/55, the Community legislature was intending to promote comparative advertising, stating, inter alia, in recital 2, that comparative advertising 'can also stimulate competition between suppliers of goods and services to the consumer's advantage' and, in recital 5, that it 'may be a legitimate means of informing consumers of their advantage'."

"(40) Such a limitation of the effects of the mark for the purposes of promoting comparative advertising appears necessary not only in the case of use, by the advertiser, of a competitor's actual mark, but also in the case of use of a sign similar to that mark.

(41) Under Article 2(2a) of Directive 84/450, 'comparative advertising' means any advertising which explicitly or by implication identifies a competitor or goods or services offered by a competitor.

(42) According to settled case-law, that is a broad definition covering all forms of comparative advertising, so that, in order for there to be comparative advertising, it is sufficient for there to be a statement referring even by implication to a competitor or to the goods or services which he offers (see Toshiba Europe, paragraphs 30 and 31; Case C-44/01 Pippig Augenoptik [2003] ECR I-3095, paragraph 35; and Case C-381/05 De Landtsheer Emmanuel [2007] ECR I-3115, paragraph 16).

(43) The test for determining whether an advertisement is comparative in nature is thus whether it identifies, explicitly or by implication, a competitor of the advertiser or goods or services which the competitor offers (Toshiba Europe, paragraph 29, and De Landtsheer Emmanuel, paragraph 17)."

"(45) Consequently, in order to reconcile the protection of registered marks and the use of comparative advertising, Article 5(1) and (2) of Directive 89/104 and Article 3a(1) of Directive 84/450 must be interpreted to the effect that the proprietor of a registered trade mark is not entitled to prevent the use, by a third party, of a sign identical with, or similar to, his mark, in a comparative advertisement which satisfies all the conditions, laid down in Article 3a(1) of Directive 84/450, under which comparative advertising is permitted.

(46) It must, however, be pointed out that, (...).

(47) First, in the case of similarity between the mark and the sign and between the goods or services, the likelihood of confusion constitutes the specific condition for protection. Article 5(1)(b) of Directive 89/104 is thus designed to apply only if, by reason of the identity or similarity both of the marks and of the goods or services which they designate, there exists a likelihood of confusion on the part of the public (Case C-120/04 Medion [2005] ECR I-8551, paragraphs 24 and 25).

(48) Second, it is apparent from Article 3a(1)(d) of Directive 84/450 that comparative advertising is not permitted if there is a likelihood of confusion between the advertiser and a competitor or between the advertiser's trade marks, goods or services and those of a competitor.

(49) In the light of recitals 13 to 15 of Directive 97/55, the same interpretation must be given to the term 'confusion' used in both Article 5(1)(b) of Directive 89/104 and Article 3a(1)(d) of Directive 84/450."

(c) Answers to the questions by the 1st Chamber of the ECJ (Jann; Tizzano; Borg Barthet;

Ilesic, rapporteur; Levits)

"(1) Article 5(1) and (2) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks and Article 3a(1) of Council Directive 84/450/EEC of 10 September 1984 concerning

misleading and comparative advertising, as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997, must be interpreted to the effect that the proprietor of a registered trade mark is not entitled to prevent the use by a third party of a sign identical with, or similar to, his mark, in a comparative advertisement which satisfies all the conditions, laid down in Article 3a(1) of Directive 84/450, under which comparative advertising is permitted.

However, where the conditions required in Article 5(1)(b) of Directive 89/104 to prevent the use of a sign identical with, or similar to, a registered trade mark are met, a comparative advertisement in which that sign is used cannot satisfy the condition, laid down in Article 3a(1)(d) of Directive 84/450, as amended by Directive 97/55, under which comparative advertising is permitted.

(2) Article 5(1)(b) of Directive 89/104 is to be interpreted as meaning that the proprietor of a registered trade mark is not entitled to prevent the use by a third party, in a comparative advertisement, of a sign similar to that mark in relation to goods or services identical with, or similar to, those for which that mark was registered where such use does not give rise to a likelihood of confusion on the part of the public, and that is so irrespective of whether or not the comparative advertisement satisfies all the conditions laid down in Article 3a of Directive 84/450, as amended by Directive 97/55, under which comparative advertising is permitted."

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

Smirnoff Ice or UDV North America : C-62/08 - Office contribution filed (internal document).

Keywords: CTMR: infringement – CMTR: scope of trade mark rights, Article 9(1),(2).

The case is a reference from the *Hof van Cassatie* of Belgium and concerns infringement proceedings brought against the Belgian company Brandtraders NV by the owner of CTM No. 1 540 913, "Smirnoff Ice" for alcoholic beverages, UDV North America Inc. The CTM rights had been established in the year 2000. Brandtraders is a distributor or specialised agent on the internet in respect of beverages bearing a brand. In 2001, Brandtraders purchased, from Hillyard Trading of Gibraltar, a consignment of bottles of Smirnoff Ice from South Africa, supported by advertising on its internet site, and eventually sold it to Checkprice (UK). *Vis-à-vis* the purchaser, Brandtraders acted in its own name but "on behalf of" the vendor Hillyard Trading. Goods bearing the trade mark "Smirnoff Ice" had been offered on Brandtraders' website. Several invoices had been issued, by Brandtraders, in performance of the contract between them and the purchaser in the case in question.

The court of first instance, the Commercial Court of Brussels, had found Brandtraders guilty of infringing Article 9 (1) and (2)

CTMR notwithstanding that Brandtraders had claimed that it played a role only as intermediary in the transaction and that it purchases and sells only on behalf of a third party, receiving a commission. Since purchasers are invoiced by Brandtraders in its own name, and given that Brandtraders itself is invoiced under its name by vendors, it therefore acquires full ownership of the merchandise, and be it only for "a legal second". Further, by using the Smirnoff Ice brand on its website, Brandtraders itself had made use of that brand in its own interest, namely to further its own business standing, i.e. it had exploited the brand's goodwill in its own interest.

The Court of Appeal of Brussels (Hof van Beroep) subsequently had annulled that judgment, *inter alia* on the grounds that Brandtraders did not use the sign as an interested party or contractor in relation to trade in goods but only on behalf of a third party, in this case the initial vendor. Therefore it had not been using the sign within the meaning of Article 9(1)(a) and (2)(d) CTMR.

UDV North America Inc. then had lodged an appeal *in cassation* against that judgment with the Hof van Cassatie, submitting that for application of Article 9(1)(a) and (2)(d) CTMR it is not necessary that the party in question acts on its own behalf and/or uses the sign as an interested party in relation to trade in goods in which it is itself a contractual party. By order dated 7 February 2008, the referring Court had decided to stay the main proceedings and had referred to the Court of Justice the following questions:

"(1) For there to be use of the sign within the meaning of Article 9(1)(a) and (2)(d) of Council Regulation 40/94 of 20 December 1993 on the Community trade mark, is it necessary that a third party, within the meaning of Article 9(1)(a) of the Regulation:

*(a) uses the sign on his own behalf?
(b) uses the sign as an interested party in relation to trade in goods in which he is himself a contractual party?*

(2) Can a trade intermediary who acts in his own name, but not on his own behalf, be regarded as a third party who uses the sign within the meaning of Article 9(1)(a) and (2)(d)?"

Christian Dior/SIL : C-59/08 – Office contribution filed (FR); internal document.

Keywords: EU Trade Marks Directive 89/104/EC: scope of the rights of the trade mark owner – Trade mark licensing – Trade mark rights: invokeable against licensee?

The case is a reference from the French *Cour de Cassation* in an action initiated by Dior against SIL, a licensee, which allegedly had sold Dior products outside the agreed channels. The referring court wishes to know what the exact scope of Article 8(2) and Articles 7(1) and 7(2) TMD would be in relation to a situation where the prestige of a product and of the respective manufacturer allegedly is at stake, given the concrete form of marketing of the licensed products by the licensee.



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

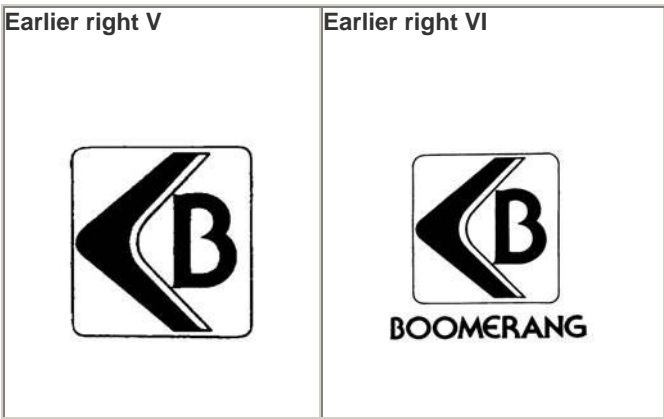
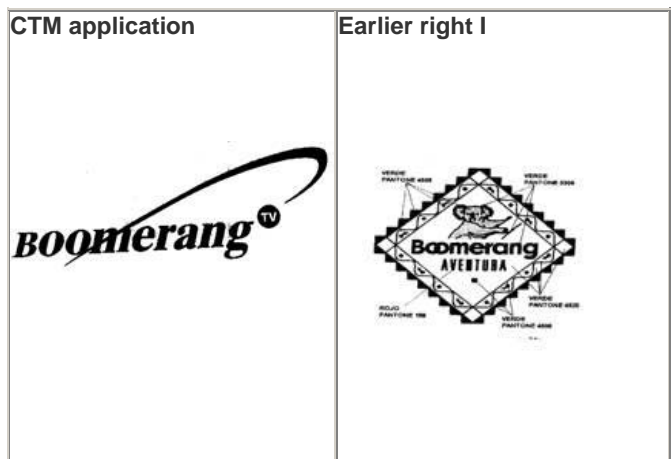
C-1: CFI Judgments and Orders

Boomerang : T-420/03 - Judgment of 17 June 2008 (dismissed; Office practice confirmed).

Keywords: CFI proceedings: correct pleas in law – CFI proceedings: evidence for the first time before the court – CFI proceedings: presentation of national judgments – OHIM Board proceedings: evidence produced for the first time – Opposition proceedings: formalities – Formalities: translations concerning earlier rights – Opposition: earlier rights – Paris Convention: Article 6bis (well-known marks). Earlier rights: mark with reputation – Reputation: risk of dilution – Dilution: criteria – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 1.10.2003 in R 0088/2003-2 relating to CTM application “Boomerang TV” (figurative mark) which had been applied for for a range of services, namely in Class 38 for telecommunications; services of radio and television programmes; radio and television broadcasting and diffusion, and in Class 41 for educational, formative and entertainment services; cinema and recording studios, rent of videos, concourse (scattering), installation of televisions and radiophones, production of films. Upon receipt of the notice of opposition, the CTM applicant had restricted its claim to services in Class 41 corresponding to the following description: cinema and recording studios, rent of videos, concourse (scattering), installation of television and radiophones, production of films.

The CTM application had been opposed, in English, on the basis of several earlier rights in “Boomerang” (word mark) and in figurative marks containing the word Boomerang or the representation of a boomerang.



The earlier (Spanish) “Boomerang Aventura” brand (Earlier right I) is registered for telecommunications services in Class 38, for education and entertainment services in Class 41, for footwear and hats in Class 25, for installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes in Class 11, and for hand tools and instruments, cutlery, forks and spoons; side arms and safety razor in Class 8. The (Spanish) B-Boomerang brand (Earlier right II) is registered in respect of articles of clothing for men, women and children and footwear in Class 25; for gymnastic and sporting articles (except for clothing and footwear); games and toys in Class 28, and for leather and imitations of leather, and products made of these materials and not included in other classes; animals' skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery in Class 18.

The word mark Boomerang (Earlier right III) is registered in Spain in respect of all kinds of clothing for gentlemen, ladies and children, handkerchiefs, towels, lingerie, drapery, bed and table covers in Classes 24 and 25. The Spanish “B-Boomerang-La Base del Deporte” brand (Earlier right IV) is registered in respect of paper, cardboard, paper and cardboard articles, printed matter, newspapers and periodicals, books; bookbinding material, photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers' type and clichés (stereotype) in Class 16. The figurative Boomerang-B brand (Earlier right V) is a UK mark registered for suits, coats,

tailcoats, trousers, skirts, shorts, T-shirts, sweaters, jumpers, jackets, sweatshirts; socks, scarves, gloves, headbands, wristbands; shoes, slippers, boots, sportshoes in Class 25.

The Boomerang-B combination mark (Earlier right VI) is registered in Greece and in Ireland, and as a CTM. It covers clothing, headgear and footwear, and clothing, including boots and slippers, in Class 25. The CTM covers a range of goods in Classes 3, 18 and 25.

A claim had been made under Article 6bis Paris Convention (well-known marks) and Article 8(5) CTMR (marks with reputation) in respect of earlier rights in Spain, Ireland, Greece and the UK (Earlier rights I; II; IV and V above), for all the goods and services in Classes 18, 25, 38 and 41.

The opponent had been invited to rectify some formal deficiencies as regards correct identification of the invoked earlier rights in the language of the opposition proceedings (English). He had done so as regards several earlier rights but not as concerns four Spanish registrations. The Opposition Division had rejected the opposition. It had found, *inter alia*, that the opponent had failed to submit the list of goods and services covered by four Spanish marks, despite being requested to do so, and therefore it had held that the opposition was inadmissible to the extent to which it was based upon those marks. Furthermore, it had held that the opposition was unfounded inasmuch as it was based on specified other earlier rights since no evidence of the existence of those marks had been adduced in the language of the proceedings, in particular the information concerning the issuing authorities, the proprietor of those registrations, the date and number of those marks and the specification of the services referred to by those registrations had not been submitted in evidence. The Opposition Division had also held that the opponent had not adduced sufficient evidence to prove that its invoked marks are well known within the meaning of Article 6bis of the Paris Convention in Spain, Ireland, Greece and the United Kingdom. Lastly, it had taken the view that the conditions for the application of Article 8(1)(a) and (b) and Article 8(5) CTMR had not been met, *inter alia* on the grounds that the earlier rights of which the opponent had provided proof (several Spanish registrations, the United Kingdom registration, the Irish registration and the CTM) cover goods and services which are not similar to those in respect of which registration of the mark Boomerang-TV had been sought, and that the evidence provided was not sufficient to prove that the earlier marks have a reputation.

The Board had confirmed these findings and had also dismissed evidence filed by the opponent for the first time at the appeal stage. The 4th Chamber of the CFI (Wisniewska-Bialecka, rapporteur; Moavero Milanese, Wahl) agreed.

(a) Correct pleas in law (forms of order sought)

“(30) In its second head of claim, the applicant (*plaintiff*) essentially requests the Court to instruct OHIM to refuse registration of the trade mark BoomerangTV. In their third head of claim, the interveners essentially ask the Court to instruct OHIM to allow registration of the trade mark BoomerangTV in respect of the services in Class 41 (...).

(31) Pursuant to Article 63(6) CTMR, OHIM is required to take the measures necessary to comply with a judgment of the Community judicature. Therefore, it is not for the Court to issue directions to OHIM. It is for the latter to draw the conclusions from the operative part of the judgment given by the Court and the grounds on which it is based (Case T-331/99 Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform) [2001] ECR II-433, paragraph 33; Case T-192/04 Flex Equipos de Descanso v OHIM – Leggett & Platt (LURA-FLEX) [2007] ECR II-0000, paragraph 33). Therefore, the applicant's second head of claim and the interveners' third head of claim are inadmissible.”

(b) The production of new evidence before the Court

“(32) The applicant has included with its application a number of documents intended in particular to demonstrate that it and its earlier marks are well known and of repute. It also offers to produce certain additional evidence.”

“(34) It is evident from the case-file that the applicant produced for the first time before the Court: (i) the judgment of the Tribunal Superior de Justicia de Madrid (Madrid High Court of Justice, Spain) of 11 September 2003 in Case No 1118/2000 between the interveners and OEPM concerning that office's refusal to register the figurative mark BoomerangTV to designate services in Class 41 (...); (ii) various documents intended to prove that it and its earlier marks were well known and of repute (...) and (iii) an extract from the Sitadex database corresponding to the application for registration No 2 184 869 of the trade mark BoomerangTV in respect of services in Class 41 (...).

(35) Actions before the Court seek a review of the legality of decisions of the Boards of Appeal of OHIM for the purposes of Article 63 of Regulation No 40/94. Therefore, it is not the Court's function to review the facts in the light of documents adduced for the first time before it. To allow such evidence would be contrary to Article 135(4) of the Rules of Procedure, according to which the parties' submissions may not alter the subject-matter of the proceedings before the Board (...). Accordingly, such evidence is inadmissible and must be excluded, without any need to assess its probative value (Case T-128/01 DaimlerChrysler v OHIM (Calandre) [2003] ECR II-701, paragraph 18, and judgment of 23 May 2007 in Case T-342/05 Henkel v OHIM – SERCA(COR), not published (...) paragraph 31). For the same reason, an offer of new evidence submitted by a party must also be disregarded (see, to that effect, Joined Cases T-183/02 and T-184/02 El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR) [2004] ECR II-965, paragraph 97).

(36) It follows that in the present case annexes 5 to 8, annex 14 and the last three pages of annex 13 to the application are inadmissible, in so far as they constitute new evidence which was not produced during the proceedings before OHIM, and that the applicant's offer to produce additional evidence cannot be accepted.

(37) Nevertheless, neither the parties nor the Court 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 35 above, since it is not alleged that the Board of Appeal failed to take the factual aspects of a specific national judgment into account but that it infringed a provision of Regulation No 40/94 and the case-law is cited in support of that plea (Case T-277/04 Vitakraft-Werke Wührmann v OHIM – Johnson's Veterinary Products (VITACOAT) [2006] ECR II-2211, paragraph 71). Any account to be taken by the Court of the judgment of the Tribunal Superior de Justicia de Madrid reproduced in annex 4 to the application therefore depends on the reason for which the applicant invokes that judgment. Consequently, whether the Court is able to take that judgment into account will be examined during the detailed analysis of the plea in connection with which that judgment is invoked.”

(c) Evidence submitted for the first time before the Board of Appeal

“(40) By its first plea, the applicant alleges, essentially, that the Board of Appeal infringed Article 74(2) CTMR. Under that provision, OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned.

(41) It follows that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the passing of the time-limits to which such submission is subject under the provisions of Regulation No 40/94 and that OHIM is in no way prohibited from taking account of facts and evidence which are submitted or produced late. However, a party has no unconditional right to have such facts and evidence submitted out of time taken into consideration by OHIM. In stating that the latter ‘may’, in such a case, decide to disregard those facts and that evidence, Article 74(2) CTMR grants OHIM a wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take such information into account (OHIM v Kaul, (...) paragraphs 42 and 43).

(42) Where OHIM is called upon to give judgment in the context of opposition proceedings, taking facts or evidence submitted out of time into account is particularly likely to be justified where OHIM considers, first, that the material which has been produced late is, on the face of it, likely to be relevant to the outcome of the opposition brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (OHIM v Kaul, (...) paragraph 44).

(43) It follows that, contrary to what the applicant submits, the Board of Appeal was not required to take into consideration the evidence produced for the first time before it. It is, however, necessary to determine whether, in refusing to take that evidence into consideration, the Board of Appeal did not infringe Article 74(2) CTMR by considering itself to have no discretion in that regard. Contrary to what OHIM and the interveners maintain, there is no need, in principle, to restrict the application of the principles set out in paragraphs 40 to 42 above on the basis of the nature of the facts and evidence in question, since no such restriction is provided for in Article 74(2) CTMR. The nature of the facts and evidence at issue is, nevertheless, a factor which OHIM may take into account when exercising the discretion granted to it under that article.

(44) In the present case, the Board stated in paragraph 27 of the contested decision that it was in accordance with the

practice of the Boards of Appeal to consider as inadmissible documents included for the first time with the statement of the grounds of appeal. It added that such documents should have been submitted to the Opposition Division within the relevant deadline and that a party could not validly avail itself of the appeal in order to introduce, inter alia, new evidence not submitted in due time. It referred, in this connection, to two earlier decisions of Boards of Appeal of OHIM and to Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301.

(45) Thus, in order to conclude that the documents produced for the first time before it were inadmissible, the Board of Appeal relied on the fact that the applicant had already been granted the opportunity to produce all of the documents at issue before the Opposition Division. It thus implicitly took the view that the circumstances in which the documents at issue had been produced precluded their being taken into account. Furthermore, it is evident from the case-file that the period given to the applicant to produce the documents at issue before the Opposition Division had been extended and that the applicant had not in any way contended that it had not been in a position to produce the relevant documents before the Opposition Division when it granted the applicant additional time for that purpose.”

(46) The contested decision therefore shows that the Board did not hold on principle that the documents produced by the applicant for the first time before it were inadmissible, but that it took into account the facts of the case and gave grounds for its decision on that issue. Admittedly, the list of those grounds is brief and the factors referred to by the Board do not expressly correspond to those referred to by the Court of Justice in OHIM v Kaul, cited in paragraph 27 above. However, that does not justify the conclusion that the Board infringed Article 74(2) CTMR.

(47) According to OHIM v Kaul, cited in paragraph 27 above (see, in this connection, paragraphs 42 and 43), it is an essential requirement that the Board should not consider itself to be unable to take into account facts and evidence which are submitted for the first time before it. However, as shown in paragraphs 44 and 45 above, that was not the case here. The factors which the Court of Justice identified as those which may justify taking into account facts or evidence submitted out of time are given only by way of example, as the term ‘particularly’ (see paragraph 42 above) indicates. The reference in the present case to factors which are not identical to those referred to by the Court of Justice in that judgment cannot therefore be regarded as constituting a failure to state reasons within the terms of that judgment. That applies all the more so since the Court of Justice expressly ruled only as to factors which might warrant taking account of facts and evidence submitted out of time, even though, as noted in paragraph 41 above, Article 74(2) CTMR also allows such facts and evidence to be rejected, depending on the circumstances.

(48) It follows that the Board did not dismiss the action brought before it by the applicant solely on the grounds that that party had submitted facts and evidence out of time and that it did not take the view that it had no discretion to take account of the documents produced by the applicant for the first time before it. On the contrary, it exercised the broad discretion conferred upon it by Article 74(2) CTMR, in so far as it was only after having analysed the facts of the case and



the position in law that it decided to reject as inadmissible the documents at issue.

(49) In the absence of any manifest error of assessment by the Board of Appeal in this respect, it has not been established that Article 74(2) CTMR was infringed. Consequently, the first plea must be rejected as unfounded."

(d) *Well-known trade marks under Article 6bis PC: how to prove?*

"(79) Since Article 8(2)(c) CTMR refers to trade marks which are 'well-known in a Member State, in the sense in which the words "well-known" are used in Article 6 bis of the Paris Convention' it is necessary, in order to ascertain how the existence of a well-known mark can be proved, to refer to the guidelines for the interpretation of Article 6bis.

(80) Under Article 2 of the joint recommendation concerning the provisions on the protection of well-known trademarks, adopted by the Assembly of the Paris Union and the General Assembly of the World Intellectual Property Organisation (WIPO) at the 34th series of meetings of assemblies of the Member States of the WIPO (of 20 to 29 September 1999), in determining whether a mark is a well-known mark within the meaning of the Paris Convention, the competent authority can take into account any circumstances from which it may be inferred that the mark is well known, including: the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of any use of the mark; the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies; the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent to which they reflect use or recognition of the mark; the record of successful enforcement of rights in the mark, in particular, the extent to which the mark has been recognised as well known by competent authorities; the value associated with the mark.

(81) In the present case, it is apparent from the case-file that, in order to establish the existence of its earlier well-known marks in Spain, Ireland, Greece and the United Kingdom, the applicant produced before the Opposition Division, first, extracts from catalogues of its goods, showing that the trade name 'Boomerang' is used for a variety of sports clothing, accessories and equipment, secondly, a photograph of two zeppelin-shaped balloons which bear the word 'Boomerang' taken at a sporting event and, thirdly, various articles from Spanish newspapers relating to an indoor-soccer club called 'Boomerang Interviu' and, later, 'Boomerang', sponsored by the applicant.

(82) It must therefore be held, as the Opposition Division rightly stated and the Board of Appeal confirmed in paragraph 41 of the contested decision, in which it adopted the grounds set out by the Opposition Division, that those documents do not prove that the trade marks at issue were used or even known or recognised in Ireland, Greece and/or the United Kingdom. Moreover, although those documents prove that at least some of the marks at issue were used by the applicant in Spain, they contain no information as to the duration and the extent of that use, the degree of knowledge or recognition of the trade marks at issue in Spain or any other information

from which it might be inferred that the marks at issue are well known in Spain or in a substantial part of Spanish territory."

Gabel/Garel : T-85/07 – Judgment of 10 June 2008 (action allowed; law of the case).

Keywords: CFI proceedings: correct claims – OHIM proceedings: restriction of the list of goods and services ('G&S') after opposition decision – Board proceedings: scope of examination of a case.

The action had been directed against a decision of the 2nd Board of 25 January 2007 in R 0960/2006-2 relating to CTM application "Gabel", word mark, applied for in Classes 24 and 25 for fabric, bed and table covers, travelling rugs, sheets, pillowcases, towels, bath sponges, bedspreads, quilts, eiderdowns, bath linen, and for clothing, including boots, shoes and slippers.



It had been opposed on the basis of several earlier rights in "Garel" (figurative mark), registered for a range of goods in Classes 24, 25 and 26, namely: textiles and textile goods, not included in other classes; bed and table covers; girdles, brassieres, breeches (for wear), slips and bodies (...) embroidery, ribbons and braid. The opposition had been allowed in full. Some three weeks after the decision, the CTM applicant had informed that it wished to restrict the list of goods and services as follows: "(instead) of 'clothing, including boots, shoes and slippers' (...) limit those goods to only 'bath gowns, themselves belonging to Class 25'."

Subsequently, the CTM applicant had filed an appeal against the decision of the Opposition Division. By the contested decision, the Board had set aside the decision of the Opposition Division, had allowed the trade mark applied for to proceed to registration in respect of 'bath gowns' in Class 25 and had ordered each party to bear its own costs. The 2nd Chamber of the CFI (Pelikánová, rapporteur; Jürimäe; Soldevila Frago) revoked the Board's decision on formal grounds since the Board had not ruled on a specific head of claim concerning the goods in Class 24.

CFI proceedings: correct claims

"(17) It must be held that, by its second and fourth heads of claim, the applicant is seeking to obtain from the Court a ruling which is confirmatory or declaratory, respectively. It follows, however, from Article 63(2) and (3) of Regulation No 40/94 that an action brought before the Court under those provisions seeks to have the lawfulness of decisions of the Boards of Appeal examined and to obtain, as the case may

be, the annulment or alteration of those decisions (Case C-106/03 P Vedral v OHIM [2004] ECR I-9573, paragraph 28; see also, in that regard, Case T-247/01 eCopy v OHIM (ECOPY) [2002] ECR II-5301, paragraph 46, and Case T-407/05 SAEME v OHIM – Racke (REVIAN's) [2007] ECR II-0000, paragraph 65), with the consequence that such an action cannot have the objective of obtaining confirmatory or declaratory rulings in respect of those decisions.

(18) Consequently, the applicant's second and fourth heads of claim must be rejected as being inadmissible."

Blue Soft : T-330/06 – Judgment of 10 June 2008 (only in FR, DE); action dismissed, Office practice confirmed.

Keywords: Absolute grounds for refusal: descriptiveness.

The action had been directed against a decision of the 1st Board of 14.9.2006 in R 0270/2006-1 relating to CTM application "Blue Soft" for contact lenses. It had been rejected under Article 7(1)(b) and (c) CTMR on the grounds that the sign would merely describe the nature of the goods at issue. The 1st Chamber of the CFI (Tiili; Dehousse, rapporteur; Wiszniewska-Bialecka) confirmed rejection on the basis of Article 7(1)(c) CTMR, relying on standard case-law.

Oftasil : T-30/08 - Case closed; Order of 14 Mai 2008.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: pharmaceutical products – LOC: family of marks – Family of marks: criteria.

The action had been directed against a decision of the 2nd Board of 29.10.2007 in R 0599/2007-2 relating to CTM application Oftasil (figurative mark) which had been applied for pharmaceutical and veterinary preparations, hygiene products for medical purposes, 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 and herbicides in Class 5.

| | |
|-----------------|---------------------------|
| CTM application | |
| OFTASIL | OPHTHAL OPHTAN |

It had been opposed on the basis of several earlier rights to the word marks "Ophthal" and "Ophan", registered in Class 5


for (1) pharmaceutical preparations and sanitary preparations, namely medicines for application to the eyes, nose and ears; preparations for the care of contact lenses, wetting, storage, cleaning, washing and disinfecting agents for contact lenses; wetting agents for artificial eyes, and (2) for pharmaceutical preparations; sanitary preparations for medical use; 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 and herbicides (Class 5). The opponent had invoked the "family of marks" argument in order to show a broader basis for assuming LOC.

The opposition had been dismissed mainly on the grounds of dissimilarity of the marks at issue. The "family of marks" argument had been rejected (two marks do not constitute a family). Since the plaintiff withdrew the action, the case was closed.

RS/RS : T-501/07 - Case closed; Order of 23 May 2008.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: figurative mark v word mark.

The action had been directed against a decision of the 2nd Board of 16.10.2007 in R 0531/2007-2 relating to CTM application "RS" (figurative mark). It had been applied for in Class 9 for articles for protection against accidents, in particular clothing for protection against accidents; in Class 17 for insulated shoes and gloves of rubber, gum, leather and plastic, and in Class 25 for clothing, footwear, headgear, in particular weather-proof clothing.

| | |
|--------------------------------------------------------------------------------------|-----------|
| CTM application | |
|  | RS |

That application had been opposed on the basis of the word mark "RS", registered inter alia in Class 9 for safety goggles; safety harness; safety footwear; in Class 17 for rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes, and in Class 25 for clothing, footwear, all being workwear or protective clothing and including gloves; hats; jackets; overalls; shirts; socks; sweaters; trousers; waterproof clothing. The opposition had been allowed. Since the plaintiff declared that it wished to discontinue proceedings, the case was closed.



RadioCom : T-254/06 – Judgment of 22 May 2008 (only FR, DE); action dismissed; Office practice confirmed.

Keywords: Absolute grounds for refusal: descriptiveness.

The action had been directed against a decision of the 1st Board of 7.7.2006 in R 1266/2005-1 by which it had rejected registration of the word mark "RadioCom" for a range of services in Classes 35, 38 and 41, mainly relating to radio broadcasting, radio advertising and marketing and internet services etc. The Board had relied on Article 7(1)(b) and (c) CTMR. The 5th Chamber of the CFI (Vilaras; Prek; Ciucà, rapporteur) confirmed rejection pursuant to Article 7(1)(c) CTMR, relying on standard criteria.

Bocksbeutel or Franconian Wine Bottle : T-180/06 - Case closed; Order of 5 May 2008.

Keywords: Collective Community trade marks – Types of signs: 3D signs – 3D signs: shape of the product itself – 3D signs: shape of a bottle – Regulation (EEC) 3201/90, annex V (O. J. EC L 309 of 8 November 1990).

The action had been directed against a decision of the 1st Board of 25.4.2006 in R 0479/2004-1 relating to CTM application No. 2 323 301 which had been filed by the Franconian Vintners Association as a collective trade mark for a range of goods and services in Classes 32, 33 and 42.



It had been rejected under Article 7(1)(b) CTMR, in that the sign represents the classic Franconian Bocksbeutel but cannot be reserved for wines originating from Franconia (Northern Bavaria) as follows from annex V of Regulation (EEC) 3201/90. Further, a blank Bocksbeutel cannot serve as a badge of individual commercial origin since in the wine trade the consumers are educated to concentrate on the label in order to identify the individual commercial origin of the

product. Since the plaintiff withdrew the action, the case was closed.

Letter "E" : T-329/06 – Judgment of 21 May 2008 (only in DE, FR); action dismissed; Office practice confirmed.

Keywords: Type of signs: single letters – Absolute grounds for refusal: relationship between Article 7(1)(b) and (1)(c) CTMR – Absolute grounds for refusal: reference consumer – Distinctiveness/assessment: impact of registrations at Member State level.

The action had been directed against a decision of the 1st Board of 8.9.2006 in R 0394/2006-1 relating to the CTM application for the single letter "E" for a range of goods in Classes 7, 9 and 19, all consisting of or relating to wind energy apparatus. The application had been rejected on the grounds that, in the eyes of the relevant highly specialised public, the sign at issue had no distinctive character, under Article 7(1)(b) CTMR, as concerns wind energy apparatus because it would be understood as relating to "energy". Further, according to evidence from the internet, the letter E is widely used, for instance by German-speaking Union citizens, as a generic indicator for energy (for instance, E-Werk meaning a power plant). In consequence, it is descriptive for the claimed goods under Article 7(1)(c) CTMR.

The 5th Chamber of the CFI (Vilaras; Martins Ribeiro; Jürimäe, rapporteur) confirmed rejection of the application. The court relied on Article 7(1)(c) CTMR and saw no need, within the given context, to additionally analyse Article 7(1)(b) CTMR.

Immucell/Immunorell : T-368/06 – Case closed; Order of 5 May 2008.

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 3.10.2006 in R 1064/20004-4 relating to CTM application No. 1 065 903, "Immucell", word mark, which had been applied for for a range of goods and services in Classes 5, 6 and 41. It had been opposed, as regards Class 5 goods, on the basis of "Immunorell", word mark, registered for a range of goods in Class 5. The opposition had been allowed in full. The opponent withdrew its opposition and, in consequence, the case was closed.

Alira/Akira : T-315/07 – Case closed; Order of 28 April 2008.

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

The action had been directed against a decision of the 4th Board of 19.6.2007 in R 0850/2006-4 relating to CTM application "Alira", word mark, which had been applied for in Class 11 for fittings for water supply, namely kitchen faucets, kitchen faucets with pull-out hand shower, sink mixers and parts of the aforesaid goods. It had been opposed on the



basis of "Akira", word mark, which is registered in Class 11 for apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, sanitary purposes, taps and fittings. The opponent had to file proof of use. The Opposition Division had upheld the opposition against all the goods covered by the CTM application.

The POU submitted by the opponent had been found sufficient to show genuine use of the earlier mark in Spain during the relevant period in relation to bathtubs (copy of a price list for 1998-2003, copies of some invoices to various clients in Spain from 1998 to 2003, copies of catalogues for the years 1998, 2000 and 2001, and copies of pages from the website of the respondent). The marks had been found very similar. As regards comparison of goods, it had been held that there is similarity since these respective goods are made with the same material, can be found in the same shops or areas of department stores, and may have the same usual origins and distribution channels. The opponent withdrew its opposition at pending proceedings and, in consequence, the case was closed.

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

Famoxin/Lanoxin : T-27/08 – Office response filed.

Keywords: Opposition/invalidation: pharmaceutical products – Opposition/invalidation: proof of use (POU) – POU: pharmaceutical goods registered in general terms – Likelihood of confusion (LOC): impact of parallel proceedings at Member State level.

The action is directed against a decision of the 1st Board of 19.11.2007 in R 0009/2007-1 relating to CTM No. 2 491 298, "Famoxin", word mark, which had been challenged on the basis of several earlier rights in "Lanoxin", word mark, by way of a request for invalidation on relative grounds. The CTM is registered in Class 5 for pharmaceutical preparations for the treatment of metabolic disorders adapted for administration only by intravenous and for intra-muscular or subcutaneous injection. The earlier rights are registered, *inter alia*, in Class 5 for pharmaceutical preparations with digoxin for human use and for medicinal and pharmaceutical products. The request for invalidation had been dismissed, mainly on the following grounds:

Proof of use of the earlier mark had been submitted in respect of 'pharmaceutical preparations for cardiovascular illnesses'. For the purpose of the cancellation proceedings, the earlier marks were deemed to be registered in respect of this sub-category of goods.

The relevant public includes health professionals and end users (or patients) in Italy. The patients will be assisted by health professionals during the administration of the pharmaceuticals in question. Patients will display a high degree of attentiveness when confronted by the pharmaceuticals that are prescribed for the treatment of potentially severe disorders. 'Pharmaceutical preparations for the treatment of metabolic disorders adapted for administration only by intravenous, intra-muscular or subcutaneous injection' and 'pharmaceutical preparations for

cardiovascular illnesses' are similar to a certain degree in spite of different therapeutic indications.

Given that the common ending '-OXIN' is visually and phonetically much less important than the different beginnings 'FAM-' and 'LAN-', and given that the conceptual similarity results from the common reference to a descriptive suffix '-OXIN' (that denotes the chemical compound "digoxin"), the overall similarity between the signs was held to be "very low".

Keeping in mind that patients will always be under the guidance of professionals, the notable differences between the signs suffice to exclude a risk of confusion against the perception of the relevant, highly attentive, public. Likewise, it was held that "there should not be any risk of a medical error".

The outcome of the decision was not influenced by the alleged fact that the other party has claimed the existence of a risk of confusion between the same marks, in parallel proceedings in Sweden.

Yoghurt Gums : T-25/08 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board of 25.10.2007 in R 1322/2006-4 relating to CTM application "Yoghurt Gums" (figurative mark) which had been applied for for a range of goods in Class 30.



It had been rejected on the grounds of descriptiveness under Article 7(1)(c) and (2) CTMR in that the sign merely conveys the message that the "gums" in question contain an amount of yoghurt. The CTM applicant itself describes, on its website, the product in exactly that manner.

Slim Line : T-36/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 2nd Board of 22.11.2007 in R 1532/2007-2 relating to CTM application "SLIM LINE", word mark, which had been applied for in Class 9 for equipment and instruments for guiding, switching, transformation, accumulation, regulation or control of light signals, in the form of optical fiber and data cables for communication purposes, optical fiber cables, data cables, network components, including optical cabinets, man holes and joint closures, and other passive equipment for fiber optic communication networks and other data networks,

telecommunication cables, connector systems in as well as splice cabinets and patching panel solutions for fiber, telecommunication and data. It had been rejected on the grounds of lack of distinctive character under Article 7(1)(b), (c) CTMR in that it does no more than directly convey a message about the type of design of the products ("slim design").

Pinzette (3D) : T-78/08 - Office response filed (DE).

Keywords: Types of signs: 3 dimensional ('3D') signs: shape of the product itself – Absolute grounds for refusal: 3D signs.

The action is directed against a decision of the 4th Board of 12.12.2007 in R 1405/2007-4 relating to CTM No. application 5 480 108, a pair of tweezers, applied for as a 3D sign in Class 8.

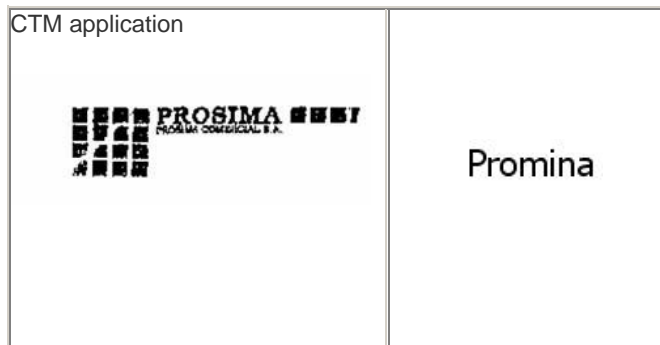


It had been rejected under Article 7(1)(b) CTMR, on the grounds that the sign applied for represents nothing more than an ordinary pair of tweezers. The little holes on the surface have a technical function in that they are meant to provide a better grip on the instrument. Where the sign applied for is the product itself, distinctiveness in a trade mark sense can only be established if the shape differs significantly from what is average in the respective trade.

Prosima : T-71/08 – Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: order of assessment – LOC: comparison of goods – Comparison of goods: impact of classification – Comparison of goods: dissimilarity of goods classified in the same class.

The action is directed against a decision of the 2nd Board of 27.11.2007 in R 0574/2007-2 relating to CTM application 2 423 176, "Prosima" (figurative mark). It had been applied for a range of goods and services in Classes 6, 7, 11, 16, 17, 20, 22, 35, 36, 37, 38, 39, 41 and 42.



The goods in Class 17 in the CTM application had been opposed on the basis of word mark "Promina" registered in Class 17. The Opposition Division rejected the opposition on the grounds of lack of similarity of the marks in question; it did not compare the goods. Upon appeal, the Board revoked that decision and remitted the case back (Board decision of 22.2.2006 in R 0364/2005-1). In its second decision, the Opposition Division again rejected the opposition on the additional grounds of lack of sufficient similarity of the goods at issue. This time, the Board confirmed the Opposition Division and rejected the appeal.

Center Shock/Center : T-16/08 - Office response filed.

Keywords: OHIM proceedings: material submitted by telecopier and by mail –Opposition/invalidation: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: earlier mark contained in the subsequent sign – Comparison of marks: version as registered or version as used on the market? – LOC: impact of the existence of similar business identifiers on the market.

The action is directed against a decision of the 2nd Board of 7.11.2007 in R 0149/2006-2 relating to CTM No. 973 065, word mark "Center Shock", which is registered in Class 30 for coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice and chewing gum. It had been challenged by way of a request for invalidation on relative grounds, on the basis of two rights in the word "Center", as follows: (a) Swedish registration 50.898 of 24.10.1938, for caramels, cocoa, chocolate, confectionery, marmalade and other chocolate or sugar products, in the form of cakes, tablets, pralines, powder, and in any other form, liquorices, coffee, tea, yeast, baking-powder, biscuits, bread, honey, chewing gum, marzipan, sugar, treacle, glucose, salt and honey; (b) Benelux registration 49.520 of 27.8.1971, for coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; chocolate, flour and preparations made from cereals, bread, biscuits, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; pepper, vinegar, sauces (except for salad dressing); spices; ice.

The CTM proprietor had asserted that the evidence had not been submitted in time, and had also sought to rely on the argument that the use it makes of its CTM on the market significantly differed from the registered version, in that



“Shock” would be strongly figurative. The CTM was declared invalid, on the following main grounds:

The evidence substantiating the earlier rights had been filed twice; firstly by fax within the time limit given by the Office and secondly by post. Only the latter arrived after expiry of the time limit. The evidence had therefore been filed in due time. As concerns comparison of marks, it is the registered version of the challenged right which must be taken into account. Both trade marks contain “center” which will easily be understood as what it says, and what also constitutes conceptual similarity apart from visual and phonetical similarities. The earlier mark is not weak in relation to the goods covered, and addition of the word “shock” does not alter the overall impression of similarity (Thomson Life, Judgment of the ECJ of 6.10.2005 in Case C-120/04 Medion AG v Thomson multimedia, referred). The fact that there are other trade marks on the market that contain the element CENTER as a word element does not necessarily imply that this term has a low degree of distinctive character because most of those trade marks have a different structure and overall impression. CENTER SHOCK, thus, might well be perceived as a variant of the mark CENTER.

Diaquest : T-22/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: pharmaceutical and veterinary goods – Pharmaceutical and veterinary goods and services ('G&S'): reference consumers – LOC: comparison of marks.

The action is directed against a decision of the 2nd Board of 25.10.2007 in R 1557/2006-2 relating to CTM application No. 3 736 584, word “Diaquest”. It had been applied for for a range of goods and services in Classes 1, 5 and 42, namely in Class 1 for diagnostic preparations for scientific purposes, in Class 5 for pharmaceutical and veterinary preparations and substances for immunotherapeutic purposes; diagnostic and test preparations for immunotherapeutic purposes, and in Class 42 for development, research and tests in the field of immunotherapy.

| | |
|-----------------|-------------------|
| CTM application | |
| DIAQUEST | QUEST DIAGNOSTICS |

It had been opposed on the basis of (a) CTM No. 2 402 980, word mark “QUEST DIAGNOSTICS”, registered for goods and services in Classes 5, 10, 16 and 35, and (b) CTM 1 952 589, word mark “QUEST DIAGNOSTICS” registered for services in Classes 35, 39 and 42. The goods and services on which the opposition had been based are the following: in Class 5 pharmaceutical, veterinary and sanitary preparations; food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; pharmaceutical preparations for the treatment, monitoring or diagnosis of disease; diagnostic preparations for clinical or medical use;

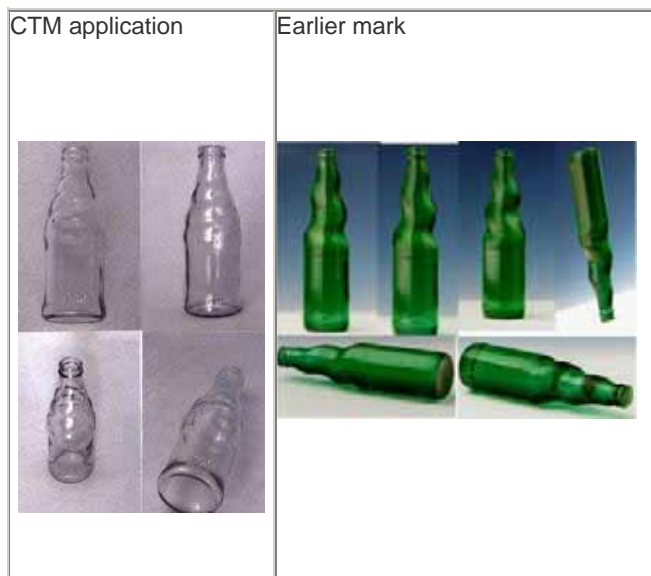
reagents for the treatment, monitoring or diagnosis of disease; reagents for clinical or medical use; in Class 10: surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopedic articles; suture materials; diagnostic kits for the treatment, monitoring or diagnosis of disease; diagnostic kits for clinical or medical use; diagnostic assays for the treatment or diagnosis of disease; diagnostic assays for clinical or medical use; storage and retrieval system of biological samples for medical use, and Class 42: clinical testing information services for the diagnosis, monitoring and treatment of disease, and in support of clinical trials; providing medical informatics services (i.e. data analysis for the health care industry, and medical information services for the health care industry); providing services of retrieval of medical information via interactive computer networks; providing to managed care organisations, hospitals, employers and other institutional healthcare providers, access to a network of clinical diagnostic laboratories providing services of processing requests for diagnostic test, performing tests, reporting test results, and playing claims to network laboratories; and providing consolidated chronological reports in graphical and/or numerical form, representing the results of clinical diagnostic tests performed on individual patients and groups of patients over monitored periods of time, together with an analysis of the results and quality and utilisation management.

The opposition had been rejected. It was held that the attentiveness of the consumers in the area of goods and services at issue is higher than average but that even in this case the relevant consumers would not perceive “dia-“ as an abbreviation of diagnostics. Referred: Judgment of the ECJ of 26 April 2007, Case C-412/05P, Alcon Inc. / OHIM (TRAVATAN / TRIVASTAN), ECR I-3569, paragraph 58; Judgments of the CFI of 13 February 2007, Case T-256/04, Mundipharma AG / OHIM, (RESPICUR / RESPICORT), ECR II-449, paragraph 57 and of 13 February 2007, Case T-353/04, Ontex NV / OHIM, (CURON / EURON), ECR II-10, paragraphs 55-58.

Bottle v Bottle or Snipp : T-24/08 – Office response filed.

Keywords: Opposition: conflict of 3D signs – Opposition: likelihood of confusion (LOC) – LOC: comparison of two 3 D signs.

The action is directed against a decision of the 4th Board of 15.11.2007 in R 1096/2006-4 relating to CTM application No. 3 367 539, a 3D sign; the shape of a bottle with the following description: “a bottle of cylindrical form (with) a narrowed, helically formed neck and its cylindrical part (...) labeled ‘snipp’”.



It had been applied for in Class 30 for coffee, tea, cocoa, artificial coffee, sauces, vegetable sauces, confectionery, chocolate based beverages, cocoa based beverages, coffee based beverages, tea based beverages, flavourings for beverages other than essential oils, golden syrup; in Class 32 for non alcoholic beverages, non alcoholic fruit beverages, fruit extracts (non alcoholic), fruit nectars, fruit juice, mineral water, effervescing beverages, essences for making beverages, syrups, beers, and in Class 33 for alcoholic beverages.

It had been opposed on the basis of CTM No. 690 016 (also a 3D mark) which is registered in Class 21 for boxes of glass, bottles, jugs (not of precious metal); in Class 32 for beers; mineral and aerated waters; fruit drinks and fruit juices; syrups and other preparations for making beverages; ale, porter, and in Class 33 for alcoholic beverages (except beer), liqueurs, spirits, wine. The opposition had been rejected on the following main grounds:

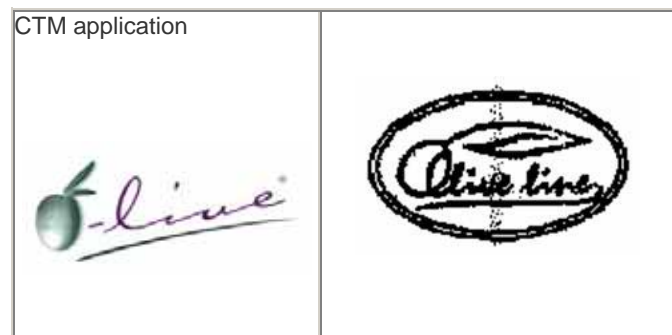
“The earlier mark has an average degree of distinctiveness. A comparison of the overall visual impression of the marks, bearing in mind their distinctive and dominant elements, shows several differences in the width and length of the bottles. The earlier mark appears longish, light and therefore filigree, while the contested one with its thick, corpulent silhouette gives a more bulky impression. Also the lower parts of the bottles under comparison are very different: the one of the earlier trade mark has a regular form, the one of the contested mark is irregular and has a specific curvy form with a thinner middle part. Furthermore, the contested mark also contains a word mark, “snipp”, whereas there are no word elements in the earlier mark. The distinctive element of the earlier mark is the long, helical-shaped neck. The spiralled neck of the earlier mark is thin (like the whole bottle) and consists of two helical turns. The contested mark also contains a kind of helical neck. Its shape is, however, different from the one of the earlier mark; it is wider and made of at least four helical turns. Therefore, in their overall impression the necks of the bottles under comparison are similar only to a low degree, even if both use the spiralled shape: the one of the earlier mark reminds of a screw thread, the one of the contested mark is more similar to a snail.”

“All in all, the comparison of the signs shows several grave differences. The fact that the neck of both bottles can be described as “helical shaped” has a very low relevance, as the shapes of each neck are very different. Moreover, as the variety of possible shapes for bottles is not unlimited, because some features are given by their function and technical or economical aspects of the production, the requirement for a sufficient distance between the trade marks cannot be unreasonably exaggerated. Under these circumstances, taking into consideration the average distinctiveness of the earlier trade mark, coupled with the significant differences between the trade marks, a likelihood of confusion in the mind of the average consumer can safely be excluded even for identical goods.”

Olive : T-485/07 – Office response filed (DE).

Keywords: Opposition: type of earlier right – Earlier right: a registered trade name (ES); Article 8(4) CTMR – Opposition: likelihood of confusion (LOC) – LOC: comparison of a service with goods.

The action is directed against a decision of the 2nd Board of 26.9.2007 in R 1478/2006-2 relating to CTM application “Olive” (figurative mark) which had been applied for a range of goods in Classes 29, 30, 31 and 33.



It had been opposed on the basis of an earlier registered Spanish trade name consisting of a device (as shown above). The opposition had been rejected on the grounds that the business identifiers differ significantly (no LOC).

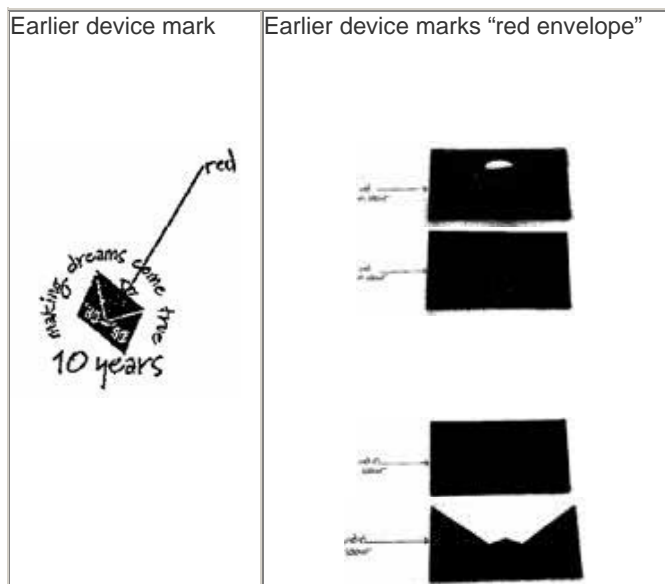
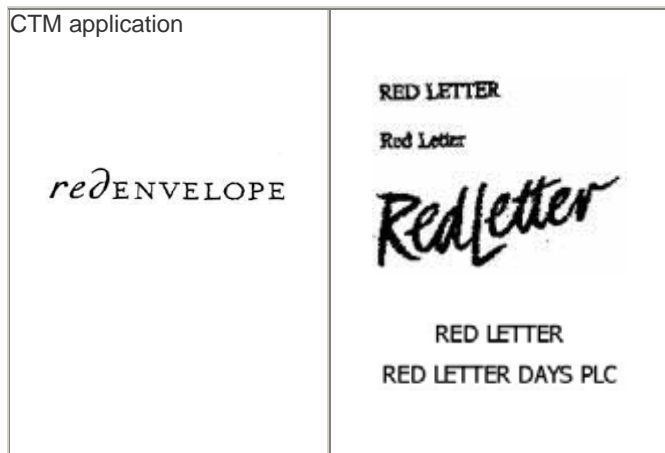
Red Envelope-I : T-415/07 - Office response filed.

Keywords: Opposition: earlier rights – Earlier right: a series mark – Earlier right: a non-registered business identifier, Article 8(4) CTMR – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: conceptual comparison.

The action is directed against a decision of the 1st Board of 14.9.2007 in R 1117/2005-1 relating to CTM application No. 1 601327, “Red Envelope” (figurative mark). It had been opposed on the basis of a UK series mark (“Red Letter”; figurative mark), several non-registered business identifiers



used on the market and a company name. The non-registered device marks consist of or contain a red envelope.



The sign had been applied for in respect of a range of services in Classes 35 and 42, namely in Class 35 for advertising; business management; business administration; advertising and marketing services; promotion services; database management services; business information services provided online from a computer database or the Internet; composing advertisements for use as web-pages; market surveys; analysis of advertising response and market research; consultancy, advisory and information services relating to prize draws all provided from a global computer network or the internet; consultancy, advisory and information services relating to mail order services in the field of gifts; consultancy, advisory and information services for retail outlets carried out via a global computer network or the Internet; computerized online retail services in the field of gifts; computerized on-line ordering services; on-line shopping services; all the above excluding gifts in the nature of experiences, and in Class 42 for providing information in the field of gifts by means of a global computer network or the Internet; consumer goods and product browsing services; computer services relating to the sale of goods; computerized on-line search services; graphic design for the compilation of web-pages on the internet; creating and maintaining web sites; computer database management; leasing access time

to computer database; hosting the web sites of others; all the above excluding gifts in the nature of experiences.

The series mark is registered for a range of goods and services in Classes 9, 14, 16, 18, 21, 22, 25, 26, 33, 36, 39, 41 and 42, amongst which in Class 36 for insurance services; gift certificates; gift vouchers; leasing, rental and sale of property; in Class 39 for travel services; delivery of flowers; delivery of magazines; delivery of food and drink products; in Class 41 for entertainment services, namely, arrangement and provision of sporting activities, leisure activities and special interest events; arranging of sporting activities; cultural activities; training services all relating to leisure and lifestyle activities; arranging of leisure activities; educational services all relating to leisure and lifestyle activities; exhibition and conference services; in Class 42 for web site design services; in Class 43 for catering services for the provision of food and drink; accommodation services, and in Class 44 for beauty services; spa services; hairdressing services.

The non-registered word mark RED LETTER is allegedly used in the United Kingdom; the same applies as regards the non-registered word mark RED LETTER DAYS. The non-registered device marks consisting of a red envelope, as shown above, are allegedly used in the United Kingdom. The earlier sign in the form of a non-registered trade mark and company name RED LETTER DAYS PLC is used in the United Kingdom. All of the above are allegedly used for a range of goods and services in Classes 9, 14, 16, 18, 21, 25, 26, 33, 35, 36, 39, 41, 42, 43 and 44, *inter alia* in Class 35 for organisation, operation and supervision of incentive schemes; administration of incentive schemes; in Class 36 for insurance services; gift certificates; gift vouchers; leasing, rental and sale of property; issuing of vouchers in relation to incentive schemes, in Class 39 for travel services; delivery of flowers; delivery of magazines; delivery of food and drink products, in Class 41 for entertainment services, namely, arrangement and provision of sporting activities, leisure activities and special interest events; arranging of sporting activities; cultural activities; training services all relating to leisure and lifestyle activities; arranging of leisure activities; educational services all relating to leisure and lifestyle activities; exhibition and conference services; and in Class 42 for website design services.

The Opposition Division had upheld the opposition for part of the contested services under Article 8(1) CTMR, namely in respect of composing advertisements for use as web pages in Class 35, computer services relating to the sale of goods; graphic design for the compilation of web pages on the internet and creating and maintaining websites in Class 42. It had rejected it as to the remainder, holding that the rest of the services of the application in Classes 35 and 42 were dissimilar to the goods and services on which the opposition is based. As regards Article 8(4) CTMR, the Opposition Division had dismissed the relevant claim on the grounds that the opponent had failed to invoke any specific ground contained in the law of the United Kingdom that would entitle it to prohibit the use of the mark applied for, irrespective of the fact that the earlier signs invoked in that context may have been used in the course of trade and might eventually have acquired goodwill or reputation.

On appeal, the Board had broadened the scope of the rejection of the CTM application under Article 8(1) b) CTMR to also include advertising, advertising and marketing services

and promotion services in Class 35. As regards Article 8(4) CTMR, it dismissed the finding that the opponent had not specifically identified the relevant provisions of UK law and had remitted the case back to the Opposition Division pursuant to Article 62(1) CTMR for further prosecution, that is, in order to examine the merits of this claim, also taking into consideration the complementary evidence submitted by the opponent at the appeal proceedings.

RedEnvelope-II : T-416/07 – Office response filed.

The legal issues are the same as in Red Envelope-I, above. The sign applied for is “REDENVELOPE” (word mark). The challenged Board decision is that of 14.9.2007 in R 0765/2005-1, relating to CTM application No. 1 601 392.

NEW DECISIONS FROM THE BOARDS OF APPEAL

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

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 N°', without the letter 'R'.

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

I - Procedural issues

R 0108/2008-2 RUUKKI – (fin)
R 0883/2005-4 OSEOFORT / OSTEOFORTE – (en)

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

R 0108/2008-2 RUUKKI – (fin)
R 0559/2004-1 (i) – (de)

III - Inter partes – Article 8(4) CTMR

R 0980/2004-1(real) / real,- – (en)

Inter-partes – Articles 8(1)(b) and 52(1)(a) CTMR

R 0247/2006-4(BALI KITCHEN) / BALI – (de)

I - Procedural issues

Appeal proceedings – language of the proceedings – interpretation – guidelines – case-law

Decision of the Second Board of Appeal of 24 May 2008 in Case R 108/2008-2 (Finnish)

R 0108/2008-2 RUUKKI – (fin) – following the 'KIK' and 'CARDIOLOGY UPDATE' cases, Article 115(4) CTMR and Rule 48(2) CTMR must be interpreted as meaning that even if the decision subject to appeal was taken in the second language of the application, the notice of appeal and statement of grounds shall be filed in the language of proceedings, which in *ex parte* cases is always the first language of the application.

Opposition proceedings – proof of use – proper reasons for non-use

Decision of the Fourth Board of Appeal of 27 May 2008 in Case R 883/2005-4 (English)

R 0883/2005-4 OSEOFORT / OSTEOFORTE – (en) – the Board confirmed that for the sole earlier right invoked, Spanish trade mark No 1940 507, the opponent failed to furnish proof of use or proper reasons for non-use. Consequently, the Opposition Division had to reject the opposition. The opponent's request for a marketing authorization was pending before the Spanish health authorities for only three months out of a period of five years. However, the Board observed, after taking a more detailed look at the legal background, that proper reasons for the non-use were not given, identifying four main points, namely that no use was ever made of the mark at all, that the purported obstacle was merely mutual recognition, that the opponent did have a marketing authorization and that no explanations were given as to why he requested it so late

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

Absolute grounds for refusal – internet search – geographical indication – descriptiveness – distinctiveness – competence of the Boards – distinctiveness acquired by use

Decision of the Second Board of Appeal of 24 May 2008 in Case R 108/2008-2 (Finnish)

R 0108/2008-2 RUUKKI – (fin) – Ruukki is a former municipality of Finland located in northern Finland. In January 2007, the municipality joined together with Siikajoki, and Ruukki is now officially a village of Siikajoki. Ruukki is the oldest industrial locality in northern Finland: the industrial history of Ruukki goes back to 1672. The applicant did not contest the information cited by the examiner and the Board saw no reason to doubt its reliability in this specific case. The fact that the Ruukki municipality has merged with Siikajoki municipality very recently does not prevent the relevant consumers from understanding the term RUUKKI as a geographical indication. The Board held that the size of the geographical place concerned is not relevant in assessing the descriptiveness of the term in question. The word 'Ruukki' must remain freely available to all undertakings so that they



can describe their own goods using the same characteristic, i.e. goods emanating from Ruukki. The application was also held to be devoid of any distinctive character for the goods claimed, because it has no additional, in particular graphic, features, other than the descriptive indication, which could afford it distinctive character.

The applicant claimed for the first time in the appeal proceedings that the mark has acquired such distinctiveness for the goods in question. The Board remitted the case back to the examiner for an appraisal of the evidence of use submitted in the appeal proceedings. If the material submitted is found to be insufficient for the purposes of Article 7(3) CTMR, the examiner may invite the applicant to submit whatever further evidence might be deemed necessary.

Absolute grounds for refusal – letter – distinctiveness – Judgment of the CFI

Decision of the First Board of Appeal of 28 May 2008 in Case R 559/2004-1 (German)

I **R 0559/2004-1 (i) – (de)** – the mark applied for is a capital letter “I” in ordinary blue font. The services claimed are largely in the real state sector. The decision of the Board of Appeal – issued after a judgment of the CFI (T 441/05) had annulled a previous Board decision for lack of reasoning – found the mark devoid of distinctive character (Article 7(1)(b) CTMR) on the grounds that the relevant consumers are unlikely to perceive it as a trade mark. The decision focuses on the various ways in which the sign in question might be used and points out that it is capable of being understood, if noticed at all, as indicating various things apart from trade origin.

III - Inter partes – Article 8(4) CTMR

Opposition proceedings – sign used in the course of trade – national law – similarity of signs – retail services

Decision of the First Board of Appeal of 13 May 2008 in Case R 980/2004-1 (English)



R 0980/2004-1 (real) / real,- – (en) – the opponent invoked ‘real,-’ as the dominant part of its company name ‘real,- SB Warenhaus GmbH’, as an abbreviation of its company name, and as a trade name of the opponent’s business establishments, all being signs used in the course of trade in the sense of Article 8(4) CTMR in combination with German law, in particular § 5(2) and § 15(2) of the German Law on the Protection of Trade Marks and Other Signs (hereinafter ‘Markengesetz’).

In the contested decision the Opposition Division came to the conclusion that the opponent had not proved its well-established presence in the market nor that the goods or services on which it had based its opposition had been sold or

rendered under its trade name ‘real,-’. In this respect, the Board held that the Opposition Division had erred in applying German law. The opponent based its opposition on the submission that it runs department stores where, amongst others, the listed goods and services are sold or provided to the public. It did not invoke the goods and services as such but the operating of a department store business with regard to certain goods and services offered therein. This is in line with the provisions of the Markengesetz which also protects commercial designations including company symbols, i.e. ‘signs used in the course of trade as names or special designations of business establishments or enterprises’. Therefore, it is not necessary that the goods themselves bear the commercial designation, as the Opposition Division seemed to suppose, thereby confusing a commercial designation used for services rendered by the enterprise with a trade mark protected for goods.

The contested decision was annulled. The Board held that the conflicting signs are, if considering the visual impression and, to a minor extent, the conceptual impression of the distinctive elements, somewhat similar. Still, the word element is identical which leads to an aural identity and a conceptual similarity. Nevertheless, it must be appreciated that the phonetic impression is of little importance in the context of a self-service department store and that, conceptually, the additional symbols counteract to a certain extent the effect of the word element ‘real’. As to the sectors of activity of the contested trade mark for computer software in Class 9 and computer services in Class 42, those are similar to a low degree with the services rendered by the department store ‘real,-’. As the sectors of activities do not share any relevant common features, the Board concluded that the contested mark is not capable of causing confusion with the commercial designation of the opponent regarding the goods and services in Classes 9 and 42 of the contested mark.

III - Inter-partes – Articles 8(1)(b) and 52(1)(a) CTMR

Cancellation proceedings – first time on appeal – new claim – admissibility – likelihood of confusion – dissimilar goods – weak earlier mark – geographical origin

Decision of the Fourth Board of Appeal of 27 May 2008 in Case R 247/2006-4 (German)



R 0247/2006-4 (BALI KITCHEN) / BALI – (de) – the Board did not take into account the claim of enhanced distinctiveness acquired by use, as claimed for the first time on appeal. The goods are not very similar or are dissimilar (‘milk, coconut fat, coconut butter, preserved meat and vegetables’ (Class 29), ‘spices, condiments, noodles and chips, snacks’ (Class 30) and ‘juices from fruits, soft drinks and coconut milk’ (Class 32) v. ‘rice’). The earlier trade mark BALI, which consists solely of the indication of a geographical region with no fanciful additions such as word or graphic elements, has an extremely weak distinctive character, and the more recent trade mark has only one descriptive element in common with the earlier trade mark. There is no likelihood of confusion between the two marks.