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July launch for new OHIM website

OHIM's new website will be launched on 1 July, after almost 18 months of planning and consultation of users. The development is intended to make the site more user-friendly for both professionals and newcomers and to provide better visibility for the tools needed to register trade marks and designs.

Professional Area



The familiar acronyms of OHIM, OAMI, OHMI, HABM and UAMI continue to be used, according to the language version of the site, and this is supported by a description of our function as the trade marks and designs registration office of the European Union. The site includes technology capable of recognising the language used by browsers, giving visitors direct access to the front page without first having to pre-select Spanish, German, English, French or Italian. If users subsequently make a different language choice, using the drop-down list on the top bar, this will be stored in a cookie. Likewise, users who wish the text to be displayed in larger characters can chose this option from the top bar and have it saved as a display "preference" for their next visit.

Latest News



The front page includes a "Professional Area", with links to MyPage and to legal texts and case-law. There is also improved access to OHIM's databases for Community trade marks and designs and to the e-filing tools and forms.

In fact there is easy access to both databases and forms – the essential tools for registering trade marks and designs - on every page of the website. A new section has been created on the existing OHIM website, previewing the changes, and this will be updated with further information as the launch date approaches

The middle of the page is devoted to a welcome message and the provision of an expanded "Latest News" service, which should help make the home page an essential first stop for all users keen to find out the latest developments at OHIM.



One feature that should help users find their way about the site is an improved search service, accessed on the top right of all pages. This feature includes both a simple and an advanced search, and covers the content of the web pages. Separate searches continue to be available for OHIM's databases as before.

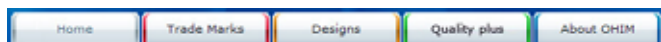


Basics

- What is a trade mark?
- What is a design?
- Why a Community trade mark?
- Why a Community design?

More practical questions >

For less frequent visitors the front page also includes handy access to some basic information helping them to understand the value of registering Community trade marks and designs.



The site has a new structure, which has been developed in consultation with users and external advisors. Apart from the "Home" page there are four sections: "Trade Marks", "Designs", "Quality plus" and "About OHIM". Each section is colour-coded to help users understand where they are in the site and there is also an additional menu in white showing supporting information. The site organisation represents a change in approach with greater emphasis on doing business with the office and less on institutional information. In order to help users who have stored certain pages as "favourites" in their browser, OHIM will be publishing a table of the "old" and "new" links for key pages that have been identified with the help of external users.



The first two sections, "Trade Marks" and "Designs", have red and gold colour codes respectively. They provide information about Community trade mark and designs, outlining the advantages, and explaining about the registration process, fees and payments and renewals.



The "Quality plus" section provides access to the Office's quality policy, the Service Charter, User Satisfaction Survey, and guidance on how to file a complaint. You will also find information on cooperation projects with IP offices in member states and internationally.

The Networks and Users' Groups subsection in Quality plus includes:

- The OAMI Users Group and the e-Business Users Group
- The European Judges' Symposium, a network which meets to promote harmonization in the application of the Community trade mark and Community design regulations at all levels of jurisdiction.
- Information about OHIM's participation in networks with other major IP offices.



The section titled "About OHIM", is where users can find institutional information about the Office. It is also the "home" section for news, events and multimedia. While "Latest News" is accessed via the front page, the news archive is kept here, and this section also provides access to our monthly online magazine, Alicante News.

Under "Institutional information" you can find out more about how OHIM is organised, in sections on our Administrative Board and Budget Committee, the Boards of Appeal, financial and budget information, and our organisational chart.

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Select the topic(s) you are interested in:

All topics

News, Executive and Multimedia

Select language:

- Select -

Provide your e-mail address:

E-mail address:

Use enter e-mail address:

Captcha:

Type the code shown below:

Link displayed with the user's IP address sensitive

The website includes some innovations that should improve service to users, including an "opt-in" e-mail alert service, covering "Latest News" and "Legal References". Users who wish will be sent an e-mail when there are important changes in either of these areas.

Search functions and Chats

Not Connected

Nickname

Type a nickname:

Chat Posts for Search functions and Chats

Web Editor:

Welcome to our best chat on the OAMI website search functions and Chats. The chat will be open up until 1400 tomorrow (20 May). I will be online to answer questions "live" between 1200 and 1300, but we would invite you to post questions in advance so that we can prepare detailed answers.

Web editor:

Please note that this is a moderated chat. Selected questions, with answers will be posted before the chat goes "live" at 1200 tomorrow. An edited version of the chat log will be available for examination on the website. If very similar questions are posted by several people, they will be dealt with together in order to avoid unnecessary

Post a new message

Post



Multimedia and interactive services, accessed via "About OHIM" are a key part of the future communication and training strategy for the new website. User discussions, in various forms including "chats", and the possibility of voting on issues using integrated polling software, will be an important new means of consulting users.

Development continues on a number of advanced multimedia services, including webcasts which will, in future, complement the more traditional means of conveying information and these new features will be added to the website as they become available.

What do you think about the new web page?

The OHIM has put a great deal of effort in the creation of this new web page, consulting users and conducting user tests. The new web page has a different structure from the previous web site, and combines a service-oriented approach and an informative site at the same time. We would like to know your opinion about the new web page and the new services that we provide.

The web site structure is better than the previous one

MUCH BETTER

BETTER

EQUAL

WORST

MUCH WORST

Select the words that describe what you think about this design

Cute

Stable

Responsive

Reputable

Cluttered

Concerning this site, with other IP sites, how, this site is (only applicable if you use any other IP website)

IN GENERAL BETTER

EQUAL

IN GENERAL WORST

The James Nurton interview with Peter Munzinger, Bardehle Pagenberg

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

This month James Nurton interviews Peter Munzinger, a partner of Bardehle Pagenberg in Munich. He speaks about his experience of managing international trade mark portfolios and reflects on some of the topics discussed at the recent INTA Annual Meeting, at which he was co-chair of the programming committee.

How did you become involved in trade marks?

After law school I started as a lawyer on my own but business was not overwhelming so after a while I looked to be engaged by a company. I sent a few letters out and then received a reply from Puma, who asked me for an interview.

I started in the mid-1980s and I was there for about seven years, taking care of Puma's trade marks on a worldwide scale. We had a lot of counterfeiting going on and I was involved in proceedings in many different countries. At the beginning of the 1990s, I moved into private practice focusing on work with an international dimension.

What were the challenges of protecting the Puma brand?

The Puma brand consists of three elements – the word Puma, the jumping cat device (not the feline device, however, which was the subject of the famous European court decision *Puma/Sabel*) and the stripe design on the shoes themselves. The last was the most problematic. It took a long battle to get it registered in Germany and it was also a big deal in other countries, especially the more exotic countries, such as China

– which was already an emerging market for manufacturing sports shoes back then – as well as Indonesia, Korea and Taiwan. But in the end we were surprisingly successful.

Puma and adidas both had quite a mature concept of trade mark protection incorporating the name, logo and design, which was the basis for the success of the two companies in the 1980s. Nike, Reebok and others also developed similar concepts, which contributed largely to their success in the 1990s.

Was the stripe design the most difficult trade mark you have had to register?

No, some have been so difficult we have not been able to succeed. For example, attempts to register single colour trade marks have required significant distinctiveness through use to be shown, and sometimes a very specific definition of the goods.

What does your work involve now?

It is split. A large part is trade mark portfolio counselling and helping clients with their filing strategy, and following up administrative and legal problems in various jurisdictions, using mechanisms such as the Madrid Protocol, Community trade mark and Community design and other systems such as OAPI. A lot of it involves working with colleagues from other countries as you can't know all the ins and outs yourself.

Have the new mechanisms, such as the Madrid Protocol and the CTM, made things easier?

There has been a lot of progress for clients compared to 20 years ago. The Madrid system covers a lot more countries than before the Madrid Protocol came into force. But this also brings problems, uncertainties and bureaucratic questions. While it appears practical and cost-effective, it has to be dealt with carefully: even after 20 years of practice, you can be surprised by the rules. So sometimes we still file nationally instead.

Do you use the link between the Madrid System and the CTM?

We often use the CTM as the basis for an international registration through the Madrid Protocol. But there is a problem, which is that it can be more expensive. Using a German mark as the basis for an application means we can also use the Madrid Agreement, which is mostly cheaper, so you can get the Madrid registration for less cost.

What do you think of the CTM system?

It has been fantastic – it has changed the trade mark world in Europe. American companies, for example, used to find it almost impossible financially to get protection in all the European countries. Nowadays it has become very easy, and the costs of a CTM are not much higher than a trade mark for one country.

What is the best thing about the system?

The advantage of having a number of countries with a trade mark that cannot be divided. If, for example, someone in Greece has an older trade mark the system guides the parties to seek a private "European" solution which in most of our cases is ultimately found. That makes the system very successful: parties learn not to take disputes before a court or the Office to resolve.

What aspects could be improved?

The system of filing and registering is very good. But with the success and income of the Office it should be possible to become number-one in the world in terms of processing speed. So improving the speed is the most important improvement that can be made; it would be possible to set a new standard for trade mark offices if they invested the necessary funds.

Ideally, trade marks would go through examination within two to three months and be registered within six months if there is no opposition. The speed of opposition proceedings could also be enormously improved.

You were co-chair of the program committee for the 130th INTA Annual Meeting, held in Berlin last month. What did you see as the most important topics at the meeting?

One key issue was addressing the global challenge that trade mark practitioners have to cope with. A national point-of-view used to be sufficient but nowadays all practitioners have to look globally. I was also very interested in the quasi-philosophical topics such as the session titled "Why we do what we do". It is useful to reflect on some of these questions.

From a European perspective, the session on pan-European enforcement and protection of trade marks was very important, as this issue is of great interest to European practitioners. The EU system is only 12 years old, and there are many question marks when it comes to enforcing Community trade marks in the courts, and whether the system is comparable to national systems. This brings up quite sophisticated issues that trade mark litigators have to deal with, involving complex questions about jurisdiction and the competence of courts: where can I sue a company? Can I sue the subsidiaries in the same court or do I have to go to a different country? At the moment, there is a slightly regulated chaos. It is surprising for clients how many issues there are to address before deciding how and where I can sue for trade mark infringement. It's mostly to do with national procedural law and to some extent the Brussels Convention.

What are the future challenges in trade marks?

For bigger companies, the questions are how to manage a worldwide trade mark portfolio. For lawyers, the picture is changing with more firms providing formalities and administrative IP services. So lawyers have to deal with more challenging issues, rather than bureaucratic ones. That is more difficult, but there will be more work around.

The other trend is the increasing role of the Internet as a platform for IP business. That will be a big change in the next five years, with more work being handled over the web. Trade mark applicants will become more like consumers buying books or clothing over the Internet.

Community Trade Mark

Legal battle over "PRIVATE" trade mark

An application from a German film company to have the Community trade mark "PRIVATE", declared invalid, has failed. The CTM was registered in 2000 in connection with a range of goods and services including adult entertainment.

The applicant, who holds title to the film "DEUTCHLAND PRIVAT", created in 1980, argued that the CTM was invalid



on absolute grounds as the mark "PRIVATE", in the context of adult entertainment, was devoid of any distinctive character, was descriptive and had also become a customary term for the particular type of goods and services covered.

On relative grounds, the invalidity applicant argued that there was a high degree of similarity between the marks "PRIVATE" and their right to the work title "DEUTCHLAND PRIVAT", under the German Trademark Act.

The CTM proprietor, for their part, provided evidence that they owned the German figurative trade mark PRIVATE, which had been used to commercialise products in the adult entertainment sector since 1970.

The Cancellation Division said that the evidence filed by the invalidity applicant indicated that the term "private" might give the average English-speaking consumer "certain allusions relating to sexual activities and a wish to keep such activities secret". However, the Division ruled that this was considered "suggestive" rather than "descriptive" and said the application had failed to show that the word "PRIVATE" was the usual way of describing the characteristics of the goods and services involved.

It followed from the above that the trade mark was therefore not excluded from registration on the basis of Article 7(1) (c) CTMR. It was considered a word with a suggestive meaning, which nevertheless did not fall foul of the said Article.

Having concluded that the mark was not descriptive, the Cancellation Division said it found little to suggest that it might nevertheless be devoid of distinctive character and, therefore, it was acceptable for registration under Article 7(1) (b) CTMR. The Office said the applicant had failed to meet the burden of proof that the word "private" had become a customary term for a product or service, which was a possible ground for invalidity under Article 7 (1) (d) CTMR.

Examining the case for invalidity on the ground of the prior German right "DEUTCHLAND PRIVAT", the Office said that while evidence had been given of the commercial use of this title there was no conclusive proof that it had been used in the course of trade since February 1989. The invalidity applicant had, therefore, not met the burden of proof that the sign in question was used in commerce at the time of the CTM application, effectively ten years later, in 1998.

Country overview: United Kingdom & the Community Trade Mark

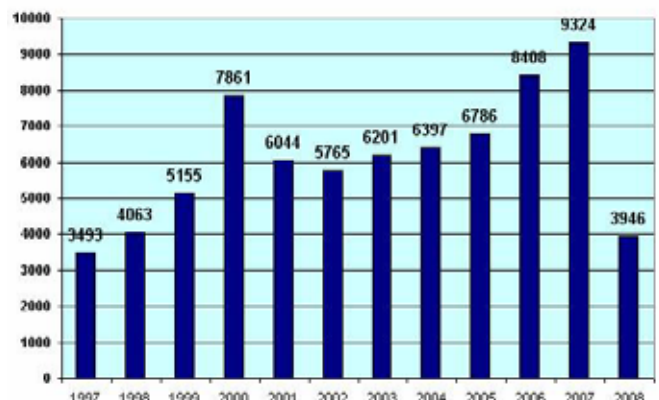


The UK joined the EU in 1973, and has a population of 60m. The economy - one of the largest in the EU - is increasingly service-based although it maintains industrial capacity in high-tech and other sectors. The City of London is a world centre for financial services.

GDP growth has slowed recently and was 0.4 % higher in the first quarter of 2008 compared with the previous quarter. The EU average for the same period was 0.8%. The service sector accounts for 76% of GDP followed by industry (23%) and agriculture (0.9%).

UK interest in the CTM has been consistently high with a record 9 300 filed last year and a total of more than 73 000 UK CTMs filed to date.

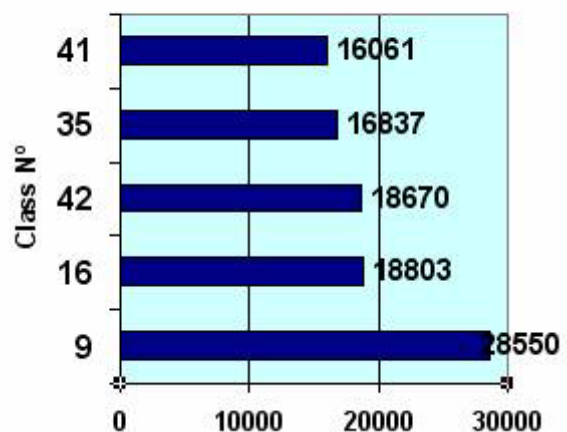
UNITED KINGDOM - CTM Filing Evolution
(Total CTMs: 73 443)



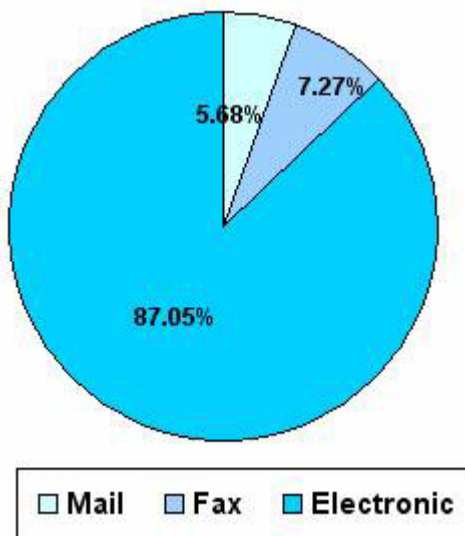
Word	Figurative	3-D	Colour	Other
68.71 %	30.62 %	0.47 %	0.10 %	0.09 %

Word marks are the most popular with UK enterprises and account for almost 69% of applications, followed by figurative marks (31%). The most popular goods and services applied for are in classes 9, 16 and 42.

UNITED KINGDOM - Top Classes
Filed (Nice)



E-filing is the most popular filing route for UK businesses and their intermediaries, accounting for more than 87% of all filings at present, followed by fax at 7% and mail at 6%.



Top 10 UK-based owners by number of CTMs filed

Company	CTMs
GLAXO GROUP LIMITED	767
Reckitt & Colman (Overseas) Limited	268
Scottish & Newcastle plc	245
SmithKline Beecham p.l.c.	221
Eidos Interactive Limited	184
Orange Personal Communications Services Ltd.	184
BP p.l.c.	180
Sony Computer Entertainment Europe Limited	167
Barclays Bank PLC	143
SMARKS AND SPENCER plc	141

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

Representative	CTMs
MARKS & CLERK	5 333
MURGITROYD & COMPANY	3 217
URQUHART-DYKES & LORD LLP	1 884
BOULT WADE TENNANT	1 761
FORRESTER KETLEY & CO.	1 442
WITHERS & ROGERS LLP	1 321
WILSON GUNN	1 275
APPLEYARD LEES	1 104
HARRISON GODDARD FOOTE	1 003
KELTIE	949

Community Design

Raising the bar for design protection

Recently the European Patent Office has announced a new strategy for its examination called "Raising the bar" in response to criticism that European patents were granted for technical innovations with only minor inventive merits.¹

Similar comments were expressed when the Community Design Regulation (CDR) came into force in 2001 because it does not require a Community design to "clearly differ"² from the prior art in order to have individual character as a prerequisite for protection. In fact, all it specifies is that the Community design produces a different overall impression on an informed user than any prior design.

However, the simplicity of the legal provision is often wrongly equated with the ease of getting design protection. Plain differentiation is believed to be achieved by introducing minor variations to a previously known design.

Such comments should become history in view of the recent decision of OHIM's Boards of Appeal in the case R 860/2007-3³ confirming a previous decision of the Invalidity Division. In this case, the Boards had to compare the subject matter of the contested Community design RCD 171178-0004 concerning inverter generators (below right) with a prior design (below left):



Despite the many differences between the two opposing designs, the Boards found that "the differences are not sufficient to affect the overall impression that the two designs produce on the informed user", because "the informed user is more likely to be impressed by the overall aspect of the generator rather than the various details that characterise mechanical devices in general." The Boards took into account that "the two designs concern products having a high technical content" and agreed with the holder of the contested RCD that the degree of freedom of the designer was limited, however, it concluded that the holder "could have distanced itself much more from the prior design, rather than by merely incorporating differences, which is what the changes it has mentioned to its design amount to."

The decision of the Boards is not only doing away with the reputation of the European design legislation as an easy access to design protection, but also testifies to the strength of a Community design when it comes to enforcement because the legal provision defining the scope of protection uses exactly the same terms as the legal definition of individual character. Article 10 CDR stipulates that a later design falls within the scope of protection of a Community design where both designs produce the same overall

impressions on an informed user. Applying the reasoning of the Boards to a hypothetical case in which the prior design (above left) was protected by a Community design and the owner had sued for infringement by the later design (above right), the result would have been an injunction. Minor variations cannot take a design out of the scope of protection. Therefore, raising the bar is not an issue in design matters: Community design protection was never easy to obtain and likewise never easy to circumvent.

¹ Meeting of the Council of the European Patent Organisation on 14 December 2007

² During the drafting process of the CDR the term "clearly" has been deleted in the definition of individual character. The fact that it was forgotten to delete the term in the preamble of the Regulation has led to some confusion.

³ Decision of the Third Board of Appeal of 17 April 2008, Wuxi Kipor Power Co., Ltd. vs. Honda Motor Co., Ltd.

The long life of Community designs

Since the first Community designs were registered in April 2003, the initial life span of five years granted to new registrations has expired for the first time, bringing up the question of how many registered Community designs (RCD) will be renewed. In design matters the rate of renewals is of particular interest since designs are often believed to be subject to rapid changes and short lifetimes, particularly in the field of fashion. Everybody still remembers the role of the textile industry during the drafting of the Community Design Regulation (CDR). Representatives lobbied intensely for the creation of the unregistered Community design (UCD) to provide protection without costs during a limited period of three years, which was considered to be long enough.

In the meantime, the registered Community design has become the dominant protection right for designs in Europe, with the textile industry the second biggest user of the system (behind furniture). In the Community design courts, actions against counterfeits are increasingly based on RCDs, beating its short-lived sibling, the UCD.¹

The interest of industry in sustained design protection is confirmed by the most recent statistics on renewals. Almost half the designs (48%) reaching the end of the 5-year period are renewed. In view of the fact that almost 90% of RCDs are incorporated in multiple registrations, the high number of renewals is quite impressive since there is no fee reduction for the renewal of multiple registrations. Apparently, many of the designs in multiple registrations are considered important enough to deserve a renewal fee of €90, which would certainly not be the case if multiple registrations were used only to provide initial protection for variations around a basic design until the commercially most successful form was identified.

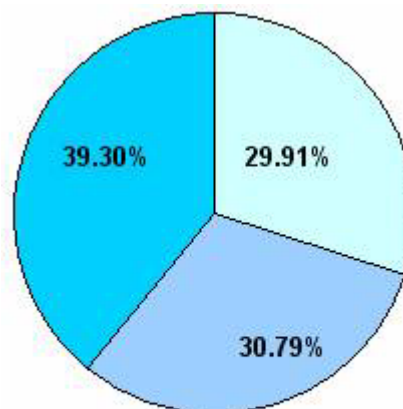
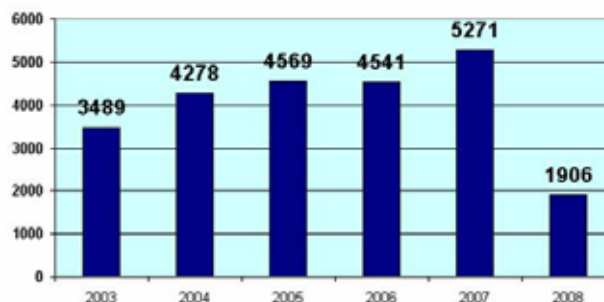
¹A list of judgments of the Community design court is found on the website of OHIM under <http://oami.europa.eu/en/design/aspects/cdcourt.htm>

Country overview: United Kingdom & the Registered Community Design

The first UK filings of RCDs were made 2003, with almost 3 500 designs registered when the Community design became available. Altogether, more than 24 000 UK designs have been registered. Last year there were almost 5 300 filings and in 2008 so far, there have been over 1 900.

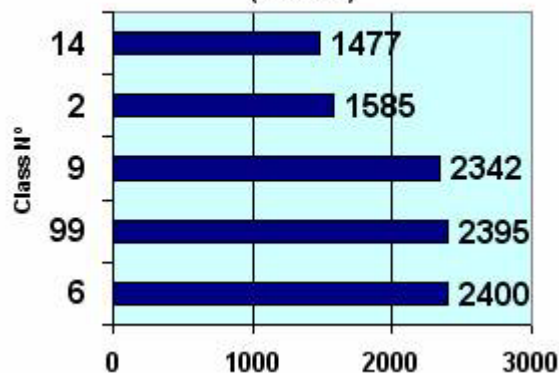
The most popular classes for design owners are 6, 99 and 9. The most popular filing route for UK owners is via the Internet, which accounts for 39%, followed by fax (31%) and mail (30%).

UNITED KINGDOM - RCD Filing Evolution
(Total RCDs: 24 054)



Mail Fax E-Filing

UNITED KINGDOM - Top Classes Filed
(Locarno)



Top 10 UK-based owners by number of RCDs filed

Owner	RCDs
J. Choo Limited	517
RECKITT BENCKISER (UK) LIMITED	401
ROBERT WELCH DESIGNS LIMITED	305
Willis Gambier LtdD	245
Typhoon Europe Limited	240
Typhoon International Group Limited	217
GLAXO GROUP LIMITED	197
Mainetti (UK) Limited	194
Lambert Howarth Group PLC	188
Armstrong World Industries Limited	163

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

Representative	RCDs
MARKS & CLERK	1 447
BOULT WADE TENNANT	980
A.A. THORNTON & CO.	829
URQUHART-DYKES & LORD LLP	735
WITHERS & ROGERS LLP	591
MEWBURN ELLIS LLP	516
BUSSE & PARTNER	468
WILSON GUNN	457
BARKER BRETTELL LLP	424
ABEL & IMRAY	392

E-business at OHIM

Conducting your business with OHIM via the MyPage platform

In 2004, OHIM launched MyPage as a free service for users to interact electronically with the Office. The purpose was to provide a professional and secured online platform, on which users could carry out CTM and RCD-related operations.

MyPage is a useful tool that has been adopted by more than 2 000 users who, altogether, are responsible for more than 40% of CTM transactions.



What kind of action can be done via MyPage?

First of all, MyPage permits the personalisation of electronic forms such as e-filing, into which the language preferences and the personal details of the MyPage account holders are automatically loaded.

In addition, some specific features are only accessible via MyPage:

- downloading both national and community search reports and configuring the e-mail alert system
- access to Online Access to CTM files documents relating to MyPage account holders that are still not open to third parties via the normal Online access to CTM files (further information at <http://oami.europa.eu/en/office/newsletter/08004.htm#EB1>)
- electronic renewal managers (CTM and RCD) displaying a list of CTMs and RCDs pending for renewal
- online modification of personal client details including details for representatives
- electronic communication to receive official notifications in your MyPage mailbox and also to submit documents electronically

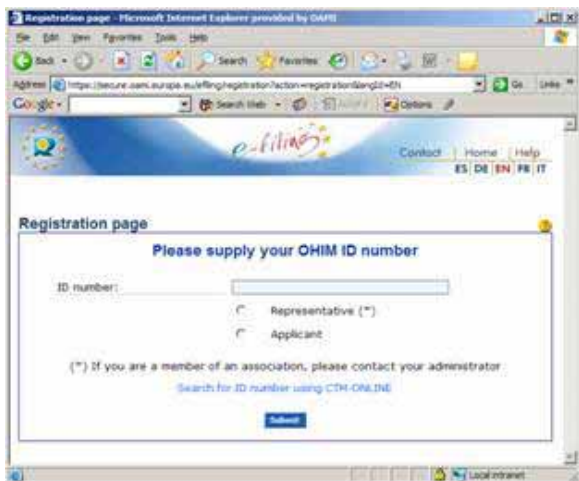
OHIM will be providing more and more services via the MyPage platform in the future.

Who can have MyPage?



Everybody who has had at least one interaction with OHIM (having filed a CTM, RCD, Opposition etc...) can subscribe to the MyPage system. In order to sign in online, the user needs the ID number that can be found by searching in CTM-ONLINE or RCD-ONLINE, or by looking at the OHIM notification.

Each MyPage account is linked to a specific ID number. Once authenticated in MyPage the account holder can gain access and take action regarding their user files.



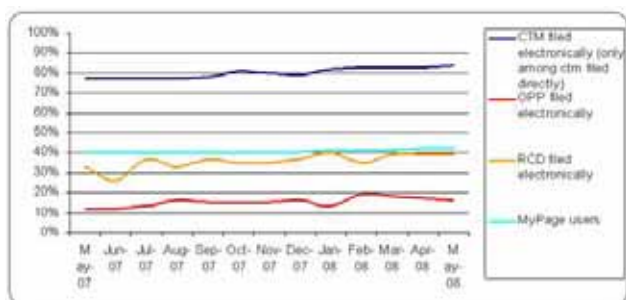
In the event that the same company or trade mark agent is identified at OHIM by several ID numbers, they will have to use several MyPage accounts, corresponding to the separate ID numbers. However, for companies it is possible to use the single MyPage account of the representative that is declared in all files.

Should you need any further information regarding MyPage please contact the OHIM Information Centre at information@oami.europa.eu

OHIM e-business roundup (2008)

Statistical summary

- The use of the CTM e-filing web form is steadily at 84 %.
- The use of RCD e-filing is 39%
- Oppositions against CTM applications received electronically is 16%.
- MyPage users represent around 40% of CTM Applications filed.



State of play of future projects

Service - New version of e-Communication:

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

Status - OHIM has started the final testing phase

Service - New version of CTM E-filing:

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

Status - OHIM has started the development phase

Service - New version of electronic filing of RCD applications

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

Status - OHIM has started the development phase

CTM watch:

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

Status - OHIM is going to start the testing phase

More News

CTM renewals

This short note is intended to answer some questions that have been raised with the Office concerning the renewal of Community trade marks (CTM).

CTMs are registered for a period of ten years calculated from the filing date of the application. Unless renewed they expire at the end of that period. They can be renewed at any time during the six months ending on the last day of the month in which they expire.

For example, a mark is due to expire in June 2008. It may be renewed at any time from 1 January to 30 June 2008. If not renewed within that period it will expire. The CTM which has expired may be revived if the renewal fee and a penalty payment is made in the six month grace period following the renewal period. In the example above the grace period runs from 1 July to 31 December 2008.

The Office does not issue renewal certificates. It only issues simple notices that renewal has taken place.

Monthly statistical highlights May 2008

Community trade mark applications received	7 443
Community trade mark applications published	7 993
Community trade marks registered (certificates issued)	6 107
Community trade mark renewal applications	1 247
Registered Community designs received	3 768
Registered Community designs published	7 110

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

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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

Eurohypo : C-304/06-P – Judgment of 8 May 2008 (appeal from T-439/04; partially allowed on a formal point of methodology as regards the applicable sub-paragraph of Article 7(1) CTMR; dismissed on substance = Office decision confirmed).

Keywords: ECJ proceedings: admissible pleas – ECJ proceedings: final decision by the ECJ itself – Absolute grounds for refusal: relationship between sub-paragraphs (b) and (c) of Article 7(1) CTMR – Absolute grounds for refusal: descriptiveness – Descriptiveness: assessment of compound signs – Descriptiveness: word combinations with “euro”.

By its appeal, Eurohypo AG sought to have set aside the judgment of the CFI of 3.5.2006 in Case T-439/04 (EUROHYPO; [2006] ECR II-1269) in which the CFI had dismissed the plaintiff's action brought against a decision of the 4th Board of 6.8.2004 in R 0829/2002-4. Initially, the sign had been applied for for: financial affairs; monetary affairs; real estate affairs; provision of financial services; financing; financial analysis; investment affairs; insurance affairs. By the

contested decision, the Office had refused to register the word mark EUROHYPO as a CTM for services, in Class 36, corresponding to the following description: financial affairs; monetary affairs; real estate affairs; provision of financial services; financing.

The examiner had based his decision on Article 7(1)(b) and (c) and Article 7(2) CTMR. In the contested decision, the Board had partially upheld the appeal and had annulled the examiner's decision as regards “financial analysis; investment affairs; insurance affairs”. The appeal had been dismissed as regards the other services in Class 36, namely: financial affairs; monetary affairs; real estate affairs; provision of financial affairs; provision of financial services; financing.

Essentially, the Board had held that the components EURO and HYPO contained a clearly understandable indication of the characteristics of the five services mentioned above, and that the combination of those two components in one word did not render the mark less descriptive. Therefore, it had held that the word sign EUROHYPO was descriptive of “financial affairs; monetary affairs; real estate affairs; provision of financial services; financing” and that it was, therefore, devoid of any distinctive character within the meaning of Article 7(1)(b) CTMR at least in German-speaking countries, and that that ground was sufficient under Article 7(2) CTMR to justify a refusal of protection.

Upon subsequent appeal, the CFI had first observed, at paragraphs 41, 43 and 44 (of its judgment under appeal): “(Contrary) to OHIM’s submissions, it is clear from paragraph 12 et seq. of the contested decision that the decision to refuse registration of the word sign EUROHYPO, in respect of “financial affairs; monetary affairs; real estate affairs; financial services; financing”, refers only to Article 7(1)(b) of Regulation No 40/94. However, the analysis carried out in paragraphs 13 to 16 underpinning that decision to refuse registration concerns the descriptiveness of the word sign EUROHYPO.” – “[However,] there is a clear overlap between the scope of the grounds for refusal set out in subparagraphs (b) to (d) of that provision (...).” – “(It) is also clear from the case-law of the Court of Justice and the Court of First Instance that a word mark which is descriptive of the characteristics of the goods or services concerned for the purposes of Article 7(1)(c) (CTMR) is, on that account, necessarily devoid of any distinctive character in relation to those goods or services within the meaning of Article 7(1)(b) (CTMR).”

The CFI had then gone on to state at paragraph 45 of the judgment under appeal that: “[the] assessment of the legality of the contested decision requires verification as to whether the Board has established that the word sign EUROHYPO was descriptive of “financial affairs; monetary affairs; real estate affairs; financial services; financing” within Class 36. If that is the case the refusal to register is the result of a correct application of both Article 7(1)(b) (CTMR) and Article 7(1)(c) and the contested decision must be upheld.” The CFI then had examined whether the word sign EUROHYPO was descriptive for the services at issue. First, it had held, at paragraphs 51 and 52, that the Board had rightly found that the individual components EURO and HYPO were descriptive of the services at issue. Second, the CFI had examined whether the descriptive character of the components which comprised the word sign EUROHYPO also existed for the compound word itself. At paragraph 55, the CFI had found in the affirmative in the following terms: “In the present cases

the word sign EUROHYPO is a straightforward combination of two descriptive elements, which does not create an impression sufficiently far removed from that produced by the mere combination of the elements of which it is composed to amount to more than the sum of its parts. The applicant has not shown that that compound word had become part of everyday language and had acquired a meaning of its own. It argues, to the contrary, that the word sign EUROHYPO has not become part of everyday German for describing financial services.”

In addition, at paragraph 56 of the judgment under appeal, the CFI had held that the solution identified in the judgment of the ECJ in case C-383/99-P Proctor & Gamble v OHIM [2001] ECR I-6251 ('Baby-dry') could not be transposed to the present case given that: “[the] term at issue in that case was a lexical invention which had an unusual structure, which is not the case for the word sign EUROHYPO.”

The 1st Chamber of the ECJ (Jann; Tizzano, rapporteur; Borg; Bartet; Ilesic; Levits) revoked the challenged CFI decision only to the extent that the judgment was vitiated by an error in law as regards the assessment of Article 7(1)(b) CTMR. On the substance, however, the ECJ took a final decision in the case pursuant to Article 61 of the Statute of the Court of Justice by which it rejected the appeal, i.e. it confirmed the initially challenged decision of the 4th Board to reject registration of “Eurohypo” for the claimed services in Class 36.

(a) Plea that the Board of appeal did not properly assess the facts (Article 74(1) CTMR)

“(32) It should be stated, at the outset, that by its first plea, even though it has formally pleaded an error in law, the appellant is seeking, in essence, to call into question the factual assessment carried out by the (CFI) and, in particular, to dispute the probative value of a number of facts which led the Court of First Instance to find that OHIM was not obliged to undertake additional research where it was sufficiently certain as regards the descriptive character of the components EURO and HYPO and of the word EUROHYPO.

(33) It follows from settled case-law that the (CFI) has no jurisdiction to establish the facts or, in principle, to examine the evidence which the (CFI) accepted in support of those facts. Provided that the evidence has been properly obtained and the general principles of law and the rules of procedure in relation to the burden of proof and the taking of evidence have been observed, it is for the (CFI) alone to assess the value which should be attached to the evidence produced to it. Save where the clear sense of the evidence has been distorted, that appraisal does not therefore constitute a point of law which is subject as such to review by the Court of Justice (see, to that effect, Case C-185/95 P Baustahlgewebe v Commission [1998] ECR I-8417, paragraph 24; Case C-40/03 P Rica Foods v Commission [2005] ECR I-6811, paragraph 60; and Case C-551/03 P General Motors v Commission [2006] ECR I-3173, paragraph 52).

(34) In that regard, it should be recalled that there is distortion of the clear sense of the evidence where, without recourse to new evidence, the assessment of the existing evidence appears to be clearly incorrect (Case C-229/05 P PKK and KNK v Council [2007] ECR I-439, paragraph 37, and Case C-

326/05 P Industrias Químicas del Vallés v Commission [2007] ECR I-6557, paragraph 60).

(35) However, it must be pointed out that, in the context of the first plea, the appellant limits itself to challenging the assessment of the facts carried out by OHIM in the contested decision and, in particular, the alleged incomplete nature of that assessment. By contrast, it has not shown, nor even alleged, that the (CFI) carried out a clearly incorrect assessment of the evidence. 36 Therefore, the first plea in law must be held to be inadmissible.”

(b) Assessment of a compound mark

“(41) As regards a compound trade mark, such as that at issue in the present case, the assessment of its distinctive character cannot be limited to an evaluation of each of its words or components, considered in isolation, but must, on any view, be based on the overall perception of that mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, have a distinctive character (see, to that effect, Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317, paragraph 35). The mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that their combination cannot present such character (Case C-37/03 P BioID v OHIM [2005] ECR I-7975, paragraph 29).

(42) At paragraph 54 of the judgment under appeal, the (CFI) rightly held that in order to assess the distinctive character of a compound mark, not only must the various elements of which it is composed be examined but also the mark as a whole.

(43) Admittedly, in the same paragraph, the (CFI) stated that a mark consisting of a word composed of elements, each of which is descriptive of the characteristics of those goods or services in respect of which registration is sought, is itself descriptive of the characteristics of those goods and services.

(44) However, that finding did not affect the analysis of the (CFI) on that point, since it did not limit itself to assessing, as a secondary issue, the overall impression produced by the trade mark applied for, but devoted a part of its reasoning to evaluating, with regard to a compound mark, the descriptive character of the sign as a whole.

(45) At paragraph 55 of the judgment under appeal, the (CFI) held that the impression created by the mark at issue was not sufficiently far removed from that produced by the mere combination of the elements of which it is composed to amount to more than the sum of its parts and that the appellant had not shown that that compound word had become part of everyday language and had acquired a meaning of its own.

(46) Moreover, at paragraph 56 (...), the (CFI) examined whether the mark at issue was a lexical invention which had an unusual structure, finding that that was not the case. 47 Finally, at paragraph 57 (...), the (CFI) held that the mark EUROHYPO, considered as a whole, was descriptive of the services in question.

(48) Therefore, the (CFI) cannot be criticised for not having verified whether the mark, taken as a whole, had a descriptive character or for having done so merely as a secondary point.”

(c) Relationship between Article 7(1)-(b) and 7(1)-(c) CTMR

“(54) It must, first, be borne in mind that, while the Court of Justice has had occasion to find a degree of overlap between the respective scope of the absolute grounds for refusal to register a trade mark set out in Article 7(1)(b) to (d) (CTMR) (see, by analogy, as regards the identical provisions of Article 3(1) of First Council Directive 89/104/EEC (...), Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619, paragraph 67, and Case C-265/00 Campina Melkunie [2004] ECR I-1699, paragraph 18), it is nevertheless the case that, according to established case-law, each of the grounds for refusal to register listed in Article 7(1) (CTMR) independent of the others and requires separate examination (see Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 45; Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 39; and Case C-173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551, paragraph 59).

(55) The Court of Justice has also had occasion to make it clear that the various grounds for refusal must be interpreted in the light of the public interest underlying each of them. The public interest taken into account in the examination of each of those grounds for refusal may, or even must, reflect different considerations, depending upon which ground for refusal is at issue (Henkel v OHIM, paragraphs 45 and 46; SAT.1 v OHIM, paragraph 25; and BioID v OHIM, paragraph 59).

(56) In that regard, it should be noted that the notion of general interest underlying Article 7(1)(b) (CTMR) is, manifestly, indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (SAT.1 v OHIM, paragraphs 23 to 27, and BioID v OHIM, paragraph 60).

(57) In the present case, the reasoning followed by the Court of First Instance is based on an incorrect interpretation of the principles mentioned in paragraphs 54 to 56 of this judgment.

(58) It is apparent from paragraphs 45, 54, 55 and 57 of the judgment under appeal that the (CFI) assessed the distinctive character of the mark EUROHYPO by carrying out solely an analysis of its descriptive character within the meaning of Article 7(1)(c) (CTMR). Consequently, the judgment under appeal contains no separate examination of the ground for refusal laid down in Article 7(1)(b) on the basis of which, however, the (CFI) rejected the second plea, raised at first instance, against the contested decision.

(59) In so doing, the (CFI) assessed the mark EUROHYPO without, in particular, taking into account the public interest which Article 7(1)(b) aims specifically to protect, that is, to guarantee the identity of the origin of the designated product or service.

(60) Moreover, in the context of such an assessment, the (CFI) used an incorrect criterion to determine whether the mark in question could be registered.

(61) According to that criterion, a mark composed of descriptive elements could meet the conditions for registration where the word has become a part of everyday language and has acquired a meaning of its own. But, while that criterion is relevant in the context of Article 7(1)(c) (CTMR), it cannot form a basis for the interpretation of Article 7(1)(b).

(62) Although that criterion permits excluding the use of a trade mark to describe a product or a service, nevertheless, it does not allow it to be determined whether a mark is capable of guaranteeing the identity of the origin of the designated product or service to the consumer or end user.

(63) In those circumstances, the appellant is right to claim that the judgment under appeal is vitiated by an error in law in the interpretation of Article 7(1)(b).

(64) It follows from the foregoing, without it being necessary to examine the third part of the second plea of the appeal, that the judgment under appeal must be set aside inasmuch as the (CFI) held that the Fourth Board did not infringe Article 7(1)(b) of Regulation No 40/94 by refusing, in the contested decision, to register the term EUROHYPO as a CTM for the services, ‘financial affairs, monetary affairs, real estate affairs, provision of financial services, financing ...’, in Class 36 of the Nice Agreement.”

A-2: ECJ: Developments in pending cases

Activity Media Gateway : C-57/08-P (appeal from T-434/05; Office contribution filed).

Keywords: Opposition: likelihood of confusion (LOC).

The case is an appeal from the judgment of the CFI (5th Chamber) of 27. 11.2007 in Case T-434/05 ('ACTIVY Media Gateway/GATEWAY'). On 25.4.2001, Fujitsu Siemens Computers GmbH had filed a CTM for the following goods and services in Class 9: optical, electrotechnical and electronic apparatus and equipment, electrotechnical and electric apparatus for recording, broadcasting, transmission, reception, reproduction and processing of sounds, signals and/or images; electrotechnical and electric apparatus for the recording, processing, sending, transmission, relaying, storage and output of messages and data; communications computers, software; optical, electrotechnical and electronic information technology and communications technology apparatus, Class 35: gathering, storage and retrieval of data, information, images, video and audio sequences; Class 38: forwarding and distribution of data, information, images, video and audio sequences, and in Class 42 for: consultancy with regard to the construction and operating of apparatus, installations and other data, information and communications technology products; planning, development, consultancy, testing, technical monitoring, systems integration and product integration in the field of data technology, information technology and communications technology; development, creation and rental of computer programs.

Subsequently, Gateway, Inc. had filed a notice of opposition based on two UK rights and two CTM rights in the word Gateway, the latter registered in Class 35 for retail and mail order services relating to computers, software computer peripherals and computer manuals., and for: computers, none being a gateway or incorporating a gateway device or software; computer peripherals fittings and accessories not being gateway devices; computer software other than gateway software (in Class 9); and retail, mail-order and Internet selling services relating to computers, computer peripherals fittings and accessories; and the demonstration of those products (in Class 35). Reputation had been claimed for both the national marks and the CTM.

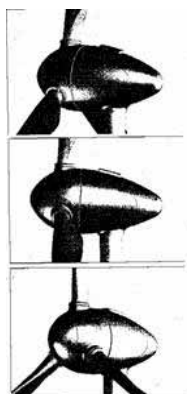
Further, a pending CTM application for Gateway had been invoked, applied for in Class 38 for services for the transmission of data and of information by electronic, computer, cable, radio, radiopaging, teleprinter, teletype, electronic mail, telecopier, television, microwave, laser beam or communication satellite means; services for the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank; services for the broadcasting or transmission of radio and television programmes; none of the services relating to gateways or software for gateways. The CTM application had subsequently been rejected; that decision is final.

By decision No 3267/2004 of 27 September 2004, the Opposition Division had rejected the opposition for all the contested goods and services; the decision had been confirmed by the Board on the ground that LOC was in-existent given the absence of similarity between the signs. It further supported the Opposition Division's arguments concerning the rejection of the opposition based on the relative grounds for refusal contained in Articles 8(4) and 8(5) CTMR. By its challenged judgment, the CFI had dismissed the subsequent action against the Office.

Windenergie-Konverter : C-20/08-P - Appeal from T-71/06; Office response filed (DE).

Keywords: 3D signs – 3D signs: absolute grounds for refusal/distinctiveness – 3D signs: shape of the product – 3D signs: part of the product – Distinctiveness: relevant public.

The case is an appeal from a decision of the CFI of 15.11.2007 in Case T-71/06 which related to a decision of the 2nd Board of 30.11.2005 by which the following sign had been rejected as a CTM:



The sign consists of part of a wind energy apparatus in the form of an American football. It had been applied for a specific type of wind energy apparatus in Class 7. The application had been rejected at all instances on the ground of lack of distinctive character for a highly specialised public.

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

None

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

Volks.Handy-Schwabenpost : C-39/08 and C-43/08 - Reference from the German Patent Court (BPatG); Office contribution filed (internal document).

Keywords: Absolute grounds for confusion: distinctiveness – Distinctiveness: principles of assessment – Administration of trade mark applications: public law effects – Public law effects: binding effect of previous IP office practice?

The joint cases are references from the German Patent Court (Bundespatentgericht; BPatG) on appeal from decisions of the German Patent and Trade Marks Office (DPMA).

In Case C-39/08, applications had been filed with the DPMA for “VOLKS.HANDY”, “VOLKS.CAMCORDER” and “VOLKS.KREDIT” (figurative marks) for a variety of goods and services. When the applications met with an objection on the basis of absolute grounds for refusal, the applicant pointed out that it had already registered a family of similarly constructed signs for similar goods and services at the DPMA. The DPMA, however, had rejected the applications in question stating that the fact that identical signs had previously been accepted for identical goods and services does not confer an “entitlement to a repetition of errors”. In its appeal, the applicant pointed out that it had successfully registered in total a family of 45 similar trade marks, all constructed in the same way as the trade marks at issue, at the DPMA, both before and after the contested decisions.

In Case C-43/08, applications had been filed for registration of “SCHWABENPOST” for a variety of goods and services. The DPMA had partially rejected the application on the ground that the sign would only combine the generic business indicator “Post” (mail) with an indication of geographical origin “Schwaben” (Swabia). In its appeal, the applicant pointed out that both the applicant itself and competitors had already registered similarly constructed signs for similar services at the DPMA. In particular, Deutsche Post AG had successfully registered the significant number of 248 trade marks containing “Deutsche Post...” (“German Mail...”) which only in some cases contain minor figurative elements. The applicant claims that, due to the registration practice of the DPMA, the relevant public has become accustomed to perceiving such signs as indicators of origin. The applicant further considers that its “equality of opportunity in the market place” is



adversely affected by the rejections at issue inasmuch as competition is being distorted.

In both cases, the court had invited the President of the DPMA to become party to the proceedings, considering it necessary to clarify the criteria underlying the registration practice of the DPMA. In the course of proceedings, the President of the DPMA had explained the practice aiming at ensuring uniformity in decisions. In his statement, he had referred to settled domestic and Community case-law that earlier registrations of an identical or similar mark cannot generate any binding effect, even where there is a possibility of violation of the basic right to equal treatment and of the principle of the protection of legitimate expectations. Interpretation of the legal concept of distinctive character under Section 8(2) No. 1 of the Markengesetz is not a matter of discretion. The DPMA, as a matter of principle, is of course obliged to apply the law as uniformly as possible. However, the vast number of potential linguistic, graphic and other forms of signs, in conjunction with the particular features of the most differentiated goods and services, make it impossible to set up an absolutely uniform list of criteria for ascertaining protectability. When it had revised its examination guidelines, the DPMA therefore had deliberately refrained from requiring examiners to provide an explicit statement of reasons for departing from an earlier registration. However, there is an unwritten rule that earlier registrations and rejections should be included in the decision-making process. The endeavour to secure a coordinated approach to decision-making is also catered for by discussing legal and factual developments at various levels, although the DPMA has not established a formal procedure. The examination guidelines of the DPMA of 13 June 2005 lay down that each application constitutes an individual case which must be separately assessed. Previous registration of national trade marks does not give rise to entitlement to registration, either *per se* or in conjunction with the principle of equal treatment.

The BPatG explains that, as reflected in the first recital of the Preamble of the First Council Directive 89/104/ EEC (EU Trade Marks Directive, hereafter "TMD"), trade mark law is an essential element in the system of undistorted competition. It therefore appears to be the responsibility and duty of the national registration authorities, for reasons of legal certainty and proper administration, to carry out a stringent and full examination of the grounds for refusal in order to prevent, in the interests of free competition, the registration of trade marks that are not capable of being protected. According to the BPatG, the principle of equality of opportunity must exist not just in relation to competitors (Case C-43/08 SCHWABENPOST), but also in regard to one and the same applicant which wishes to protect its economic activities by means of a series or family of marks (Case C-39/08 VOLKS.HANDY). The BPatG asserts that it follows from the national registration authority's duty of proper administration and its duty to conduct a stringent and full examination of the grounds for refusal that, when establishing the facts, it must take account of its previous examination practice. Where the factual or legal circumstances have not changed, the registration authority cannot reach a conclusion that departs from its earlier decisions.

The BPatG went on to state that the required consistency of decision-making practice must be amenable to judicial review which simply involves putting into effect the wording of Article 3(1)(b) and (c) TMD. In the light of the general principle of

equal treatment, which is also a fundamental principle of Community law, the BPatG cannot pass over cogently-argued complaints concerning arbitrary examination practice and, consequently, unequal treatment resulting in a distortion of competition. It appears necessary to have regard for the principles of the internal market in order to guarantee equality of opportunity in matters of competition. This gives rise to the duty to have regard to the earlier decisions of the registration authority in the process of establishing facts, either if there is reason to assume that a significant number of identical or similar signs exists, or if the allegation of arbitrariness has been raised, and if there are specific indications of inconsistent administrative practice.

The BPatG stated that, in view of the seventh recital in the preamble of the TMD, equality of conditions and, thus, equality of opportunity in matters of competition can be achieved only if the national registration authorities of all the Member States follow a comparably stringent examination practice. In the present proceedings, the BPatG wishes, for the stated reasons, to take account of the earlier registrations. In doing so, the BPatG does not fail to recognise that the right to registration of a sign as a trade mark cannot be implemented effectively if there are grounds for refusal under Article 3(1)(b) and/or (c) of the TMD even if, in the past, identical or similar signs have been registered in error. The principle of legality does not grant entitlement to continuation of an administrative practice which has been found to be unlawful.

However, the BPatG is of the view that it is essential to take account of the earlier registrations in order to verify the consistency of the administrative practice. It also has to be taken into account that the holder of the registered trade marks already uses them on the market as a family of trade marks. It must therefore be assumed that the registration practice of the DPMA has already had a direct impact on the commercial perception of similarly constructed signs. The BPatG believes that the infringement of the requirement of consistent examination practice establishes a right to registration of the signs at issue. The distortion of competition resulting from inconsistent examination practice can thereby be prevented and equality of competitive opportunity in the acquisition of trade mark rights be established only if judicial review of administrative decisions takes, to a great extent than previously, account of the factor of potential arbitrary (unequal) treatment.

However, the BPatG is of the view that it is precluded from taking account of the earlier registrations in determining the protectability of the signs applied for in view of the case-law of the ECJ according to which the legality of the decisions of the Board of Appeal of the OHIM must be assessed solely on the basis of the CTMR, Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, and not on the basis of the decision-making practice of the OHIM or of national trade mark offices. The Community law concept of discretion appears to be different from the German concept, and the ECJ apparently interprets that as being solely linked to the "facts" of the case. It appears, against this background, that the ECJ does not allow discretion for the OHIM in relation to appraisal or prognosis. However, in the view of the BPatG, the respective judgments of the ECJ have not addressed the issue of eliminating arbitrariness and the need to take account of earlier decisions for that purpose.

The questions referred

By its judgments dated 19 December 2007, the BPatG stayed the main proceedings and referred to the ECJ the following questions:

A: Case 39/08

Does Article 3 of Directive 89/104/ EEC of 21 December 1988, which seeks to secure equality of opportunities in matters of competition, require that identical or similar applications be treated in the same way?

B: Case 43/08

(1) Does Article 3 of Directive 89/104/ EEC of 21 December 1988 require equal treatment, with regard to the registration of trade marks, of applicants in competition with one another in order to safeguard equality of opportunity in matters of competition?

(2) If the answer is “yes”, is the national court required to investigate specific indications of unequal treatment which distort competition and to take account of earlier decisions of the competent authority in similar cases?

(3) If the answer is “yes”, is the national court required to take account of prohibition of discrimination having the effect of distorting competition when interpreting and applying Article 3 of the Directive 89/104 if it has established discrimination of that nature?

(4) If Questions 1 to 3 are answered in the negative, in order to prevent distortion of competition, must it be possible under national legislation for the national authority to be placed under an obligation to initiate, of its own motion, an action for the annulment of trade marks which have previously been wrongly registered?

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

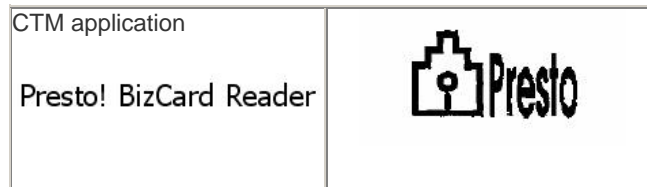
C-1: CFI Judgments and Orders

Presto : T-205/06 – Judgment of 22 May (only in FR, DE; action dismissed; Office practice confirmed).

Keywords: Registration formalities: divergences as regards the different linguistic versions of the list of goods and services – Invalidation proceedings: formal aspects as regards deficiencies of the registration certificate – Opposition/invalidation: likelihood of confusion (LOC) – LOC: comparison of services with goods.

The action had been directed against a decision of the 2nd Board of 19.5.2006 in R 0601/2005-2 relating to cancellation proceedings based on relative grounds against CTM “Presto! BizCard Reader” which had been registered for a range of

goods and services in Classes 9, 16 and 42. Whereas the German version of the list of goods and services on the registration certificate contained “book binding articles” in Class 16, that indication had been found to be missing in the English version on the registration certificate.



The request for invalidation on relative grounds, based on Presto (figurative mark), had been filed on an English form and had been directed against “all goods and services” (box on the standard form). However, in its brief setting out details, the requestor for invalidation did not mention book binding articles when it set out the challenged goods. The invoked earlier Spanish right is registered in Class 42, inter alia for programming, designing computer programmes, and for “sophisticated services in the IT sector”.

The Cancellation Division invalidated the challenged CTM for all goods and services in Classes 9 and 42, and for part of the goods in Class 16. In that class, it maintained the CTM for paper ware and goods made therefrom, and for photographs. The Board confirmed that decision without expressly mentioning book binding articles. The CTM holder and plaintiff in the proceedings submitted that, since the Board had not expressly referred to them, book binding articles have been left untouched. The 5th Chamber of the CFI (Vilaras; Prek; Ciuca, rapporteur) did not follow that line of argument. It confirmed the Board decision that there existed LOC in respect of all goods and services covered by the CTM, in relation to the services in the invoked mark which had been found similar.

Publicare : T-358/07 – Order of 28 April 2008 (DE, FR; dismissed for formal reasons).

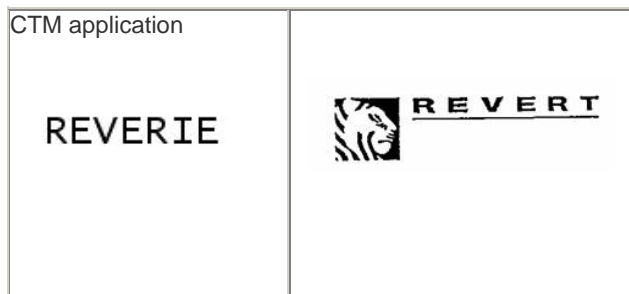
Keywords: CFI proceedings: formal requirements – CFI proceedings: filing of the action by fax; submittal of the original within 10 days – Absolute grounds for refusal: descriptiveness.

The action had been brought against a decision of the 4th Board of 27.6.2007 in R 0157/2007-4 by which it had rejected CTM application Publicare, word mark. The applicant's representatives filed the respective appeal to the CFI by fax but failed to submit the original within 10 days thereafter (Article 43 § 6 CFI Rules of Procedure). In consequence, the action was dismissed a limine (8th Chamber, Martins Ribeiro; Wahl; Dittrich, rapporteur).

Reverie/Revert : T-246/06 - Judgment of 6 May 2008 (action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been initiated against a decision of the 4th Board of 10.7.2006 in R 0171/2005-4 relating to a CTM application for REVERIE, word mark, which had been opposed on the basis of figurative Community trade mark REVERT.



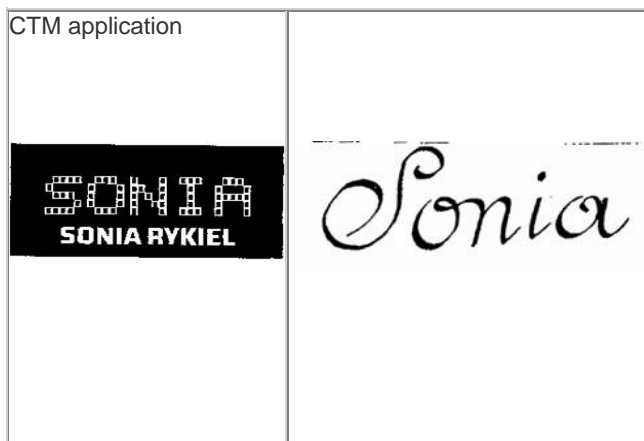
As regards the CTM application, it had been applied for in Class 16 for paper and cardboard (untreated, semi-finished or for stationery or printing); printed matter; photographs; stationery; printers' type; printing blocks; mail order catalogues; in Class 20 for beds, bed bases, mattresses, and in Class 24 for sheets, blankets, duvets, pillowcases. The invoked earlier right covers Class 24: textiles and textile goods, not included in other classes; bed and table covers, including blankets, bedspreads and sheets, Class 25: ready-made outer and under garments; footwear; belts, and Class 39: services for the transport, packaging, storage and distribution of goods.

The opposition had been partially successful, namely as regards sheets, blankets, duvets and pillowcases included in Class 24, on the ground that those goods were either identical or highly similar to the goods covered by the earlier mark which fell within the same class, and that there was a certain visual and phonetic similarity between the signs at issue (phonetically similar in German and Spanish), and that while their verbal elements might have a meaning in some Member States, that was not the case in Germany, Austria and Spain. It had, thus, been concluded that there was a likelihood of confusion in those three Member States. The 4th Chamber of the CFI (Wisniewska-Bialecka, rapporteur; Moavero Milanese; Wahl) confirmed these findings relying on standard criteria.

Sonia Rykiel : T-131/06 - Judgment of 30 April 2008 (action allowed; law of the case).

Keywords: Opposition: proof of use (POU) – POU: criteria for assessment – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action had been directed against a decision of the 1st Board of 30.1.2006 in R 0329/2005-1 relating to opposition proceedings initiated against CTM application Sonia/Sonia Rykiel (figurative mark) on the basis of earlier Spanish rights in Sonia (stylised word).



The CTM had been applied for, in Class 18, for leather and imitations of leather and goods made of these materials, namely handbags, trunks, suitcases and travelling bags, purses, pocket wallets, chequebook holders, card holders, key ring cases, umbrellas, parasols, walking sticks and switches, and in Class 25 for clothing, including headscarves, underwear, socks, stockings, footwear (except orthopedic footwear), headgear, for men, women and children. The invoked earlier Spanish registrations cover knitwear (Class 24) and stockings, socks, articles of clothing for women, men or children, footwear (except orthopedic) and headgear in Class 25.

In the course of the opposition proceedings, the CTM applicant called on the opponent to provide evidence of genuine use of its earlier marks, in accordance with Article 43(2) and (3) CTMR. By its decision of 26.6.2001, the Opposition Division, without examining the issue of whether there had been genuine use of the earlier marks, had found that there was a likelihood of confusion between those marks and the mark applied for with regard to the goods in Class 25, and dismissed that likelihood with regard to the goods in Class 18.

In its appeal, the CTM applicant and plaintiff in the case at issue had restricted the subject matter of its appeal to disputing the existence of LOC between its mark and the earlier marks in respect of all the goods in Class 25. In that respect, it drew attention to the fact that there was no evidence of genuine use of the earlier marks with regard to those goods. In its decision R 0744/2001-2 of 21.5.2002, the 2nd Board had ruled that there had been a breach by the Opposition Division of its obligation to request the opponent to submit evidence of use of those earlier marks. It also had noted that the decision was definitive in so far as it rejected the opposition with regard to the goods in Class 18. The case had therefore been remitted to the Opposition Division for further action regarding the opposition in respect of the applicant's goods in Class 25.

In the course of the subsequent opposition proceedings, the opponent had submitted several documents to prove that the marks on which the opposition was based had been put to genuine use in Spain. By decision No 204/2005 of 28.1.2005, the Opposition Division had taken the view that the evidence submitted showed genuine use of the earlier word mark, but only in respect of 'women's slips' and 'petticoats'. On the other hand, it considered that no evidence of genuine use of the other mark (No 101 394) had been provided. Comparing the



earlier word mark, the only mark for which genuine use had been established, with the sign applied for, it had then concluded that there was no likelihood of confusion between them. The opponent subsequently appealed that decision.

By its decision R 0329/2005-1 of 30.1.2006, the 1st Board, after having confirmed the Opposition Division's findings as to whether there had been genuine use of the earlier national word mark, had nevertheless found that there was a likelihood of confusion between that mark and the mark applied for and, consequently, had annulled the Opposition Division's decision. In consequence, it had rejected the CTM application in respect of the goods in Class 25.

The 1st Chamber of the CFI (Cooke; Labucka; Prek, rapporteur) did not agree as regards the positive assessment of proof of use:

“(35) As the ninth recital in the preamble to Regulation No 40/94 indicates, the legislature took the view that the protection of an earlier trade mark is justified only to the extent that the mark has actually been used. In keeping with that recital, Article 43(2) and (3) of Regulation No 40/94 provides that an applicant for a Community trade mark may request proof that the earlier mark has been put to genuine use in the territory where it is protected during the five years preceding the date of publication of the Community trade mark application against which an opposition has been filed (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 34; *VITAFRUIT*, cited in paragraph 30 above, paragraph 36, and *LA MER*, cited in paragraph 32 above, paragraph 51).

(36) Under Rule 22(2) of Commission Regulation (EC) No 2868/95 (...) the proof of use must cover the place, duration, extent and nature of the use made of the earlier trade mark.”

(37) In interpreting the concept of genuine use, account must be taken of the fact that the rationale for the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application, is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (*Silk Cocoon*, cited in paragraph 29 above, paragraph 38). However, that provision does not involve either assessing the commercial success of an undertaking or monitoring its economic strategy, nor is it designed to reserve the protection of trade marks for large-scale commercial uses of them (*VITAFRUIT*, cited in paragraph 30 above, paragraph 38; *HIPOVITON*, cited in paragraph 31 above, paragraph 32; and *LA MER*, cited in paragraph 32 above, paragraph 53).

(38) As is apparent from the judgment in *Ansul*, cited in paragraph 21 above (paragraph 43), relating to the interpretation of Article 12(1) of First Council Directive 89/104/EEC (...), the legislative content of which effectively corresponds to that of Article 43 of Regulation No 40/94, there is genuine use of a trade mark where it is used in accordance with its essential function, namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. In that regard, the condition relating to genuine use of the trade mark

requires that the use of the mark, as protected on the relevant territory, be public and external (*Silk Cocoon*, cited in paragraph 29 above, paragraph 39; see, by way of analogy, *Ansul*, cited in paragraph 21 above, paragraph 37).

(39) When assessing whether use of a trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see, by analogy, *Ansul*, cited in paragraph 21 above, paragraph 43)

(40) As regards the scale of the use made of the earlier trade mark, account must be taken of, inter alia, first, the commercial volume of all the acts of use and, second, the duration of the period over which the acts of use were carried out and the frequency of those acts (judgment of 14 December 2006 in Case T-392/04 *Gagliardi v OHIM – Norma Lebensmittelfilialbetrieb(MANU MANU MANU)*, not published in the ECR, paragraph 82).

(41) To examine whether an earlier trade mark has been put to genuine use in a particular case, an overall assessment must be carried out, taking account of all the relevant factors in the case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court of Justice has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark (order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21; *LA MER*, cited in paragraph 32 above, paragraph 57; see, by way of analogy, *Ansul*, cited in paragraph 21 above, paragraph 39).

(42) However, the more limited the volume of sales of items bearing the mark, the more necessary will it be for the party opposing new registration to produce additional evidence to dispel possible doubts as to the genuineness of the use of the mark in question (*HIPOVITON*, cited in paragraph 31 above, paragraph 37).

(43) The Court of Justice also added, in paragraph 72 of its judgment in Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, that it was not possible to determine a priori and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of



the dispute before it, cannot therefore be laid down. Thus, in that judgment, the Court held that, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use.

(44) The (CFI) has held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (HIWATT, cited in paragraph 35 above, paragraph 47, and Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 28).

(45) The issue as to whether the Board of Appeal was correct in holding that the evidence submitted by Cuadrado before OHIM proved genuine use of the earlier word mark should be examined in the light of the foregoing considerations. It is necessary to note, first of all, that in paragraph 18 of the contested decision the Board of Appeal, after examining the evidence provided by Cuadrado, merely confirmed the findings of the Opposition Division on the issue of the genuine use of the earlier word mark. The analysis of the evidence of genuine use should therefore be conducted on the basis of the findings in the decision of the Opposition Division.

(46) Since the applicant's Community trade mark application was published on 6 December 1999, the relevant five-year period for the purposes of Article 43(2) of Regulation No 40/94 therefore lasts from 6 December 1994 to 5 December 1999.

(47) The evidence which Cuadrado presented before the Opposition Division as to the use, in Spain, of the earlier word mark consists, as the Opposition Division's decision shows, of copies of invoices issued in 1997, 1998 and 2002, packaging and labels and a copy of an invoice for the cost of manufacturing packaging bearing the earlier word mark. The Court therefore notes that, during the proceedings before OHIM, Cuadrado did not submit any document designed to indicate the volume of its sales or the commercial volume of all the acts of use, with the result that only the documents referred to above can provide evidence of genuine use of the trade mark.

(48) First, the Board of Appeal, like the Opposition Division, took into consideration only nine invoices, drawn up between 10 January 1997 and 10 March 1998, and thus during the relevant period. OHIM thus acted correctly in disregarding the invoices drawn up in 2002.

(49) In addition, each of those nine invoices includes at least one of the reference numbers identifying the two products covered by the earlier word mark. Those reference numbers are No 908010 and No 908018 in respect of women's slips and No 910004 and No 910007 in respect of petticoats. The Board of Appeal therefore did not in any sense take into account invoices without either of those reference numbers.

(50) Secondly, the Board was correct to disregard, on grounds of irrelevance, the invoice addressed to Cuadrado for the manufacture of packaging bearing the earlier word mark. That invoice, which was, moreover, drawn up after the relevant period, does not in fact indicate that the goods covered by the earlier word mark were actually sold or, at

least, that they had been placed on the market during that period.

(51) Thirdly, the Board was right to take into account the labels and packaging with a view to establishing the use of the earlier word mark. However, that evidence, of limited probative value, is, as such, insufficient to support a finding that the earlier word mark was genuinely used. The mere fact that Cuadrado still has in its possession a number of years after the relevant period examples of labels and packaging bearing the mark at issue does not in itself prove that that mark was actually used during that period, or provide any information on the volume of any acts of use. That evidence must therefore be assessed together with the other evidence as a whole.

(52) Fourthly, as regards the argument that the quantities of articles sold were so modest that it cannot be concluded that there was genuine use of the earlier word mark, it should be noted that 54 units of women's slips and 31 units of petticoats were sold over a period of 13 months, for a total sum of EUR 432. It is therefore necessary to determine, having regard to the previously cited case-law, whether that small turnover and the very modest quantities of articles sold over that period allow the conclusion to be drawn that there was genuine use of the earlier word mark.

(53) As stated in paragraph 39 of *Ansul*, cited in paragraph 21 above, those figures and quantities cannot be assessed in absolute terms but must be assessed in relation to other relevant factors. In this respect, the data above should be viewed in relation to the nature of the goods and the structure of the relevant market.

(54) Those articles are goods of everyday consumption, sold at a very reasonable price. They are therefore not luxury goods, expensive and sold in limited numbers in a narrow market, but goods to be sold to a large number of consumers throughout Spain.

(55) Therefore, pursuant to the case-law referred to above, it is necessary to examine whether the very small volume of sales of those goods under the earlier word mark might have been offset by the fact that use of the mark was extensive or very regular. In the present case, there is nothing to indicate that use of the mark was extensive or regular, the nine relevant invoices being concentrated in the months of January, February and March 1997, and February and March 1998.

(56) The assessment of the turnover and the volume of sales of the product under the earlier trade mark must also be conducted in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark.

(57) Admittedly, it is apparent from the Opposition Division's decision that Cuadrado offers a huge range of articles, of which the goods sold under the earlier word mark form only one part.

(58) However, the fact remains that such an explanation is not sufficient to dispel the doubts as to the genuine use of the

earlier word mark arising from the extremely limited commercial volume of its exploitation.

(59) The contested decision does not include either any concrete information on or an adequate analysis of the relevant factors, referred to in the previously cited case-law, enabling the minimal turnover (EUR 432) and the very small quantity of goods sold under the earlier word mark (85 units) over a relatively long period (13 months) to be placed in context.

(60) In addition, the total amount of transactions over the relevant period seems to be so token as to suggest that, in the absence of supporting documents or convincing explanations to demonstrate otherwise, the use by Cuadrado of the earlier word mark cannot be held to be warranted, in the economic sector concerned and taking account of the nature of the goods concerned, for the purpose of maintaining or creating market shares for the goods protected by the earlier word mark.

(61) Moreover, the applicant cannot rely on the judgment in LA MER, cited in paragraph 32 above, on the ground that, unlike in the present case, the low volume of sales of the goods under the earlier mark was to a large extent offset by the very regular nature of the use of that mark. The evidence provided in that case related to a period of 33 months (20 months more than in the present case) and the 10 invoices adduced were not concentrated on 2 or 3 months but were spread over the whole of that period.

(62) In the light of all those considerations, the Court finds that the Board of Appeal failed to take into account all the relevant factors for the purpose of determining whether the use which was made of the mark could be regarded as genuine and, on that basis, infringed Article 43(2) and (3) of Regulation No 40/94.

(63) Accordingly, the contested decision falls to be annulled, without it being necessary to rule on the other pleas put forward by the applicant.”

Celia/Celta : T-35/07 - Judgment of 23 April 2008 (only in FR; action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 5.12.2006 in R 0294/2006-4 relating to CTM application Celia (figurative mark) which had been applied for for a range of goods in Class 29.



It had been opposed on the basis of Celta, word mark, registered in Spain for a range of products in Class 29. The opposition had been rejected on the grounds that, overall, there is no risk of confusion. Notwithstanding that the goods in question are quite similar, partially even identical, the differences in the marks are sufficient to exclude LOC. The 3rd Chamber of the CFI (Azizi; Cremona; Frimodt Nielsen, rapporteur) confirmed these findings, relying on standard criteria.

El Tiempo/Teletiempo : T-233/06 – Judgment of 22 April 2008 (only in FR, ES; action dismissed; Office practice confirmed).

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

The action had been directed against a decision of the 4th Board of 22.6.2006 in R 0760/2005-4 relating to CTM application “El Tiempo”, word mark, which had been applied for for a range of goods and services in Classes 16, 35, 38 and 41. It had been opposed on the basis of two Spanish rights in “Teletiempo”, word mark, which are registered in Classes 16 and 38. The opposition had been allowed in full, and the 3rd Chamber of the CFI (Jaeger; Tiili; Czúcz, rapporteur) confirmed the decision, relying on standard criteria.

Map&Guide : T-226/06 - Order of 3 April 2008 (DE; action withdrawn; case closed).

Keywords: Absolute grounds for refusal: distinctiveness/descriptiveness.

The action had been brought against a decision of the 1st Board of 16.6.2006 in R 1175/2005-1 relating to CTM application Map&Guide (figurative mark) which had been applied for for a range of goods and services in Classes 9, 16 and 42.

MAP&GUIDE
The Mapware Company

It had been partially rejected for some goods and services relating to computer software and printed matter. The plaintiff withdrew the action and, in consequence, the case was closed.

Map&Guide Travelbook : T-219/06 - Order of 3 April 2008 (DE; action withdrawn; case closed).

Keywords: Absolute grounds for refusal: distinctiveness/descriptiveness.

The action had been brought against a decision of the 1st Board of 8.6.2006 in R 1174/2005-1 relating to CTM application "map&guide travelbook" which had been applied for for a range of goods and services in Classes 9, 16 and 42. It had been partially rejected for some goods and services relating to computer software and printed matter. The plaintiff withdrew the action and, in consequence, the case was closed.

Vitality : T-294/06 – Judgment of 17 April 2008 (only in FR, DE; action dismissed; Office practice confirmed).

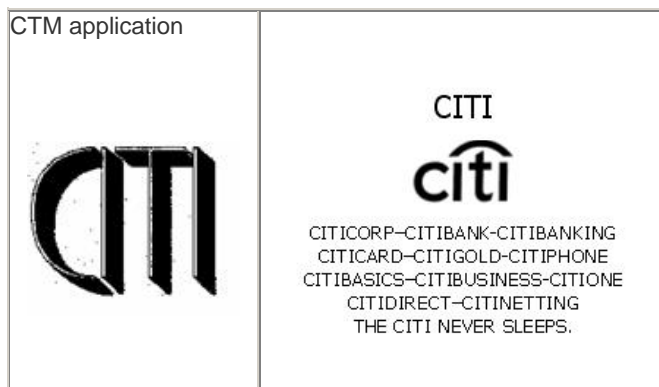
Keywords: Absolute grounds for refusal: distinctiveness.

The action had been brought against a decision of the 4th Board of 9.8. 006 in R 0746/2004-4 relating to CTM application Vitality, word mark, which had been applied for by Nordmilch eG for a range of goods and services in Classes 29, 32, 33 and 43, mainly milk products. It had been partially rejected on the ground that the word is devoid of distinctiveness for part of the claimed goods in that it simply refers to a desired effect of the said products. The application had been allowed in relation to, *inter alia*, milk drinks containing alcohol, alcoholic beverages and catering and restaurant services. The 8th Chamber of the CFI (Martin s Ribeiro; Papasavvas; Dittrich, rapporteur) confirmed these findings; VITALITE (= Sunrider case, CFI judgment of 31.1.2001, Case T-24/00) distinguished.

Citibank : T-181/05 – Judgment of 16 April 2008 (action allowed; law of the case).

Keywords: CFI proceedings: the Office (as defendant) taking a different stance to the Board – Opposition: earlier rights a family of marks – Earlier right: with reputation, Article 8(5) CTMR – Reputation mark: risk of dilution – Opposition: comparison of services – Opposition: comparison of marks.

The action had been directed against a decision of the 1st Board of 1.3.2005 in R 0173/2004-1 relating to CTM application CITI (figurative mark) which had been applied for for the services 'customs agencies, property valuers, real estate agents, evaluation and administration of house contents' in Class 36.



It had been opposed on the basis of earlier rights in several national and Community trade marks consisting of or containing CITI. The invoked German mark CITI is registered for real estate services and financial services in Class 36; the opponent invoked existence of a reputation in Germany attached to this mark in respect of financial services. The same applies as regards CTM "citi" (figurative mark). The Opposition Division had allowed the opposition in full based on Article 8(5) CTMR, earlier right(s) with reputation.

In contrast, by its contested decision, the 1st Board had annulled the decision of the Opposition Division. It had accepted the opposition in respect of the services of property valuers and real estate agents, and those of evaluation and administration of house contents, but had rejected it in respect of the services of customs agencies. In essence, the Board had found that Article 8(5) CTMR was not applicable in this case. In contrast to the Opposition Division, the Board had decided that none of the evidence produced substantiated the claim that the family of trade marks, of which the element 'citi' is the common denominator, enjoyed a reputation, or that the public perceived the earlier mark CITIBANK as being part of a family of trade marks belonging to the opponent. According to the Board, the opponent had only one trade mark with a reputation, that being the earlier trade mark CITIBANK, for financial services only.

However, also according to the Board, that trade mark and the trade mark applied for (CITI) were not similar within the meaning of Article 8(5) CTMR. The Board accordingly had taken the view that it was not necessary to further examine the case under that latter provision. Nevertheless, in the contested decision the Board had upheld the refusal of the application in respect of real estate services pursuant to Article 8(1)(b) CTMR on the ground that there was a likelihood of confusion between the trade mark applied for and the earlier German trade mark 'CITI' covering financial and estate agency services. As regards customs agency services, the Board had allowed the application, holding that these were not similar to the services covered by the earlier trade mark CITI. The 1st Chamber of the CFI (Cooke; Labucka; Prek) revoked the Board decision.

- *CFI proceedings: Representative of the Office taking a stance different from that of the Board of Appeal*

"(17) The Board of Appeal held that, contrary to what the applicants claim, there is no similarity between the trade mark CITIBANK and the trade mark applied for (CITI). However, in its response, OHIM concurs with the applicants' arguments,



presented within the second strand of the third plea in law, that the Board of Appeal incorrectly assessed the similarity of the signs at issue within the meaning of Article 8(5) CTMR.

(18) In that regard, the Court has held, in proceedings relating to a Board of Appeal ruling on opposition proceedings, that, while OHIM does not have the requisite capacity to bring an action against a decision of a Board of Appeal, conversely it cannot be required to defend systematically every contested decision of a Board of Appeal or automatically to claim that every action challenging such a decision should be dismissed (Case T-107/02 *GE Betz v OHIM – Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, paragraph 34; Case T-379/03 *Peek & Cloppenburg v OHIM (Cloppenburg)* [2005] ECR II-4633, paragraph 22; and Case T-53/05 *Calvo Growers v OHIM – Calvo Sanz (Calvo)* [2007] ECR II-37, paragraph 26).

(19) There is therefore nothing to prevent OHIM from endorsing a head of claim of the applicant's or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate to assist the Court (*BIOMATE*, cited in paragraph 18 above, paragraph 36, and *Cloppenburg*, cited in paragraph 18 above, paragraph 22)."

- *Assessment of reputation within Article 8(5) CTMR*

"(59) Article 8(5) CTMR provides that, 'upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

(60) Given that the services covered by the trade mark application are not similar to those for which the trade mark CITIBANK is registered, the application of Article 8(5) CTMR in this case presupposes that three conditions are satisfied, namely, first, that the marks at issue are identical or similar, second, that the earlier trade mark has a reputation, and third, that there is a risk that use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(61) Since those three conditions are cumulative, failure to satisfy one of them is sufficient to render inapplicable the provisions of Article 8(5) CTMR (Case T-67/04 *Spa Monopole v OHIM – Spa-Finders Travel Arrangements (SPA-FINDERS)* [2005] ECR II-1825, paragraph 30, and judgment of 16 May 2007 in Case T-137/05 *La Perla v OHIM – Worldgem Brands (NIMEI LA PERLA MODERN CLASSIC)*, not published in the ECR, paragraph 26)."

- *Risk of dilution*

"(75) The third of the conditions set out in Article 8(5) CTMR falls to be assessed with regard to three distinct types of risk, namely, that use of the trade mark applied for without due cause, first, would adversely effect the distinctive character of the earlier mark, second, would cause detriment to the repute of the earlier mark, and, third, would take unfair advantage of the distinctive character or repute of the earlier mark (*SPA-FINDERS*, cited in paragraph 61 above, paragraphs 43 to 53; see also, by analogy, the Opinion of Advocate General Jacobs in *Adidas*, cited in paragraph 25 above, paragraphs 36 to 39).

(76) Having regard to the wording of Article 8(5) CTMR, the existence of one of the above three types of risk is sufficient for that provision to apply (Case T-215/03 *SIGLA v OHIM – Elleni Holding (VIPS)* [2007] ECR II-0000, paragraph 36).

(77) The proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He must, however, adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment (*SPA-FINDERS*, cited in paragraph 61 above, paragraph 40).

(78) Such a conclusion may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case.

(79) The concept of taking unfair advantage of the distinctive character or repute of the earlier mark is intended to encompass instances where there is clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation (*SPA-FINDERS*, cited in paragraph 61 above, paragraph 51).

(80) Finally, the stronger the earlier mark's distinctive character and reputation, the easier it will be to accept that detriment has been caused to it for the purposes of Article 8(5) of Regulation No 40/94 (*SPA-FINDERS*, cited in paragraph 61 above, paragraph 41).

(81) As has already been stated, the reputation of the trade mark CITIBANK in the European Community in regard to banking services is not disputed. That reputation is associated with features of the banking sector, namely, solvency, probity and financial support to private and commercial clients in their professional and investment activities.

(82) As OHIM recognises, there is a clear relationship – as well as an overlap in the applicants' and the intervener's groups of clients – between the services of customs agencies and the financial services offered by banks such as the applicants, in that clients who are involved in international trade and in the import and export of goods also use the financial and banking services which such transactions require. It follows that there is a probability that such clients will be familiar with the applicants' bank given its extensive reputation at international level.

(83) In those circumstances, the Court holds that there is a high probability that the use of the trade mark applied for, CITI, by customs agencies, and therefore for financial agency activities in the management of money and real estate for clients, may lead to free-riding, that is to say, it would take unfair advantage of the well-established reputation of the trade mark CITIBANK and the considerable investments undertaken by the applicants to achieve that reputation. That use of the trade mark applied for, CITI, could also lead to the perception that the intervener is associated with or belongs to the applicants and, therefore, could facilitate the marketing of services covered by the trade mark applied for. That risk is further increased because the applicants are the holders of several trade marks containing the component 'citi'.

(84) Finally, the Court takes the view that the intervener has failed to produce evidence that the use of the trade mark applied for complies with the due cause rule.

(85) The use, by the intervener, of the trade mark CITI in Spain cannot constitute a valid justification in that, first, the extent of the geographical protection of the Spanish trade mark does not correspond to the territory covered by the trade mark applied for and, second, the legal validity of the registration of the Spanish trade mark is the subject of dispute before the national courts. By the same token, the fact that the intervener is the owner of the domain name 'citi.es' is irrelevant.

(86) Therefore, the third branch of the third plea in law must also be upheld and, consequently, the contested decision must be annulled without it being necessary to rule on the other pleas in law submitted by the applicants."

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

Sorvir/Norvir : T-149/08 (new case).

Keywords: Opposition proceedings: silence on the part of the CTM applicant – Opposition: likelihood of confusion (LOC) – LOC: pharmaceutical goods – LOC: comparison of marks.

The action is directed against a decision of the 2nd Board of 6.2.2008 in R 0809/2007-2 relating to CTM application Sorvir which had been applied for for anti-viral pharmaceuticals in Class 5. It had been opposed on the basis of CTM Norvir, registered for "a pharmaceutical preparation, namely an anti-infective" also in Class 5. The Opposition Division had rejected the opposition in its entirety, in essence on the ground that the marks are sufficiently dissimilar to avoid LOC.

In more detail: anti-viral pharmaceuticals are pharmaceutical preparations to fight viruses while the goods of earlier mark fight infections. As some infections are consequences of viral diseases, both goods can be considered as complementary or similar. A visual comparison of the two trade marks shows that both are composed of six letters written in common typeface characters. Both marks have their five last letters 'ORVIR' in common, but their beginnings are different N / S. Phonetically, the signs 'NORVIR' and 'SORVIR' contain two syllables /NOR/VIR and /SOR/VIR/. The earlier mark starts

with the letter 'N', whereas the CTM applied for starts with the letter 'S'.

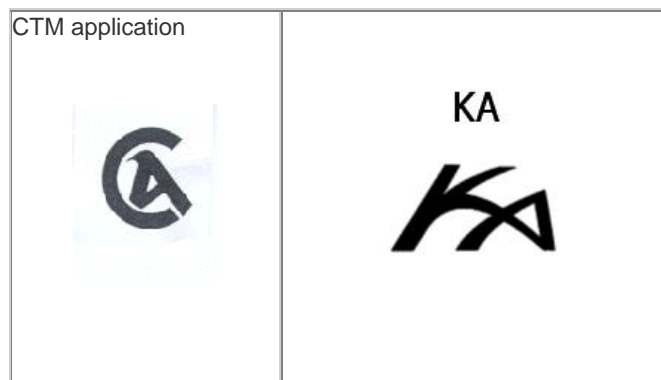
Due to the fact that the attention of the relevant public is especially high concerning these kinds of goods, and since the marks at issue are very short, a difference of one character placed at the beginning of the marks is sufficient to avoid confusion between the two marks and distinguish them from each other. Consumers are more attentive to the beginnings of marks and consequently, similarity between the first parts of a sign should have a greater influence on the assessment on whether or not the marks are similar. Conceptually, neither 'SORVIR' nor 'NORVIR' has a meaning in the relevant languages. Therefore, a conceptual comparison cannot be made. The signs in dispute are, thus, visually and phonetically different.

The pharmaceutical products covered by the marks in question are normally targeted at specialist experts like doctors or pharmacists but, could also be targeted directly at the usual end-consumer because there is no restriction either in the list of goods of the CTM applied for or in that of the earlier mark which would mean that only prescribed drugs are at issue. Therefore, it is to be taken into account that the relevant products are not only prepared to be targeted at qualified professionals, but also at people without particular medical and pharmaceutical knowledge. In that case, the attention of the end-consumers is higher than average, and even small differences between the signs will be perceived by the consumer. Overall, the Opposition Division found the signs to be dissimilar. Since the similarity of the signs is an absolute requirement for a finding LOC, there is no such likelihood. At the appeal stage, the CTM applicant submitted no reply. The Board had confirmed the challenged decision.

Ford KA : T-486/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of goods – LOC: comparison of marks – LOC: enhanced recognition of the earlier mark

The action is directed against a decision of the 4th Board of 25.10.2007 in R 0085/2006-4 relating to CTM application No 3 186 764, a stylised "A" contained in a stylised "C" which had been opposed on the basis of KA, word mark, and stylised KA both belonging to the Ford Motor Company.



The CTM application had been filed in respect of Class 9 for signalling (luminous and mechanical), and, in particular, luminous signs and flashing lights for vehicles; in Class 11 for lighting apparatus for vehicles, and in particular headlights, lamps and lights for vehicles, and in Class 12 for rear view mirrors; vehicles, apparatus for locomotion by land, air or water.

The opposition had been based on the Community trade mark registrations KA (word mark) and KA (figurative mark). The word mark is registered in Class 12 for motor land vehicles and parts and fittings therefore; in Class 27 for floor coverings; vehicle carpets and mats; door mats, and in Class 37 for motor vehicle maintenance and repair services. The figurative CTM covers in Class 9: electric accumulators; aerials; anti-theft warning devices; electric batteries and mountings; electric blowers; electric lighters; electric circuit breakers; commutators; electric condensers; electric connections; electric cables; electric fuses; electric fuse boxes; electric control apparatus and instruments for motor vehicles and engines; electrical sensors; fire extinguishing apparatus; gauges; instrument panels and clusters; lenses for lamps; loudspeakers; odometers; printed electrical circuits; electric relays; electric switches; speedometers; tachometers; temperature sensors; voltage regulators; voltmeters; electric wiring harnesses; ammeters; radio apparatus; sound reproducing equipment; telecommunication equipment; tape players; compact disc players; testing apparatus; computer software; mouse mats; parts and fittings for motor land vehicles; calculators; tape cassettes; recording media; storage boxes for recording media; containers for compact discs; car telephone installations; car vacuum cleaners; highway emergency warning equipment; cleaning equipment for motor vehicles; sunglasses; magnets; tape measures; binoculars; thermometers; magnifying glasses; compasses; in Class 12: motor vehicles and parts and fittings therefore; Class 14: clocks, watches; Class 16: pens, pencils, books, printed publications, posters, paper cubes and notes, letter holders, plastic carrier bags and playing cards; Class 18: wallets, card cases, belts, bags, cosmetic cases, suitcases, briefcases, umbrellas and luggage tags; Class 20: storage containers; non-luminous signs; boxes; canisters; vehicle registration plates; seat cushions; pillows; clamps; pennants; (all of non-metal); all being parts and fittings for motor land vehicles; Class 21: cleaning cloths, cleaning utensils for vehicles; mugs, bowls, cups, cooling bags, drinking bottles and bottle openers, and Class 32: beer; mineral and aerated waters and other non-alcoholic drinks; fruit drinks, fruit juices; syrups and other preparations for making beverages.

The opposition had been based on all the goods of the earlier marks and had been directed against the following goods in the CTM application: Class 9 signalling (luminous), and, in particular, luminous signs and flashing lights for vehicles; in Class 11 lighting apparatus for vehicles, and in particular headlights, lamps and lights for vehicles, and in Class 12 rear view mirrors; vehicles, apparatus for locomotion by land. The opposition had been rejected in its entirety on the ground that the marks are so dissimilar that there cannot be any likelihood of confusion within the meaning of Article 8(1)(b) CTMR even for identical goods, despite the enhanced distinctiveness of the earlier trade marks.

R.U.N./ran : T-490/07 - Office response filed (IT).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 4th Board of 22.10.2007 in R 1267/2006-4 relating to CTM application No 1 069 863, word mark R.U.N., which had been applied for on 9.2.1999 for a range of services in Classes 35, 38, 41 and 42, *inter alia* for legal, administrative and financial services and IT services for the legal profession.


CTM application	
R.U.N.	ran

It had been opposed on the basis of two earlier rights in "ran" (word mark), a CTM and a German mark, registered for a wide range of goods and services in Classes 3, 6, 8, 9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 26, 28, 32, 33, 34, 35, 38, 41 and 42. Whereas the Opposition Division had rejected the opposition, the Board had partially allowed it in respect of various services in Classes 38 and 42 (phonetical identity of the German word "ran" and the English pronunciation of "run"; identical services).

McKenzie/McKinley : T-502/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 15.10. 007 in R 1425/2006-2 relating to CTM application No 2 664 423, stylised word McKenzie.

CTM application	
McKENZIE	McKINLEY 

It had been applied for, *inter alia*, for the following goods in Class 18: leather and imitations of leather and goods made of these materials; articles made from leather or imitation leather; leather goods; trunks and travelling bags; articles of luggage; articles of baggage; bags; cases; attaché cases; briefcases; suitcases; valises; handbags; shoulder bags; casual bags; rucksacks; backpacks; school bags; satchels; gym bags; sports bags; tote bags; shopping bags; holdalls; bags for clothing; shoe bags; beach bags; hip bags; pouches;

purses; wallets; billfolds; card cases; passport cases; chequebook covers; filo-faxes; key fobs; key cases; luggage tags; cosmetic bags; vanity cases; document cases, portfolios, belts; umbrellas; parasols and walking sticks; parts and fittings for all the aforementioned goods; and in Class 25 for clothing, footwear, shoes, boots and sandals, headgear and hats.

It had been opposed on the basis of two earlier CTM the first of which is registered, *inter alia*, in Class 18 for sports and travelling bags, backpacks, rucksacks for mountaineers, sling bags for carrying children, rain protective covers for bags; beggar's bags, game bags and rucksacks for hunters; saddlery, and in Class 25 for clothes, shoes, gloves and knitted caps, fishing boots, articles of clothing for hiking, mountain touring, mountain climbing, hunting, fishing and horse riding. The second one covers, in Class 18, bags for campers, bags for climbers, beach bags, hand bags, rucksacks and parts thereof, namely pack frames, bicycle bags, huckaback baby carriers, rucksack raincovers, rifle cases, hunting bags, bivouac sacks, and in Class 25 articles of clothing, shoes and boots, gloves, caps, hip-boots and hi-waders for fishing, clothing articles for trekking, for mountaineering, for climbing, for hunting, for fishing, for horse riding.

Whereas the Opposition Division had upheld the opposition in part, that is in respect of all goods in Class 18 except 'leather and imitations of leather, key fobs, belts; umbrellas; parasols and walking sticks; parts and fittings for all the aforementioned goods', and for all goods in Class 25, the 2nd Board had allowed the subsequent appeal. As regards the signs, the Board had held that they are visually dissimilar notwithstanding the fact that they both begin by the sequence of letters 'McK'. Consumers cannot be expected to split up words as they perceive marks on their whole. There are many Irish family names having the same beginning as the conflicting marks. Irish names starting by 'Mac' have been popularised in Europe. Moreover, in the same manner as consumers would not focus on a prefix such as 'de' or 'di', they would not attach a great importance to the prefix 'Mc'. The figurative element in one of the earlier CTM may be considered an element of visual differentiation, however, phonetically, the signs are also dissimilar given the different speech sound of the endings '-ENZIE' and '-INLEY'.

Conceptually, both signs will be perceived as surnames beginning by the prefix 'Mc' which means "son of". This element of conceptual similarity is all but decisive given that surnames beginning with this prefix are very common. Moreover, the earlier mark may refer to the name of the highest mountain in Northern America. The mark applied for may also refer to the name of a mountain in Australia, but it is unlikely that this reference will be understood by the public since this mountain is relatively unknown to the average public in Europe. Finally, the Board had observed that 'McKenzie' is a widespread Scottish surname. Further, it is common practice to use names in the clothing sector. The CTM applicant had shown that there are trade marks beginning with the prefix 'Mc' that are used in Europe. In addition, the European consumers are familiarized with Celtic names and they can distinguish between them. Even though the relevant public's attentiveness is not more than average for the classes of products in question, a risk of confusion is excluded.

Green and Yellow or Deere & Company : T-137/08 – New case; appeal from the 2nd Board of 16 January 2008 in R 0222/2007-2.

Keywords: Cancellation proceedings: invalidation based on absolute and on relative grounds – Types of signs: colour per se – Absolute grounds for refusal: distinctiveness – Distinctiveness: colour per se – Colour *per se* : distinctiveness acquired in the market place.

The action is directed against the aforementioned decision of the 2nd Board in an invalidation case directed against Deere & Company's CTM "Green and Yellow". The background of the case can be summarised as follows: By an application which had been granted a filing date of 1.4.1996, Deere & Company sought to register a colour mark green/yellow (as represented below under nr. 1) for the following goods as specified after a restriction, in Class 7: attached, pushed or self-propelled agricultural and forestry machines, and in Class 12: self-propelled agricultural and forestry machines, in particular farm tractors, small tractors, land tractors and trailers. The colours had been defined by Munsell codes as: "Green: Munsell 9.47 GY3.57/7.45, Yellow: Munsell 5.06 Y7.63/10.66". The arrangement is described as being green for the vehicle body and yellow for the wheels, as is shown by a picture attached to the CTM application (reproduced below, figure 2).



It had been challenged on the grounds laid down in Article 51(1)(a) in conjunction with both Article 7(1)(b) and Article 52(1)(c) as well as Article 8(4) CTMR. In the first place, the applicant for invalidity (the plaintiff in the present proceedings) had claimed that the contested CTM lacked distinctive character, and furthermore that there had been insufficient proof of acquired distinctiveness. Next, it had argued that the CTM had been registered despite the existence of an Italian unregistered trade mark (previously owned by OFFICINE MECCANICHE FERRARI F. S.p.A. = Ferrari) consisting of a combination of green and yellow colours. The use of this sign before 1996 in relation to 'agricultural machines, in particular farm tractors, small tractors, land tractors and trailers' in Belgium, Denmark, Greece, Spain, France, Italy, the Netherlands, Austria, Portugal and the United Kingdom had conferred on the plaintiff the right to prohibit the use of a subsequent trade mark.

In support of its entitlement, the plaintiff had forwarded evidence which consisted, *inter alia*, of photos of Ferrari tractors, images of the plaintiff's products extracted from


journals, magazines, flyers and catalogues of its products and prospectuses with indications of the quantities of the products sold in Italy and Europe. Further, it also filed affidavits made by its vendors abroad, Italian vendors and former employees. In turn, the CTM holder had forwarded, inter alia, proof of its participation in trade fairs in France from 1867; a distributorship in the UK in 1934 and turnover figures for the UK in 1939; turnover figures for Sweden and Finland for 1939; turnover figures for France for 1947 and 1949; turnover figures for the UK, Sweden, Finland and Belgium, Denmark and Spain for 1947; turnover figures for the Netherlands and Greece for 1949; a presence in Scotland and Ireland in 1951; turnover figures for Italy for 1953; turnover figures for Portugal for 1960; the record of sales houses established in Italy and Italian turnover figures for 1965; evidence regarding a commercial presence in Austria in 1966; an advertisement for the respondent's tractor in green and yellow for 1927; an Italian tractor book 'Trattori Classici nel Mondo' featuring the respondent's tractors from 1918 – 1960 and Don MacMillan's books on John Deere Tractors and Equipment, volumes I (1837-1959) and II (1960-1990).

By its decision of 30.11.2006, the Cancellation Division had rejected both grounds of the request for declaration of invalidity. It concluded that the applicant for invalidity had failed to give sufficiently convincing reasons for considering the evidence of acquired distinctiveness in accordance with Article 7(3) CTMR valid only for some of the products claimed in the trade mark specification. In any event, it considered that this conclusion probably does not affect the real 'scope of protection' of the disputed registration, because of the similarity of the remaining products to those other products. With regard to the relative grounds, the Cancellation Division had found that, although the applicant for invalidity had shown that it had used the yellow and green colours before the filing date of the contested mark (April 1996), it had not proven that, before that date, the use of the sign was perceived as a trade mark. The 2nd Board had confirmed these findings.

FUScollection : T-48/08 - Office response filed (IT).

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

The action is directed against a decision of the 2nd Board of 24.10.2007 in R 0047/2007-2 in relation to CTM application No 1 503 366, FUSCollection (figurative mark). It had been applied for for a range of goods in Classes 9, 18 and 25.

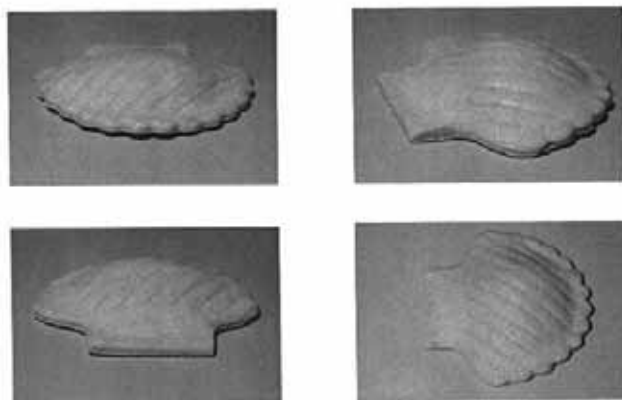
CTM application	
	ENZO FUSCO

The said CTM application had been opposed on the basis of several earlier rights in the word Enzo Fusco, amongst which a CTM (see Case T-185/03), registered in Classes 3, 9, 18, 24 and 25. The opposition had been rejected on the ground of lack of sufficient similarity of the marks at issue.

Conchiglia or Shell : T-8/0 - Office response filed (IT).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 28.9.2007 in R 0530/2007-1 relating to CTM application No 4 522 892. It had been applied for for a range of foodstuffs in Class 30.



It had been partially rejected on the grounds that the shape of a shell is a common decorative form in the sector of bakery (for instance, brioches and empanadillas) and, thus, cannot serve as a badge of individual commercial origin.

Famoxin : T-493/07 - Office response filed.

Keywords: Opposition/invalidation: proof of use (POU) – Pharmaceutical products: perception of the consumers – LOC: impact of a conflict on another market.

The action is directed against a decision of the 1st Board of 14.9.2007 in R 0008/2007-1 relating to CTM No 2 491 298, word mark FAMOXIN, which is registered in respect of the following goods in Class 5: pharmaceutical preparations for the treatment of metabolic disorders adapted for administration only by intravenous, intra-muscular or subcutaneous injection. It had been challenged on the basis of a request for invalidation on relative grounds. The invoked earlier Italian mark is Lanoxin (word mark), registered on 24.5.1957 (and renewed since then) in relation to pharmaceutical preparations in Class 5. Proof of use had been requested and evidence had been filed. The request for invalidation had eventually been rejected; the Board gave the following reasons:

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

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

Given that the common ending '-OXIN' is visually and phonetically much less important than the different beginnings 'FAM-' and 'LAN-', and given that the conceptual similarity results from the common reference to a descriptive suffix '-OXIN' (that denotes the chemical compound "digoxin"), the overall similarity between the signs is "very low". Keeping in mind that patients will always be under the guidance of professionals, the notable differences between the signs suffice to exclude a risk of confusion against the perception of the relevant, highly attentive, public in Italy. Likewise, "there should not be any risk of a medical error". The outcome of the decision cannot be influenced by the allegation that the opponent has claimed the existence of a risk of confusion between the same marks, in parallel proceedings in Sweden .

Factory Finish : T-487/07 – Office response filed (attention: Alicante News' previous mention of the case, in May 2008, concerned the observations filed with respect to a formal issue concerning representation by a Patent Attorney).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board of 24.10.2007 in Case R 0668/2007-4 relating to Community trade mark application No 4 538 518, word mark FACTORY FINISH. The following range of goods had been claimed in Class 2: paints, varnishes, lacquers; driers including curing driers, thinners, colouring matters, all being additives for paints, varnishes or lacquers; preservatives against rust and against deterioration of wood; priming preparations (in the nature of paints); wood stains; mastic; putty; repositionable patches of paint, varnishes or lacquers.

It had been rejected because it is directly indicative of the kind and quality of the goods concerned and, in particular, of the fact that the goods give a professional finish to a painting, lacquering, varnishing or related job. In support of this finding, the examiner had quoted examples from the internet showing that the expression FACTORY FINISH was commonly employed within the commercial field to which the goods in question belonged. On appeal, the Board had confirmed these findings, basically holding that the sign applied for is descriptive within the meaning of Article 7(1)(c) CTMR and also, both on that account and because it is laudatory,

inherently devoid of distinctiveness within the meaning of Article 7(1)(b) CTMR.

Specifically, the Board had held, first, that in relation to the goods listed in the application the term 'FACTORY FINISH' would immediately be understood by the relevant consumer as denoting that a product is manufactured to a standard befitting factory production and, second, that the sign is also highly laudatory, as it merely indicates that the relevant products have a gleaming, brand new and high quality appearance. Moreover, the Board had gone on to state that the expression is banal, commonplace and unremarkable and that it contains no element of fancifulness that would enable it to function as a trade mark. Consequently, the Board had concluded that the sign at issue could not distinguish the applicant's goods from those of other undertakings and, accordingly, could not be registered as a Community trade mark.

NEW DECISIONS FROM THE BOARDS OF APPEAL

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

See also the Boards of Appeals 2006 case-law overview; <http://oami.europa.eu/en/office/diff/default.htm>, which provides an annual overview of selected decisions grouped by type of decision.

Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'.

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

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Decision of the Grand Board of Appeal of 18 April 2008 in Case R 1341/2007-G KOSMO/COSMONE (French)

R 1341/2007-G – KOSMO/COSMONE – The Board held that the four-month time limit to file a written statement of grounds of appeal in accordance with Article 59 CTMR cannot be suspended, not even in the case of a common request of both parties, and declared the appeal inadmissible.

Note: The translation of this decision into the official languages of the OHIM can be found on our [website](#)

International Registration

International Registration – professional representative – appointment

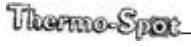
Decision of the Second Board of Appeal of 29 April 2008 in Case R 358/2008-2 MIRACA (English)

R 0358/2008-2 – MIRACA – The Board confirmed that if the proprietor of an International Registration has its business seat outside the European Union, it is required to appoint a representative. Should it fail to do so, the Office must refuse protection. The Board noted that the holder may still appoint a representative during the appeal proceedings. Such proceedings are primarily a matter between the party that is required to appoint the representative and the Office, even if the refusal was issued in the framework of opposition proceedings. Consequently, the Board annulled the refusal of the CTM applied for, and remitted the case to the Opposition Division for further prosecution.

Relative Grounds of Refusal – Article 8(1)(b) CTMR

Opposition proceedings – weak trade marks – level of protection

Decision of the First Board of Appeal of 15 April 2008 in Case R 1067/2007-1 THERMOPOINT/Thermo-Spot (English)



R 1067/2007-1 – THERMOPOINT/  The Board noted that the signs are visually and phonetically rather similar, inasmuch as they both begin with the term THERMO. Conceptually, the Board held that the similarity is even greater in English because 'point' and 'spot' both mean roughly the same. However, it pointed out that both trade marks are extremely weak since they allude to the idea of an area where the temperature is unusually high. It went on to state that undertakings are free to use extremely weak, semi-descriptive trade marks if they wish. They may also seek to register such trade marks insofar as they are not entirely devoid of distinctive character. They must, however, accept that their competitors are equally entitled to use trade marks

that contain similar descriptive elements. Banal, descriptive terms such as 'thermo' cannot be monopolized as a result of their incorporation in a trade mark. The Board held that, even if the goods in question are partly identical in this case, no likelihood of confusion exists with respect to the average, reasonably well-informed and reasonably observant and circumspect consumer.

Relative Grounds of Refusal – Article 8(1)(b) CTMR

Likelihood of confusion – comparison of the signs – visual dissimilarities – phonetic similarity – conceptual identity – weak element – enhanced distinctive character acquired through use

Decisions of the First Board of Appeal of 10 April 2008 in Cases R 0297/2007-1, R 1038/2007-1, R 1285/2007-1, T / T et al. (English)

R 0297/2007-1 , R 1038/2007-1 , R 1285/2007-1 ,  (figurative mark)/  (figurative mark) et al. – Both the CTMs applied for and some of the earlier trade marks invoked contained colour claims. The Board held that, even if all the signs contain the capital letter 'T', the visual dissimilarities between the earlier marks and the contested CTM's outweighed the visual similarities. Conceptually, it noted that all the signs refer to the same letter of the alphabet; however, such meaning has, due to its weak character, hardly any trade mark importance for the average consumer. Aurally, the signs are identically. With respect to the claim that the earlier signs have acquired enhanced distinctive character through use, it observed that the opponent had not submitted any relevant evidence. The evidence filed referred to 'telecommunication', however, telecommunication services are dissimilar to the services at stake. Neither had the opponent provided explanations for a spillover effect to other services. Consequently, the Board held that, even for identical services in Class 36, there is no likelihood of confusion since the dissimilarities between the signs outweigh any similarity.

Restitutio in Integrum - Article 78 CTMR

Restitutio in Integrum – all due care required by circumstances – delivery by courier service

Decision of the First Board of Appeal of 30 April 2008 in Case R 722/2007-1 PEPEQUILLO/PEPE JEANS et al. (Spanish)

R 07222/2007-1 – PEPEQUILLO/PEPE JEANS et al. – The appellant submitted its statement of grounds by courier service to the Office. This document was given to the courier service the day before the expiry of the time limit, and the appellant contracted a special service guaranteeing delivery before 10.00am the next working day, i.e. within the time limit. The Board thus held that reasons for non-delivery cannot be attributed to the appellant, especially since the courier service accepted full responsibility. Consequently, it decided that the appellant had acted with all due care required by the circumstances and that restitutio in integrum must be granted, the appeal being declared admissible. The Board ordered that appeal proceedings be resumed.