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What enlargement has meant for the Community trade mark and design

This year Europe celebrates an historic double anniversary. It is now two decades since the fall of the Berlin Wall, and last month marked the fifth anniversary of the enlargement of the European Union that reunified Eastern and Western Europe.

The ten member states who joined 1 May 2004, included Cyprus and Malta, and eight Eastern European countries - the Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia, and Slovenia. On 1 January 2007 Bulgaria and Romania also became part of the EU.

Since the Community trade mark and design system was set up to help the EU internal market function, enlargement brought in its wake a major expansion of the territory covered by the Community systems of IP protection.

While the biggest users of the Community design system are, as you would expect, the largest economies – among European countries, Germany, UK, Italy, Spain and France – the new member states are increasingly using Community trade marks and designs.

The number of applications in absolute terms from some of the new member states continues to be quite small, but this is to be expected, given the size of the economies and their current state of development. However interest among the new member states in the Community trade mark and design system is consistently high.

Looking at the statistics, in 2008 Poland was the seventh largest European user of the CTM system. This year so far (January – May), when the global recession has been biting hard, Poland has dropped back to tenth place among EU members. In total, Polish companies have applied for just under 6,000 CTMs since 1996. The Czech Republic is the next largest CTM user among the new member states with 2,200 applications and Hungary is third (1,400).

Community Trade Mark Applications		
	Total 1996-2009	2009 (Jan-May)
POLAND	5,996	560
CZECH REPUBLIC	2,171	197
HUNGARY	1,404	128
CYPRUS	1,161	105
ROMANIA	897	100
BULGARIA	817	97
SLOVAKIA	495	60
SLOVENIA	652	56
LITHUANIA	363	44
MALTA	411	41
ESTONIA	396	38
LATVIA	241	23

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Registered Community Designs		
	Total 2003-2009	2009 (Jan-May)
POLAND	6,792	859
CZECH REPUBLIC	2,539	151
SLOVAKIA	547	58
HUNGARY	831	49
BULGARIA	310	36
SLOVENIA	450	27
LATVIA	228	23
ESTONIA	126	19
ROMANIA	159	15
LITHUANIA	118	5
CYPRUS	114	3
MALTA	44	2

Interest in registered Community designs is quite high in some new member states, though smaller countries, like Malta make only a few applications every year. Polish companies have applied for 6,800 RCDs since 2003, the Czech Republic for 2,500 and Hungary for over 800, making them the top three users of Community designs to date. However, during the January to May period this year, Slovakia edged ahead of Hungary, albeit based on a small number of design applications.

The way in which new member states choose to do business with OHIM differs also with a very high percentage of companies opting for online methods rather than using mail or fax. A recent e-business workshop held by OHIM in Warsaw, for example attracted a record 120 participants and more than 90% of Polish CTM applications are currently being made online.

For the Office, enlargement has meant recruiting expertise from the new EU member states, and an expansion of the languages covered (currently 22). We now have staff and customers from every country in the EU.

Elzbieta Szepietowska from north east Poland joined OHIM 18 months ago and currently works in the Finance Department. For her, getting a job outside Poland was a natural step following a degree in Spanish and English and post-graduate studies in project management.

"I was a child of the Communist era and it has been very interesting to live through the changes. Then, you could not voice your opinion and when you went to the shops there were queues to buy the most basic things. As a teenager, I remember the euphoria following the fall of the Berlin Wall.

"Joining the EU has meant many more opportunities. Nowadays, Polish people have a much more international perspective and I think they are more willing to travel and work abroad than their counterparts in other parts of the EU", she said.

To find out more about the impact of enlargement see the European Commission website:

<http://ec.europa.eu/enlargement/5years/>

Interviewer: Reg Rea

The James Nurton interview with Davide Follador, Perani Mezzanotte & Partners, Milan, Italy

James Nurton is a specialist intellectual property journalist from the UK and is currently the managing editor of the leading global magazine for IP owners, *Managing Intellectual Property*. This month, he talks to Davide Follador in Italy about the disadvantages of designs, Facebook's trade mark protection plans and how to tackle counterfeiting in Europe.

How did you get into trade mark work?

My background is legal. After law school, I went into general practice and after a couple of years I started to specialise in IP. I have been with a specialist IP firm now for about 10 years.

The most interesting feature about IP for me is the international aspect compared to other fields of law. Our client portfolio is about 80% domestic, but we also assist many multinational clients, especially those from Asia.

What kind of work do you do?

As I am both a lawyer and a trade mark attorney, I do both prosecution and contentious work. Our firm is actually two firms – one is a firm of attorneys and one is a law firm – so in total we have around 20 people working in trade marks.

This year I am doing more prosecution work, which is probably about 60% of my time. But it varies from year to year, depending on the needs of clients. I have been less involved in litigation this year than in previous years. I'm also more involved in more international work, not just for multinationals but also for SMEs.

Why is that?

We stress when we present our services to new clients that we live in a unified and harmonised European market and national protection is more and more being replaced by European protection. We now file more CTMs than national trade marks. We file about 50 CTMs each month and this number is still increasing despite the economic crisis. By contrast, we only file about 10 or 20 national trade marks each month, and most of those are as the basis for an international application.

Why do you prefer to base international registrations on national marks?

Basing an international registration on national rights is safer and more secure than using a Community trade mark in the first five years. In Italy there is no novelty examination and marks are usually registered so there is less of a risk that the mark will be cancelled or not granted.

What are the advantages of the CTM system?

One of my colleagues recently attended the Italian day in Alicante and I know there was lots of discussion about what the Office can do to improve. But generally speaking I think it's a good system. I prefer the European to the US system: for example, novelty examination is not always useful and can be a waste of time.



The recent reduction in CTM fees was also good generally speaking. It should improve and encourage applicants not to file national registrations. It may involve problems for firms that billed a lot at the registration stage who will now have to reorganise and adapt.

Having said that, there are some areas that can be improved at OHIM. In particular, sometimes the Office does not have a high level of efficiency, particularly with reference to oppositions, which often last too long. And sometimes the decisions are not consistent. I understand only 60% of decisions are supported by the Boards of Appeal, which suggests that 40% are wrong or at least arguable.

How can this be improved?

That is a difficult question. More and better staff are needed. The priority should be to improve in terms of the time taken and the quality of decisions. We need to be able to rely on consistent lines of reasoning and case-law. The Office Guidelines on Opposition Procedure are a very good tool in that respect as they mean we can know how the Office applies similar principles.

What about Community designs?

I think there is much more work to do here. It is difficult to rely on a Community design as an IP right as almost anything can be registered. Designs could be used by companies looking for a title to stop the opposition – like patent trolls in the US. There are lots of Community designs on the register that could not be considered designs – because they are not novel or lack individual character – and the only way to challenge them is through a cancellation action which is costly and time-consuming.

We recommend the Community design where there is a genuine design to protect but we don't file very many. It would be better if there was at least examination for individual character as a first filter. But that would of course make the cost higher, as it would involve more staff and more work. Of course, it must also be said that designs can be a good and inexpensive tool when used properly and good attorneys can find when a design is worth protecting.

What are the biggest IP issues in Italy?

The biggest improvement recently was in 2006 when the new IP court was implemented. This has been very good, and brings together trade mark, patent and design law in a single court. It is also harmonised with all the relevant EU directives. That has probably been the biggest change so far in my career.

But unfortunately we are still waiting for the trade mark opposition system, which has not been implemented yet due to the need for new examiners and equipment. With the current economic crisis, we do not expect this to be implemented in the next couple of years. This is a pity: we were expecting it to start this year as it will improve things in Italy. At the moment, if you want to challenge a trade mark application you have to go to court, which can cost tens of thousands of euros.

Another development is that a new law was introduced to protect brands from piracy and counterfeiting. Criminal fines are now higher than before. But there is still much more to do

– not on the laws but on putting them into practice through enforcement.

Another area I work in is protecting brands over the internet, including realignment procedures through arbitration such as the UDRP. Cybersquatting seems to have decreased in recent years, though the introduction of new gTLDs may change that as it will provide new opportunities to grab domains.

What do you think about the recent Facebook announcement?

We have been following that. It could certainly be a problem if someone registers a brand as a username, so it is good that trade mark owners have this opportunity. I know some of our clients in the food and fashion industries have filed some of these applications. But even if you don't fill in a form there will be legal tools to stop people abusing trade marks in this way.

But it is unbelievable that this process has been done so quickly. With two weeks more we could have done something professional to present to clients. So the majority of our clients have not done it.

What will be the biggest challenge for trade marks in the future?

In the immediate future, the biggest change for us will be the introduction of oppositions in Italy – whenever it happens.

More generally, the big challenge will be to tackle counterfeiting. It is very easy to say it is a Chinese problem, but I don't think this is fair. The Chinese government and administration has improved a lot so you can enforce trade marks in China and it is more efficient than in some other countries.

The problem is often the other way round – dealing with counterfeiting at home. For example, many counterfeits sold here are produced by Chinese people living in Italy, especially in factories in the Tuscany region where fake Louis Vuitton, Gucci and Chanel products are produced. A lot more needs to be done in Customs enforcement: despite the 2003 Regulation, there is still a lack of efficiency especially in Eastern Europe. There is a lot to do at the European level to harmonise this.

Community Trade Mark Ruling on “THE HOME DEPOT” CTM

A German company has failed in its attempt to invalidate “THE HOME DEPOT” CTM, registered in 2000 by the US home supplies firm Homer TLC.

Bauhaus AG, based in Mannheim, argued that the CTM both in word and figurative forms, was not distinctive, did not serve to indicate origin, and was simply a customary use of language in the relevant trade. (Articles 7(1) (b), 7(1) (c) and 7(1) (d) CTMR respectively).



CTM No 51 482

The invalidity proceedings were suspended in 2004 at the request of the CTM owner to allow a similar invalidity case in a German court to be completed. The court subsequently rejected the invalidity claim under Articles 7(1) (b) and 7(1) (c), and this was confirmed on appeal.

When the proceedings before OHIM's Cancellation Division resumed, the invalidity applicant was informed that only the remaining ground, namely that the CTM had become customary in current language (Article 7(1) (d)), would be examined as the parties were the same and the ruling from the German Supreme Court had become final.

The invalidity proceedings for the word and figurative marks were considered together. The question whether the expression "THE HOME DEPOT", as well as the figurative components of the mark, had become customary in the current language or in the bona fide and established practices of the trade, were assessed in relation to the goods and services for which it is registered, namely the following:

Class 19: *building and construction materials, not of metal.*

Class 35: *advertising; professional business consultancy; efficiency experts; direct mail advertising; sales promotion.*

Class 42: *interior design services; landscape gardening services; consulting in the field of construction, repair, maintenance and installation of domestic furnishings, decoration, fixtures and fittings.*

The Cancellation Division found that it had not been argued by the applicant that the figurative element of the challenged mark had become customary in the bona fide and established practices of the trade.

With regard to the word form, while the Office accepted the argument that word "DEPOT" would be understood in a number of countries, including the United Kingdom, to mean a store or storehouse, and the word "HOME", a place where someone lived, there was no evidence that the combination, "THE HOME DEPOT", had become customary in trade at the time of its filing or its subsequent registration.

The Cancellation Division concluded: "Given the lack of evidence relating to the use of the word combination 'THE HOME DEPOT' in the relevant territories, it cannot be concluded that the mark had become customary in the current language or in the bona fide and established practices of the trade to designate the goods in respect of which the mark is registered. The request is not well founded. In the light of the evidence before it, the Office does not consider that the CTM has been registered in breach of Article 7(1) CTMR. Article 51(1)(a) CTMR is not applicable".

Country overview: Greece & the Community Trade Mark



Greece, with a population of 11.2m, forms the southern extremity of the Balkan Peninsula in south-east Europe. Its territory includes more than 2 000 islands in the Aegean and Ionian seas, of which only around 165 are inhabited.

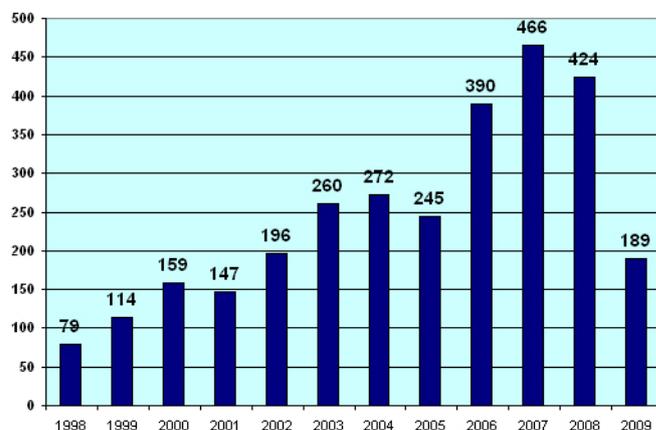
One of the cradles of European civilisation, whose ancient scholars made great advances in philosophy, medicine, mathematics and astronomy, Greece joined the EU in 1981.

Greek figures for GDP show growth in the final quarter of 2008 was up slightly (0.3%), compared with the previous quarter, during a period when EU growth as a whole fell by 1.7%.

Tourism accounts for an estimated 15% of Greek GDP and the service sector as a whole is 73%, followed by industry (23%) and agriculture (3.5%).

Greek undertakings have filed a total of more than 2 900 CTMs, including 420 last year. This year so far, there have been around 190 filings.

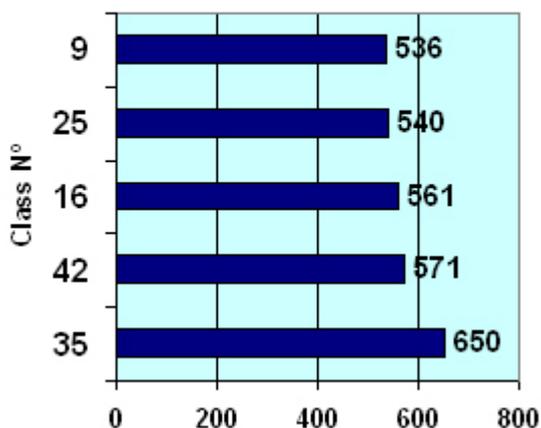
Greece - CTM Filing Evolution
(Total CTMs: 2 941)



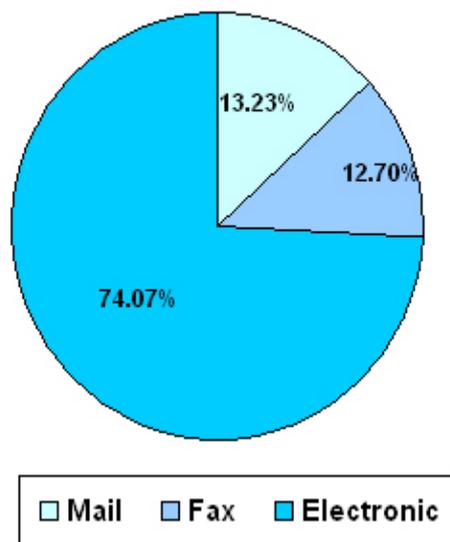
Word	Figurative 3-D	Colour	Other	Sound
34.53%	62.94%	0.58%	1.88%	0.06%
				0.00%

Figurative marks are the most popular with Greek enterprises and account for 63% of applications, followed by word marks (35%). The most popular goods and services applied for are in classes 35, 42 and 16.

Greece - Top Classes Filed (Nice)



Almost three-quarters of Greek trade marks (74%) are filed electronically, with fax mail accounting for around 13% each.



Top 10 Greece-based owners by number of CTMs filed

Company	CTMs
COSMOTE-MOBILE TELECOMMUNICATIONS S.A.	85
MEVGAL S.A. - DAIRY PRODUCT INDUSTRY trading as MEVGAL S.A.	38
DYNAMIKI ZOI ANONYMI ETAIRIA	30
TOYRISTIKES EPICHEIRISEIS MESSINIAS A.E. (TEMES)	23
FAGE DAIRY PROCESSING INDUSTRY S.A. trading as FAGE	21
FRIGOGLASS COMMERCIAL REFRIGERATION S.A.I.C.	21
INFOTE PLIROFORIES GIA OLOUS A.E.	20
YANNIDIS BROTHERS SA-INDUSTRIAL-COMMERCIAL-CHEMICAL-TECHNICAL-AND HOTEL BUSINESS COMPANY Business title	19
HERMES-VITEX	17
ION S.A. Cocoa & Chocolate Manufacturers	17
GALAKTOVIOMICHANIA LARISIS A.E.	16

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

Representative	CTMs
LAW FIRM THANOS MASOULAS & PARTNERS	94
P.D. THEODORIDES · H.G. PAPACONSTANTINOU	87
NIKOLAIDI	80
VAYANOS KOSTOPOULOS	79
DRYLLERAKIS & ASSOCIATES	64
MALAMIS & MALAMIS LAW OFFICES	59
G.S. KOSTAKOPOULOS & COLLABORATEURS	56
SAKELLARIDES LAW OFFICES	43
Seloulis	41
Siotou	39

Community Design

Switching-on the difference in designs

The Invalidity Division for designs has taken a decision¹ in which just one feature of a registered Community design (RCD) was enough to establish its novelty and individual character.

The decision concerns an application for a declaration of invalidity of RCD 757547-0003 wherein the applicant claimed that the RCD was anticipated by the publication of a prior design, namely RCD 330402-0014, and therefore the contested RCD lacks novelty and individual character.

The relevant views of the two designs are the followings:



The two opposing designs are almost identical in so far as both concern radiators with horizontal heating elements arranged in a bank of vertical planes between two upright panels. The only difference is marked by a further panel on top of the horizontal heating elements foreseen in the RCD but not in the prior design. In two of the three views of the RCD, this additional panel is only visible as just another vertical plane. However, in the first view it is shown that this seemingly unremarkable element can be turned into a flashy feature throwing a soft blue light over the radiator.

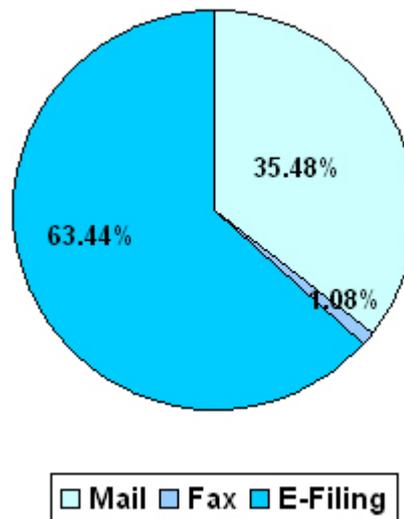
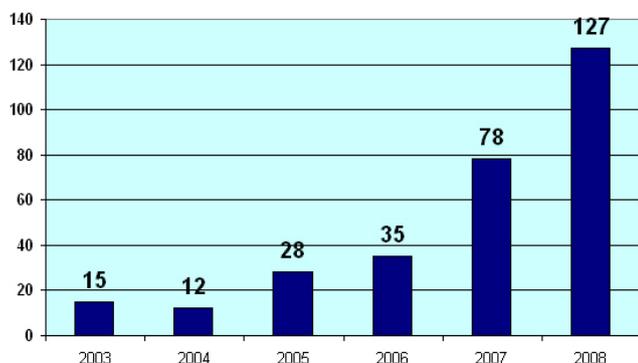
The decision explains that “the illumination of this top panel as it is shown in the first view of the RCD produces a stark effect which distinguishes the RCD from the prior design”. The fact that this top panel was shown in a switched-on state in the first view made all the difference in the outcome of the decision. This case illustrates that a single feature shown appropriately in the graphical representation of a design may suffice to fulfil the requirements of protection for a RCD.

¹Decision of the Invalidity Division of 18 Mai 2009, in case ICD 5155

Country overview: Greece & the Registered Community Design

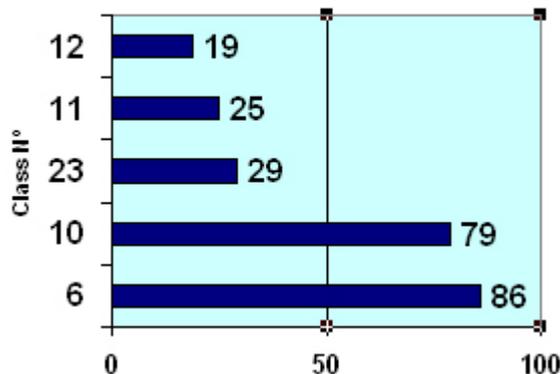
The total number of registered Community design filings by Greek companies is not large – around 350 to date, including 127 last year.

Greece - RCD Filing Evolution (Total RCDs: 534)



The most popular classes for RCDs are 6, 10 and 23. E-filing now accounts for 63% of Greek RCD filings, with mail the second most popular at just over 35%. Only around 1% of RCDs are filed by fax.

Greece - Top Classes Filed (Locarno)



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

Representative	RCDs
Xirokosta	142
Zounta	78
HEUSSEN RECHTSANWALTSGESELLSCHAFT MBH	17
Meligos	14
Kotsani	7
Laskaridou	6
Panagiotidou	6
Perivolaris	6
VALTOUDIS LAW OFFICE	6

Top 10 Greece - based owners by number of RCDs filed

Owner	RCDs
Folli Follie Anonimi Viotehnikai & Emporiki Etaireia Kosmimatou, Orologion, Endymaton, Ypodimaton, Accessories	44
Savakis	42
FOLLI-FOLLIE ANONIMI VIOTECHNIKI KAI EMPORIKI ETAIREIA KOSMIMATON, OROLOGION, ENDIMATON, YPODIMATON, AXESOUAR	31
Pantelakis	22
Paziouros	19
NIPPONIA Holding and Management S.A.	18
Dimitracas	14
Pyramis S.A.	12
PANAGIOTIS THEODORIDIS & CO	11
Glentos	7

E-business at OHIM**Training users of e-business services**

With the progressive introduction of new and improved e-business services, the level of support and training offered by OHIM to current and potential users has become increasingly important.

Our objective is to provide simple and user-friendly e-business tools. Ideally the way in which the tools work should be self-explanatory, but we also recognise the need to help users make the transition smoothly, either through direct presentations or online demonstrations.

OHIM's online e-business demonstrations are available to everyone via the OHIM E-Business section under About OHIM/Multimedia. The "how-to" videos include, among other things, demonstrations of the new CTM and RCD E-Filing systems.

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In addition to the material that can be found online, OHIM is developing a programme of practical workshops dedicated to e-business solutions. In 2009, the main focus is on the newly released e-business solutions such as RCD and CTM E-Filing tools.

The workshops are organised in cooperation with the relevant national professional organisations in the IP field and upon their request. An ambitious programme is planned this year, with workshops already completed in Warsaw (Poland), Manchester and London (United Kingdom).

Further workshops are already scheduled in Italy (Milan and Rome on 29 and 30 June organised by the Ordine di Consulenti) and in Germany (in Hamburg on 24 September organised by GRUR). Similar workshops are being organised in Spain, France and Hungary on dates that will be announced on our website.

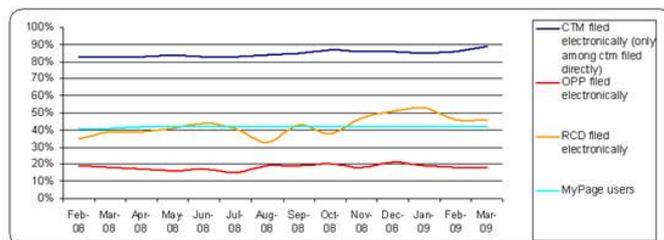
The workshops normally last around three hours and provide the opportunity not only to learn how to use the OHIM e-business services but also to share experience with OHIM staff and other participants. So far, they have proved very popular among participants - the Warsaw event attracted a record 120 participants.

OHIM is currently planned to introduce more advanced interactive technology to disseminate information on how to get the most from our e-business services. The first trial online workshops will be held in the near future.

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

OHIM e-business roundup (2009)**Statistical summary**

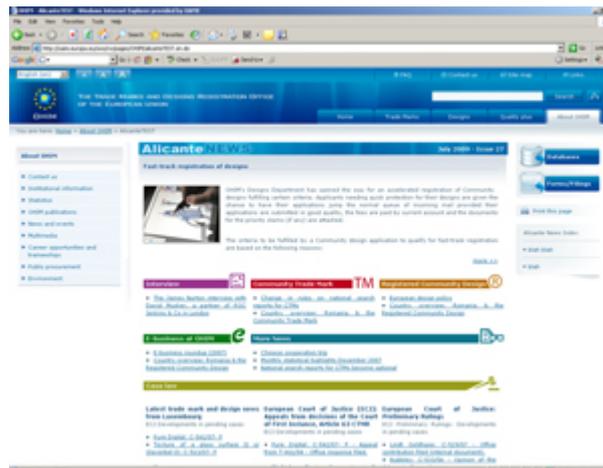
- The use of the CTM e-filing web form is steady at above 80%.
- The use of RCD e-filing has increased over 60%
- Oppositions against CTM applications received electronically are around 18%.
- MyPage users represent around 42% of CTM Applications filed.





State of play of future projects:

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



More News

What kind of Alicante News do you want?

When Alicante News was launched five years ago as an electronic newsletter, the Internet was already an important source of information. Since then we have seen increasing use of news feeds, Blogs coming of age, and the flourishing of social media such as Facebook and Twitter.

Now, almost a year after the OHIM website was given a major revamp, we think it is time to consider a new look for Alicante News. This will give us an opportunity to integrate the magazine more closely with the website and also reflect on the changes in the way in which information is delivered to our customers through other media.

Alicante News is not setting out to compete with either IP magazines or Blogs. We feel there is still a place for a regular monthly dose of news and information related to the Community trade mark and design, and the rising numbers of regular readers of Alicante News (we now have almost 7,000 e-mail subscribers) confirms this view.

However, this does not mean that we cannot and should not change. After more than 50 issues in more or less the same format, we would like to ask our readers for some help in improving what has already proved to be a popular formula.

We have developed some ideas on how Alicante News might look within the new website format and anyone interested is welcome to click on the following screenshot. This is not a final design and it does not imply any changes in content.

We would also be very grateful if you would take a few minutes to answer a short online mini survey (completely anonymous). There are just 10 multiple choice questions so it should only take a few minutes to complete.

[Yes, take me to the Alicante News mini survey!](#)

Chinese design seminar

OHIM has taken part in a major international seminar on design protection at Shunde, China on 3-4 June. The seminar compared the Chinese design system with the US, the European and Japanese systems.

The seminar was sponsored by OHIM, the Japan Patent Office, the Chinese State Intellectual Property Office, and the United States Patent and Trademark Office. Its objective was to exchange information on the examination of industrial designs and discuss how best to protect designs with interested parties from the private sector, including Chinese and foreign design applicants.



Monthly statistical highlights May 2009

Community trade mark applications received	6 625
Community trade mark applications published	5 828
Community trade marks registered (certificates issued)	6 497
Community trade mark renewal applications	1 473
Registered Community designs received	4 809
Registered Community designs published	5 072

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

Case-law

Latest trade mark and design news from Luxembourg

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

A-1: ECJ Judgments and Orders

Corpo Livre : C-90/08-P – Appeal from T-86/05; Order of 5 March 2009 (only in DE, FR; a *limine* rejected; CFI and Office practice confirmed).

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

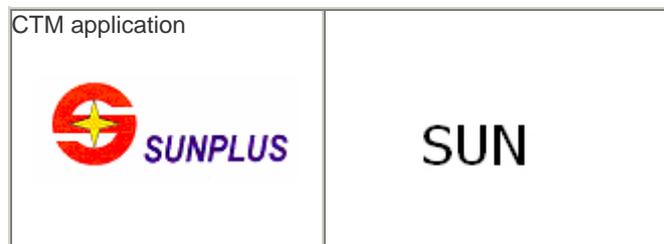
The case had been an appeal from a decision of the CFI of 12.12.2007 in Case T-86/05 by which it had rejected an action against a decision of the 1st Board of 7.12.2004 in Case R 0328/2004-1. The Board had rejected an opposition based on Livre, word, against CTM application Corpo/livre (figurative mark) on the grounds of lack of POU because the material had been filed out of time. The 8th Chamber of the ECJ (Danwitz; Arestis, rapporteur; Malenovsky) rejected the subsequent challenge as partially inadmissible and partially manifestly unfounded.

Sunplus/sun : C-21/08-P – Judgment of 26 March 2009 . Appeal from T-38/04 (action dismissed, CFI and Office practice confirmed).

Keywords: ECJ proceedings: admissibility of new legal arguments. Opposition: likelihood of confusion (LOC).

By its appeal, the CTM applicant and plaintiff in the action, Sunplus Technology Co. Ltd, had sought to have set aside the CFI judgment of 15.11.2007 in Case T-38/04, by which it had dismissed Sunplus Technology's action for annulment of the decision of 7.10.2003 of the 4th Board in Case R 0642/2000-4. The plaintiff had applied for SUNPLUS (figurative mark) in class 9 for chips, semi-conductors,

integrated circuits, electronic circuits, semiconductor chips, semi-conductor elements, micro-processing chips, floating-point computing chips, super-large-scale integrated circuits, program cards, discs containing computer programs and for magnetic discs.



Sun Microsystems Inc. had filed a notice of opposition based on four earlier trade marks, including the word mark SUN, registered for information processing installations and apparatus, computers, personal computers, computer terminals, computer input and output devices, computer accessories, computer parts and computer memories, text processing apparatus; computer software; magnetic and electronic data carriers, apparatus and for instruments for recording and reproducing data.

The opposition had been allowed in all instances, and the 2nd Chamber of the ECJ (Timmermans; Schiemann; Makarczyk; Küris, rapporteur; Toader) rejected the appeal, relying on the ECJ case law relating to the interpretation of what would make up a “point of law” and the admissibility of new legal arguments.

New legal arguments

(33) As regards failure to state reasons for the judgment under appeal, it is clear from Articles 42(2) and 118 of the Rules of Procedure that no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure. Since it was not until the hearing that Sunplus Technology relied on failure to state reasons and that the plea is not based on matters which have come to light since the bringing of the appeal, the plea must be rejected as having been filed too late.

Manufacturing Score Card : C-17/08-P – Appeal from T-459/05; Order of 6 February 2009 (only in DE, FR; appeal dismissed; CFI and Office confirmed).

Keywords: Absolute grounds for refusal: descriptiveness.

The case had been an appeal from a judgment of the CFI of 8.11.2007 in Case T-459/05, relating to a decision of the 2nd Board of 19.10.2005 in Case R 1059/2004-2 by which CTM application “manufacturing score card” had been rejected. It had been applied for for a range of goods in class 9 and for related services in classes 35 and 42. The 8th Chamber of the ECJ (Danwitz, rapporteur; Juhász; Arestis) rejected the appeal as mainly manifestly inadmissible (assessment of distinctiveness = an issue of fact), and the rest as evidently unfounded.



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

Notfall Bonbons : T-372/08 – Case closed; Order of 20 April 2009 (DE; upon withdrawal of the cancellation request at pending proceedings).

Keywords: Procedural law: withdrawal of a request before the Office pending CFI proceedings. Cancellation: invalidation on absolute grounds. Absolute grounds for refusal: descriptiveness.

The action had been directed against a decision of the 1st Board of 10.7.2008 in Case R 0909/2007-1 by which the Board had revoked a decision of the cancellation division and had invalidated CTM Notfall Bonbons (word), registered in classes 5 and 30, on the grounds that the term would simply convey the message that the products provide “rescue remedy” in stressful situations as described by the British doctor Edward Bach in the respective part of his flower therapy. The latter, in German speaking countries, is widely and generically known as “Dr. Bachs Notfall-Tropfen”. The parties reached an agreement out of court and the requestor for cancellation withdrew its request before the Office; consequently, the case was closed.

Oftal Cusi/Ophthal : T-462/08 – Case closed; Order of 21 April 2009 (ES; following revocation, by the Board, of its challenged decision).

Keywords: OHIM decision: revocations, by the decision-making body, pending appeal proceedings. Opposition: likelihood of confusion (LOC).

The case is related to a decision of the 1st Board of 17.7.2008 in Case R 1471/2007-1 concerning CTM application OFTAL CUSI, word, which had been applied in class 5 for pharmaceutical preparations and sanitary preparations, ophthalmologic and for otorhinolaryngologic pharmaceutical preparations. It had been opposed on the basis of an earlier German right in OPTHAL, word, which covers pharmaceutical preparations and sanitary preparations in class 5, namely medicines for application to the eyes, nose and ears; preparations for the care of contact lenses, wetting, storage, cleaning, washing and disinfecting agents for contact lenses, and wetting agents for artificial eyes.

The opponent had underlined that ‘Ophtal’ is a leading brand name in Germany in the field of ophthalmologic preparations and appears in many other trade marks: Clon-Ophtal, Lac-Ophtal, Betam-Ophtal, Lacri-Ophtal, Ophthalmin, Ophtalon, Ophtalkan, etc. It had submitted a declaration signed by the president of the German Association of Ophthalmologists stating that ‘Ophtal’ is exclusively associated to the opponent by at least 80% of ophthalmologists and that ‘Ophtal’ branded preparations belong to the most prescribed preparations from 1996 to 2001. Therefore, the opponent had argued, the earlier mark should be regarded as highly distinctive in Germany. The opposition had been rejected on the grounds that the CTM applicant's mark is unlikely to cause confusion in the

Community market with the earlier mark – even if used for the same or similar ophthalmic products – because it contains sufficient differences. It had been observed, first, that the earlier mark is a ‘commonly used term in a number of languages which indicates that a product or service is related to the eye’ (‘ophtalmos’, in ancient Greek) and that since it is ‘of limited distinctiveness, if any’, it should ‘not be taken into account on the same basis as the other elements in the comparative analysis of the marks in dispute’. Secondly, it had been observed that the CTM applicant's mark displays, visually and phonetically, more dissimilarities than similarities because it contains the meaningless word CUSI and that the marks are conceptually similar because they allude to eyes. The claim that ‘Ophtal’ belongs to a family of marks is unfounded because the opponent had not shown how these marks are used in trade and did not supply any evidence showing that the public recognises ‘Ophtal’ as exclusively identifying the opponent's products.

Upon revocation, by the Board, of its challenged decision, at pending CFI proceedings (3 February 2009), the case was closed.

Ayanda : T-43/09 – Case closed; Order of 2 April 2009 (ES; dismissed as manifestly inadmissible).

Keywords: CFI proceedings: formal requirements of an appeal. Opposition: likelihood of confusion (LOC). LOC: comparison of goods.

The action had been initiated against a decision of the 2nd Board of 19.11.2008 in Case R 0087/2008-2 relating to CTM application AYANDA, word, which had been applied in class 30 for coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; treacle, yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices and ice, and in class 32 for beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

These had been opposed on the basis of two earlier rights in AMANDA (word and figurative mark) which cover, in class 30, yerba mate, honey and Paraguay tea. The opposition had been allowed for part of the contested goods, namely coffee, cocoa, sugar, artificial coffee; treacle in class 30, and for mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages in class 32. The opponent's subsequent appeal to the CFI has been a *limine* rejected as inadmissible because of failure to rectify, in good time, the formal deficiencies of the respective brief.

Ultimate Fighting : T-379/05 - Judgment of 2 April 2009 (action allowed; the case may have an impact on the motivation of decisions on absolute grounds for refusal).

Keywords: OHIM decisions: formal issues. Formal issues: obligation to state reasons. Motivation of decisions: as regards absolute grounds for refusal. Absolute grounds for refusal: relationship with each other.

The case had been brought against a decision of the 1st Board of 8.8.2005 in Case R 0024/2005-1 relating to CTM



application ULTIMATE FIGHTING, word, which had been applied for a range of (215) goods and (13) services in classes 9, 16, 25, 28 and 41. By his decision of 11.11.2004, the examiner had refused the application on the grounds that the trade mark applied for was descriptive, as well as being devoid of any distinctive character, pursuant to Article 7(1)(b) and (c) CTMR. The Board had confirmed that decision, stating that the sign would convey no more than a specific tough combat, an entertainment business etc., in which the applicant is engaged. The 3rd Chamber of the CFI (Azizi; Cremona ; Frimodt Nielsen, rapporteur) revoked the decision on the grounds of insufficient motivation.

(a) *Statement of reasons – an issue to be looked into ex officio:*

(14) Although, in the present case, the applicant has not invoked a failure to state reasons, compliance with the duty to state reasons, which applies to all acts subject to judicial review by the Community Courts, is a matter of public policy that must be raised, if necessary, of the Court's own motion (see, to that effect, Case 18/57 Nold v High Authority [1959] ECR 41, at p. 52; Case C-166/95 P Commission v Daffix [1997] ECR I-983, paragraph 24; and Case T 388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 59). The Court finds it necessary to consider, of its own motion, whether the contested decision contains an adequate statement of reasons. The parties were questioned at the hearing on the adequacy of the statement of the reasons given in the contested decision.

(15) Under Article 73 CTMR, decisions of the OHIM must state the reasons on which they are based and may be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. In addition, Rule 50(2)(h) CTMIR provides that the Board of Appeal's decision must contain the reasons therefore. The duty to state reasons set out in those provisions has the same scope as that enshrined in Article 253 EC (see Joined Cases T-124/02 and T-156/02 Sunrider v OHIM – Vitakraft-Werke Wührmann and Friesland Brands (VITATASTE and METABALANCE 44) [2004] ECR II-1149, paragraph 72, and Case T-168/04 L & D v OHIM – Sämann (Aire Limpio) [2006] ECR II-2699, paragraph 113 and the case-law cited).

(16) It is settled case-law that the statement of reasons required under Article 253 EC must set out clearly and unequivocally the reasoning of the body which adopted the act in question. Accordingly, the duty incumbent on the Board to set out reasons for its decisions has two purposes: first, to allow interested parties to know the justification for the measures taken so as to enable them to protect their rights and, second, to enable the Community Courts to exercise their power to review the legality of those decisions (see VITATASTE and METABALANCE 44, paragraph 73, and Aire Limpio, paragraph 114 and the case-law cited). (17) Whether the statement of reasons for a decision satisfies those requirements is a question to be assessed by reference not only to the wording of the decision but also to its context and the whole body of legal rules governing the matter in question (see VITATASTE and METABALANCE 44, paragraph 73 and the case-law cited).

(b) *Assessment of absolute grounds for refusal: each separately, each individually in relation to each good or service:*

(20) Furthermore, each of the grounds for refusal listed in Article 7(1) CTMR must be interpreted in the light of the public interest underlying each of them, each of those grounds being independent of the others and calling for separate examination (see Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 45 and the case-law cited). (21) In that context, the subject of the public interest underlying Article 7(1)(b) CTMR is, first, the need not unduly to restrict the availability of the sign for which registration is sought for the other traders who offer goods or services of the same type as those in respect of which registration is sought and, second, to guarantee to the consumer or end-user the identity of the origin of the goods or services designated by the trade mark application by enabling that consumer or end-user, without any possibility of confusion, to distinguish those goods or services from others which have a separate origin. Such a guarantee thus constitutes the essential function of the trade mark (see, to that effect, Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317, paragraphs 23, 26 and 27, and the case-law cited, and Case C-304/06 P Eurohypo v OHIM [2008] ECR I-0000, paragraphs 59 and 62).

(22) It follows that, where registration of a mark is sought in respect of various goods or services, the Board of Appeal must determine specifically that none of the grounds for refusal listed in Article 7(1) CTMR applies to the mark in question, in relation to each of those goods or services claimed, and may reach different conclusions depending upon the goods or services in question (see, by way of analogy, Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619, paragraphs 33 and 73). Therefore, when refusing registration of a trade mark, the Board is required to state in its decision its conclusion for each of the goods and services specified in the application for registration, regardless of the manner in which that application was formulated. However, where the same grounds of refusal are given for a category or group of goods or services, the competent authority may limit itself to using general reasoning for all of the goods or services concerned (see, by way of analogy, Case C-239/05 BVBA Management, Training en Consultancy [2007] ECR I-1455, paragraph 38).

(24) In the present case, the trade mark applied for covers more than 215 goods falling within four separate classes (...), as well as at least 13 kinds of different services, including pre-recorded audio cassettes, cookery books, baby booties, bows and arrows, or the provision of information in the field of sports via computer networks (...). The goods and services covered by the trade mark applied for thus demonstrate such differences between them, by reason of their nature, characteristics, intended purpose and the method of their marketing, that they cannot be regarded as constituting a homogenous category that would allow the Board to adopt a general statement of reasons in their regard.

(25) In the contested decision, the Board confined itself to distinguishing between the goods and services covered by the trade mark application which are directly related to fighting and those which are not (see paragraph 21 of the contested decision). For the goods and services directly related to fighting, first, the Board indicated that, by virtue of the



meaning of the terms 'ultimate' and 'fighting', the target public could not perceive the sign applied for as indicating the origin of those goods and services (see paragraphs 12 to 16 of the contested decision). For the goods and services not directly related to fighting, second, the Board stated that the latter would be considered by the target public as being marketed during or in relation to a competition in mixed martial arts, or as being suitable for the practicing of that sport, or as forming part of a merchandising programme. For that reason too, with regard to the goods and the services not directly related to fighting, the target public could also not perceive the sign applied for as indicating the origin of those goods and services (see paragraph 21 of the contested decision). (26) By reason of its very general nature, such a statement of reasons is evidently not sufficient to allow the Court to verify whether the contested decision is well-founded.

Spaline/Spa : T-21/07 – Judgment of 25 March 2009 (action dismissed; Office practice confirmed).

Keywords: Opposition: earlier right with reputation.

The case had been an appeal from a decision of the 1st Board of 18.10.2006 in Case R 0415/2005-1 relating to CTM application SPALINE, word, which had been applied, in class 3, for bath and shower soaps, skin moisturisers, body lotions, skin toners, astringents, skin and body cleansers, facial masks, scrubs, and fragrance products, namely perfumes, colognes, eau de toilette and oils. It had been opposed by Spa Monopole SA/NV, which had invoked, in particular, Article 8(5) CTMR, relying on the reputation of its word mark SPA, which had been registered with the Benelux Mark Office in 1983 with respect to mineral water and aerated waters and other non-alcoholic beverages, syrups and other preparations to make beverages, in class 32.

By its contested decision, the Board confirmed the opposition division which had allowed the opposition on the grounds that the conditions of Article 8(5) CTMR had been satisfied. The Board held, first of all, that the earlier mark had a reputation in the Benelux countries in respect of mineral waters, referring, in particular, to the position adopted by the court in its judgment in Case T-67/04 Spa Monopole v OHIM – Spa-Finders Travel Arrangements [2005] ECR II-1825. With respect, next, to the similarity of the signs, the Board had taken the view, in essence, that this had been established since the earlier mark was included in the mark applied for. Finally, the Board found that there was in this case a likelihood in the circumstances that the applicant would, by making use of the mark applied for, take unfair advantage of the reputation of the earlier mark in the light of the highly distinctive character of the word 'spa' and the close relationship between the goods in question. The Board did not accept the applicant's argument that the term 'spa' was descriptive of cosmetic products and that, consequently, the use of the sign SPALINE was not without due cause in respect of those products. In its brief decision, the 5th Chamber of the CFI (Vilaras; Prek, rapporteur; Ciucà), in essence, confirmed these findings.

Allsafe : T-343/07 – Judgment of 25 March 2009 (only in DE, FR; action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness.

The case had been brought against a decision of the 4th Board of 11.7.2007 in Case R 0454/2006-4 relating to CTM application ALLSAFE, word, which had been applied for for a range of goods and services in classes 6, 12, 22, 35, 39 and 42. It had been rejected on the grounds of Article 7(1)(b) and (c) CTMR. The 6th Chamber of the CFI (Meij, rapporteur; Vadapalas; Truchot) confirmed the findings in relation to Article 7(1)(c), relying on standard criteria, and did not find it relevant to also examine Article 7(1)(b) CTMR.

Arcol/Capol-II : T-402/07 – Judgment of 25 March 2009 (appeal against the OHIM's implementing decision pursuant to the ECJ judgment in C-29/05-P; action dismissed.)

Keywords: OHIM proceedings: implementation of a judgment annulling a Board decision. Procedural law: scope of assessment of the case, by the Board, after a court decision. OHIM proceedings: material filed for the first time before the Board. Opposition: likelihood of confusion (LOC).

The background of the case, in brief, is the following: On 3.4.1996, a CTM application had been filed for ARCOL, word, for a range of goods in classes 1, 17 and 20. Among the goods in class 1 are chemical substances for preserving foodstuffs. It had been opposed on 20.10.1998 by the plaintiff, Kaul GmbH, with regard to the chemical substances for preserving foodstuffs. The opposition had been based on the earlier CTM CAPOL, word, which covers chemical preparations for keeping fresh and preserving foodstuffs, namely, raw materials for smoothing and preserving prepared food products, in particular confectionery. By its decision of 30.6.2000, the opposition division had rejected the opposition on the grounds that, even if the goods were identical, there could be no likelihood of confusion between the marks at issue because they were visually and phonetically different.

In support of its appeal, the plaintiff had argued for the first time before the Board that an enhanced recognition of its earlier right would flow from the fact that that mark had become well-known through use. In order to substantiate that well-known character, it had produced, in the annex to its written statement before the Board, an affidavit by its managing director, and a list of its customers. The 3rd Board had dismissed the appeal by its decision of 4.3.2002, holding that it could not take into account the alleged highly distinctive character of the earlier mark since such a factor and the evidence mentioned above seeking to substantiate it were introduced for the first time in support of the appeal brought before it.

On subsequent appeal, in its judgment in Case T-164/02 Kaul v OHIM – Bayer (ARCOL) [2004] ECR II-3807, the CFI had accepted the plea in law as regards infringement of the right to defense and Article 74(1) CTMR, and had annulled the Board's decision without ruling on the other pleas in the action. In consequence, the OHIM had appealed to the ECJ which, in Case C-29/05-P of 19. 6. 2007, OHIM v Kaul [2007] ECR I - 2213, had allowed the OHIM's appeal and had set aside the judgment in ARCOL. Giving final judgment itself in the matter, the ECJ, however, also annulled the 2002 Board decision.

The ECJ had found that the Board, in the 2002 decision, had infringed Article 74(2) CTMR, which grants the Board, when presented with facts and evidence which are submitted late, a



discretion as to whether or not to take into account such information when making the decision which it is called upon to give. Since, instead of exercising the discretion which it thus has, the 3rd Board had wrongly considered itself to be lacking any discretion as to whether to take into account or not of the facts and evidence at issue. The Presidium of the Boards of Appeal of the OHIM reallocated the case to the 2nd Board for further dealing. By its decision of 1.8.2007, in issue here, the 2nd Board had dismissed the plaintiff's appeal and had upheld the initial decision of the opposition division which had rejected the opposition. In essence, the Board, after finding that the marks at issue could not, in any way, be regarded as similar by the relevant public, made up of manufacturers of food and confectionery products. Thus, any argumentation relating to an enhanced recognition of the earlier brand is immaterial.

The 5th Chamber of the CFI (Vilaras, rapporteur; Prek; Ciuca) confirmed these findings, holding, in particular, that the issue of LOC had not been looked into by the CFI in its first decision, and that, thus, no binding effect could have flown from that decision as regards re-examination of the case on substance in the second round:

“(39) The 2nd Board was also not bound, on that point, by the operative part or the reasoning in OHIM v Kaul (...) since, in that judgment, the Court did not take any position whatsoever on whether the marks at issue were similar or not. That question could only have been examined, if appropriate, in connection with a plea alleging infringement of Article 8(1)(b) CTMR. The Court of Justice, like the CFI, (had) annulled the contested decision without examining that plea. (44) In any case, the applicant's complaint relating to the alleged infringement of Article 74(2) CTMR is irrelevant. Having found that there was no similarity between the mark applied for and the earlier mark, the 2nd Board was not bound to take into consideration the supposed well-known character of the earlier mark, since it was properly entitled to conclude that there was no likelihood of confusion, whatever the supposed especially distinctive character of the earlier mark (see, to that effect, judgment of 25 June 2008 in Case T-224/06 Otto v OHIM – L'Altra Moda (l'Altra Moda), paragraph 50).”

Budweiser Budvar : T-191/07 – Judgment of 25 March 2009 ; action dismissed; Office practice (opposition division) confirmed.

Keywords: Procedural law: rights of defense. Procedural law: late submission of documents. Late submission of documents: discretion granted by Article 74(2) CTMR – Assessment of a case: previous practice/self-binding effect.

The action had been initiated against a decision of the 2nd Board of 20.3.2007 in Case R 0299/2006-2 by which it had dismissed an appeal by Anheuser-Busch, Inc. against rejection of CTM application BUDWEISER for beers etc. That application had been opposed on the basis of Budweiser Budvar (figurative mark), registered for beers etc. The case is only one of a series of Budweiser cases and the 1st Chamber of the CFI (Tiili; Dehousse, rapporteur; Wiszniewska-Bialecka) confirmed rejection of the application.

Self-binding effect of previous practice of the OHIM (none):

(49) With regard to practice in previous decisions, according to settled case-law, decisions concerning registration of a sign as a CTM mark which the Boards of Appeal are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. The legality of decisions of the Boards of Appeal must therefore be assessed purely by reference to that regulation, as interpreted by the Community Courts, and not to the practice of the Boards in earlier cases (Case C-37/03 P BioID v OHIM [2005] ECR I-7975, paragraph 47; Case T-36/01 Glaverbel v OHIM (Surface of a plate of glass) [2002] ECR II-3887, paragraph 35; and Case T-207/06 Europig v OHIM (EUROPIG) [2007] ECR II-1961, paragraph 40). Moreover, a mere practice, no matter how current, does not amount to precise, unconditional and consistent information within the meaning of the case-law recalled in paragraph 46 above (see, to that effect, Case T-135/05 Campoli v Commission [2006] ECR-SC I-A-2-297 and II-A-2-1527, paragraph 70). Furthermore, Anheuser-Busch cites, in support of its claims, only two decisions of the Boards of the OHIM.

Spa Therapy : T-109/07 – Judgment of 25 March 2009 (appeal dismissed; Office confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The case had been brought against a decision of the 4th Board of 24.1.2007 in Case R 0468/2005-4 relating to L'Oreal's CTM application for the word SPA THERAPY in class 3 (perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics, in particular creams, milks, lotions, gels and powders for the face, body and hands; sun-tanning milks, gels and oils and after-sun preparations; make-up preparations; shampoos; gels, mousses, balms and preparations in aerosol form for hairdressing and hair care; hair lacquers; hair-colouring and hair-decolorising preparations; permanent waving and curling preparations; essential oils).

It had been opposed by Spa Monopole, c. f. de Spa SA/NV, on the basis of several earlier rights including SPA, which had been registered with the Benelux Office for bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; toothpastes, in class 3. The opponent also invoked Article 8(4) and (5) CTMR. The opposition had been fully allowed under Article 8(1)(b) CTMR, relying on standard criteria. The 5th Chamber of the CFI (Vilaras; Prek, rapporteur; Ciuca) confirmed these findings in a brief judgment.

General Optica: T-318/06 to 321/06 – Judgment of 24 March 2009 (action dismissed; Office practice confirmed).

Keywords: OHIM proceedings: impact of national judgments. Opposition/invalidation: earlier rights under Article 8(4) CTMR. Article 8(4) rights: registered name of a business. Article 8(4) rights: notion of local significance.

The action had been brought against the decisions of the 1st Board of 8.8.2006 in Cases R 0944/2005-1, R 0945/2005-1, R 0946/2005-1 and R 0947/2005-1 by which the Board had rejected four appeals against rejection of requests for



invalidation on relative grounds directed against four CTMs “General Optica” (figurative mark), registered for services in class 42.



The CTMs had been challenged on the basis of the Portuguese registered business name “Generalóptica” for the import and retail sale of optical apparatus etc. On that basis, the plaintiff had also brought legal proceedings before a Portuguese court to have the extension to Portugal of the international trade mark and the CTM holder's company name declared void, and to have the use of those signs prohibited. At the hearing, the plaintiff submitted a decision of the Supremo Tribunal de Justiça of 10.7.2008 in which that court upheld the decisions of the Tribunal Judicial da Comarca de Lisboa and the Tribunal da Relação de Lisboa which had ruled in favour of the plaintiff. The requests for invalidation had been rejected on the grounds of lack of proof of use and of more than local significance. The 2nd Chamber of the CFI (Pelikánová; Jürimäe; Soldevila Fragoso, rapporteur) confirmed these findings.

National judgments:

(18) The applicant submits that a Community decision which is contrary to the decision given by the Portuguese courts would undermine the principle of the unity of the Community trade mark system, under which that mark must produce its effects in all the Member States of the Union, and that that system does not have absolute autonomy with respect to the various national laws. Consequently, the applicant claims that the proceedings must be stayed until the decision given by the Portuguese courts becomes final. Findings of the Court: (20) It must be pointed out that, at the current stage of the proceedings before the Court and following the decision of the Supremo Tribunal de Justiça referred to in paragraph 9 above, which makes final the decisions of the Portuguese courts concerning the international mark No 483246, GENERAL OPTICA, and the intervener's company name, the applicant's request for the proceedings to be stayed until the decision given by the Portuguese courts becomes final has become devoid of purpose.

(21) In any event, the decision of the Portuguese courts concerns only the extension to Portugal of the international registration of the trade mark GENERAL OPTICA and the intervener's company name. As the decision of the Portuguese courts does not contain any general prohibition against the use in Portugal of a mark including the words ‘general optica’, the CTMs GENERAL OPTICA are not

affected by it. Therefore, and contrary to the arguments put forward by the applicant at the hearing, a decision of the CFI upholding the registration of the Community trade marks GENERAL OPTICA does not make it possible for the intervener to circumvent the decision of the Portuguese courts. In particular, the confirmation of the validity of the Community trade marks GENERAL OPTICA has no bearing at all on the obligation arising from the decision of the Supremo Tribunal de Justiça to refrain from using in Portugal the international trade mark GENERAL OPTICA and the intervener's company name. (22) Lastly, contrary to what the applicant maintains, the unitary character of the CTM cannot be called into question by a contradiction between the decision of the Portuguese courts and the decision of the CFI. The unitary character of the Community trade mark constitutes a principle which is not absolute, but permits exceptions, such as those provided for in Article 106 CTMR, relating to the prohibition of use of Community trade marks, and Article 107 CTMR, relating to prior rights applicable to particular localities (Case C-9/93 IHT Internationale Heiztechnik and Danzinger [1994] ECR I-2789, paragraph 55).

Trenton : T-171/06 – Judgment of 17 March 2009 (action allowed; the judgment clarifies the impact of silence of a “defendant” at OHIM proceedings).

Keywords: Procedural law: impact of silence of a party.

The CTM application in issue had been the word sign TRENTON. The goods in respect of which registration had been sought are in classes 7, 9 and 11, namely machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than those operated manually and incubators for eggs.

It had been opposed, in class 7, on the basis of CTM LENTON, word, registered in respect of goods in classes 6 and 7, namely threading machines, chasers, and gauges therefore, hydraulic wedge drivers, swaging machines, and wire tying machines. The CTM applicant did not file any observations at that stage of the procedure. By fax of 1 July 2003, the OHIM had informed the CTM applicant, pursuant to Rule 20(3) CTMIR that, on account of its failure to file observations within the prescribed period, the OHIM would give a ruling on the opposition on the basis of the evidence before it. Subsequently, the opposition had been rejected. It had been found that the differences between the marks at issue did not allow for the conclusion that there was LOC despite the identity and partial similarity of the goods.

In its subsequent appeal, the opponent had claimed that the CTM applicant did not exist, given its complete procedural inactivity. The Board sent these claims to the CTM applicant and requested it to submit observations, both on the appeal in general and on the more specific issue of the CTM applicant's existence. The applicant did not make any contact within the prescribed period. At the expiry of that period, the registry of the Boards contacted the applicant's representative to confirm that the applicant did not have any observations to submit, a fact which was confirmed to him over the telephone. By its decision, the Board then had held that, on account of its complete procedural inactivity during the opposition and appeal stages, the applicant had implicitly withdrawn its CTM



application under Article 44(1) CTMR. The CTM applicant appealed to the CFI, and the Office supported its claim to have the Board decision set aside. The 3rd Chamber of the CFI (Azizi; Cremona ; Frimodt Nielsen, rapporteur) annulled the decision based on the following considerations:

(44) Article 44(1) CTMR concerns only the applicant for a CTM and not the Board of Appeal. The Board cannot therefore rely on that provision to infer – by substituting itself for the applicant – from the applicant's procedural inactivity that there has been an implicit withdrawal of its trade mark application. Moreover, while the case-law cited above envisages situations in which the list of goods is restricted, the reasoning set out in the Court's judgments also refers expressly to the scenario of a straightforward withdrawal of the CTM application (...). The same logic necessarily applies in both situations, given that it is up to the applicant to indicate 'expressly and unconditionally' the content which he intends to give to his trade mark application. It is, then, for the Opposition Division and the Board to rule on the content of that application in the light of the arguments submitted in the opposition proceedings. That reasoning does not prevent the OHIM from registering the trade mark sought for only a portion of the goods or services indicated, but that restriction will then occur following the assessment of the likelihood of confusion, which was advanced in the present case.

(45) It should also be pointed out that the implicit withdrawal of the trade mark applied for, established by the Board in the contested decision, applies to all of the goods covered by the CTM application, even though the opposition was directed against only some of those goods (see paragraph 4 above). In any event, it cannot therefore be 'unequivocally' demonstrated that the applicant had lost all interest in registration of the trade mark applied for in its entirety by reason solely of the fact that it did not defend its position in the course of the opposition and appeal proceedings before OHIM relating to only some of the goods covered. (46) Consequently, Article 44(1) CTMR cannot be relied upon to infer the implicit withdrawal of the CTM application by reason solely of the fact that the applicant for that mark took no action in the course of the opposition and appeal proceedings before the OHIM.

(47) As regards the third stage of the Board's reasoning, the application, by analogy, of the requirements for a renunciation of rights accruing from the exclusive right which a trade mark confers on its proprietor, which were defined by the ECJ in Zino Davidoff and Levi Strauss (...), is not necessary in the present case in view of the content of Article 44(1) CTMR and the interpretation which has been given to that provision by the case-law. In the present case, it is irrelevant whether the Community trade mark proprietor's consent to the placing of the goods on the market in the European Economic Area (EEA) must be express. Furthermore, the ECJ held at paragraph 46 in Zino Davidoff and Levi Strauss, (...), that, even though '[s]uch intention will normally be gathered from an express statement of consent[, i]t is conceivable that consent may, in some cases, be inferred from facts and circumstances prior to, simultaneous with or subsequent to the placing of the goods on the market outside the EEA which, in the view of the national court, unequivocally demonstrate that the proprietor has renounced his rights.' Lastly, such an application by analogy fails to take account of paragraph 55 of that judgment, which states that 'implied consent to the marketing within the EEA of goods put on the

market outside that area cannot be inferred from the mere silence of the trade mark proprietor'. (48) It follows from the foregoing that the contested decision infringes Article 44(1) CTMR and must for that reason be annulled.

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

Hund (Dog) : T-385/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action has been directed against a decision of the 1st Board of 30.6.2008 in Case R 1734/2007-1 relating to CTM application 4.829.321, the representation of a dog.



It had been applied for for a range of goods in classes 18, 25 and 31 (amongst which foodstuff and beverages for animals) and had been rejected on the ground that the sign would not convey more than the purpose and/or function of the respective goods.

Pferd (Horse) : T-386/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action has been directed against a decision of the 1st Board of 7.7.2008 in Case R 1730/2007-1 relating to CTM application 4.829.354, the representation of a horse.



It had been applied for for a range of goods in classes 18, 25 and 31 (amongst which foodstuff and beverages for animals) and had been rejected on the ground that the sign would not convey more than the purpose and/or function of the respective goods.

Superleggera : T-464/08 – Office response filed (IT).

Keywords: Absolute grounds for refusal: descriptiveness.

The action has been directed against a decision of the 1st Board of 17.7.2008 in Case R 0666/2008-1 relating to CTM application 5.456.207.

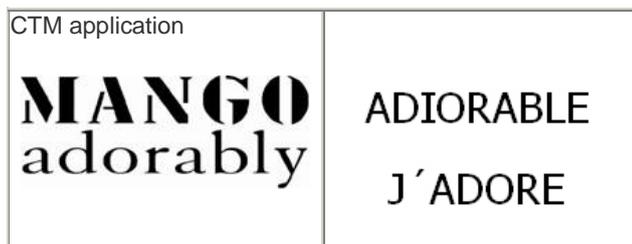
Superleggera

The sign which translates into "super light" had been applied for for a range of goods and services in classes 12, 18, 25, 37, 40 and 42. It had been rejected as regards the products in classes 12, 18 and 25.

Mango Adorably : T-308/08 – Office response filed (FR).

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

The action has been initiated against a decision of the 2nd Board of 23.5.2008 in Case R 1162/2007-2 relating to CTM application 4.119.996, Mango Adorably (figurative mark), which had been applied for for a range of cosmetics in class 3.



It had been opposed on the basis of several earlier rights as shown above, registered also for class 3 products. The opposition had been rejected on the grounds that the marks are dissimilar.

Ultimate HD : T-463/08 – Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The case has been brought against a decision of the 4th Board of 13.8.2008 in Case R 0488/2008-4 relating to CTM application 6.092.241, DYNAMIC HD, word, which had, *inter alia*, been applied for services in classes 35, 38, 41 and 42, relating to data processing, telecommunication, multimedia entertainment and digital data processing and storing. It had, in this respect, been rejected on the grounds that HD means High Definition, and Dynamic would convey no more than what it says, namely a "quality indication" of the services and related goods.

Thinking Ahead : T-473/08 – Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness.

The case has been initiated against a decision of the 2nd Board of 14.8.2008 in Case R 0728/2008-2 concerning CTM application 5.744.495, word THINKING AHEAD, which had been applied *inter alia* for services in class 41: education; providing of training; entertainment; sporting and cultural activities; education services, namely, providing courses of

instruction at the post-secondary level. These services had been rejected on the ground that the relevant English-speaking public would perceive the expression THINKING AHEAD as a laudatory promotional message which indicates that, by participating in the educational, cultural and sports activities offered by the applicant, the consumer is preparing for the future and improving his or her life.

Botox : T-357/08 – Office response filed.

Keywords: Opposition/invalidation: earlier right with reputation. Opposition/invalidation: earlier right within Article 8(4) CTMR. Opposition/invalidation: likelihood of confusion (LOC).

The case has been brought against a decision of the 1st Board of 5.6.2008 in Case R 0865/2007-1 relating to CTM 2.782.282, BOTOCYL, word. It is registered for the following goods in class 3: perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics, in particular creams, milks, lotions, gels and powders for the face, body and hands; sun-tanning milks, gels and oils and after-sun preparations (cosmetics); make-up preparations; shampoos; gels, mousses and balms, preparations in aerosol form for hairdressing and haircare; hair lacquers; hair-colouring and hair-decolorizing preparations; permanent waving and curling preparations and essential oils.



A request for a declaration of invalidity was filed, based on earlier rights, claimed to be reputed, and which are all registered in respect of pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain, in class 5. By its decision, the cancellation division dismissed the application for a declaration of invalidity. In its decision at issue here, the Board upheld the appeal, annulled the contested decision and gave the following reasons for its decision:

On Article 8(1)(b) CTMR: The Board dismissed the appeal as far as the application for a declaration of invalidity was based on Article 52(1)(a) CTMR read in combination with Article 8(1)(b) CTMR. It considered that there was a low degree of similarity between the CTM holder's 'cosmetics among other creams' and the requestor's 'pharmaceutical preparations for the treatment of wrinkles'. The remaining goods were found to be dissimilar. As regards the marks, the differences affecting the endings of the signs BOTOCYL and BOTOX allow the public to distinguish between them on the three levels of the perception.

On Article 8(5) CTMR: The earlier marks' reputation was considered substantiated in all Member States, in respect of 'pharmaceutical preparations for the treatment of wrinkles', as



a result of massive media exposure since 2000. Unlike the prefixes BOT- or BOTU-, the prefix BOTO- has no meaning in respect of the goods as it will not be perceived as referring to 'botulinum' or 'botulism'. This prefix is so uncommon that it will allow the public, be it professional or not, to establish a link between the marks. Use of the contested CTM registration BOTOCYL would take unfair advantage of the earlier marks' repute because the public will establish a link between the marks and the goods they cover. The public will no longer perceive the unique character of the earlier mark BOTOX, which was the basis of its reputation. Use of the contested CTM registration would be without due cause because the prefix BOTO- is fully distinctive and does not refer to the toxin known as 'botulinum'. Having upheld the application for a declaration of invalidity on the basis of Article 52(1)(a) CTMR read in combination with Article 8(5) CTMR, the Board did not adjudicate on Article 8(4) CTMR.

Botolist or Helena Rubinstein : T-345/08 – Office response filed.

Keywords: Opposition/invalidation: earlier right with reputation, Article 8(5) CTMR. Reputation: criteria. Earlier right: Article 8(4) CTMR. Opposition/invalidation: likelihood of confusion (LOC).

The action has been brought against a decision of the 1st Board of 28.5.2008 in Case R 0863/2007-1 relating to CTM application 2.686.392, BOTOLIST, word, for the following goods in class 3: perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics among other creams, milks, lotions, gels and powders for face, body and hands, sun-tanning and after-sun milks, gels and oils (cosmetics); make-up preparations; shampoos; gels, mousses and balms, preparations in aerosol form for hairdressing and haircare; hair lacquers, hair dyes and preparations for bleaching hair; permanent waving and curling preparations and essential oils.

It had been challenged on the basis of a request for a declaration of invalidity. The grounds for invalidity were Article 52(1)(a) CTMR read in combination with Article 8(1)(b), (4) and (5) CTMR.



The request for a declaration of invalidity was based inter alia on earlier rights in Botox (figurative mark), claimed to be reputed, and which were all registered in respect of pharmaceutical preparations for the treatment of neurological disorders, muscle dystopias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain' in class 5. By its decision of 28.3.2007, the cancellation division had dismissed the request for a declaration of invalidity. Upon subsequent appeal, the Board, overall, had upheld the appeal, mainly on the following considerations:

The Board dismissed the appeal as far as the application for a declaration of invalidity was based on Article 52(1)(a) CTMR read in combination with Article 8(1)(b) CTMR. It considered that there was a low degree of similarity between the 'cosmetics among other creams' and the 'pharmaceutical preparations for the treatment of wrinkles'. The remaining goods were found to be dissimilar. Further, the differences affecting the endings of the signs BOTOLIST and BOTOX allow the public to distinguish between them on the three levels of the perception. Given the lower degree of similarity of the 'cosmetics among other creams' and the 'pharmaceutical preparations for the treatment of wrinkles', and of the signs, there is no likelihood of confusion in the mind of a highly attentive public, notwithstanding the earlier marks' reputation.

The earlier marks' reputation was considered substantiated in all Member States, in respect of 'pharmaceutical preparations for the treatment of wrinkles', as a result of massive media exposure since 2000. Unlike the prefixes BOT- or BOTU-, the prefix BOTO- has no meaning in respect of the goods as it will not be perceived as referring to 'botulinum' or 'botulism'. This prefix is so uncommon that it will allow the public, be it professional or not, to establish a link between the marks. Use of the contested CTM BOTOLIST would take unfair advantage of the earlier marks' repute because the public will establish a link between the marks and the goods they cover. The public will no longer perceive the unique character of the earlier mark BOTOX, which was the basis of its reputation. Use of the contested CTM registration would be without due cause because the prefix BOTO- is fully distinctive and does not refer to the toxin known as 'botulinum'. Having upheld the request for a declaration of invalidity on the basis of Article 52(1)(a) CTMR read in combination with Article 8(5) CTMR, the Board did not adjudicate on Article 8(4) CTMR.

Line/Line : T-449/08 – Office response filed (DE).

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

The case has been brought against a decision of the 4th Board of 18.7.2008 in Case R 0759/2007-4 relating to CTM application 3.316.908, Line (figurative mark), which had been applied for in class 11.



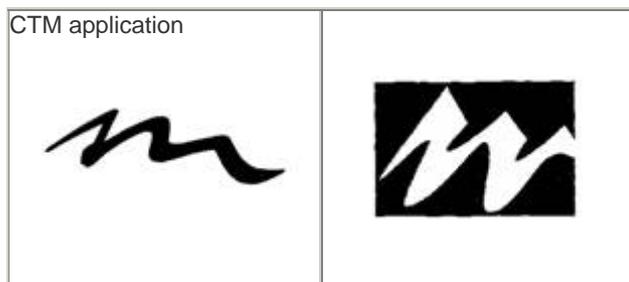


It had been opposed *inter alia* on the basis of an earlier right in Line (figurative mark), registered in class 37, for maintenance and the cleaning of luminous signs. The opposition had been allowed except for one specific good in the CTM application.

Wavy Line : T-379/08 – Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action has been initiated against a decision of the 4 th Board of 8.7.2008 in Case R 0859/2007-4 relating to CTM application 4.081.352, a black wavy line (figurative mark). It had been applied for for a range of products in classes 3, 18 and 25.

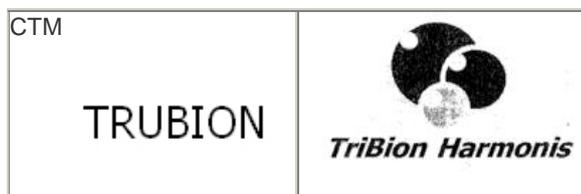


It had been challenged on the basis of an international registration, a wavy white line against a black background (as shown above) which covers products in the same classes. The opposition had been allowed.

Tribion/Tribion : T-412/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC). LOC: comparison of goods. LOC: pharmaceutical goods. Pharmaceuticals: relevant public.

The case has been initiated against a decision of the 2nd Board of 3.7.2008 in Case R 1605/2007-2 concerning CTM application 3.668.977, word TRIBION.



The CTM had been applied in classes 5 and 42 for pharmaceutical preparations; pharmaceutical preparations for use in the fields of immunology and oncology, and for pharmaceutical drug development services. It had been opposed on the basis of Tribion Harmonis (figurative mark), registered for various goods including dietetic preparations for medical use, in class 5. The opposition had been partially upheld.

In essence, the Board held: Whether or not the relevant goods are prescription only drugs, the relevant public is composed not only of professionals, that is, doctors who prescribe the medicinal product and pharmacists who sell that

prescribed product, but also of end-users. The opponent's 'pharmaceutical preparations; pharmaceutical preparations for use in the fields of immunology and oncology' in class 5 and the CTM applicant's 'dietetic preparations for medical use' in class 5, are somewhat of a different nature, but they often share the same channels of trade and have frequently the same or complementary purpose, namely to improve the medical condition of patients, as is implicitly mentioned in the fact that the dietetic preparations are for medical use. Therefore, the goods have to be considered as being similar.

Good Life/Good Life : T-108/08 – Office rejoinder filed.

Keywords: CFI proceedings: second round of written proceedings. Opposition: earlier national right. Earlier national right challenged at the national level: impact on pending OHIM proceedings. Earlier national right/use requirement: impact of European criteria.

The action has been brought by the CTM applicant against a decision of the 2nd Board of 30.11.2007 in Case R 0298/2007-2, relating to opposition B 402 893 and to CTM application 1.709.641, word Good Life. The G&S are not in issue here. The CTM application had been opposed on the basis of an earlier Greek mark, word Good Life. Subsequently, the CTM applicant had challenged the validity of the earlier Greek trade mark before the national authorities (i.e. the Greek Administrative Trademarks Committee) on the ground that it had not been used. The Greek Administrative Trademarks Committee then had ruled against the plaintiff, stating that the earlier mark had been in use in Greece. Instead of challenging the national decision before the Greek authorities, the plaintiff had reopened the same issue (lack of use) before the Office. The opposition had been allowed. The Board had taken the view that "under Council Directive of 21 December 1988 (...), the rules concerning the obligation to use the mark in national laws are equivalent to the corresponding rules under the CTMR. Therefore, the jurisprudence of the European Courts as to what can be considered as being genuine use is relevant for both systems".

Clearwifi : T-399/08 – Office response filed.

Keywords: Examination proceedings: IR part. IR part: limitation of the list of G&S before the OHIM. Absolute



grounds for refusal: distinctiveness.

The action has been brought against a decision of the 1st Board of 30.6.2008 in Case R 0706/2008-1 concerning international trade mark registration W00.934.594, word mark CLEARWIFI. The IR mark covers services in class 38: telecommunications services, namely providing hi-speed access to computer and communication networks, and the



electronic transmission of voice, video and data via computer and communication networks. The examiner had issued a notification of *ex officio* provisional refusal of protection of the international trade mark in whole pursuant to Article 5 of the Madrid Protocol and Rule 113 CTMIR, as the mark lacks distinctive character under Article 7(1)(b) CTMR and is descriptive of the services concerned under Article 7(1)(c) CTMR, since it conveys the notion to the average consumer that the services of the application are “telecommunication services providing a wireless and free from contamination access to the internet”.

The applicant had replied, noting that ‘contamination’ (i.e. the existence of polluting substances in the atmosphere) is not known to negatively affect access to the Internet and that the adjective ‘clear’ makes little sense in combination with ‘wifi’ (which uses radio waves) since it is used in common parlance to describe a property of things, like water. The applicant also reported results of searches made on the Internet about occurrences such as ‘clear wifi’ and ‘contaminated wifi’ in order to prove that its mark is not used in a generic sense. It concluded that CLEARWIFI, as a neologism, has no clear meaning and does not describe directly and specifically the kind or quality of the services.

Eventually, the examiner had rejected the application pursuant to Article 7(1)(b) and 7(1)(c) CTMR. She considered that ‘contamination’ was an appropriate notion in the present context because it is not only applicable to substances like water but also the air may be contaminated. Furthermore, one also speaks of “noise contamination” and waves may be contaminated, for instance the so-called interferences which disturb a radio or television transmission, or a telephone conversation. Since wireless connections are made through radio waves, the word ‘clear’ will be perceived by the relevant consumer as ‘free from contamination’. The examiner also rejected the applicant’s argument that the combination of words ‘clear’ and ‘wifi’ does not appear to be used in trade.

In its appeal, the CTM applicant sought to limit the list of G&S. The Board dismissed the appeal, holding, first, that limitations to the list of G&S covered by an international registration may not be submitted before the Office but must be recorded at the International Bureau. On substance, it confirmed the examiner’s position.

1.2.3.TV : T-440/08 – Office response filed (DE).

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

The case has been initiated against a decision of the 1 st Board of 30.6.2008 in Case R 1076/2007-1 relating to CTM application “1.2.3.TV” which had been applied for for a range of services in classes 35, 38 and 41.

It had been opposed on the basis of an earlier right in figurative trade mark “1.2.3.” registered for a range of goods and services in classes 3, 5, 9, 12, 14, 16, 18, 21, 24-30, 32, 35, 38 and 41. The opposition had been allowed in respect of the services covered by the CTM application.

Metromeet/Metro : T-407/08 – Office response filed (DE).

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

The action has been brought against a decision of the 1 st Board of 12.6.2008 in Case R 0387/2007-1 relating to CTM application 3.740.529, Metromeet (figurative mark), which had been applied for for a range of goods and services in classes 9, 16, 35 and 41.



It had been opposed on the basis of two earlier marks, namely Metro (figurative mark) and “meeting metro”, registered in classes 9, 16, 35 and 41. Whereas the opposition division had allowed the opposition based on the word mark, the Board had rejected it on the ground that the sign applied for would convey, for a specialised public, something relating to “metrology”, the science of measurement.

Enercon/Energol : T-400/08 – Office response filed.

Keywords: Opposition: mark with reputation (evidence). Opposition: likelihood of confusion (LOC). LOC: comparison of goods.

The case had been brought against a decision of the 4th Board of 14.7.2008 in case R 957/2006-4, relating to CTM application 3.326.03, ENERCON, word. The application had been filed in respect of, among others, the following goods in classes 1, 2 and 4: chemicals used in scientific research in the field of regenerative energy production; fuel-saving preparations, solvents for varnishes and lacquers; paints, primers, engraving inks, fireproof paints; colours; fixatives; thinners; lacquers; preservatives against rust, metal protection preparations and other preservatives, all in particular for coating wind energy plants and water treatment installations, and in class 4 industrial oils and oils for paints; lubricants, lubricating oils and greases; dust removing preparations, in particular dust absorbing, wetting and binding compositions; fuels and illuminants; candles, wicks.

It had been partially opposed by BP p.l.c. on the basis of ENERGOL, word, which covers, in classes 1 and 4: chemical products for use in industry excluding cleaning preparations, products for cleaning and de-oiling of metal and porcelain, and stearins for use in the manufacture of pharmaceuticals, foodstuffs, cosmetics and the fermentation process; fluids for use in hydraulic circuits and in hydraulically-operated



equipment; fluids for use in metal cutting and in operating machinery; transmission fluids; oils for use in manufacturing processes, and lubricating oils and greases; industrial oils and greases; lubricants; fuels; additives (in the nature of oils) for lubricants and fuels; oils and spirits for lighting, heating and lubrication; petroleum products; transmission oils. Furthermore, the opponent invoked reputation.

The opposition had been partially allowed, namely apart from 'dust removing preparations, in particular dust absorbing, wetting and binding compositions; candles, wicks' in class 4, which were found to be dissimilar to the goods in the earlier mark. The reputation claim had been rejected due to lack of sufficient evidence.

NEW DECISIONS FROM THE BOARDS OF APPEAL

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

Opposition proceedings – Article 8(4) CTMR

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

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

R 513/2008-1 – BASMALI LONG GRAIN RICE RIZ LONG DE LUXE/ BASMATI - The wording used in Article 8 CTMR suggests that an opposition may only be filed by the 'proprietor' of another right. The opponent submitted abundant material in support of its assertions but absolutely nothing in support of its claim that (i) 'BASMATI' is a 'trade mark' and (ii) it has proprietary rights on it. However, the evidence submitted by the opponent indicates that 'BASMATI' is not, in fact, a trade mark but the generic designation for a type of rice grown in parts of India and Pakistan. Case-law on passing off requires, as a precondition, proprietorship of goodwill, not necessarily of an earlier right. Article 8(4) CTMR requires, as a precondition, proprietorship of an earlier right, not necessarily of goodwill. Since the opponent did not substantiate its claim of ownership on the Basmati name, the opposition is not well-founded.

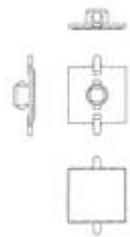
Absolute grounds of refusal – Article 7 CTMR

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

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

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

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



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

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

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

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

applied for differs from the customary range of shapes for adhesive fastening element carriers or surface adhesive fastening element carriers.

The appeal must therefore be dismissed.

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

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

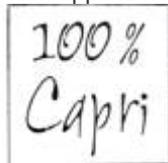
Decision of the First Board of Appeal of 2 April 2009 in Case R 1148/2008-1 – CAPRI [Fig. Mark]/100% CAPRI [Fig. Mark] (Italian)

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

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



CTM applied for



earlier IT right

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

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

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

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

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

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

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

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

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

The expression 'BEHAVIOURAL INDEXING' was considered as grammatically correct in structure and intellectually meaningful with respect to the goods and services applied for. The expression plainly informs the relevant public that the goods and services concern the compilation of an index that takes into account human, social and cognitive factors (for



example, overconfidence, over optimism, mimicry, risk aversion, emotional attachment to assets, etc), that affect key issues in the financial management of entities and investment decisions concerning matters such as, prices, returns and allocation of resources. Indeed, the applicant itself concedes that the goods and services in the application concern gathering data by reviewing and evaluating the actions of investors in the marketplace and using cognitive errors (mental mistakes) made by investors due to bias.

Consequently, the CTM applied for was rejected.