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Serving IP users during the recession

OHIM President Wubbo de Boer reviews the first six months of 2009 and looks at the challenges ahead.

When financial times get tough, companies tend to question every investment decision even more carefully. In common with most major world IP offices, OHIM has seen a slight drop in demand, though it is encouraging to see that in recent months we have started to regain some of the lost ground.

The reality is, our customers are affected by the economic crisis and, consequently, so are we. We saw a drop in applications when the "dot-com" bubble burst and from the middle part of last year CTM and RCD applications started to decline in response to the current problems.

In recent months there have been modest signs of recovery so that, in the first half of 2009, CTM applications were down by around 5% compared the same period in 2008; design applications have fared slightly less well. Overall, I would say that, given the seriousness of the downturn, that is a steady performance.

We think it helps companies to continue to make the decision to invest in protecting IP rights if the process is simpler, faster, and cheaper – provided quality standards are maintained or improved.

Over a number of years we have managed to speed up procedures so that the registration period for a CTM has fallen from 22 months to between six and eight months on average for an application that does not run into objections or opposition.

In May this year we introduced a 40% cut in the cost of getting a CTM – this was the second reduction in fees. At the same time, we also simplified the process by doing away with the separate registration fee and it now costs just €900 to get a CTM via an online application.

An increasing proportion of our business is now done online. More than 90% of CTM applications come via the updated CTM E-Filing system and, the new RCD E-Filing means that the proportion of designs filed online is now over 60%, and is growing rapidly.

Our vision towards having an Office in which business is 100% electronic is progressing, but has still some way to go. An important step was the updating of some of our back office services. We had been using an electronic file management system for dealing with trade mark procedures since 1996. That system served us well, but it needed to be updated, and at the end of February a completely new tool (EuroMarc++) was introduced after years of development. The goal of the system is to have a simplified workflow, task-oriented structure, and allocation of work according to the specific competences of each examiner.

Many things are functioning well - for example, the data migration from the old system to the new one was completed successfully, however, we acknowledge that there have been problems. This is a large-scale computer program and the Office is still working on solving difficulties, which are affecting performance and to a certain extent also user satisfaction. We will continue to keep users informed via the website but I am convinced that, ultimately, the results of this initiative will be seen in improved quality and service standards.

We need the right tools to run a modern IP office, and of course, we also need the right management structures. That is the reason why there have been changes recently in our departmental structure. The most visible difference for users is the bringing of all the steps from application to registration under a single Community trade mark department. This has been accompanied by various other measures to reinforce quality, using where possible modern tools and databases, with the intention of ensuring that we continue to make progress on our promises to users.



The James Nurton interview with Ingrid Mennens, Novagraaf, Belgium

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, he talks to Ingrid Mennens, managing director of Novagraaf Belgium, about reforms in the Benelux, how oppositions can be improved at OHIM and the changing demands on trade mark attorneys.

When did you first become interested in trade marks?

I studied law and took IP as the main course in my final, fifth, year. I liked the topic above others such as fiscal and tax law as it involved something tangible. So I then contacted a trade mark consultancy firm and started immediately. I have now been a trade mark attorney for more than 20 years and it has been a very interesting career. I have worked for a couple of different companies and am now back at Novagraaf, where I worked earlier in my career.

What do you like about working in trade marks?

Trade marks are very visible in daily life – they are not theoretical – and you have contact with a lot of people. In some areas of law you are mainly dealing with problems, but trade marks are constructive and people are enthusiastic because they are building something up.

Do you only work in trade marks?

Our firm does do patent work but not in Belgium. And we do design work but it is less important than trade marks. We also increasingly work with domain names, which are closely involved with trade marks.

Traditionally we do prosecution work, but there is more and more competition now with trade mark offices, as there is more do-it-yourself filing. There are individuals and start-ups who want to file applications themselves to save money, and there are big companies with their own legal and IT departments. But there are many issues involved and we have found that sometimes inexperienced applicants regret not using a professional adviser.

Increasingly we are involved in other work, such as Customs actions, domain name disputes and *saisie-description* actions, which allow you to investigate whether a trade mark is being infringed together with a bailiff. You can compare products and describe what you see. It is a very useful tool in anti-counterfeiting procedures.

What sort of clients do you have and how big is the firm?

We have a lot of Belgian SME clients. They need different services to global companies, though we also act for some of these – including the world's biggest brewery. We have 30 people, including six attorneys, in Belgium.

How many applications do you handle?

We probably file close to 1,000 marks a year and we have about 1,600 Community trade marks in our portfolio. We didn't file a lot of CTMs in the beginning but the number is increasing now.

Why is that?

It probably depended in part on the size of the clients. Smaller companies preferred to file for Benelux rights. But now we see a stricter standard of refusals on absolute grounds in the Benelux office, so the CTM is being preferred.

Do you think the approach is too strict?

I have the impression that trade mark offices sometimes lack a bit of feeling with commercial reality. Some types of trade marks work very well in practice – there are a lot of elements that help consumers to recognise products. Examiners need to take a balanced approach. There is still a bit of frustration, and even at OHIM the grounds of refusal are not always reasonable to clients.

Are you happy with the service at OHIM?

Overall we are quite satisfied with how it works. In particular, the information centre works really well. But the examiners are often hard to reach: it can be difficult to get your examiner on the line, which can mean that some actions take a few weeks longer than they need to.

Everybody is talking about costs at the moment! To take a different view, I do think the opposition charges are quite low – taking a psychological view, we might prefer them to be higher.

The opposition system is generally working well, but we are not very happy with the long cooling-off period. As you automatically have two years there is not much incentive to go ahead with the opposition, and everyone takes their time. If you don't agree soon, it just adds another year or year-and-a-half until you know the outcome of the procedure. If you have a deadline, that's a good incentive to make a decision.

How does OHIM compare with the Benelux office?

The Benelux office is working really fast in prosecution, and the accelerated registration allows you to get a trade mark in as little as a couple of hours! I think there is a love-hate relationship between the Benelux office and OHIM. The CTM was originally seen as an enlargement of the Benelux trade mark, for example with the adoption of the principle of likelihood of association. But in practice it has turned out not to be the same as Benelux.

Meanwhile, in Benelux there have been a lot of changes. It used to be a very passive office, with no absolute grounds examination and no oppositions. But examination is now hard and oppositions have been introduced and it has turned out to be stricter. Another difference is that in the Benelux oppositions can only be based on identical or similar trade marks, not on the basis of reputation.

There may also be further changes in Benelux as there is a proposal to introduce a chamber for appeals and cancellation actions, so you do not have to file an appeal before the courts. That proposal is only at an early stage though.

What was the first CTM you filed?

I couldn't say as I was working for another company when the CTM was launched and we filed about 1,000 applications in the sunrise period. Everybody worked on filing and translating the description of goods, which kept us very busy during that time.



Probably the most interesting case I worked on was protecting various aspects of the Toblerone brand. We filed applications for the tablet itself, and the various forms of packaging, including the shapes with and without the colours. It was interesting to see what was accepted and what wasn't and the reasons given. For example, the triangular shape of the box was accepted but the hexagonal one was not, as it was sold only with a word mark. We thought the hexagon was inspired and distinctive. But ultimately there is always a personal, subjective element in assessing whether the conditions are met.

What has changed during your career?

The changes I mentioned in the Benelux office practice have been important. And our work used to be mainly prosecution, but that changed with the CTM and the need to deal with oppositions. The other major change is the increasing number of international registrations, which changes a lot of portfolios. It means we have to find the most appropriate protection for the client's current needs.

Trade marks have changed a lot in the past 20 years – they are now important assets for companies. So they are higher on the agenda and get more attention and there is a lot at stake if there is a conflict. And, with the change in the size of many companies, there is a change in how to manage trade mark portfolios and costs are always an issue.

Also, the profession of trade mark attorneys has changed a lot and they are now more active. Trade marks are more likely to conflict with other rights such as domain names, so there is a lot more strategy involved. It is no longer just about filing and watching; there is a whole strategy that has to be put together.

Community Trade Mark

LASTMINUTE.COM ruled invalid for some information services

The LASTMINUTE.COM Community trade mark has been ruled invalid for some of the commercial or business information services for which it was originally registered.

The UK company that owns the mark, Last Minute Network Ltd, was granted the CTM in 2004 for a range of services in classes 35, 36, 37, 38, 39, 41 and 42. However, the mark was refused for ticket reservation services for sport and entertainment in Class 41 and for travel agency services and reservation services for restaurants in Class 42.

Subsequently, the German firm, L'TUR TOURISMUS AG filed a request for declaration of invalidity against all services for which the trade mark was registered on the grounds that it was descriptive, devoid of distinctive character and generic (Article 7(1)(b), (c) and (d) CTMR in conjunction with Article 51 CMTR).

The invalidity applicant argued that LASTMINUTE.COM would be considered only as a domain name for Internet pages with content relating to last-minute offers, and not as a

trade mark relating to a specific business. Furthermore, the term "last minute" was used by many companies to describe products or activities rendered at the last minute and would not be understood as an indication of origin from one particular company. By its CTM registration of LASTMINUTE.COM the CTM proprietor could effectively preclude all its competitors from indicating that they provided last-minute services, especially via the Internet.

The applicant also claimed that the UK company was guilty of bad faith in registering the CTM. L'TUR TOURISMUS AG had been offering last-minute holidays on the German market since 1987, and by 1998 was also established on the Internet as the "last-minute market leader in Europe" with its unregistered trade mark "L'TUR-Last-Minute". Since the CTM proprietor had been using the term LASTMINUTE only since December 1998, it was alleged that it had been exploiting the existing degree of recognition of the applicant's trade mark.

The German firm also sought the revocation of the contested trade mark on the ground of lack of genuine use in respect of part of the services and because the CTM proprietor had not taken action against third party trade marks containing the words "LASTMINUTE", thereby allowing the trade mark to be diluted.

In response, the CTM proprietor pointed out that it was irrelevant to refer to the fact that the expression "last minute" was well-known, especially in the field of travel business, since the contested trade mark did not currently protect travel services. The fact that "last minute" could be used in a descriptive manner and that it had become a common phrase in the English language for any action taken just in time did not preclude the term from being a distinctive trade mark for certain goods and services, including the services covered by the contested registration. The CTM proprietor also denied the allegation that it only offered so-called last-minute services, since several of the services offered on its website could be purchased well in advance. The UK company also claimed that its registered trade mark had acquired a secondary meaning and distinctiveness through the use made of it.

Rejecting the request for revocation under Article 50(1)(a) and 50(1)(b) CTMR, the Cancellation Division said that combining invalidity and revocation requests was not admissible under the rules. They had to be filed as separate requests and a separate fee should be paid.

On the "bad faith" claim, the Office said that the burden of proof was on the cancellation applicant to show that the CTM proprietor acted in bad faith when filing the application. However, the reasoning of the applicant was inconclusive and even contradictory to the extent that, on the one hand, they argued that the term "lastminute" was descriptive and non-distinctive and, on the other that they had obtained exclusive rights to this term in Germany, where its meaning would also be understood.

With regard to the claim that LASTMINUTE.COM had been registered with a view to preventing third parties from using the words, without the intention to exploit the mark in respect of part of the services concerned, the Cancellation Division noted that there was no requirement for the owner of a registration to show genuine use before five years from



registration have lapsed. Thus, absence of use was not a ground for establishing bad faith. Similarly, applying for protection across a broad range of goods and services did not constitute bad faith.

Turning to the alleged descriptiveness, lack of distinctiveness and generic nature of the trade mark, the Office said that the extensive references to Internet websites featuring the descriptive use of the word "last-minute" in domains relating to various business sectors did not allow conclusions to be drawn as to its suitability to indicate commercial origin when it came to the specific services covered by the contested registration.

Many of the services covered were of such a nature that it was quite unlikely that the relevant public would consider their availability at very short notice as a relevant feature. Nor had it been adequately proven that these services were normally rendered at the very last minute.

Given the foregoing, the Office concluded that the combination LASTMINUTE.COM was inherently distinctive in respect of the following services covered by the contested registration:

- Class 35 *auctioneering services including via the Internet; provision and/or rental of advertising space on the Internet; compilation of business directories; advertising and promotional services; dissemination of advertising matter; the bringing together, for the benefit of others, of a variety of goods and/or services, enabling customers to conveniently view and purchase those goods and/or services via the Internet; information, advisory and consultancy services relating to the aforesaid.*
- Class 36: *financial and banking services; consultancy and advisory services relating to the aforesaid.*
- Class 37: *provision of plumbing services, cleaning services, ironing services, carpentry services, electrical and building services; the provision of information, advisory and consultancy services relating to gas and central heating, and other household/domestic services; installation services relating thereto; information, consultancy and advisory services relating to the aforesaid.*
- Class 38 *telecommunication services; provision of electronic communications links, electronic order transmission services; electronic transmission services; providing access to on-line information; providing access to the Internet to allow electronic purchasing.*

Class 42 *provision of facilities and equipment to enable trade via electronic means or non-electronic means; design of facilities for the searching and retrieval of information via the Internet and on-line databases including related networking systems; provision of dating/introduction services; social escorting services; provision of information via the Internet, databases or other electronic means in relation to the aforesaid; gardening services; information, advisory and consultancy services relating to the aforesaid.*

However, the Office partly agreed with the applicant in that, for some services, the expression LASTMINUTE.COM was, if not directly descriptive, at least non-distinctive to the extent that the possibility of obtaining, by accessing an Internet address, last-minute information was a relevant feature likely to orientate the consumers' choice to resort to the CTM proprietor's services

Regarding the provision of information relating to sport and entertainment, the Office noted that the evidence filed by the CTM proprietor showed beyond any doubt that the visitors of its websites were given the opportunity to access sport and entertainment-related information.

For example, sections of the site were dedicated to sports such as football, rugby and racing-related topics, others to information relating to shows, representations, and events. Given the above, the Cancellation Division concluded that the CTM proprietor had proven that its registered trade mark had acquired distinctiveness in respect of *provision of information relating to sport and entertainment; information, advisory and consultancy services relating to the aforesaid* if not at the time of filing of the trade mark, at the time of its registration, so that, under Article 51(2) CTMR, the registration could not be declared invalid in that respect.

However, OHIM's Cancellation Division found that the registration was partially invalid, namely for commercial information agency services; provision of information relating to businesses and companies in class 35 and provision of financial information; information services relating to financial and banking services in class 36. The invalidity request was rejected for the remainder of the services.



Country overview: Hungary & the Community Trade Mark



Hungary, with a population of 10m, is a landlocked state with many neighbours – Slovakia, Ukraine, Romania, Serbia, Croatia, Slovenia and Austria. The capital city, Budapest, which straddles the River Danube, is rich in history and culture and famed for its curative springs.

The country held its first multiparty elections in 1990 and initiated a free market economy. It joined NATO in 1999 and the EU in 2004.

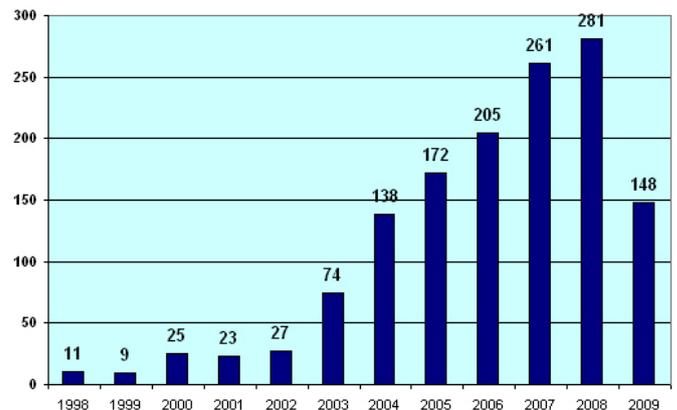
Hungary has some limited natural resources (bauxite, coal, and natural gas), as well as fertile soil and arable land. Hungarian wines are enjoyed throughout Europe. The country's main manufactured exports include electric and electronic equipment, machinery, foodstuffs and chemicals.

Hungarian GDP per capita is around two-thirds of the EU average. GDP growth fell by 2.5% in the first quarter of this year compared with the previous quarter, a performance in line with that of the EU as a whole (-2.4%).

The service sector accounts for an estimated 65% of Hungarian GDP, followed by industry (40%) and agriculture (3%).

Hungarian undertakings have filed almost 1 400 CTMs in total, including 280 last year. This year so far, there have been almost 150 filings.

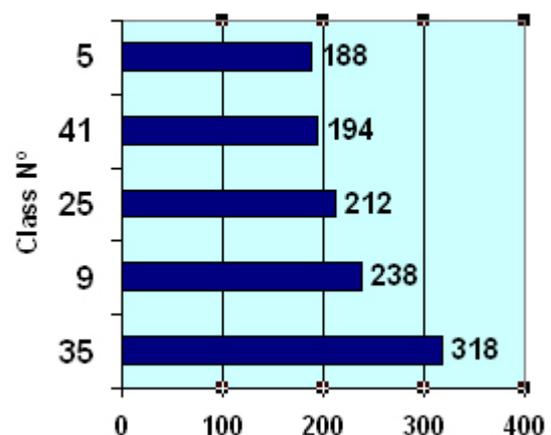
Hungary - CTM Filing Evolution
(Total CTMs: 1 374)



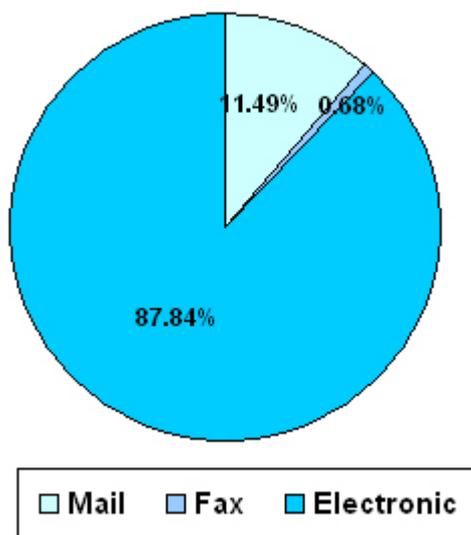
Word	Figurative 3-D	Colour	Other	Sound
47.40%	49.58%	2.04%	0.98%	0.00%

Figurative marks are the most popular with Hungarian enterprises and account for 50% of applications, followed by word marks (47%). The most popular goods and services applied for are in classes 35, 9 and 25.

Hungary - Top Classes Filed (Nice)



The vast majority of Hungarian trade marks (88%) are filed electronically, with mail accounting for 11% and fax for less than 1%.



Top 10 Hungarian-based owners by number of CTMs filed

Company	CTMs
PJ HUNGARY SZOLGALTATÓ KORLATOLT FELELŐSÉGŰ TARSASAG	31
Zwack Unicum Nyrt.	27
MEDICO UNO PHARMA GYÓGYSZERKERESKEDELMI KFT	26
URSA Salgótarján Glass Wool Close Co., Ltd.	25
OTP Bank Nyrt.	24
MOL Magyar Olaj- és Gázipari Nyilvánosan Működő Részvénytársaság	22
G-Star Raw Denim Kft	21
The Dream Merchant Company Kft	19
SWEET POINT EDESIPARI ZRT.	17
VITAFREENET KFT.	15

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

Representative	CTMs
DANUBIA SZABADALMI ÉS JOGI IRODA KFT.	114
S.B.G. & K. ÜGYVÉDI IRODA	79
PATENDER NEMZETKOZI IPARJOGVEDELMI KEPVISELETI KFT.	41
CARLOS POLO & ASOCIADOS	40
NOVAGRAAF NEDERLAND B.V.	39
Mészárosné Dónusz	36
GEORG PINTZ & PARTNERS	31
SZÉLES ÜGYVÉDI IRODA	30
ELZABURU, S.L.P.	28
INTERINNO SZABADALMI IRODA	27

Community Design

First Decision of the ECJ on Community Designs

In the first preliminary-ruling case concerning Community designs reported in the [Alicante News of March 2009](#) the European Court of Justice took a decision on 2 July 2009 (C-32/08) where it ruled as follows:

1. Article 14(3) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs does not apply to Community designs that have been produced as a result of a commission.
2. In circumstances such as those of the main proceedings, Article 14(1) of Regulation No 6/2002 must be interpreted as meaning that the right to the Community design vests in the designer, unless it has been assigned by way of contract to his successor in title.

As regards the five questions submitted by the Spanish *Juzgado de lo Mercantil Número Uno de Alicante* as follows itself, the reply of the Court reads as follows:

First of all, it should be borne in mind that, in the present case, the Court is only asked to rule on the case where, on the one hand, there are unregistered Community designs produced as a result of a commission, and on the other, the LPJDI does not deem such designs to be the same as designs developed in the context of an employment relationship.

Thus, it follows from the need for uniform application of Community law and from the principle of equality that the terms of a provision of Community law which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope must normally be given an autonomous and uniform interpretation throughout the Community, having regard to the context of the provision and the objective pursued by the legislation in question (see, *inter alia*, Case 327/82 Ekro [1984] ECR 107, paragraph 11; Case C - 287/98 Linster [2000] ECR I-6917, paragraph 43; and Case C - 316/05 Nokia [2006] ECR I-12083, paragraph 21).

That is the case for the terms 'designer' and 'successor in title' in Article 14 of the regulation.

If those terms were to be interpreted differently in the various Member States, the same circumstances could mean that in some Member States the right to the Community design belongs to the designer and in others to his successor in title. In that case, the protection afforded to the Community designs would not be uniform throughout the entire area of the Community (see, by analogy, Nokia, paragraph 27).

It is therefore essential that those terms be given a uniform interpretation within the Community legal order.

That interpretation is borne out by recital 1 in the preamble to the regulation, which states that '[the] unified system for obtaining a Community design ... is given [uniform protection]

with uniform effect throughout the entire territory of the Community ...'.

It is also clear from Article 1(3) of the regulation that the design is not to be transferred save in respect of the whole Community, unless otherwise provided in the regulation.

As regards, more particularly, the transfer of the right to a Community design from the designer to his successor in title within the meaning of Article 14(1) of the regulation, it should be noted that, as pointed out in essence by the FEIA, Cul de Sac and Acierta, the possibility of such a transfer is implicit from the wording of that article.

In addition, such an interpretation follows expressly from the term 'successor in title' in some language versions, such as the German, French, Polish, Slovenian and Swedish versions which refer to 'Rechtsnachfolger', 'ayant droit', 'następcy prawnemu', 'pravni naslednik' and 'den till vilken rätten har övergått' respectively.

Such a transfer includes contractual assignment.

It is clear from the drafting history of the regulation, as the Advocate General notes at points 46 to 50 of his Opinion, that the designer may transfer the right to a Community design to his successor in title by way of contract.

That interpretation is supported by recitals 8 and 15 in the preamble to the regulation which emphasise the need to adapt the protection of Community designs to the needs of all sectors of industry in the Community.

In addition, it is essential, for the purposes of protecting unregistered Community designs in particular, to uphold the right to prevent the copying of those designs, in accordance with recital 21 and Article 19(2) of the regulation.

Apart from individual designers referred to in recital 7, it follows from recitals 16 and 25 that some sectors of industry in the Community may also be the producers of unregistered Community designs.

In such circumstances, it cannot be ruled out, as the United Kingdom Government has in essence pointed out, that the successor in title is financially a stronger party than the designer and has more means at its disposal in order to commence proceedings with a view to preventing those designs from being copied.

Accordingly, adapting the protection of Community designs to the needs of all sectors of industry in the Community, as set out in recitals 8 and 15 in the preamble to the regulation, by means of a contractual assignment of the right to the Community design is likely to help to achieve the essential objective of the enforcement of the rights conferred by a Community design in an efficient manner throughout the territory of the Community, as set out in recital 29.

Moreover, in accordance with recital 7, enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of Community excellence in

the field, but also encourages innovation and development of new products and investment in their production.

It follows from the above that the possibility of assigning by way of contract the right to the Community design from the designer to his successor in title within the meaning of Article 14(1) of the regulation is consistent with both the wording of that article and the aims of the regulation.

It is, however, for the national court to ascertain the contents of such a contract and in that regard to determine whether the right to the unregistered Community design has in fact been transferred from the designer to his successor in title.

The above considerations clearly do not preclude the national court, in the context of that assessment, from applying the law on contracts in order to determine who owns the right to the unregistered Community design, in accordance with Article 14(1) of the regulation.

In the light of all the above considerations, in circumstances such as those of the main proceedings, the answer to part (a) of the third question is that Article 14(1) of the regulation must be interpreted as meaning that the right to the Community design vests in the designer, unless it has been assigned by way of contract to his successor in title.

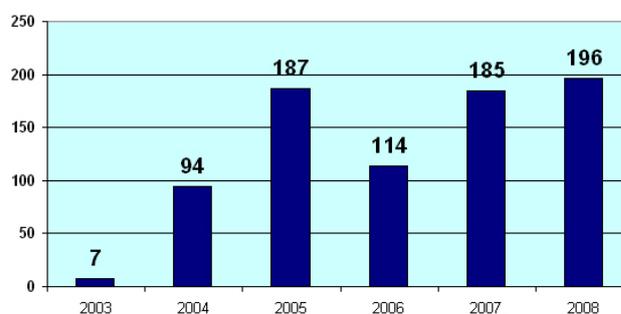
Part (b) of the third question, and the fourth and fifth questions

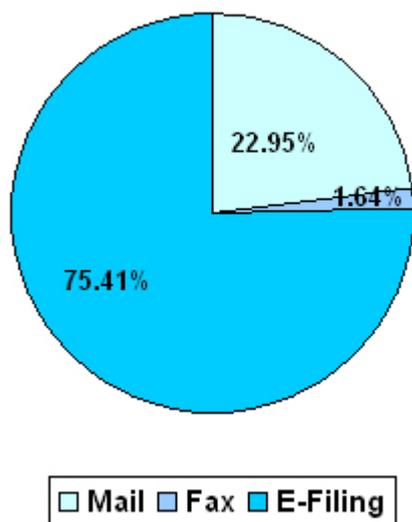
In the light of the answer to part (a) of the third question, it is not necessary to answer part (b) of that question, or the fourth or fifth questions.

Country overview: Hungary & the Registered Community Design

Around 850 registered Community designs have been filed by Hungarian companies today date, including just under 200 last year.

Hungary - RCD Filing Evolution
(Total RCDs: 844)



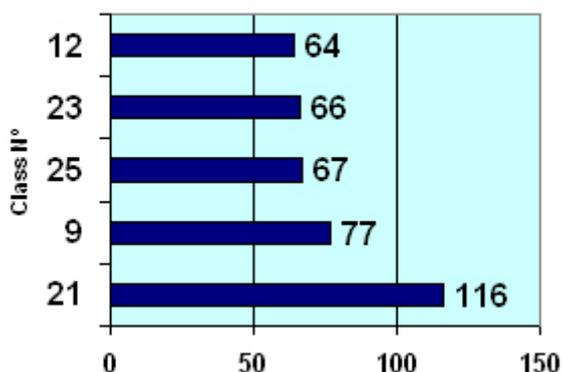


Top 10 representatives by number of RCDs received from Hungarian - based applicants

Representative	RCDs
Varga	125
S.B.G. & K. ÜGYVÉDI IRODA	91
DANUBIA SZABADALMI ÉS JOGI IRODA KFT.	68
PATENDER NEMZETKOZI IPARJOGVEDELMI KEPVISELETI KFT.	45
GEORG PINTZ & PARTNERS	40
ADVOPATENT OFFICE OF PATENT AND TRADEMARK ATTORNEYS	33
Kormos	28
CARLOS POLO & ASOCIADOS	27
DEVELOPAT SZABADALMI ES VEDJEGY IRODA	24
JUREX IPARJOGVEDELMI IRODA	24

The most popular classes for RCDs are 21, 9 and 25. E-filing now accounts for over three-quarters of Hungarian RCD filings, with mail the second most popular at 23%. Less than 2% of RCDs are filed by fax.

Hungary - Top Classes Filed (Locarno)



Top 10 Hungarian - based owners by number of RCDs filed

Owner	RCDs
Fireplace Kft.	61
Csepi	56
FRIESLAND Hungaria zRt.	45
Bogáthy	29
ITALOTRADE KFT	28
Horvath	26
Scroll-Info Reklamszolgáltató Kft.	24
Illes Csók es Tsa. Kkt.	23
Lamperth	22
PJ HUNGARY SZOLGALTATÓ KORLATOLT FELELŐSÉGŰ TARSASAG	21

E-business at OHIM Summer review of e-business.

This year OHIM has launched two important improvements to its e-business solutions: CTM and RCD E-Filing. Despite some issues with the CTM E-Filing solution during its inception phase, the feedback from customers regarding both tools has generally been very positive.

User experience has significantly improved, and this has resulted in increased use of E-Filing. More than 90% of CTM applications and 65% of RCD applications are currently filed online.

In June, OHIM started a programme of practical workshops dedicated to the e-business solutions, mainly focusing on the e-filing tools, but also covering MyPage and E-Communication.

The workshop series is being organised in cooperation with the relevant national professional organisations in the IP field. Events have already taken place in June and July in Warsaw (Poland), Milan and Rome (Italy), Manchester and London (United Kingdom) and Paris (France). More than 200 people have attended the workshops, and this has provided a good opportunity to get direct feedback from users. For example, it emerged that users wanted RCD E-Filing applications that they were in the process of completing, to remain available for longer in "saved" form, before being submitted. In response, we have extended the time that a saved application remains available from two hours to four hours.

Similar workshops will be held in September and October in Germany, Spain, Portugal and Hungary. Dates and details will be announced on the OHIM website under the events section.

In order to extend the training available for OHIM e-business solutions, online demonstrations are also published under the

[multimedia section](#) of the website and OHIM is looking at solutions for providing short interactive workshops online.

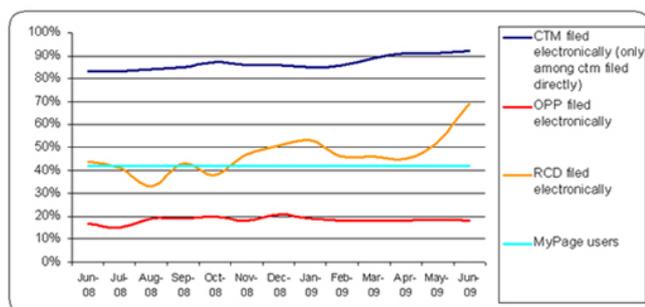
During the second half of this year, new e-business solutions will be made available. An improved MyPage, with a new layout, and a new CTM watch service are in the pipeline. It is also expected that RCD E-filing will be made available via MyPage.

Further information will be posted on our website so please stay connected.

OHIM e-business roundup (2009)

Statistical summary

- The use of the CTM e-filing web form is steady at above 90%.
- The use of RCD e-filing has increased over 60%
- Oppositions against CTM applications received electronically are around 18%.
- MyPage users represent around 42% of CTM Applications filed.



State of play of future projects:

Service	Status
New version of MyPage The current MyPage service will be improved with a new layout consistent with the website design and some enhanced functionalities.	OHIM is going to start the testing phase
CTM watch The objective is to provide an e-mail notification tool when specific CTM status changes. This service will only be available to MyPage users	OHIM is going to start the testing phase

More News

OHIM and China: 2009 highlights

OHIM's activities in China date back to the IPR 1 programme in 2002. Now, after the launch of the IPR 2 programme in 2007, and in particular the establishment of annual work plans with China, the pace of activities has increased.

The Office is the primary provider of trade mark and design expertise in the framework of the EU-China project on the protection of IPR (IPR 2). The aim of this project is to assist Chinese authorities in the strengthening of their IP systems, notably their enforcement. The project is a multi-annual one and is funded by the European Commission and the Chinese authorities.

The Office has bilateral relations with the responsible trade mark and designs agencies in China and in April, OHIM signed agreements for further cooperation with these organisations. This marked an important step forward in this process.

In a nutshell, OHIM seeks as regards China:

- To promote the Community trade mark and design among the Chinese user community, with a view to making them part of the "mainstream" of the users at OHIM.
- To assist Chinese authorities in their efforts to streamline examination and cancellation processes and establish fully-fledged electronic business services for users.

This has translated into a number of milestones achieved so far during the first half of 2009 including the completion of "comparative studies", the conclusion of Memorandums of Understanding, agreements on continued promotional activities, and the stationing of an OHIM official in the EU Delegation in Beijing.

The purpose of the "comparative studies" between the CTM and the Chinese trade mark registration system, and the RCD and the Chinese design system, was to carry out an in-depth analysis of registration procedures, in order to form the basis for supporting co-operation activities.

In July a delegation from OHIM presented the draft reports on the comparative study in the State Administration for Industry and Commerce (SAIC) and the State Intellectual Property Office (SIPO) in Beijing. The design study has been formally delivered in agreement with SIPO.

As regards the comparative study with SAIC, areas for cooperation are:

- Quality Management System (e.g. mapping Processes and identifying relevant indicators)
- IT Issues (e.g. moving to full electronic workflows to shorten pendency times)
- Strategy Issues (e.g. strategies to ensure a regular workflow and reduce backlogs)



- Business Issues (e.g. Use of Nice Classification and 'ad hoc' sub-classifications)
- Training Issues (e.g. improving the current training programme. Assessing new training initiatives for examiners.)

The comparative study with SIPO identified the following areas for further cooperation:

- IT Issues
- Training Issues
- Quality Management System
- Classification
- Examination practice

As a result of the conclusion of Memorandums of Understanding with SAIC and SIPO in April 2009, a detailed planning of activities has been drawn up, lasting until mid-2010.

It has also been agreed to maintain promotional activities within the respective bilateral frameworks. For example, the first-ever international seminar on design registration organised by the trilateral partners in China, with the support of SIPO, took place in Shunde in June 2009.

One important initiative has been the stationing an OHIM official, Jesús Romero Fernandez, in the EU Delegation in Beijing, with a view to assisting the delegation in the implementation of the IPR 2 project, and to provide support to EU right holders before Chinese authorities in difficult enforcement situations.

The appointment of an OHIM representative to the EU Delegation in Beijing has significantly reinforced the capacity to provide support to EU companies on trade mark and design protection matters in China. In fact, since his arrival several EU companies have already made good use of this support. Moreover, in June 2009, the OHIM representative contributed to and coordinated, along with several European IP national offices, comments to the latest draft of the revision of the Chinese Trade Mark Law, following the official request of the Chinese Trademark Office. The different comments were presented in a single document indicating the office of origin.

Monthly statistical highlights June 2009

Community trade mark applications received	7 251
Community trade mark applications published	6 543
Community trade marks registered (certificates issued)	11 681
Community trade mark renewal applications	1 719
Registered Community designs received	4 313
Registered Community designs published	6 197

- *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

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

Waterford Stellenbosch: C-398/07-P – Appeal from T-105/05 - Judgment of 7 May 2009 (dismissed; CFI decision stands).

Keywords: Opposition: likelihood of confusion (LOC). – LOC: comparison of goods. – Comparison of goods: notion of complementarity. - Comparison of goods: wine and wine glasses.

By its appeal, Waterford Wedgwood plc sought to have set aside the judgment of the CFI of 12. 6. 2007 in case T-105/05 Assembled Investments (Proprietary) v OHIM — Waterford Wedgwood (WATERFORD STELLENBOSCH), by which the CFI had allowed the action brought against the decision of the 1 st Board 15. 12. 2004 (case R 0240/2004-1) by which the Board had allowed an opposition based on the consideration that wine and wine glasses were similar. In other words, the CFI had denied similarity between wine and wine glasses.

The 5th Chamber of the ECJ (Tizzano; Borg Barthet, rapporteur; Levits) confirmed the CFI and rejected the appeal, relying on standard case law.

Assembled Investments (Proprietary) Ltd ('Assembled Investments') had applied for the figurative sign "Waterford Stellenbosch" in class 33 for alcoholic beverages, namely wines produced in the Stellenbosch district, South Africa. It had been opposed on the basis of Waterford, word, registered inter alia in class 21 for articles of glassware, earthenware, chinaware and porcelain. The opposition division had rejected the opposition on the ground that there was no LOC in so far as the goods concerned were not similar, the fact that wine is generally drunk in a glass being insufficient in this respect, and that the evidence provided by Waterford Wedgwood was insufficient to establish the repute of the trade marks on which the opposition was based. By its decision at issue, the 1 st Board then had annulled that decision.

It had found, first, that the sign applied for and the earlier mark were highly similar on the visual, phonetic and conceptual levels for the relevant consumers in the UK and Ireland and, secondly, that the goods covered by the sign applied for and the 'articles of glassware' in the earlier mark were similar on account of the high degree to which wine and wine glasses complement each other. The Board also found that the evidence submitted by Waterford Wedgwood could be taken into account. A study based on a survey carried out among consumers in the United Kingdom established the strong distinctive character of the earlier mark in the UK and in Ireland.



In contrast, the CFI subsequently had assessed dissimilarity of wine and glassware. It first had found that these goods are distinct by their nature and their use, that they are neither in competition with one another nor substitutable and that they are not produced in the same areas. Then, as regards shared distribution channels, it held that such sales represent no more than a negligible proportion of the overall sales of the articles of glassware concerned. In the case of a wine glass and a bottle of wine being distributed together, the CFI found that this is normally perceived by the consumers concerned as a promotional attempt to increase sales of wine rather than as an indication that the producer concerned devotes part of his activity to the distribution of articles of glassware. Lastly, the CFI had noted that even though there is a degree of complementarity between some articles of glassware and wine, that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer's point of view, the goods in question are similar within the terms of Article 8(1)(b) CTMR. – As stated above, the ECJ agreed.

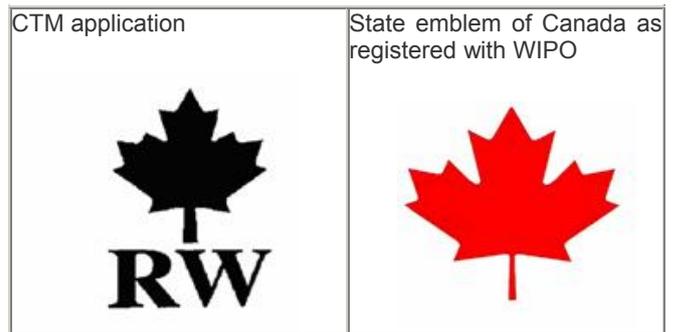
A-2: ECJ Judgments and Orders: Developments in pending cases

Maple Leaf : C-202/08-P and C-208/08-P – Appeal from T-215/06. Opinion of Advocate General Ruiz-Jarabo Colomer (in favour of the Office).

Keywords: IP Basics: Paris Convention for the Protection of Industrial Property, Article 6-ter PC. Absolute grounds for refusal: official emblems. Official emblems: signs which are identical or similar to a State emblem, Article 7(1)(h) CTMR. Article 7(1)(h) CTMR: whether it can be overcome through use. Official emblems: whether acceptable for service marks.

By this appeal from a judgment of the CFI of 28.2.2008 in Case T-215/06, both the CTM applicant and the Office have challenged the CFI decision. The legal question which the ECJ needs to clarify is the scope of the protection afforded to national emblems under Article 7(1)(h) CTMR in conjunction with Article 6-ter of the Paris Convention. On the one hand, the CTM applicant criticises the generous protection given by the judgment under appeal to national emblems, and, on the other, the Office challenges the judgment on the ground that it erred in interpreting the Paris Convention as precluding the protection of State symbols in respect of service marks.

In 2002, the CTM applicant had filed an application consisting of an image of a maple leaf with **the letters 'rw' in capitals, for goods and services in classes 18, 25 and 40, namely: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing, footwear, headgear, and tailoring; taxidermy; bookbinding; dressing, processing and finishing of skins, leather, furs and textiles; photographic film development and photographic printing; woodworking; fruit pressing; grain milling; processing, tempering and finishing of metal surfaces.**



In Case R 1463/2005-1, the 1st Board had confirmed rejection of the application. The Board stated that the red-coloured maple leaf was the emblem of Canada and, on the basis of the judgment of the CFI in the ECA Case, T-127/02, examined whether, from a heraldic point of view, the disputed sign contained an element which was identical to or an imitation of the Canadian emblem. The Board held that the word element 'RW' did not preclude the application of Article 6-ter (1)(a) PC. It further rejected the argument that the different colours of the maple leaves distinguished between them, since, as the application for registration did not specify any particular colour, the mark could be represented with any colour, including the vermilion of the Canadian emblem. It likewise did not accept the alleged reputation, in Belgium, of the mark RIVER WOODS, since it considered that use contrary to Article 7(1)(h) CTMR bars any acquisition of distinctiveness through use.

In contrast, the CFI took a different view as regards service marks and annulled the Board decision in respect of the services in class 40, on the grounds that Article 6-ter (1)(a) PC, to which Article 7(1)(h) CTMR refers, does not apply to services in general. To that end, it examined the wording of the provision in the Paris Convention, emphasising that it refers only to 'trade marks'. It also added that it is clear from Article 1(2), Article 6(1) and Article 6-ter PC that the Convention establishes a distinction between, on the one hand, trade marks and, on the other hand, service marks. As Article 6-ter refers only to trade marks, that is to say to marks for goods, it concluded that the prohibition on registration and use established by that provision does not apply to marks designating services.

The CFI also pointed out that Article 7(1)(h) CTMR merely refers to Article 6-ter PC, by stating that "the following shall not be registered: trade marks which [... are to be thus treated] pursuant to Article 6-ter (...)". As Article 6-ter PC does not concern service marks, they cannot be covered by the absolute ground for refusal established by that Community provision. In that regard, the CFI rejected OHIM's argument that Article 7 CTMR makes no distinction between marks for goods and service marks, since, according to the court, the distinction established by Article 6-ter PC prevails, according to the reference made to that provision by Article 7(1)(h) CTMR. The CFI inferred, from the combination of the two provisions, that the Community legislature intended not to extend the prohibition contained in Article 6-ter PC to services, since, if it had intended otherwise, it would have included a similar prohibition in the text of Article 7 CTMR, thereby avoiding the distinction which it implicitly created, by the mere fact of referring to Article 6-ter PC, between product marks and service marks.



Advocate General Ruiz-Jarabo Colomer started his analysis by saying: “ *The science of heraldry evokes fights and adventures from other ages such as that between Don Quixote and the Knight of the White Moon, so called because that glowing orb adorned his shield; but, fortunately, it is not a question of settling arguments regarding the ‘pre-eminence of beauty’ as between two ladies but of using the heraldic art to define the limits of the protection of a national emblem* ” and proposed to decide along the argumentation of the Office, namely to:

(1) dismiss the appeal brought by American Clothing Associates SA in Case C-202/08-P against the judgment delivered on 28 February 2008 by the Fifth Chamber of the CFI in Case T-215/06;

(2) allow the sole ground of appeal put forward by the OHIM in its appeal in Case C-208/08 P against the judgment delivered on 28 February 2008 by the Fifth Chamber of the CFI in Case T-215/06 and set aside that judgment in so far as it held that Article 7(1)(h) CTMR, in conjunction with Article 6 *ter* of the Paris Convention, did not apply to service marks.

I.T.@Manpower : C-520/08-P – Appeal from T-248/07; Office response filed.

Keywords: Absolute grounds for refusal (AG); distinctiveness. AG: descriptiveness stemming from generic use by the relevant public, Article 7(1)(d) CTMR.

The case is an appeal from a decision of the CFI (5th Chamber) of 24.9.2008 in Case T-248/05. The CTM at issue is **I.T.@Manpower** which had been unsuccessfully challenged on the basis of a request for invalidation.

The CTM is registered in class 9 for audio cassettes; audio-visual teaching apparatus; audio compact discs; video compact discs; computer software; computer programs; tape recorders; video tapes; video recorders; parts and fittings for all the aforesaid goods; in class 16 for books; printed matter; handbooks; manuals; magazines; printed publications; transparencies; instructional materials; teaching materials; parts and fittings for all the aforesaid goods; in class 35 for employment agency services; temporary personnel services; in class 38 for telecommunications services; providing access to global computer networks; electronic transmission of data, messages and information; telecommunication of information including web pages, computer programs and any other data; electronic mail services; provision of telecommunications access and links to computer databases and the Internet; information, consultancy and advisory services relating to all the aforesaid including such services provided on-line or via the Internet.

Further, in class 41, for the arranging and conducting of conferences and seminars; rental of movie projectors and accessories; rental of video recordings, audio recordings and cine-films; organisation of exhibitions; production of video and audio tapes; educational, instructional, teaching and training services, all relating to the tuition and assessment of office, industrial, driving and technical staff; information and advisory services, all relating to the foregoing, and in class 42 for professional consultancy and expert services, all relating to personnel vocational testing and guidance, personality

testing, psychological examination and career advice; personality and psychological testing services; career and vocational counselling; testing individuals to determine employment skills; occupational psychology services; consultancy services relating to the assessment, development and application of human resources; provision of temporary accommodation; information and advisory services and preparation of reports, all relating to the aforesaid; catering services; computer services; consultancy, design, testing, research and advisory services, all relating to computing and computer programming; website design services; computer programming; computer systems analysis; computer timesharing; research and development of computer hardware and software; technological services relating to computers; rental and leasing of computers; computer programming; computer rental and updating of computer software; computer software design; computer database leasing; providing access to electronic communications networks and electronic databases; transfer and dissemination of information and data via computer networks; hosting of websites; computer network services; providing access to the Internet; providing access to and leasing access time to computer databases and networks; compilation, storage, analysis and retrieval of data and information; computer help-line services; technical support services relating to computer hardware, computer software, computer networks and the Internet; computer network services; on-line services for the search, retrieval, indexing and organisation of data on electronic communication networks and for enhancing the performance and function of such networks; information, consultancy and advisory services relating to all the aforesaid services including such services provided on-line or via the Internet.

The cancellation request had been based on absolute grounds, namely on Article 7(1)(b), (c), (d) and (g) CTMR. The request had been rejected.

Pranahaus : C-494/08-P – Appeal from T-226/07; Office response filed (DE).

Keywords: Absolute grounds for refusal: descriptiveness.

The action is an appeal from a decision of the CFI of 17.9.2008 in Case T-226/07 (only in DE, FR) by which the court had confirmed rejection of CTM application PRANAHAUS, word, which had been applied for goods and services in classes 9, 16 and 35. The term PRANA indicates a specific (Hindi -) type of spiritualism, in particular yoga.

B: European Court of Justice Preliminary Rulings

B-1: ECJ Preliminary Rulings

Smirnoff Ice : C-62/08 – Order of 19 February 2009 (NL).

Keywords: CFI proceedings: Article 104(3), second subparagraph, of the Rules of Procedure – CTMR: Article 9(1)(a) and (2)(d) – TM rights: scope; right of the proprietor of a registered mark to prevent the use by a third party of a sign which is identical to the mark. Use: concept. Use by a third



party: of a sign which is identical to the mark by a trade intermediary in its business papers. Use by a third party: intermediary acting in its own name but on behalf of a vendor.

The case had been a reference from the Hof van Cassatie van België (Belgium) in UDV North America Inc v Brandtraders NV . The questions referred:

(1) For there to be use of the sign within the meaning of A 9(1)(a) CTMR, is it necessary that a third party within the meaning of A 9(1)(a) CTMR:

- uses the sign on his own behalf?
- 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 A 9(1)(a) and (2)(d) CTMR?"

The 2nd Chamber of the ECJ (Timmermans; rapporteur; Bonichot; Schiemann; Kuris; Bay Larsen; GA: Ruiz-Jarabo Colomer) gave the following answer:

“ The concept of 'use' for the purpose of Article 9(1)(a) and (2)(d) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark covers a situation, such as that at issue in the main proceedings, in which a trade intermediary, which is acting in its own name but on behalf of the vendor and is thus not an interested party in relation to trade in goods in which it is itself a contractual party, uses, in its business papers, a sign which is identical with a Community trade mark in relation to goods or services which are identical with those for which the mark is registered .”

Copad/Dior : C-59/08 – Judgment of 23 April 2009 .

Keywords: TM Directive: exhaustion of the rights of the proprietor of the TM. TM license agreement: sale of goods bearing the trade mark in disregard of a clause in the license agreement. Licensing: sale to discount stores. Licensing: no consent of the TM proprietor. Licensor: damage to the reputation of the mark.

The case had been a reference from the Cour de Cassation, France, in a dispute between Copad, a discounter, and Christian Dior couture SA. In May 2000, Dior had concluded a trade mark license agreement with company SIL in respect of the manufacture and distribution of luxury corsetry goods bearing the Christian Dior trade mark. Paragraph 5 of clause 8.2 of that agreement states that *“in order to maintain the repute and prestige of the trade mark the licensee agrees not to sell to wholesalers, buyers' collectives, discount stores, mail order companies, door-to-door sales companies or companies selling within private houses without prior written agreement from the licensor, and must make all necessary provision to ensure that that rule is complied with by its distributors or retailers”* .

Since it subsequently was faced with economic difficulties, in 2002, SIL asked Dior for permission to market goods sold under the Christian Dior trade mark outside its selective

distribution network. Dior refused to grant that request. Despite that refusal, SIL sold to Copad, a company operating a discount store business, goods bearing the Christian Dior trade mark. In consequence, Dior brought an action against SIL and Copad for infringement of a trade mark before the 'Tribunal de grande instance de Bobigny' which held that SIL's contravention of the license agreement did not constitute infringement and that it merely gave rise to contractual liability on the part of SIL. The 'Cour d'appel de Paris' dismissed the appeal brought by Dior against that judgment. In particular, it held that sales by SIL did not constitute infringement on the ground that compliance with the provision in the license agreement concluded between SIL and Dior relating to conditions governing distribution did not fall within the scope of the national provisions on trade mark law that transposed Article 8(2) of the TM Directive. The 'Cour d' appel de Paris', considered, nevertheless, that those sales did not imply exhaustion of Dior's trade mark rights, for the purposes of the national legislation transposing Article 7(1) of the Directive.

Copad brought an appeal before the 'Cour de cassation' against the judgment of the 'Cour d'appel de Paris', on the grounds, that the rights over the Dior trade mark were exhausted as a result of SIL having put the goods at issue on the market. For its part, Dior brought a cross-appeal, alleging that the 'Cour d'appel de Paris' was wrong to have ruled out any act of infringement by SIL and Copad. Accordingly, and given that it had doubts as to the interpretation of the relevant Community law, the 'Cour de cassation' decided to stay proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

1. Must Article 8(2) of the Directive be interpreted as meaning that the proprietor of a trade mark can invoke the rights conferred by that trade mark against a licensee who contravenes a provision in the license agreement prohibiting, on grounds of the trade mark's prestige, sale to discount stores?
2. Must Article 7(1) of that directive be interpreted as meaning that a licensee who puts goods bearing a trade mark on the market in the [EEA] in disregard of a provision of the license agreement prohibiting, on grounds of the trade mark's prestige, sale to discount stores, does so without the consent of the trade mark proprietor?
3. If not, can the proprietor invoke such a provision to oppose further commercialisation of the goods, on the basis of Article 7(2) of the Directive?

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

(1.) Article 8(2) (...) is to be interpreted as meaning that the proprietor of a trade mark can invoke the rights conferred by that trade mark against a licensee who contravenes a provision in a license agreement prohibiting, on grounds of the trade mark's prestige, sales to discount stores of goods such as the ones at issue in the main proceedings, provided it has been established that that contravention, by reason of the situation prevailing in the case in the main proceedings, damages the allure and prestigious image which bestows on those goods an aura of luxury.



(2.) Article 7(1) (...) is to be interpreted as meaning that a licensee who puts goods bearing a trade mark on the market in disregard of a provision in a license agreement does so without the consent of the proprietor of the trade mark where it is established that the provision in question is included in those listed in Article 8(2) of that Directive.

(3.) Where a licensee puts luxury goods on the market in contravention of a provision in a license agreement but must nevertheless be considered to have done so with the consent of the proprietor of the trade mark, the proprietor of the trade mark can rely on such a provision to oppose a resale of those goods on the basis of Article 7(2) of Directive 89/104, only if it can be established that, taking into account the particular circumstances of the case, such resale damages the reputation of the trade mark.

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

Pago/Tirolmilch : C-301/07 – Opinion of the Advocate General of 30 April 2009 .

Keywords: Reputation mark: criteria. Reputation criteria: territorial aspects.

The case is a reference from the Austrian Supreme Court. PAGO International GmbH owns a CTM for, *inter alia*, fruit drinks and fruit juices. Important elements of Pago's trade mark are the representation of a green glass bottle with a distinctive label and cap next to a full glass of fruit drink identified in large characters, known as PAGO. Tirol Milch registrierte Genossenschaft mbH markets in Austria a fruit and whey drink called 'Lattella', packaged in glass bottles whose design resembles in several respects (shape, colour, label, cap) that depicted in Pago's CTM). In the advertising for its drink, Tirol Milch uses a representation which, like Pago's CTM, shows a bottle next to a full glass. It is common knowledge that there is no likelihood of confusion, since the bottle labels used by Pago and Tirol Milch bear the names 'Pago' and 'Lattella' respectively and both names are widely known in Austria.

Pago sought an injunction before the 'Handelsgericht Wien' (Commercial Court) prohibiting Tirol Milch from infringing its trade mark by (i) promoting, offering for sale, marketing or otherwise using its drink in the bottles at issue, and (ii) advertising a representation of the bottles together with a full glass. That court granted the injunction but its decision was reversed by the 'Landesgericht Wien' (Higher Regional Court). On appeal, the Oberster Gerichtshof takes the view that the question whether there has been an infringement of Pago's CTM is to be assessed solely in accordance with the Regulation. However, since Pago's trade mark is widely known in Austria but not necessarily in other Member States, the Oberster Gerichtshof considers that it requires guidance as to how the phrase '*has a reputation in the Community*' in Article 9(1)(c) CTMR should be construed. It has accordingly referred the following questions for a preliminary ruling:

(1) *Is a Community trade mark protected in the whole of the Community as a "trade mark with a reputation" for the purposes of Article 9(1)(c) of the Regulation if it has a "reputation" only in one Member State?*

(2) *If the answer to the first question is in the negative: is a mark which has a "reputation" only in one Member State protected in that Member State under Article 9(1)(c) of the Regulation, so that a prohibition limited to that Member State may be issued?*

Advocate General Mrs Sharpston proposed the following answer:

(1) A CTM is protected in the whole of the Community on the ground that it has a 'reputation in the Community' within the meaning of Article 9(1)(c) CTMR if it has a reputation in a substantial part of the Community . What constitutes a substantial part of the Community for that purpose is not dependent on national boundaries but must be determined by an assessment of all the relevant circumstances of the case, taking account, in particular, of (i) the public concerned by the products or services covered by the trade mark and the proportion of that public which knows of the mark and (ii) the importance of the area in which the reputation exists, as defined by factors such as its geographical extent, population and economic significance.

(2) A CTM which has a reputation in an area which is not a substantial part of the Community in that sense does not enjoy, under Article 9(1)(c) CTMR, protection limited to that area. Consequently, a prohibition against infringement limited to that area may not be issued.

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

Jurado: T-410/07 – Judgment of 12 May 2009 – Action dismissed; Office practice confirmed.

Keywords: Renewal: Failure to apply for renewal where both the CTM holder and the exclusive licensee had been aware of the situation. *Restitutio*, Article 78 CTMR: whether available for the exclusive licensee after removal of CTM from register.

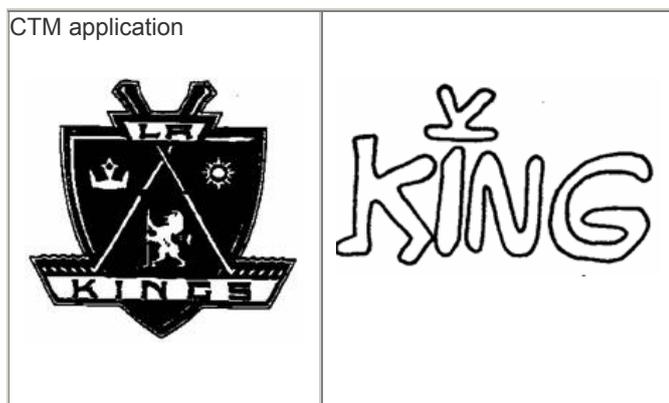
The case had been brought by an exclusive licensee against a decision of the 2nd Board of 3.9.2007 in Case R 0866/2007-2. It related to a request, by the exclusive licensee of a (former) CTM proprietor, to allow *restitutio in integrum* with respect to the time limit within which renewal had to be applied for and the renewal fee had to be paid. Both the registered owner and the licensee had been made aware by the Office of the need to file for renewal. Owing to failure to renew, the mark had been expunged from the register. The request had been rejected by the competent operative unit on the ground that the licensee had not exercised all due care; in contrast, the Board had rejected the appeal on the ground that a non-authorised licensee is not entitled to apply for renewal. The 2nd Chamber of the CFI (Pelikánová, rapporteur; Jürimäe; Soldevila Frago) dismissed the action on the grounds that, without any express authorisation on the part of the registered owner to file in its own name, the plaintiff (licensee) has not become a party to renewal proceedings merely by dint of holding an exclusive license.



LA Kings : T-414/05 – Judgment of 7 May 2009 (action allowed; law of the case).

Keywords: CFI proceedings: new pleas in law (criteria of admissibility). Opposition: likelihood of confusion (LOC). LOC: comparison of marks. Comparison of marks: impact of the various elements.

The case had been initiated against a decision of the 4th Board of 6.7.2005 in Case R 0371/2003-4 relating to a figurative CTM application LA KINGS which had been applied for for goods and services in classes 16, 25 and 41. It had been partially opposed on the basis of an earlier Spanish right in KING (figurative mark), registered in Spain in respect of goods in class 25.



One of the applicant's arguments had been that the word part LA in the sign would relate to Los Angeles, a city of Spanish origin, and that, thus, the average Spanish consumer would easily identify the meaning of the sign as relating to "LA Kings", a sports club. The opposition had been allowed.

The Board had inferred from the size and position of the word 'kings' in the sign applied for that the Spanish consumer would perceive it as a foreign word and would not link it to the element 'la' which is the Spanish feminine definite article. It had further considered that the dominant word 'king' of the earlier mark and the word element 'kings' appearing on the design in the form of a shield on the sign applied for would be remembered only imperfectly by the consumers but had, overall, assessed no visual similarity. In contrast, it had considered that there was a high degree of phonetic similarity given that the words would be pronounced 'king' and 'kings' respectively. The Board had also found that there was a high degree of conceptual similarity. The 3rd Chamber of the CFI (Azizi, rapporteur; Cremona; Frimodt Nielsen) disagreed, laying more weight on the visual dissimilarity of the signs.

At the end of the hearing, the applicant had informed the court of the assignment of the earlier mark to a third party, had subsequently submitted the relevant evidence and had introduced a new plea in law alleging the unlawfulness of the contested decision on the grounds that the opposing party in the proceedings before the Board was no longer the proprietor or licensee of the earlier mark.

Findings of the Court

(16) It is clear from the provisions of Articles 44(1)(c) and 48(2) of the CFI Rules of Procedure, taken together, that the (brief) initiating proceedings must indicate the subject-matter of the dispute and set out in summary form the pleas raised and that no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure. The fact that the plaintiff became aware of a factual matter during the course of the proceedings before the CFI does not mean that it constitutes a matter of fact which came to light in the course of the procedure. A further requirement is that the plaintiff was not in a position to be aware of that matter previously (Case T-139/99 AICS v Parliament [2000] ECR II-2849, paragraphs 59 and 62, and Case T-340/04 France Télécom v Commission [2007] ECR II-573, paragraph 164).

(17) In the present case, the plaintiff stated that the assignment of the earlier mark of Glory & Pompea to Pompea SPA had taken place on 28 January 2004, which is, in the course of the proceedings before the Board and before the action was brought before the court. The plaintiff annexed in that connection an extract from a Spanish trade mark register. It has however not been argued or proven that that matter came to light in the course of the procedure before the CFI. (18) Therefore, the court holds that that circumstance is not a matter of fact which came to light in the course of the procedure before the court. (...).

Becher 3D: T-503/08 – Order of 4 Mai 2009 (DE; case closed).

Keywords: Types of signs: 3D. Absolute grounds for refusal: distinctiveness.

The case had been brought against a decision of the 1st Board of 3.9.2008 in Case R 1400/2006-1 relating to a three-dimensional CTM application which consisted of a paper cup.



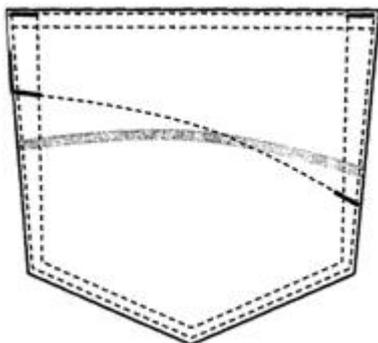
It had been applied for a range of goods in classes 16, 17 and 20. The application had been rejected on the ground of lack of distinctive character. Since the plaintiff withdrew the action, the case was closed.

Left Pocket or Gesäß-Tasche links: T-282/07 – Order of 28 April 2009 (DE; a *limine* rejected as evidently unfounded; Office practice confirmed).



Keywords: Absolute grounds for refusal: distinctiveness.

The action had been initiated against a decision of the 1st Board of 15.5.2007 in Case R 0669/2006-1 relating to a CTM application consisting of the representation of a pocket, applied for in class 25 ("Gesäß-Tasche links").

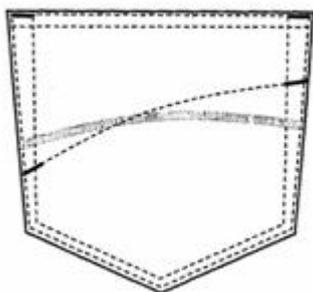


It had been rejected on the ground of lack of distinctive character which also applies if the sign would be used solely as a "logo". The 3rd Chamber of the CFI (Azizi, rapporteur; Cremona; Frimodt Nielsen) rejected the appeal *a limine* on the grounds that it evidently lacked any legal basis.

Right Pocket or Gesäß-Tasche rechts: T-283/07 – Order of 28 April 2009 (DE; *a limine* rejected as evidently unfounded; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness.

The action had been initiated against a decision of the 1st Board of 15.5.2007 in Case R 0668/2006-1 relating to a CTM application consisting of the representation of a pocket, applied for in class 25 ("Gesäß-Tasche rechts").



It had been rejected on the grounds of lack of distinctive character which also applies if the sign would be used solely as a "logo". The 3rd Chamber of the CFI (Azizi, rapporteur; Cremona; Frimodt Nielsen) rejected the appeal *a limine* on the ground that it evidently lacked any legal basis.

Parfum-Flakon or Parfumzerstäuber: T-104/08 – Judgment of 5 May 2009 (only in DE, FR; action dismissed, Office practice confirmed).

Keywords: Types of signs: 3D. 3D signs: distinctiveness.

The case had been brought against a decision of the 1st Board of 8.11.2007 in Case R 1656/2006-1 relating to a 3D-application (perfume flacon) for perfumes in class 3. It had been rejected on the grounds that the shape of the product would be devoid of distinctive character.

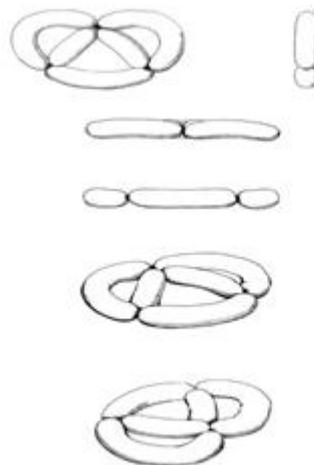


The 2nd Chamber of the CFI (Pelikánová; Jürimäe, rapporteur; Soldevila Fragoso) dismissed the appeal, relying on standard criteria.

Brezelform or Wurstbrezel: T-449/07 – Judgment of 5 May 2009 – Action dismissed; Office practice confirmed.

Keywords: Types of signs: 3D. 3D signs: distinctiveness.

The action had been brought against a decision of the 4th Board 27.9.2007 in Case R 1415/2006-4 relating to a CTM application consisting of a three-dimensional sign representing an arrangement of sausages in the form of a "Brezel".





The goods and services in respect of which registration had initially been sought were in classes 29, 30 and 43, namely: meat, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; milk and milk products; charcuterie; potato products; sugar, rice, preparations made from cereals, and providing of food and drink; temporary accommodation. The examiner accepted the application for the services in class 43 and rejected the rest under Article 7(1)(b) and (c) CTMR on the grounds that the sign applied for lacked distinctive character. The applicant and plaintiff restricted the list of goods at pending proceedings. Notwithstanding this, the 2nd Chamber of the CFI (Pelikánová; Jürimäe, rapporteur; Soldevila Fragoso) dismissed the appeal. Cases C-238/06 P Devey v OHIM [2007] ECR I-9375, Shape of a microphone head; C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, and T-129/00 Proctor & Gamble v OHIM (Encrusted rectangular tablet) [2001] ECR II-2793 referred. As regards the plaintiff's argument, the sign would represent a specific marketing concept, trade mark protection for which is required, the court held:

(35) According to settled case-law, a particular marketing concept which the applicant for a trade mark contemplates using, or is actually using, and which is, therefore, purely a matter of choice for the undertaking concerned and may be changed after a mark has been registered, is a factor which cannot have any bearing on the assessment of the registrability of the mark (Case T-355/00 DaimlerChrysler v OHIM (TELE AID) [2002] ECR II-1939, paragraph 42, and Joined Cases T-324/01 and T-110/02 Axions and Belce v OHIM (Brown cigar shape and gold ingot shape) [2003] ECR II-1897, paragraph 36).

E-Ship: T-81/08 – Judgment of 29 April 2009 (only in DE, FR; action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: descriptiveness.

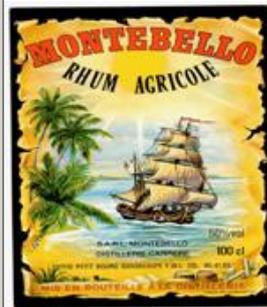
The action had been brought against a decision of the 1st Board of 4.12.2007 in Case R 0319/2007-1 relating to CTM application E-Ship, word, which had been applied for for a range of goods and services in classes 7, 9, 12 and 39. It had been rejected on the grounds laid out in Article 7(1)(c) in conjunction with (1)(b) CTMR. The letter E would merely convey something relating to electricity, electronics and the like, and in the area of “ships and shipping”, the generic term “E-Boat” for an electricity-powered yacht already exists. The 2nd Chamber of the CFI (Pelikánová, rapporteur; Jürimäe; Soldevila Fragoso) agreed, relying on standard case law.

Montebello : T-430/07 – Judgment of 29 April 2009 (only in ES, FR; action dismissed, Board confirmed; law of the case).

Keywords: Opposition: proof of use (POU). Opposition likelihood of confusion (LOC). LOC: comparison of goods. Comparison of goods: alcoholic beverages.

The action had been brought against a decision of the 2nd Board of 7.9.2007 in Case R 0223/2007-2 relating to CTM application Montebello (figurative mark) which had been opposed on the basis of Montebello, word. The Board had rejected the opposition.

CTM application



MONTEBELLO

The colours claimed in the CTM application were red and black for the lettering and yellow, brown, green, white and blue for the picture. The sign had been applied for agricultural rum in class 33. The opposing Spanish trade mark is registered for alcoholic beverages in class 33; POU had been accepted for wines. The opposition division had accepted the material filed as POU notwithstanding that the opponent had not shown where on his products the trade mark is used, i. e. the opposition had been allowed. In contrast, the Board took a different view as regards the issue of similarity of goods (none = no LOC; different circles of consumers). The 4th Chamber of the CFI agreed (Czúcz; Labucka, rapporteur; O'Higgins).

Alpha or Letter 'a' (figurative mark): T-23/07 – Judgment of 29 April 2009 (action allowed; the Office will appeal the decision).

Keywords: CFI proceedings: material produced for the first time before the court (inadmissible). Types of signs: single letters. Absolute grounds for refusal: distinctiveness.

The case had been initiated against a decision of the 4th Board of 30.11.2006 in Case R 0808/2006-4 relating to a CTM application consisting of an “alpha”, or a stylised “a”, respectively (in class 33 for alcoholic beverages).

α

It had been rejected on the grounds that the mere representation of the Greek letter alpha would be devoid of distinctive character. The 6th Chamber of the CFI (Meij; Vadapalas; Truchot, rapporteur) revoked the decision on the grounds that there had been need for a more detailed analysis (no. 56; see below).

(31) While Article 4 of Regulation No 40/94 expressly refers to letters, the fact that a category of signs is, in general, capable of constituting a trade mark for the purposes of that provision does not, however, mean that those signs necessarily have distinctive character for the purposes of



Article 7(1)(b) in relation to a particular product or service (Case T-173/00 KWS Saat v OHIM (Shade of orange) [2002] ECR II-3843, paragraph 26).

As regards the relevant public

(38) Since the sign at issue relates – as the parties confirmed in the course of the proceedings – to alcoholic beverages other than beers, and to wines, sparkling wines and beverages containing wine, that is to say, to everyday consumer goods, and consists of the lower case Greek letter ‘ a ’, the assessment as to its distinctive character must be carried out in relation to the perception of the sign by average Greek-speaking consumers who are reasonably well informed and reasonably observant and circumspect.

As regards scope and intensity of examination

(48) Thirdly, the Board, referring to *Libertel*, found in paragraph 23 (...) that – like colours and numbers presented singly – single letters, as fundamental elements, must remain available to all as a ‘general reserve’ for the purposes of identification, description or other uses. (49) As mentioned above, it is contrary to Article 4 of Regulation No 40/94 to rely on such a ground, which is based on the assumption – without any examination having been carried out as to whether, on the facts, the sign at issue is capable of distinguishing the goods at issue from those of different undertakings – that it is impossible to register a single letter as a trade mark. (50) Furthermore, as regards the judgment in *Libertel*, which was referred to in the contested decision and relied on by the OHIM, it is true that the Court has held that it must be acknowledged that there is, in Community trade mark law, a public interest in not unduly restricting the availability of colours for the other economic operators who offer goods or services for sale of the same type as those in respect of which registration is sought (*Libertel*, paragraph 60).

(51) The Court has nevertheless held that a colour may be found to possess distinctive character provided that, as regards the perception of the relevant public, it is capable of identifying the goods or services covered by the trade mark application and of distinguishing them from those of other undertakings (*Libertel*, paragraph 69). The relevance of that dictum for the purpose of the present case is not called into question by the rule in the same judgment that distinctiveness without any prior use is inconceivable save in exceptional circumstances (*Libertel*, paragraph 66), since that reservation was made in light of the fact, previously pointed out by the Court, that the perception of the relevant public is not necessarily the same in the case of a sign consisting only of a colour as it is in the case of a word or figurative mark which, as in the present case, consists of a sign that bears no relation to the appearance of the goods covered (*Libertel*, paragraph 65).

(52) The Board was not therefore entitled to rely, as against the registration of the letter ‘ a ’, on the argument relating to the availability of signs, since that argument in no way precludes the need for an examination as to whether, on the facts, the sign at issue is capable of identifying the product or service in respect of which registration is sought as originating from a particular undertaking and of distinguishing that product or service from those of other undertakings. (56) It follows from all of the foregoing that, by assuming from its

lack of graphical modifications or ornamentations that, by definition, the sign at issue lacked distinctive character in relation to the Times New Roman character font, without carrying out an examination as to whether, on the facts, that sign is capable of distinguishing, in the mind of the reference public, the goods at issue from those of the applicant's competitors, the Board misapplied Article 7(1)(b) CTMR.

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

Acno Focus: T-466/08 – Office response filed.

Keywords: Opposition: proof of use (POU). Use requirement: grace period. Grace period: calculation at national level in a system of *ex post* registration oppositions.

The action has been brought against a decision of the 1st Board of 29.7.2008 in Case R 1796/2007-1, relating CTM application 3.272.705, ACNO FOCUS, word, for cosmetic and make-up preparations in class 3. It had been opposed on the basis of earlier German rights in FOCUS, word, registered for a large number of products in classes 3, 5, 6, 7, 8, 9, 14, 15, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 33, 34, and a number of services in classes 36, 38, 39, 41 and 42, in particular in class 3: soaps; perfumery, essential oils, soaps, make-up, cosmetics, hair lotions, body and beauty-care products, shaving lotions and creams, deodorants; toilet articles, namely toilet paper, cleaning products.

After the CTM applicant had requested POU, the opponent had replied that, after its registration, the earlier trade mark had been subject to opposition proceedings which only came to an end on 13 January 2004, with the consequence that the five-year grace period would only start on that date. By its decision, the opposition division upheld the opposition. It considered that the opponent had not been obliged to furnish POU since the earlier right which had been registered on the 23 May 1996 was subject to opposition proceedings until the 13 January 2004. The Board confirmed the decision. In relation to the obligation to furnish proof of use, it observed that the provision of Section 26(5) of the German TM Act, which sets out the starting date for the five-year grace period does not differentiate between goods against which an opposition is directed and other goods which might not be subject to such opposition proceedings. Referring to the case-law of German courts, the Board took the view that the five-year grace period only started on the 13 January 2004.

Vigoss : T-431/08 – Office response filed.

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

The case has been brought against a decision of the 2nd Board of 18.7.2008, in Case R 1366/2007-2, relating to CTM application no. 4.223.236, word VIGOSS, in classes 14, 18 and 25. It had been opposed on the basis of international registration VIGOSS (figurative mark) which applies in several Member States for clothing, footwear and headgear in class 25.



The CTM application covered the following goods in class 14: ankle bracelets, belt buckles of precious metal for clothing, bolo ties with precious metal tips, bracelets, bracelets of precious metal, brooches, cigar and cigarette boxes of precious metal, cigarette cases made of precious metal, cigarette holders of precious metal, cigarette lighters of precious metal, clip earrings, clocks, costume jewellery, cufflinks, diving watches, earrings, fancy key rings of precious metals, jewel chains, jewel pendants, jewellery boxes of precious metal, jewellery cases of precious metal, jewellery caskets of precious metal, jewellery chains, jewellery findings, jewellery for the head, jewellery pins for use on hats, jewellery watches, key holders of precious metals, key rings of precious metal, lapel pins, letter openers of precious metal, match boxes of precious metal, match holders of precious metal, mechanical and automatic watches, neck chains, necklaces, necktie fasteners, ornamental lapel pins, ornamental pins, ornaments of precious metal, pins being jewellery, pocket watches, purses and wallets of precious metal, rings, tie bars, tie clips, tie fasteners, tie pins, tie tacks, watch boxes, watch bracelets, watch cases, watch chains, watches, watches containing an electronic game function, watches containing a game function, watches for outdoor use.

In class 18: athletic bags, all purpose athletic bags, attaché cases, backpacks, baby backpacks, baby carriers worn on the body, all purpose sports bags, barrel bags, beach bags, book bags, Boston bags, carry-on bags, clutch bags, diaper bags, duffel bags, gym bags, leather shopping bags, overnight bags, school book bags, school bags, shoulder bags, textile shopping bags, tote bags, travel bags, travelling bags, garment bags for travel, shoe bags for travel, billfolds, hat boxes for travel, briefcase-type portfolios, briefcases, business card cases, calling card cases, credit card cases, infants carriers worn on the body, non-motorized collapsible luggage carts, document cases, key cases, overnight cases, passport cases, cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold empty, change purses, clutch bags, clutch purses, coin purses, drawstring pouches, fanny packs, felt pouches, golf umbrellas, handbags, leather key fobs, knapsacks, luggage, luggage tags, waist packs, parasols, pocketbooks, briefcase-type portfolios, purses, rucksacks, suitcases, valises, wallets.

In class 25 for anklets, anoraks, balloon pants, bandannas, bandeaus, head bands, sweat bands, neck bands, wrist bands, bathing suits, bathing trunks, bathrobes, beach cover-ups, beachwear, bed jackets, money belts, belts, berets, Bermuda shorts, cloth bibs, blazers, bloomers, blouses, blousons, boas, body shapers, body suits, boleros, bonnets, bottoms, bow ties, boxer shorts, bras, brassieres, breeches, briefs, bustiers, caftans, camisoles, capes, caps, cardigans, cassocks, chaps, chemises, coats, fur coats, leather coats, overcoats, rain coats, sport coats, suit coats, top coats, collars, corselets, corsets, coveralls, cover-ups, cravats, creepers, cuffs, culottes, cummerbunds, dickeys, dresses,

evening gowns, dungarees, dusters, evening gowns, full weather gear except for footwear, foundation garments, frocks, fur jackets, fur stoles, gabardines, gaiters, gauchos, gloves, golf shirts, gowns, night gowns, greatcoats, gym shorts, gym suits, halter tops, hats, head wear, hoods, hosiery, housecoats, infant wear, jackets, leather jackets, wind resistant jackets, jeans, jerseys, jodhpurs, jogging suits, jumpers, jumpsuits, kerchiefs, knee highs, knickers, knit shirts, leggings, leotards, lingerie, loungewear, maillots, mantillas, mantles, miniskirts, mittens, mufflers, muffs, muu muus, neckerchiefs, neckties, neckwear, negligees, night shirts, overalls, pyjamas, pantaloons, panties, pants, sweat pants, tap pants, pantsuits, pantyhose, pareu, parkas, pedal pushers, peignoirs, petticoats, pinafores, play suits, pocket squares, polo shirts, ponchos, pullovers, quilted vests, rain wear except footwear, robes, rompers, sarongs, sashes, scarves, shawls, shifts, shirts, sport shirts, sweat shirts, undershirts, shortalls, shorts, sweat shorts, singlets, skirts, slacks, sleepwear, slippers, smocks, socks, stockings, stoles, suits, vested suits, warm-up suits, sun visors, suspenders, swaddling clothes, sweaters, turtleneck sweaters, V-neck sweaters, sweatsocks, swim trunks, swim wear, swimsuits, T-shirts, tailleurs, tangas, tanktops, teddies, tennis wear, footwear, ties, tights, togas, tops, toques, tracksuits, trousers, tunics, turbans, turtlenecks, tuxedos, underclothes, undergarments, underpants, underwear, unitards, veils, vests, visors, waistcoats, wraps and saris.

The opposition had been allowed by the opposition division for all goods in classes 18 and 25 and for part of the class 14 products. The Board went further, holding that all of the goods in class 14, as well as the 'wallets, change purses, coin purses, billfolds, business card cases, credit card cases, calling card cases, passport cases, key cases, leather key fobs; cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold empty; luggage, suitcases, valises, duffel bags, travel bags, travelling bags, garment bags for travel, hat boxes for travel, shoe bags for travel, overnight bags, overnight cases; non-motorized collapsible luggage carts; luggage tags; briefcases, briefcase-type portfolios, document cases, attaché cases; parasols, golf umbrellas' in class 18, were dissimilar to the goods of the earlier mark.

Avanzalene: T-477/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC). LOC: pharmaceutical preparations.

The action has been brought against a decision of the 4th Board of 28.8.2008 in Case R 1694/2007-4 concerning CTM 4.632.501, AVANZALENE; word, registered in class 5 for pharmaceutical preparations for human medical use. It had been opposed on the basis of an earlier CTM, no. 3.331.444, word mark AVANZ, registered *inter alia* for pharmaceutical preparations, including pharmaceutical preparations for immunotherapeutic purposes; diagnostic preparations for medical purposes, in class 5. The opposition had been allowed.

The Board, in essence, had held: The relevant consumers are not only medical professionals, but also the members of the general public in the Community. As attentive as they may be, consumers cannot be expected to pay extra attention to the trade marks while buying the claimed goods, as they may comprise any sort of pharmaceutical preparations, including



those with or without prescription, general or specific, stronger or light types. The signs are globally similar: there is a “certain similarity” on the visual level, a “medium” similarity on the phonetic level and a conceptual comparison cannot be made as the signs are meaningless. Given the imperfect recollection of trade marks they are confronted with, consumers may confuse one mark with the other. In any event, “consumers of pharmaceutical products would probably view the ending of the trademark AVANZALENE rather than as an indication of origin, as a combining form, a feature frequently used in the marketing of pharmaceutical products. Consequently, the relevant public may believe that the goods originate from the same or economically linked undertakings.

I SD IN: T-467/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC). LOC: comparison of goods (class 5).

The action has been initiated against a decision of the 1st Board of 4.7.2008 in Case R 1031/2007-1, relating to CTM application 3.288 339, I SD IN (figurative mark), which had been applied for for a range of goods in classes 3 and 5, namely: bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices, and pharmaceutical and veterinary preparations excluding cardiovascular pharmaceutical preparations; sanitary preparations 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.



It had been partially opposed (class 5) on the basis of several earlier rights in ISTIN, word, registered in class 5 for pharmaceutical preparations for human and veterinary uses. The opposition had been allowed in respect of “pharmaceutical and veterinary preparations excluding cardiovascular pharmaceutical preparations; dietetic substances adapted for medical use.”

Germany 2006: T-445/08 – Office response filed.

Keywords: Types of marks: “event identifier”; “event mark”. Absolute grounds for refusal: distinctiveness. Distinctiveness: acquired on the market, Article 7(3) CTMR. Article 7(3) CTMR: impact of the fact that the user of the sign has a monopoly or quasi-monopoly in the market place.

The case is directed against a decision of the 1st Board of 30.6.2008 in Case R 1467/2005-1, relating to cancellation proceedings 970 C, directed against CTM 2.153.005, GERMANY 2006 (word), owned by the Fédération Internationale de Football Association (FIFA). The CTM covers goods and services in classes 1, 3-12, 14-16, 18, 20, 21 and 24-42. It had been challenged, by Ferrero oHG mbH, pursuant to Article 51(1)(a) CTMR, on the grounds of Article 7(1)(b) and 7(2) CTMR because GERMANY 2006 is a descriptive indication being devoid of any distinctive character in relation to the covered goods and services. Whereas the cancellation division had rejected the request, the Board had allowed it. The Board took the view that the sign GERMANY 2006 has a clear descriptive meaning in that it does not convey more than that something is happening in Germany in 2006.

WM 2006: T-446/08 – Office response filed.

Keywords: Types of marks: “event identifier”; “event mark”. Absolute grounds for refusal: distinctiveness. Distinctiveness: acquired on the market, Article 7(3) CTMR. – Article 7(3) CTMR: impact of the fact that the user of the sign has a monopoly or quasi-monopoly in the market.

The case is directed against a decision of the 1st Board of 30.6.2008 in Case R 1468/2005-1, relating to cancellation proceedings 972 C, directed against CTM 2.152.817, WM 2006 (word), owned by the Fédération Internationale de Football Association (FIFA). The CTM covers goods and services in classes 1, 3-12, 14-16, 18, 20, 21 and 24-42. It had been challenged, by Ferrero oHG mbH, pursuant to Article 51(1)(a) CTMR, on the grounds of Article 7(1)(b) and 7(2) CTMR because WM 2006 is a descriptive indication being devoid of any distinctive character in relation to the covered goods and services. Whereas the cancellation division had rejected the request, the Board had allowed it. The Board took the view that the sign “WM 2006” (WM = Weltmeisterschaft = World Cup, World Championship) has a clear descriptive meaning, given that in sports, the word combination ‘world cup’ is nothing but a generic description of a type of competition. It also observed that the fact that the CTM holder is the only or the major enterprise organising competitions in a specific country in a particular year for football may be of interest for the examination of acquired distinctiveness, however, it does not generally exclude the application of Article 7(1)(c) CTMR.

World Cup 2006 Germany : T-448/08 – Office response filed.

Keywords: Types of marks: “event identifier”; “event mark”. Absolute grounds for refusal: distinctiveness. Distinctiveness: acquired on the market, Article 7(3) CTMR. Article 7(3) CTMR: impact of the fact that the user of the sign has a monopoly or quasi-monopoly in the market.

The case is directed against a decision of the 1st Board of 30.6.2008 in Case R 1470/2005-1, relating to cancellation proceedings 968 C, directed against CTM 2.047.843, WORLD CUP 2006 GERMANY (word), owned by the Fédération Internationale de Football Association (FIFA). – Same factual situation as above.



World Cup Germany: T-447/08 – Office response filed.

Keywords: Types of marks: “event identifier”; “event mark”. Absolute grounds for refusal: distinctiveness. Distinctiveness: acquired on the market, Article 7(3) CTMR. Article 7(3) CTMR: impact of the fact that the user of the sign has a monopoly or quasi-monopoly in the market.

The case is directed against a decision of the 1st Board of 30.6.2008 in Case R 1469/2005-1, relating to cancellation proceedings 971 C, directed against CTM 2.152.635, WORLD CUP GERMANY (word), owned by the Fédération Internationale de Football Association (FIFA). – Same factual situation as above.

World Cup 2006 : T-444/08 – Office response filed.

Keywords: Types of marks: “event identifier”; “event mark”. Absolute grounds for refusal: distinctiveness. Distinctiveness: acquired on the market, Article 7(3) CTMR. Article 7(3) CTMR: impact of the fact that the user of the sign has a monopoly or quasi-monopoly in the market.

The case is directed against a decision of the 1st Board of 20.6.2008 in Case R 1466/2005-1, relating to cancellation proceedings 972 C, directed against CTM 2.152.817, WORLD CUP 2006 (word), owned by the Fédération Internationale de Football Association (FIFA). – Same factual situation as above.

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Opposition proceedings – Article 8(4) CTMR

Relative grounds – passing off – substantiation of the earlier right - ownership

Decision of the First Board of Appeal of 19 March 2009 in Case R 513/2008-1 – BASMALI LONG GRAIN RICE RIZ LONG DE LUXE/ BASMATI (English)

R 513/2008-1 – BASMALI LONG GRAIN RICE RIZ LONG DE LUXE/ BASMATI - The wording used in Article 8 CTMR suggests that an opposition may only be filed by the 'proprietor' of another right. The opponent submitted abundant material in support of its assertions but absolutely nothing in support of its claim that (i) 'BASMATI' is a 'trade mark' and (ii) it has proprietary rights on it. However, the evidence submitted by the opponent indicates that 'BASMATI' is not, in fact, a trade mark but the generic designation for a type of rice grown in parts of India and Pakistan. Case-law on

passing off requires, as a precondition, proprietorship of goodwill, not necessarily of an earlier right. Article 8(4) CTMR requires, as a precondition, proprietorship of an earlier right, not necessarily of goodwill. Since the opponent did not substantiate its claim of ownership on the Basmati name, the opposition is not well-founded.

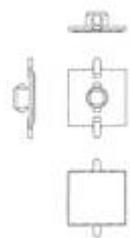
Absolute grounds of refusal – Article 7 CTMR

Absolute grounds – 3D mark - technical function – distinctive character

Decision of the First Board of Appeal of 22 April 2009 in Case R 1360/2008-1 –Adhesive fastening element carrier (3D Mark) (German)

R 1360/2008-1 –Adhesive fastening element carrier (3D Mark) – The CTM applied for sought protection for adhesive fastening element carriers and surfaces thereto in Classes 17, 20 and 26.

Shapes, the essential characteristics of which perform a technical function, are not to be registered, so that trade mark law does not limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product.



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The shape of the product needed to obtain the technical result is given by some design features included in the sign, namely by the base surface and the insertable closure. Thus, the adhesive fastening element carrier applied for can be inserted into an opening in a component, for example a section of the bodywork of a vehicle, by means of the insertable closure, and attached to the component by engaging in the opening with its spring-loaded retainer tabs. An adhesive fastening element, for example a hook-and-loop fastening element, can be attached to the base surface, by means of which, for example, an interior trim part of a vehicle can be attached to the adhesive fastening element carrier and thus to the bodywork section of the vehicle. The applicant's view that the shape of the goods can only obtain a technical result, on account of which the sign applied for does not consist exclusively of the shape of the goods that is necessary to obtain a technical result, must be opposed. In this respect, reference is made to the concrete technical functions of the extensions previously presented in detail and analysed, which show that the extensions, as well as the base surface, in



combination with the insertable closure, have only technical functions.

Accordingly, all the characteristics of the shape of the goods are only to be attributed to a technical effect, so that Article 7(1)(e)(ii) CTMR prevents the registration of the sign applied for.

Furthermore, the Board held that the trade mark applied for also lacks the necessary distinctive character pursuant to Article 7(1)(b) CTMR since it represents the shape of an adhesive fastening element carrier or surface adhesive fastening element carrier which does not offer the relevant trade circles any points of reference for the necessary distinctive character. Nor is the relevant public accustomed to seeing a trade mark in the shape of the carrier alone. In this respect it does not matter to what extent the trade mark applied for differs from the customary range of shapes for adhesive fastening element carriers or surface adhesive fastening element carriers.

The appeal must therefore be dismissed.

Relative grounds – Article 8(1)(b) CTMR

Relative grounds – likelihood of confusion – geographical name – identical goods – figurative trade marks – similar signs

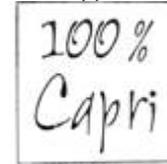
Decision of the First Board of Appeal of 2 April 2009 in Case R 1148/2008-1 – CAPRI [Fig. Mark]/100% CAPRI [Fig. Mark] (Italian)

R 1148/2008-1 – CAPRI [Figurative Mark]/100% CAPRI [Figurative Mark] - The goods covered by the trade mark applied for are essentially identical to those identified by the earlier trade mark (such as washing preparations *et al* in Class 3, clothing, including boots, shoes and slippers in Class 25 and the class heading in Class 18).

It is the geographical name 'CAPRI' which will attract the consumer's greatest attention. Even if there are differences, the word 'CAPRI' is common to both the trade marks and constitutes the dominant part thereof, it can therefore be concluded that there is a large degree of similarity visually. The pronunciation of the word 'Capri' is the same in both signs. The trade mark applied for contains, in addition, the element '100%'; consequently, the degree of phonetic difference will have to be regarded as average. Conceptually, the two trade marks must be regarded as virtually identical on account of the presence of the word 'CAPRI'. The element '100%' has a purely descriptive function and will have the effect, if any, of enhancing the evocative force of the term 'Capri', thus increasing the likelihood of confusion between the signs.

CAPRI

CTM applied for



earlier IT right

The Board held that there is no connection between the geographical name and the goods that it identifies. The island of Capri is renowned as a wonderful tourist resort but not because items of clothing, leather goods, soaps or perfumes etc., in particular, are manufactured there. Consequently, it is not possible to draw analogies between the present case and the 'Chiemsee' case. => LoC

Procedural Questions – Article 80 CMTR [ex Article 77a]

Revocation of a decision – appeal proceedings – competence of the first instance

Decision of the Grand Board of 28 April 2009 in Case R 0323/2008-G BEHAVIOURAL INDEXING (English)

R 0323/2008-G BEHAVIOURAL INDEXING – After the appellant filed an appeal, the Examiner revoked its contested decision and rejected the CTM applied for for the same reasons. The appellant also filed an appeal against the second decision.

The Grand Board held that immediately after the notice of appeal has been filed, the competence to decide on the case under appeal is transferred from the examiner to the Boards of Appeal pursuant to Articles 58, 61, 63(1) and 64(1) and (2) CTMR. Therefore, jurisdiction over the case lies solely with the Boards of Appeal and the department that issued the contested decision, no longer retains competence to decide the case. From that point on, only the Board may decide on the case and, after examination, possibly remit it to the appropriate department for further prosecution. The examiner who issued the contested decision may only rectify it after an appeal has been lodged, under the narrow conditions of Article 61 CTMR. It follows that the examiner is bound by the revision procedure laid down in Article 61 CTMR and may not, at his discretion, choose to apply revocation provisions like that of Article 80 CTMR, which are applicable outside of the appeal proceedings framework.

The legislator established within the appeal proceedings framework, a specific rectification procedure, which allows the administration to rectify the contested decision within one month after the receipt of the statement of grounds. Where the examiner does not rectify his decision within that time-limit and in accordance with Article 61 CTMR, the Board, from that point on, is the only instance competent to possibly rectify the contested decision by exercising power within the competence of the examiner since, with the filing of the appeal, the case comes under the Board's exclusive jurisdiction.



Since the examiner lacked the competence to take a new decision on the substance of the case after the filing of the appeal, the revocation decision of the examiner was thus issued contrary to Article 61 CTMR. Consequently, the decision of the examiner revoking its first decision is null and void and cannot produce legal effects.

On substance, the Grand Board held that there exists, for the relevant public, a direct and specific relationship between the expression 'BEHAVIOURAL INDEXING' and the goods and services at issue, i.e: Computer software in Class 9 and Financial Management in Class 36.

The expression 'BEHAVIOURAL INDEXING' was considered as grammatically correct in structure and intellectually meaningful with respect to the goods and services applied for. The expression plainly informs the relevant public that the goods and services concern the compilation of an index that takes into account human, social and cognitive factors (for example, overconfidence, over optimism, mimicry, risk aversion, emotional attachment to assets, etc), that affect key issues in the financial management of entities and investment decisions concerning matters such as, prices, returns and allocation of resources. Indeed, the applicant itself concedes that the goods and services in the application concern gathering data by reviewing and evaluating the actions of investors in the marketplace and using cognitive errors (mental mistakes) made by investors due to bias.

Consequently, the CTM applied for was rejected.