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Editorial Team:

Reg Rea, David García, Ian Harrington

Contributors to this edition:

James Nurton, Wouter Verburg, Cayetana Borrego, Herbert Meister, Nicolas Vigneron, Nicasio Agustina, José Izquierdo, Christoph Bartos, Alexandra Apostolakis, Nathan Wajzman and Mikael Wesslegard

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

Do global businesses need global trade mark solutions?

The need for international cooperation on trade mark issues is widely agreed, but it has proved difficult so far to make further progress in an area that is governed by a range of sometimes conflicting economic and jurisdictional interests.

To move things forward, OHIM President Wubbo de Boer has called for a major effort to cut the red tape facing businesses attempting to protect their intellectual properties worldwide.

Speaking at the International Trademark Association conference in Sydney Australia earlier this month, he invited the world's ten biggest trade mark organisations to get round the table with the ten biggest international filing companies to thrash out a workable solution.

He offered to host a working conference to take the "first exploratory steps" towards a more transparent and less bureaucratic world trade mark system. The reason being that trade mark owners increasingly dealt with more than one jurisdiction and would like to see their applications dealt with in the same way, with the same basic information demanded.

The background to this latest initiative does show a history of progress in some areas. International trade mark law has been in place through the various WIPO instruments and TRIPS for many years and the minimum guarantees that national registration must secure are provided for. In addition, an international registration system already exists and is heavily used in an increasing number of countries, and classification issues had been dealt with. Nevertheless, significant differences in practice remain, particularly between the US and the rest of the world.

Pointing to some of the key differences remaining in his speech in Sydney, OHIM's President said: "This is one area in which harmonization is really needed. International businesses need a consistent approach from international trade mark offices".

The "treaty approach" was one possible solution, as was the creation of regional systems such as the Community trade mark administered by OHIM or the Benelux approach. However, there was also the "pragmatic office approach" illustrated by OHIM's liaison meetings with EU member states, exchanges of personnel, and cooperative efforts on training. Meanwhile, on the international scene OHIM was making efforts to harmonize classifications via the Trilateral meetings between Japan, the US and the EU.

He said that the key to this kind of "pragmatic" progress was easy and immediate public access to the content of databases belonging to several offices. OHIM was already cooperating in two major projects in this area with the EU member states – EuroClass, which works towards common classification terminology; and EuroRegister, which is creating a common look-up of European trade marks.

The speech set out three ground-rules for progress:

- The field for harmonization should be well defined and reformers should not try to tackle 'the impossible'. The emphasis should be on issues like classification, common standards for electronic communication, or databases setting out the practice on similarity of goods and services.
- Trade mark owners should be asked to help define priority of issue.
- The methodological choice between harmonization and transparency must be explored.

"We talk a lot about 'harmonization' but I strongly believe that the key to a potential successful next step lies in transparency and openness, and better understanding of the legal situation in the various jurisdictions", the OHIM President added.

The James Nurton interview with Jean Pire, a director with the firm of GEVERS in Brussels
James Nurton is a specialist intellectual property journalist from the UK and is currently the managing editor of the leading global magazine for IP owners, *Managing Intellectual Property*.

This month James Nurton talks to trade mark and design attorney Jean Pire about filing Community trade marks and the law on genuine use – a subject on which he is moderating a workshop at the INTA Annual Meeting in Berlin in May.

How long have you been working in trade marks?

A long time! When the 1971 Benelux Trademark law came into force, it gave trade mark owners and applicants one year to re-file any existing rights they had.



About 110 000 applications confirming earlier rights were filed, most of them between October and December. There was a law firm named GEVERS Cie looking for some additional help and I worked there as a student preparing applications. We filed 25 000 applications using an IBM 360 computer shared with Compumark.

I found it fun and diverse, and began to work in the trade mark field as counsel to Belgian companies and gradually with large international portfolios.

In 1995 GEVERS asked me to move to the US, initially for one year, as nobody was aware of the Community trade mark system, which was about to be launched. We organised dog-and-pony shows for four weeks for American businesses all over the US. Parallel to this I had six to eight individual meetings a day with US clients. I ended up staying for three years, spending about 60% to 70% of my time travelling.

We explained all about the Community system, including the benefits and caveats. For example, we considered how the second language was a trap that could be embraced. By filing in Dutch and designating English as the second language, you could virtually determine that English would be the language of any future proceedings, and not leave the choice to the other party. This was a huge benefit to US businesses, as they could follow the arguments in plain English.

Did you file a lot of CTM applications?

We had about 2 600 applications in stock when it started. So we issued a cheque for 2 600 000 ecu [forerunner of the euro] covering the three basic classes for each application. That must be the biggest cheque ever cashed at a trade mark office.

About half our work now is for Belgian clients, and the other half for clients in the rest of the world, many of them in the US. We often visit US clients and they look for services that are responsive, clear and to-the-point. Pricing is also extremely important.

What is the most unusual mark you have handled?

We filed a CTM for a single shade, lilac, for the Milka chocolate. We received a refusal letter so I sent some samples in 15 thick binders with advertising sales from almost all 15 countries. We then visited Alicante with the client to explain what was in the binders – which as far as I know is one of the only informal meetings held in Alicante over a CTM application.

We could show use in most markets, but there were no sales in Greece or Sweden for commercial reasons. The examiner wanted us to prove use in each and every country, thus we pleaded the “market approach”. The meeting lasted four hours. Afterwards, I received a call from the examiner asking me for a Pantone colour, but we didn't give one, and the next thing we knew the application was published.

What do you think of OHIM?

OHIM does an extraordinary job to become a paperless office. Globally the office performs very well and is very proactive in reducing the prosecution time. However, on the substance there are still some inconsistencies.

One criticism I have is about claims for seniority. We have filed more than 10 000 claims of seniority, and some of these have been accepted without being documented. If the old

applications in the national offices are not renewed, then the offices might destroy the files and you can't regain that paper trail. So when you need to prove your seniority claim you find that it has not been documented.

It's hypothetical but it could happen. There should be some sort of system where national offices, rather than destroy the file, send it to OHIM, which could keep it digitally.

What about oppositions and appeals?

Statistically, 20% of all CTM applications are opposed; this means that with all the CTMs we have in charge we have been prosecuting over 6 000 oppositions. Our experience is that the opposition division used to do a very good job, being very consistent, while the Appeal Boards were very inconsistent. Today, it's the reverse: there is more consistency in the Boards but a lot of inconsistency in the opposition division.

Some of our concerns about oppositions include admissibility checks; for example in one recent opposition the outcome was determined based on one trade mark and the whole decision was based on this mark without even considering the other marks where other grounds were invoked. We hope that this was an exception and will not become the general practice.

Another concern is that in some cases the examiners are very strict with granting extension and in other case they are very lenient. At the same time, it can take the office several months before they forward documents from the other party.

Do you use electronic filing?

Personally not, but my office uses both e-filing and e-renewal. Our back office does all the CTM filing and renewals and notice of oppositions, while the arguments are prepared by ourselves and the associates. The trend we are seeing is fewer applications but more mergers and acquisitions, litigation, conflicts and opinion searches for all of the EU – so that is the work I concentrate on.

Will your clients be using the new optional search reports?

Why would you pay almost €200 more and know that it would delay your application? National search reports will remain inconsistent, and the same marks may not be picked up in different jurisdictions. Instead we are encouraging our clients to conduct comprehensive searches prior to filing their mark. In our private search reports, we use the same algorithm for all our databases to ensure consistency.

Do you see much demand for Community designs?

As designs are normally under the umbrella of patent law in the US, many US entities have yet to discover designs according to the EU. We recommend designs for shapes that are not accepted by the Office, as long as they fulfil the criteria. There seems to be a political debate in the EU about whether you can protect shape marks and what the consumer thinks when buying a product. This needs to be addressed, but the courts keep repeating the earlier case law rejecting the 3D marks and disregarding post-sale recognition. It is very strange.

You are taking part in a workshop on genuine use. What are the main issues here?

The big question is: will use in one member state be enough to keep a CTM valid? The Regulation confirms that there must



be genuine use in the EU, and at the time the Commission stated that use in one country (when there were 15 countries) would be enough. Today there are 27 countries and some of them are very small – less than the size of a city like Brussels or Stockholm. So is use just in Malta (for example) use in the entire Community?

We have two decisions – *Ansul* and *La Mer* – in which the ECJ has provided some guidance but no figures to indicate the minimum threshold.

The question is: if you are only using your mark in Malta, why do you have a Community trade mark? That is surely unfair for other traders. A regional approach has been suggested instead, so that if you use your mark in three or four member states it will be fine, but use in one country will not always be enough.

But it depends on the market, and the product. For example, if an aircraft manufacturer is using his mark in Germany that might be use enough. But if you are using your mark for cookies in just one store in Malta, that might be sufficient use to convert the mark to Malta alone but not to maintain a whole CTM registration, which seems to be the intention of the legislators when drafting the Regulation.

For sure, use is something that will be debated more in the future. I expect we will in time move towards a market approach, rather than a single country approach. There is a huge difference between 15 and 27 states, and there may be even more states in the future.

Community Trade Mark “EURO 2008” CTM upheld

OHIM's has rejected an application to cancel the “EURO 2008” CTM registered by the football body UEFA for a wide range of goods and services.

The CTM, which is associated with the European Football Championships, was challenged by German company Julius Erdmann Beteiligungsgesellschaft mbh on the basis of absolute grounds, namely Article 7(1) (b) and (c) in conjunction with Article 51 CTMR.

The applicant claimed that the term “EURO” indicated the European currency with which goods and services could be paid for in Europe. This applied also to the claimed goods and services, which made the term descriptive with regards to the goods and services covered by the CTM. Furthermore, an Internet search revealed the existence of millions of entries referring to the word “EURO”.

In addition, the applicant argued that the numeral “2008” referred to the year 2008, which made it equally descriptive. In this case too, an Internet search revealed the existence of millions of hits.

The applicant therefore argued that the CTM was descriptive and devoid of distinctive character for all the claimed goods and services.

The CTM proprietor pointed out that while the term “EURO” and the numeral “2008”, if taken separately, were devoid of distinctive character, this was not the case of the wording “EURO 2008” considered as a whole, which is merely suggestive.

UEFA also argued that the CTM could not be regarded as a descriptive indication, since the combined term did not provide any information concerning the inherent features of the claimed goods and services.

UEFA went on to say that an Internet search showed that the wording “EURO 2008” did have a distinctive character and appeared to be used only in conjunction with the sporting event which it organised, the European Football Championship, which was considered to be the second most important competition among national teams after the FIFA World Cup. The competition was held every four years and was usually named by combining the word “EURO” and the year in which the championship was held.

OHIM's Cancellation Division, rejecting the invalidity application, said that in the light of the evidence before it, the Office did not consider that the CTM had been registered in breach of Article 7(1)(b) and (c) CTMR. Article 51(1)(a) CTMR was not applicable.

In particular, and in view of the multiple meanings which could be attributed to the combination “EURO 2008”, the Cancellation Division held that a mental effort would be required by the consumer to interpret the meaning of the mark, notwithstanding the fact that, following such mental effort, he would not be capable of giving to it a precise sense which clearly and directly linked the sign to the products and services claimed.

The Division found that the CTM was not descriptive of the goods and services covered and that the expression “EURO 2008”, considered as a whole was not devoid of distinctive character.

The decision pointed to the following factual circumstances put forward by UEFA:

- UEFA usually names the football championships it organises by combining the word EURO and the year in which the championship is held.
- Football is the most popular sport in Europe.
- High audience levels were reached in some EU countries by the final match of the previous edition of the European Championship (EURO 2004 in Portugal).
- There is a previous qualifying draw that is given wide media coverage.

The Office considered that all these elements clearly demonstrated that the wording “EURO 2008” was not used in commerce as a generic expression but as an indication of a specific commercial origin.



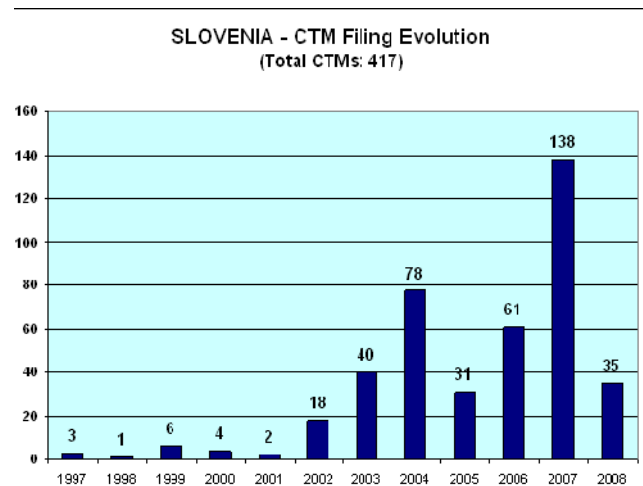
The decision concluded that in the light of the above, the mark was also correctly considered acceptable for registration pursuant to the conditions set out in Article 7(1)(b) CTMR, and the Office was convinced that it was "prima facie" distinctive and not descriptive with regards to the products and services claimed.

Country overview: Slovenia & the Community Trade Mark



Slovenia joined the EU in 2004, and has a population of 2m. GDP growth was 1.6 % higher in the third quarter of 2007 compared with the previous quarter. The service sector accounts for 64% of GDP, followed by industry (34%) and agriculture (2%).

The first few Slovenian CTMs were filed in 1997, but interest in CTMs remained quite low until last year when there were 138 filings – double the number in the previous year. To date 417 Slovenian CTMs have been filed and so far this year, there have been 35.

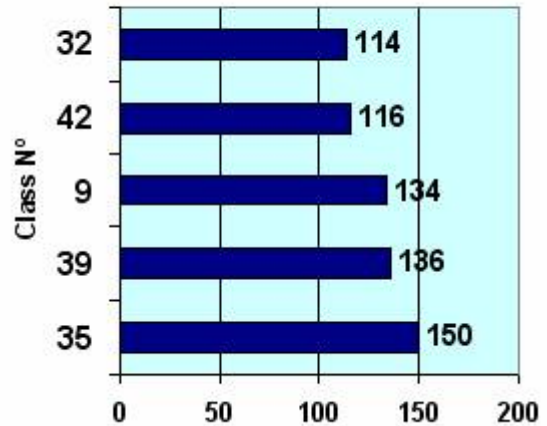


| | | | | |
|-------------|-------------------|------------|---------------|--------------|
| Word | Figurative | 3-D | Colour | Other |
| 39.71 % | 53.83 % | 5.02 % | 1.44 % | 0.00 % |

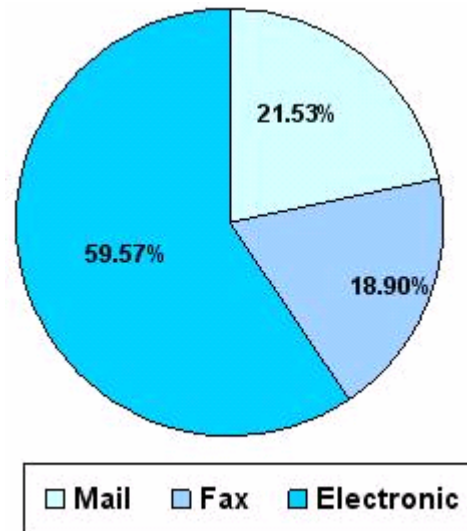
Figurative marks are the most popular with Slovenian enterprises and account for almost 54% of applications, followed by word-based marks (40%).

The most popular goods and services applied for by Slovenian businesses are in classes 35, 39 and 9.

SLOVENIA - Top Classes Filed (Nice)



E-filing is the most popular route for Slovenian businesses and their intermediaries, but mail remains popular. This year, including International Registrations, 60% of all CTM filings were made electronically, 22% came by mail and almost 19% by fax.



Top 10 Slovenian-based owners by number of CTMs filed

| Company | CTMs |
|---|------|
| Pivovarna Laško d.d. | 44 |
| Pivovarna Union d.d. | 26 |
| Telekom Slovenije d.d. | 21 |
| RADENSKA MIRAL Podjetje za poslovne storitve in svetovanje Radenci d.o.o. | 18 |
| ULTRA d.o.o. Proizvodnja elektronskih naprav | 12 |
| FRUCTAL zivilska industrija D.D. | 7 |
| Seltron d.o.o. | 7 |
| HIT hoteli, igralnice, turizem d.d. Nova Gorica | 6 |
| Zadravec | 6 |
| Geodetski zavod Slovenije d.d. | 5 |

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

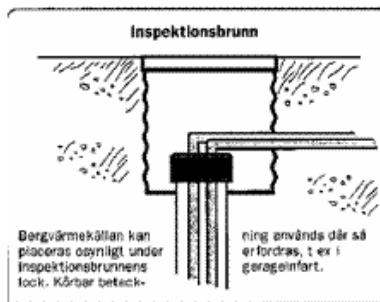
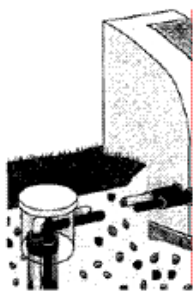
| Representative | CTMs |
|-----------------------------------|------|
| Marn | 145 |
| PATENTNA PISARNA d.o.o. Ljubljana | 21 |
| CURELL SUÑOL | 17 |
| Premru | 17 |
| BECKER KURIG STRAUS | 13 |
| Borstar | 13 |
| Drnovsek | 10 |
| ITEM D.O.O. | 9 |
| CREATOOR d.o.o. | 8 |
| ZIVKO MIJATOVIC & PARTNERS | 5 |

Community Design**Recent decisions on invalidity of Registered Community Designs****Rings for sealing**

On 20 February 2008, the first decision declaring the invalidity of a design of a component was issued. The application was based on the grounds of Art. 25(1)(b) CDR in connection with Articles 4, 5 & 6, namely, the request to declare the RCD invalid because it satisfies neither the visibility criterion for components of complex products nor the novelty and individual character criteria.

The RCD was for a ring for sealing an energy well. The applicant explained that the ring was part of a complex product, a heat pump system. Furthermore, the applicant proved the prior disclosure of another ring which destroyed the novelty and/or individual character of the RCD.

The Design Department's Invalidity Division considered that the sealing rings incorporating the RCD were component parts of a complex product, namely heat pump systems, and that they were invisible during normal use of the heat pump systems because they were always located below ground. The sealing rings remain invisible even where they are used in a so-called "inspection well", because the inspection well is closed by a lid and during normal use is not visible for security reasons. The claim by the holder that there is a normal use where the inspection well remains open was not supported by evidence, since the documentation submitted to support this argument actually showed a closed lid, not an open one.


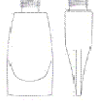



The RCD was declared invalid on the ground of Article 25(1)(b) CDR, since it was not considered to be new and to have individual character, because the component part (sealing rings) incorporating the RCD did not remain visible during normal use of the complex product (heat pump system).

Boxes and containers for cosmetics – citation of a prior RCD itself declared invalid

In recent weeks, different decisions related to designs for containers of cosmetics have been issued by the Invalidity Division. These cases illustrate different issues, from proof of disclosure to the assessment of individual character.

On 28 February 2008, two applications for declaration of invalidity were rejected. Both cases were similar in facts and findings, differing only with regards to the designs at stake.

| Challenged RCD | Outcome | Prior designs |
|---|-----------------------------|---|
|  RCD 000180997-0002 | Application rejected |  RCD 000169818-0001 Ground: Art. 25(2)(d) |
| | |  US design patents Ground: Art. 25(2)(b) |


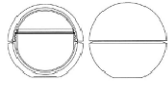
The cases show, for the first time, what happens when the prior design which is invoked against a RCD is not protected itself, and the invalidity ground to be applied is Article 25(2)(d) CDR. This provision establishes the invalidity of a RCD when in conflict with a design disclosed after the challenged RCD, but protected from an earlier date as a Community or national registered design.

The key issue was that the RCD was itself declared invalid by the Invalidity Division. This decision was endorsed by the 3rd Board of Appeal (Decision 09/11/07 - R 103/2007-3 – Botellas). Once this decision became final, the invoked RCD was deemed not to have had any effect pursuant to Article 26(1) CDR. As a consequence, the RCD was not "protected" as a RCD and therefore, the ground of invalidity under Article 25(1)(d) CDR was not founded.




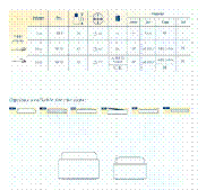

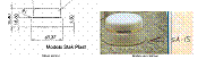
The Invalidity Division rejected the application, after having examined the other grounds (lack of novelty and individual character), based on the prior US design patents. The disclosure of US design patents constitutes an act of disclosure under Article 7 CDR, as the Invalidity Division had held in previous decisions and has been endorsed by the Board of Appeal (R 103/2007-3 – Botellas).


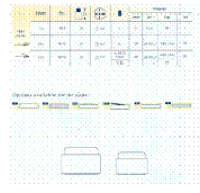

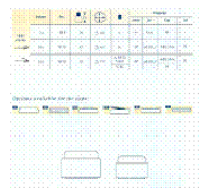
On 28 February 2008, another decision on cosmetic containers was delivered. The invalidity request was rejected.

| Challenged RCD | Outcome | Prior design |
|---|-----------------------------|--|
|  RCD 000726831-0001 | Application rejected |  RCD 000295316-0001 Ground: Art. 25(2)(b) |

The Invalidity decision considered that the “lack of individual character” ground was not founded. While both designs share the outward appearance of the whole of a container, based on a spherical shape body composed of two halves, standing on a support base, they differ in the material of the spherical body (transparent in the challenged RCD), the shape of the interior upper half of the container, the shape of the lower internal vase, the covering of the interior vase and the closing mechanism.

On 20 February 2008, a series of cosmetic containers (jars) were the subject of different decisions. The four designs were filed as part of the same multiple application. Two jars were declared invalid for lack of individual character, two applications were rejected. This proves that each RCD in a multiple application has an independent legal “life” and that the fact of declaring one invalid does not result in others being so.

| Challenged RCD | Outcome | Prior design |
|---|-----------------------------|---|
|  RCD 000321302-0002 | RCD declared invalid |  Prior design disclosed in a catalogue Ground: Art. 25(2)(b) |
|  RCD 000321302-0003 | Application rejected |  Prior design disclosed in a catalogue Ground: Art. 25(2)(b) |

| | | |
|--|-----------------------------|---|
|  RCD 000321302-0004 | RCD declared invalid |  Prior design disclosed in a catalogue Ground: Art. 25(2)(b) |
|  RCD 000321302-0006 | Application rejected |  Prior design disclosed in a catalogue Ground: Art. 25(2)(b) |

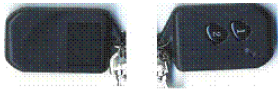

From these decisions, it is worth noting the following: the combination of a catalogue with an invoice serves to prove prior disclosure, particularly when the catalogue does not have a clear date in its front page. In this case, the catalogue was not of the kind that presents in the cover page the terms “Collection 2000” or similar. The only date that appeared in the catalogue was a date of printing and a warning notice that the company whose catalogue was being disclosed was to be moving to new premises within months. Both chronological references (date of printing and date of removal) were sufficient to establish a timeline. Within this timeline, there was evidence of sales of products referred to in the catalogue having taken place before the filing date of the RCD. When the evidence of sales was not provided (as in Case ICD 4513), the catalogue was found not be sufficient.

A second issue worth mentioning is that the filing of several designs in a multiple application means that, at the moment of filing, none of the designs implies an obstacle for the novelty or individual character of the others. This is self-evident. If both the challenged RCD and the invoked RCD are published at the same date, there is no conflict from a novelty/individual character point of view.

Remote controls

On 26 February 2008, the Invalidity Division declared invalid the design for a remote control.



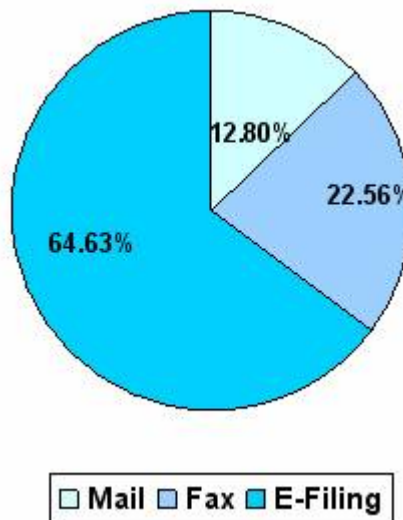
| Challenged RCD | Prior design |
|---|--|
|  <p>RCD 000646690-0002</p> |  <p>Prior design disclosed in Internet site Ground: Art. 25(2)(b)</p> |

The case illustrates the way a prior disclosure may be proven by use of an Internet site. The applicant produced a notarised statement issued by a public notary as to the content of a website on a given date in 2007. The statement certified that the website showed the invoked prior design and an indication that the image was uploaded in 2004 into the website. The Division considered that this constituted prima facie evidence of the prior disclosure in 2004. The holder did not produce sufficient evidence to overturn such finding. Furthermore, the prima facie evidence was further supported by an invoice proving the sales of the prior design, since the reference in the invoice and in the web were the same. The challenged design was declared void for lack of novelty.

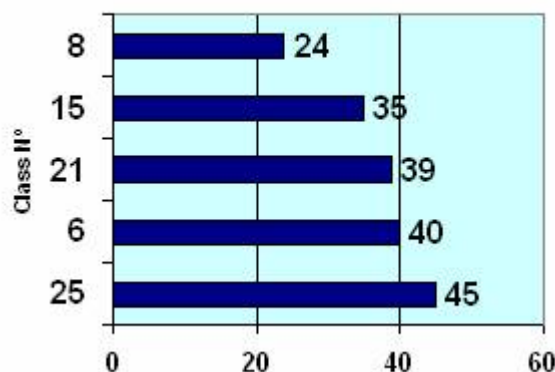
Country overview: Slovenia & the Registered Community Design

The first few Slovenian filings of RCDs were made 2003 and altogether there have been a total of just 328. Last year there were 101 filings, with 15 in 2008 to date.

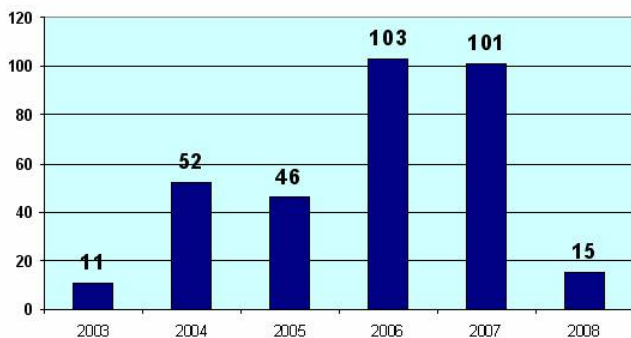
The most popular classes for design owners are 25, 6 and 21. The most popular filing route for Slovenian owners is electronic, with almost two-thirds of applications coming via the Internet. Fax is the second most popular route for design filings, accounting for around 23% of the total, with mail at 13%.



SLOVENIA - Top Classes Filed (Locarno)



SLOVENIA - RCD Filing Evolution



Top 10 Slovenian-based owners by number of RCDs filed

| Owner | RCDs |
|---|------|
| Inotherm D.O.O | 19 |
| POEKAJ d.o.o. | 16 |
| GORENJE GOSPODINJSKI APARATI, d.d. | 14 |
| Kolektor Group d.o.o. | 13 |
| Ofentavsek | 12 |
| Gorenje d.d. | 11 |
| HAM d.o.o. | 11 |
| Beta Trencin s.r.o. | 10 |
| GORENJE, d.d. | 10 |
| Liko Industrija kovinske opreme d.d. Liboje | 10 |



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

| Representative | RCDs |
|-----------------------------------|------|
| PATENTNA PISARNA d.o.o. Ljubljana | 87 |
| Pipan | 45 |
| CURELL SUÑOL | 23 |
| Marn | 19 |
| INVENTIO. D. O. O. | 17 |
| Borstar | 13 |
| GRÄTTINGER & PARTNER | 13 |
| Eapkova | 10 |
| MARK-INVENTA CO., LTD. | 10 |
| PATENTNI BIRO AF d.o.o. | 9 |

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ECJ Preliminary Rulings

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ECJ Preliminary Rulings: Developments in pending cases

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A-2: ECJ: Developments in pending cases

Pure Digital: C-542/07- P - Appeal from T-461/04 - Office response filed.

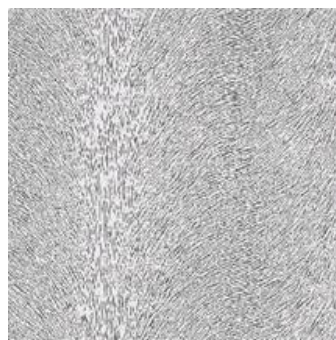
Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: acquired on the market.

The case is an appeal from the decision of the 3rd Chamber of the CFI of 20.9.2007 in Case T-461/04 relating to the CTM application "Pure Digital", word mark, which had been applied for the following goods and services: Class 9: electric and electronic apparatus for use with multi-media entertaining systems; installation apparatus for receiving, recording and displaying sound, video and digital information; digital video adapters and interactive video adapters for use with computers, video apparatus; computer hardware, software for use with multi-media and graphics applications; speakers, amplifiers, decoders, DVDs and digital radio systems; computer hand-held devices and communication devices; cards, sound cards, cartridges, tapes, discs, cassettes and other data carriers all for the recordal of data, sound and images; in-car entertainment system namely in-car navigation needs, in-car radios or graphics run on any display system in a car; parts, fittings and electronic components for all the aforesaid goods, and Class 38: telecommunication of information, computer programmes and computer and video games and programmes; electronic mail services; provision of telecommunication access to computer databases and the internet. The CTM application had been rejected on the grounds of lack of distinctiveness. The material presented in order to show acquired distinctiveness on the market had been found insufficient.

Texture of a glass surface II or Glaverbel-II: C-513/07- P - Appeal from T-141/06 - Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: design applied to the surface of the product as a figurative mark – Distinctiveness: acquired on the market.

The case is an appeal from the decision of the CFI of 12.9.2007 in Case T-141/06 by which the CFI had rejected Glaverbel's application for a figurative mark showing a design of patterned lines applied to a glass surface. The case, therefore, is also denominated "Surface with lines".



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

None



It had been applied for for the following goods in Class 19: building glass; patterned glass; glazing; glass sheets for building; glass screens and partitions, and in Class 21 for: unworked or semi-worked glass (except glass used in building); patterned glass (except glass used in building); glass sheets (except glass used in building); glass sheets for use in the manufacture of sanitary installations, showers, shower walls, shower enclosures, refrigerator shelves, glazing, double glazing, building partitions, building screens, doors, cupboard doors, furniture, and kitchen cutting boards. The application had been rejected on the grounds of lack of distinctiveness under Article 7(1)(b) and (c) CTMR. The material submitted in order to demonstrate acquired distinctiveness on the market had been rejected as insufficient.

The CTM applicant had filed an action before the CFI as far as the following goods of Class 21 are concerned: 'Patterned glass (except glass used in building); glass sheets (except glass used in building); glass sheets for use in the manufacture of showers, shower walls, shower enclosures, glazing, double glazing, building partitions, building screens, doors, cupboard doors and furniture.' Before the CFI, the plaintiff had put forward a single plea, namely that the (4th) Board had infringed Article 7(3) CTMR with the finding that it had not been proven that the sign in question had acquired a distinctive character through the use which had been made of it. The plea had been based on two arguments, namely a wrong definition of the target public and a wrong assessment of the evidence which had been submitted.

In its judgment, at issue here, the CFI had dismissed the action. As regards the determination of the target public, the CFI had stated that some of the goods in question (namely, 'patterned glass (except glass used in building)' and 'glass sheets (except glass used in building)' were not solely intended to be sold to professionals, but they were also likely to be bought and used by final consumers. Consequently, such consumers are part of the relevant public. For the remaining goods (namely 'glass sheets for use in the manufacture of showers, shower walls, shower enclosures, glazing, double glazing, building partitions, building screens, doors, cupboard doors and furniture'), it was pointed out that, even supposing that such goods are sold only to professionals, that finding is not sufficient, by itself, to warrant the conclusion that the target public is made up exclusively of professionals. End consumers may also be involved in the choice of the goods. Consequently, the CFI had concluded, as regards the plaintiff's first argument, that for all of the goods in question the target public is made up not only of professionals but also of the general public.

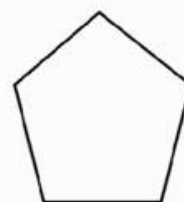
In relation to the plaintiff's second argument, the CFI had essentially concluded that the evidence did not show relevant information in respect of five countries of the Community. The CFI had gone on to say that the mark could be registered under Article 7(3) CTMR only if evidence is produced to show that it has acquired, through the use which has been made of it, distinctive character in the part of the Community in which it did not originally have such character within the meaning of Article 7(1)(b). It had also stressed that, in the case at issue, the impression which the sign, consisting of a pattern applied to the goods themselves, may create in the mind of the consumer was in principle likely to be the same throughout the Community. It was thus inferred that it was in the Community as a whole that that mark must have become

distinctive through use in order to be registerable under Article 7(3) CTMR.

Fünfeck or Device of a pentagon: C-508/07- P - Appeal from T-304/05; Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The case is an appeal from the decision of the CFI of 12.9.2007 in Case T-304/05 relating to a figurative CTM application, a pentagon, applied for wine in Class 33. It had been rejected on the grounds that it solely consists of a simple geometrical shape without any stylisation or other creative elements.



The 1st Board, in its decision of 23.5.2005 had confirmed the rejection, adding that in the wine trade consumers are used to identify the respective products by a name or any other word(s) on the respective bottle label. Absent any explanation that the relevant consumers are nonetheless able to identify the CTM applicant's products solely by the sign at issue, it held that the sign is not registerable. The CFI had confirmed these findings.

Carbonell or La Española: C-498/07-P - Appeal from T-363/04; Office response filed (ES).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: protection of the abstract concept (or image) of the earlier mark.

The case is an appeal from the decision of the CFI of 12.9.2007 in Case T-363/04 which had revoked a decision of the 4th Board of 11.5.2004 in R 1109/2000-4. The conflict had arisen between the figurative CTM application "La Española" and the earlier Carbonell trade mark(s), as set out below.





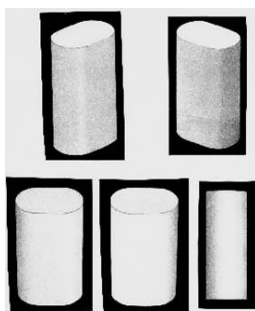
The CTM had been applied for for a range of goods in Classes 29 and 30. The invoked earlier rights are registered for olive oil. The opposition by Carbonell had been rejected by the Opposition Division in decision No 2084/2000 on the ground that the signs at issue produced a different overall visual impression, that from a phonetic point of view they had no similar elements, and that the conceptual link relating to the agricultural nature and origin of the goods was weak, which excluded any likelihood of confusion between the marks. On appeal, the 4th Board had confirmed the rejection of the opposition. It had confirmed that the visual impression produced by the marks was different overall. It had observed that the figurative elements, consisting essentially of the image of a woman seated in an olive grove had only a weak distinctive character with respect to olive oil, the effect of which was to confer the utmost importance to the word elements 'La Española' and 'Carbonell'. Finally, it had acknowledged that the Opposition Division should have given a ruling on the reputation of the earlier marks. However, it had taken the view that that assessment, together with the examination of the documents produced before the Board to establish reputation, had not been strictly necessary since one of the pre-conditions for determining LOC with a mark which has a reputation or is well-known, that is the existence of a similarity between the signs, was not satisfied.

The CFI overturned the decision of the 4th Board in R 1109/2000-4, holding that the appeal brought by the opponent before the Board was well-founded and, consequently, that the opposition was to be upheld. The ratio decidendi is contained in paragraph 111 of the CFI decision: "Finally, account should be taken of the fact that in light of the similarity of the signs at issue and the fact that the word element of the mark applied for has a weak distinctive character, the consumer may perceive the mark applied for as a sub-brand linked to the Carbonell mark designating an olive oil of a different quality from that which is the subject of that mark (see, to that effect, CONFORTFLEX, paragraph 61). As it is clear from the file, the Carbonell mark, which has been in Spain since 1904, is identified with olive oil on the Spanish market and the image that it uses automatically identifies that mark."

Shape of a packet of cigarettes: C-497/07- P – Appeal from T-140/06; Office response filed (FR).

Keywords: 3D signs: shape of the product – 3D shape of the product: distinctiveness.

The action is an appeal from a decision of the CFI of 12.9.2007 in Case T-140/06 by which the CFI had dismissed an appeal against rejection of a 3D sign as a trade mark for cigarettes.



The said appeal had been brought against a decision of the 4th Board of 24.2.2006 in R 0075/2005-4 which had held that a simple box or pack cannot serve as a source indicator for the claimed goods.

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

None

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

Lindt Goldhase: C-529/07 - Office contribution filed (internal document).

Keywords: CTM application made in bad faith, Article 51(1)(b) CTMR.

The case is a reference from the Supreme Court ("Oberster Gerichtshof) of Austria. The questions at issue have arisen in the context of infringement proceedings brought against an Austrian manufacturer of chocolate Easter bunnies wrapped in gold foil by the owner of CTM No. 1 698 885 which has a filing date of 8 June 2000 and consists of the form of a gold-colored chocolate Easter bunny with a red bow and bell. The registered Easter bunny carries the words "Lindt Goldhase" and is registered for chocolate and goods of chocolate in Class 30. Easter bunnies in a crouching position, wrapped in gold foil, have been marketed in Germany and Austria since the 1930s. Since the start of the 1950s, the claimant has manufactured Easter bunnies in a form very similar to its present trade mark, and these have been widely available in Germany even before the mid-1990s. The claimant started marketing its gold Easter bunnies in Austria in 1994. Between 2002 and 2003, the claimant's gold Easter bunnies achieved a market share in Austria of between 16.9% and 18.7%. In July 2001, around 53% of the German population associated gold Easter bunnies with the claimant, and in May 2005, this had increased to 69%. The Austrian defendant has manufactured its chocolate Easter bunnies since 1962, among other countries, in Austria, France and the Czech Republic. Since 1982, it has exhibited its products annually at food exhibitions in the Community. Other Austrian and German manufacturers have produced similar Easter bunnies in a sitting position wrapped in gold foil and, from 2000 onwards, increasingly similar competing products have appeared on the market. The claimant asked the referring court to find that the defendant has committed an infringement and to order it to cease immediately from manufacturing, offering for sale, advertising, selling, exporting and/or in other ways placing on the market within the European Union chocolate Easter bunnies wrapped in gold foil which are so similar to the Lindt gold Easter bunnies as to be likely to be confused with them. In its counterclaim, the defendant applied for the claimant's CTM to be declared invalid under Article 7(1)(c), (d) and (e) and Article 51(1)(b) CTMR. The defendant based its objection of bad faith on the fact that, for decades, competitors had been marketing Easter bunnies of a form so similar as to be capable of being confused and that the claimant had acquired the trade mark in order to exclude these competitors from the market. The first



instance court dismissed the action and granted the counterclaim. The appellate court set aside the first instance judgment and referred the case back. Both parties appealed against that decision to the Oberster Gerichtshof. By order dated 2 October 2007, the referring court decided to stay the main proceedings and referred to the Court of Justice the following questions:

“(1) Is Article 51(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p.1, 'Regulation (EC) 40/94') to be interpreted as meaning that an applicant for a Community trade mark is to be regarded as acting in bad faith where he knows, at the time of his application, that a competitor in (at least) one Member State is using the same sign, or one so similar as to be capable of being confused with it, for the same or similar goods or services, and he applies for the trade mark in order to be able to prevent that competitor from continuing to use the sign?

(2) If the first question is answered in the negative:

Is the applicant to be regarded as acting in bad faith if he applies for the trade mark in order to be able to prevent a competitor from continuing to use the sign, where, at the time he files his application, he knows or ought to know that by using an identical or similar sign for the same goods or services, or goods or services which are so similar as to be capable of being confused, the competitor has already acquired 'valuable property rights'?

(3) If either the first or the second question is answered in the affirmative:

Is bad faith excluded if the applicant's sign has already obtained a reputation with the public and is therefore protected under competition law?

Bubbles: C-533/06 - Opinion of the Advocate General.

Keywords: Council Directive 89/104/EEC ('European Trade Mark Directive' or 'TMD'): rights conferred by a trade mark, Articles 5 and 6 – Council Directive 84/450/EEC ('European Directive on Misleading and Comparative Advertising').

In this reference for a preliminary ruling, the Court of Appeal (England and Wales) puts to the ECJ questions concerning the interpretation of provisions contained in First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ('TMD') and in Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997. These questions had been raised in the context of proceedings between companies operating in the mobile phone sector, O2 Holdings Limited and O2 (UK) Limited (together 'O2'), on the one hand, and Hutchison 3G Limited ('H3G'), on the other, concerning a television advertising campaign run by the latter in the United Kingdom to promote its mobile telephone services.

For the purpose of promoting its mobile phone services in particular, O2 uses images of bubbles in various ways. It is the proprietor, *inter alia*, of trade marks consisting of the combination of the letter O and the number 2 ('the O2 trade marks') and also of two figurative trade marks, both consisting of static pictures of bubbles, registered in the United Kingdom for telecommunications apparatus and services ('the bubbles trade marks'). It is apparent from the order for reference that it is established that consumers associate images of bubbles in water (particularly against a graduated blue background) in the context of mobile phones exclusively with O2. H3G started providing mobile phone services in the United Kingdom, under the mark '3', only in March 2003 when four other providers, including O2, were well established in the market. In March 2004, H3G launched a 'pay-as-you-go' service called 'Threepay' and, in the same year, started their comparative advertising campaign using TV advertisements to make a price comparison with their competitors' services. O2 brought an action against H3G before the High Court of Justice alleging infringement of the O2 trade marks and the bubbles trade marks by a TV advertisement put out by H3G, in which the term 'O2' and moving pictures of bubbles were used, together with a stylised animated picture of a 3, and which implied essentially that the 'Threepay' service was cheaper than a similar service provided by O2.

In the course of the proceedings, O2 subsequently abandoned the claim of infringement of the O2 trade marks and accepted that the price comparison was true and that as a whole, the advertisement at issue was not misleading in any way and that, in particular, it did not suggest any form of trade connection between O2 and 3. The average member of the public would see the use of O2 and the bubbles as a reference to O2 and its imagery and realise that this was an advertisement by a trade rival, 3, claiming that its own service cost less. The action for infringement, now directed only against the use of the bubbles images in the advertisement at issue, was dismissed by a judgment of 23 March 2006 which, in essence, held that the use of the bubbles images in the advertisement fell within Article 5(1)(b) TMD, but that the advertisement complied with Article 3a(1) of Directive 84/450 and so the conditions for application of the defence referred to in Article 6(1)(b) TMD were satisfied. O2 brought an appeal against that judgment before the Court of Appeal, contending that the defence referred to did not apply. H3G, for its part, disputed the judgment in so far as it ruled that the advertisement at issue fell within Article 5(1)(b) TMD and called for O2's appeal to be dismissed. In order to settle the dispute, the Court of Appeal, by decision of 14 December 2006, considered it necessary to refer the following questions to the Court for a preliminary ruling:

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

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

(3) In particular, if there is a requirement of indispensability, does the requirement preclude any use of a sign which is not identical to the registered trade mark but is closely similar to it?"

Advocate General Mengozzi proposed the following answer:

"(1) The use of a sign identical or similar to the registered trade mark of a competitor in an advertisement which compares the characteristics of goods or services marketed by that competitor under that trade mark with the characteristics of goods or services supplied by the advertiser is covered exhaustively by Article 3a of Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising, as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997, and is not subject to the application of Article 5(1)(a) or (b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

(2) Article 3a of Directive 84/450 is not to be interpreted as permitting the use, in a comparative advertisement, of a sign identical or similar to the registered trade mark of a competitor only when that use is indispensable for the purpose of identifying the competitor or the goods or services concerned."

Wellness: C-495/07 - Office contribution filed (internal document).

Keywords: Use requirement: Articles 10(1) and 12(1) Council Directive 89/104/EEC ('European Trade Mark Directive' or 'TMD').

The case is a reference from the Supreme Patent and Trade Marks Senate ("Oberster Patent- und Markensenat") of Austria. The issue had arisen in the context of cancellation proceedings brought against the owner of the Austrian trade mark No. 127 803 "Wellness", word mark, which is registered for goods in Classes 16, 25 and 32, namely magazines, books, clothes and alcohol-free drinks (except beer). The defendant used the mark in 1999 and 2000 in relation with the sale of its textiles, in order to label an alcohol-free drink which was handed out as a gift along with the textiles sold. In this context, 3100 labels marked "WELLNESS-DRINK" were printed and 800 bottles filled with lemonade. The applicant for cancellation had claimed that the defendant's mark should be cancelled for "non-alcoholic drinks" on the grounds of non-use. It asserted that, by only trying to increase sales of its textiles, the defendant did not make sufficient and genuine use of the mark for "non-alcoholic drinks". The Cancellation Division of the Austrian Patent Office had followed that line of argument and had cancelled the trade mark for "alcohol-free drinks (except beer)". This decision had been appealed by the registered proprietor to the referring court. By order dated 26

September 2007, the referring court decided to stay the main proceedings and referred to the Court of Justice the following question:

"Are Articles 10(1) and 12(1) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (Trade Mark Directive) to be interpreted as meaning that a trade mark is being put to genuine use if it is used for goods (here: alcohol-free drinks) which the proprietor of the trade mark gives, free of charge, to purchasers of his other goods (here: textiles) after conclusion of the purchase contract?"

L'Oréal: C-487/07 - Contribution by the Office (internal document).

Keywords: Trade mark infringement: 'smell-alikes' – trade mark infringement and unfair competition (passing-off) – Council Directive 89/104/EEC ('European Trade Mark Directive' or 'TMD'): Article 5(1),(2) – Misleading Advertising Directive (84/240) as amended by the Comparative Advertising Directive (97/55): Article 3a(g),(h); now Article 4(f), (g) of Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising.

The case is a reference from the Court of Appeal (England and Wales), the factual background of which is as follows: L'Oréal SA et al. (plaintiffs) are the proprietors of United Kingdom and Community trade marks for Trésor, Miracle, Anaïs Anaïs, and Noa as word marks or figurative marks in Class 3 (perfumes). These marks have acquired market recognition and reputation in the United Kingdom in respect of luxury perfumes. Bellure N.V. et al. (defendants) are manufacturers or distributors of 'smell-alike' perfumes that are marketed under their own trade mark that is, Stitch and Creation Lamis. These perfumes are ten times cheaper than L'Oréal's and are sold through different channels of distribution. The defendants use a fragrance comparison list whereby distributors are told which original perfume (Trésor, Miracle, Anaïs Anaïs, or Noa) is the comparator for the 'smell-alike' perfume. The comparison list contains statements like: "Stitch No. 7 smells like Trésor". The claimants filed an infringement and passing-off action. The High Court of Justice held that the use of L'Oréal's trade marks in the comparison lists, both for the Stitch range and the Creation Lamis ranges amounted to an infringement under Article 5(1)(a) TMD (or, more precisely, the corresponding national provision). On appeal from the High Court, the Court of Appeal referred the following five questions for a preliminary ruling regarding the interpretation to give to Article 5(1) and (2) TMD and of Article 3a(g) and (h) of the Misleading Advertising Directive (84/240) as amended by the Comparative Advertising Directive (97/55); now Article 4(f) and (g) of Directive 2006/114/EC:

"1. Where a trader, in an advertisement for his own goods or services uses a registered trade mark owned by a competitor for the purpose of comparing the characteristics (and in particular the smell) of goods marketed by him with the characteristics (and in particular the smell) of the goods marketed by the competitor under that mark in such a way that it does not cause confusion or otherwise jeopardize the essential function of the trade mark as an indication of origin,



does his use fall within either (a) or (b) of Article 5(1) of Directive 89/104?

2. Where a trader in the course of trade uses (particularly in a comparison list) a well-known registered trade mark for the purpose of indicating a characteristic of his own product (particularly its smell) in such a way that:

(a) it does not cause any likelihood of confusion of any sort; and

(b) it does not affect the sale of the products under the well-known registered mark; and

(c) it does not jeopardize the essential function of the registered trade mark as a guarantee of origin and does not harm the reputation of that mark whether by tarnishment of its image, or dilution or in any other way; and

(d) it plays a significant role in the promotion of the trader's product does that use fall within Article 5(1)(a) of Directive 89/104?

3. In the context of Article 3a(g) of the Misleading Advertising Directive (84/240) as amended by the Comparative Advertising Directive (97/55), what is the meaning of "take unfair advantage of" and in particular where a trader in a comparison list compares his product with a product under a well-known trade mark, does he thereby take unfair advantage of the reputation of the well-known mark?

4. In the context of Article 3a(h) of the said Directive what is the meaning of "presenting goods or services as imitations or replicas" and in particular does this expression cover the case where, without in any way causing confusion or deception, a party merely truthfully says that his product has a major characteristic (smell) like that of a well-known product which is protected by a trade mark?

5. Where a trader uses a sign which is similar to a registered trade mark which has a reputation, and that sign is not confusingly similar to the trade mark, in such a way that:

(a) the essential function of the registered trade mark of providing a guarantee of origin is not impaired or put at risk;

(b) there is no tarnishing or blurring of the registered trade mark or its reputation or any risk of either of these;

(c) the trade mark owner's sales are not impaired; and

(d) the trade mark owner is not deprived of any of the reward for promotion, maintenance or enhancement of his trade mark;

(e) But the trader gets a commercial advantage from the use of his sign by reason of its similarity to the registered mark - does that use amount to the taking of "an unfair advantage" of the reputation of the registered mark within the meaning of Article 5(2) of the Trade Mark Directive?"

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

C-1: CFI Judgments and Orders

Jurado-II: T-410/07- R - Request for interim relief (rejected; decision of the CFI President of 18 February 2008 ; only in ES and FR).

Keywords: CFI proceedings: interim injunction – Interim relief against a CFI decision: Articles 242, 243 and 225(1) EC; Article 104 CFI Rules of Procedure – Interim measures: extraordinary circumstances.

A request for an interlocutory injunction (to suspend the decision of the 2nd Board of Appeal of the Office of 3 9.2007 in R 0866/2007-2 taking effect until the CFI has decided on the main proceedings) has been rejected.

Ixi: T-78/07 – Order of 12 February 2008 (case closed).

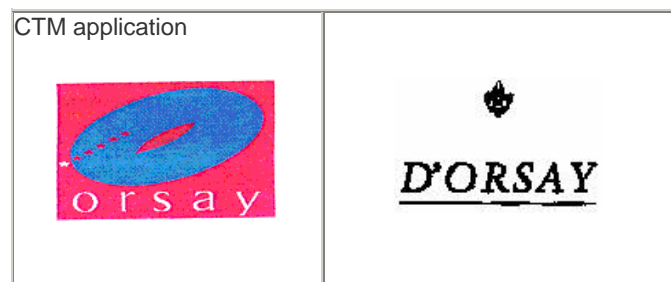
Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of goods (Class 9 products).

The action had been directed against a decision of the 2nd Board of 11.1.2007 in R 0796/2006-2 relating to a conflict between CTM application "IXI", word mark, which had been applied for in Class 9, and an earlier right in the word "ixi", also registered for a range of goods in Class 9. The opposition had been allowed in full. The plaintiff (CTM applicant) has now declared its wish to discontinue proceedings.

D'Orsay-I: T-39/04 – Judgment of 14 February 2008 (only FR, DE; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 3.11.2003 in R 0394/2002-4 relating to a conflict between the CTM application "Orsay" (figurative mark) and the earlier figurative marks "D'Orsay".



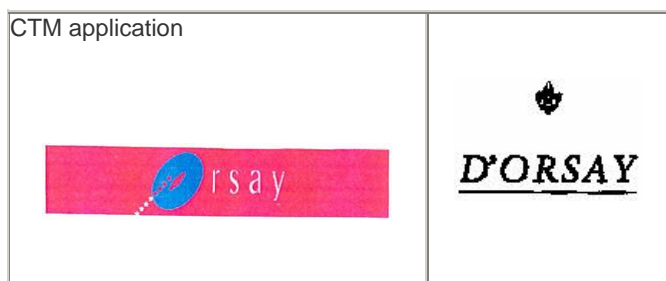
The CTM had been applied for for a range of goods in Classes 23, 24 and 25; the earlier rights are registered in

Classes 3, 18 and 25. The application had been partially rejected, namely as regards the claimed goods in Class 25. The 5th Chamber of the CFI (Vilaras; Martin s Ribeiro (rapporteur) and Jürimäe) concurred, relying on standard criteria.

D'Orsay-II: T-378/04 – Judgment of 14 February 2008 (only FR, DE; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 15.6.2002-4 in R 0909/2002-4 concerning a parallel conflict to the above action, between the CTM application “Orsay” (figurative mark) and the earlier figurative marks “D’Orsay”.



The CTM had been applied for for a range of goods in Classes 23, 24 and 25; the earlier rights are registered in Classes 3, 18 and 25. The application had been partially rejected, namely as regards the claimed goods in Class 25. The 5th Chamber of the CFI (Vilaras; Martin s Ribeiro (rapporteur) and Jürimäe) concurred, relying on standard criteria.

Galvalloy/Gallvallia: T-189/05 – Judgment of 14 February 2008 (action allowed; in court, the Office supported the plaintiff’s argument).

Keywords: CFI proceedings: matters of fact and of law put forward for the first time before the CFI – Opposition: specialised public on international markets – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: phonetic comparison – Phonetic comparison of marks: specialised public: relevance of English pronunciation.

The action had been directed against a decision of the 1st Board of 10.2.2005 in R 0411/2004-1 in respect of a conflict between CTM application “Galvalloy”, word mark, and the earlier word mark “Galvallia”. The CTM application had been made for certain steel products in Class 6; the invoked earlier right is registered for metal goods and certain steel products. The opposition had been rejected. In essence, the Board had found that, despite the identical nature of the goods designated by the marks at issue and a certain visual similarity, the signs in question differed phonetically and had no conceptual link, and that therefore there was no likelihood

of confusion between the marks at issue on the part of the relevant public (composed of particularly attentive professionals). The Board of Appeal also relied on the very low level of distinctiveness of the earlier mark and the characteristics of the international steel market, which is made up of a very limited number of manufacturers. In court, the Office supported the plaintiff’s argument that there is LOC, and the 4th Chamber of the CFI (Wiszniewska-Bialecka; Moavero Milanese; Wahl) shared this view.

(a) Matters of fact and of law put forward for the first time before the CFI.

(i) As regards the plaintiff

“(20) It is apparent from the documents before the Court relating to the proceedings before OHIM that the distinctive character acquired by the earlier mark as a result of its use was not pleaded before OHIM. It has consistently been held that matters of law relied on before the Court which have not been raised previously before the bodies of OHIM are inadmissible, in so far as a consideration of those matters by those bodies was not compulsory in order to resolve the dispute before them. In that regard, it must be noted that the reliance on distinctive character acquired as a result of use is a point of law which is independent of that of the intrinsic distinctive character of the mark in question. Therefore, unless one of the parties to the proceedings before OHIM relies on the distinctiveness acquired by its mark, OHIM is not obliged to consider, of its own motion, the existence of that distinctiveness (judgment of 17 October 2006 in Case T-499/04 Hammarplast v OHIM – Steninge Slott (STENINGE SLOTT), not published in the ECR, paragraphs 20 and 21; see also, to that effect, Case T-57/03 SPAG v OHIM – Dann and Backer (HOOLIGAN) [2005] ECR II-287, paragraphs 22 and 30). It follows that, in the present case, the reliance on distinctive character acquired by the earlier mark as a result of use is inadmissible before the Court.

(21) Furthermore, it must be held that, of the annexes in question, only Annex 23 to the application initiating proceedings had already been produced before OHIM and that Annexes 24 to 29 were produced for the first time before the Court. The latter are therefore, and in any event, inadmissible before the Court, which is called upon to assess the legality of the decision of the Board of Appeal by reviewing its application of Community law, particularly in the light of facts which were submitted to it, and cannot carry out such a review by taking into account matters of fact newly produced before the Court (Case C-29/05 P OHIM v Kaul [2007] ECR I-2213, paragraph 54).”

(ii) As regards the Office

“(42) According to what is now settled case-law, OHIM cannot be required to defend systematically every contested decision of a Board of Appeal or automatically to claim that every action challenging such a decision should be dismissed, and there is nothing to prevent OHIM from endorsing a head of claim of the applicant or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate for giving guidance to the Court. On the other hand, it may not seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application or put forward pleas in law



not raised in the application (Case T-107/02 GE Betz v OHIM – Atofina Chemicals (BIOMATE) [2004] ECR II-1845, paragraphs 34 and 36, and judgment of 16 May 2007 in Case T-137/05 La Perla v OHIM – Worldgem Brands (NIMEI LA PERLA MODERN CLASSIC), not published in the ECR, paragraph 19).

(43) It follows that the head of claim under which OHIM requests the Court to uphold the action, and thus endorses the applicant's request for an order annulling the contested decision, must be declared admissible inasmuch as that head of claim and the arguments set out in its support do not go beyond the form of order sought and the pleas in law put forward by the applicant."

(b) LOC: comparison of marks.

(i) As regards the Office's position

"(28) In contending that the Court should uphold the action, OHIM observes that it sbunnies the applicant's view and considers the action to be well founded. As regards, in the first place, the comparison of the signs at issue, OHIM observes, first of all, concerning the visual element, that the consideration set out in the contested decision – that the prefix 'galva' is not distinctive – did not lead the Board of Appeal to exclude that element altogether from the visual comparison of the signs at issue. OHIM notes therefore that the Board of Appeal acknowledged that there was a visual similarity between the signs at issue, which was attenuated to some extent by the differences in their suffixes.

(29) Next, OHIM contests the findings of the Board of Appeal with respect to the phonetic differences between the signs at issue. Both signs end with the sound 'a' in French, and the intervener failed to establish during the proceedings before OHIM that the relevant public would pronounce the mark applied for in accordance with the English rules of pronunciation. OHIM considers that, in any event, the elements of phonetic similarity in the signs at issue prevail over their differences.

(30) Finally, as regards the conceptual comparison of the signs at issue, OHIM maintains that the applicant failed to show that the suffix 'allia' in the earlier mark would be perceived as a common abbreviation of the French word 'alliage'. Moreover, according to OHIM, the conceptual similarity must be assessed on the basis of the evocative force of a mark taken as a whole, notwithstanding the meaning of its components. In those circumstances, OHIM takes the view that the Board of Appeal was justified in concluding that a conceptual comparison of the signs at issue was inappropriate. (...)"

(ii) The relevant public

"(51) As regards the relevant public in the present case, it must be accepted, as the Board of Appeal found in paragraph 20 of the contested decision without being challenged in that respect, that the goods at issue are semi-finished products intended, in particular, for the automobile industry. It is, as the applicant acknowledged at the hearing, a particularly oligopolistic market, in which the number of manufacturers of sheet steel coated with a protective laminate is very small,

and whose goods are destined for a limited number of customers.

(52) As the earlier mark was registered in France, the relevant public to be taken into consideration for the purposes of assessing the likelihood of confusion is composed of average French consumers of special steels.

(53) It follows that the relevant public is made up of a limited number of professionals specialising in the French special steels industry market, who have a high level of knowledge of the market and who pay particular attention to the choice of products offered by each manufacturer. (...)"

(iii) Phonetic comparison and international markets

"(58) In the second place, as regards the phonetic comparison, the Board of Appeal's analysis was undertaken solely on the basis of the French rules of pronunciation.

(59) In that respect, it must be noted first of all that the consumer concerned in the present case is operating in a market – the market for special steels intended in particular for the automobile industry – which is highly international and in which the English language is commonly used. Consequently, the word 'alloy' in English will be familiar to the relevant public, which will recognise in it a reference to the French 'alliage' (alloy). It follows that the relevant public may pronounce the mark applied for as if it were an English neologism, bearing in mind that 'galva' could equally be perceived as abbreviation of the English word 'galvanisation'. In any event, even on the assumption that the relevant public would pronounce the word 'galvalloy' in accordance with the rhythm of the French language, with three syllables: 'gal-val-loy', the presence of the English word 'alloy' in the mark applied for would not escape its notice and it would therefore tend to pronounce the ending as 'oi' in English, rather than, as the applicant incorrectly maintains and the Board of Appeal stated in paragraph 34 of the contested decision, as the French sound 'oua'. (...)"

"(61) It follows from the foregoing that, as the applicant claims, phonetically, the signs at issue are globally similar."

(iv) Conceptual comparison

"(63) In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, 'galva', which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.

(64) By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes 'llia' and 'lloy' were meaningless.

(65) That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word 'alloy', corresponding to 'alliage' in French, even if the first letter of



that word ('a') has merged with the last letter of the prefix 'galva', according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

(66) As far as the earlier mark is concerned, the suffix 'allia' is combined with the prefix 'galva' in the same way. The evocative force of the suffix 'allia' will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word 'alliage'. That process of identification is facilitated still further by the association of the idea of 'alliage' (alloy) with that of galvanisation, the suffix 'allia' being attached to the prefix 'galva'.

(67) By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

(68) Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark."

Aturion/Urion: T-146/06 – Judgment of 13 February 2008 (only in FR, ES; action dismissed, Office practice confirmed).

Keywords: Opposition/pharmaceuticals: attentiveness of the relevant consumers – Opposition: likelihood of confusion (LOC) – LOC: comparison of marks.

The action had been directed against a decision of the 1st Board of 3.2.2006 in R 0227/2005-1 relating to the CTM application "Aturion", word mark, which had been applied for for pharmaceutical products in Class 5 for the treatment of cardio-vascular diseases. It had been opposed on the basis of the earlier word mark "Urion", registered in Class 5. The opposition had been rejected on the ground that the marks are sufficiently dissimilar to exclude LOC as regards a normally well-informed and circumspect consumer. The 2nd Chamber of the CFI (Meij; Forwood; Papisavvas) confirmed these findings.

Camelo: T-128/06 – Judgment of 30 January 2008 (FR; action dismissed, Office practice confirmed).

Keywords: Board proceedings: filing of material for the first time – Opposition: likelihood of confusion (LOC) – Opposition: earlier right with reputation, Article 8(5) CTMR – Reputation mark: risk of dilution.

The action had been directed against a decision of the 2nd Board of 22.2.2006 in R 0669/2003-2 relating to CTM application No. 1 469 121, "Camelo" (figurative mark), which had been applied for for roasted coffee in Class 30.

CTM application



Camel



It had been opposed on the basis of various earlier rights in the word "Camel" and in figurative marks containing the word "Camel" which are registered for tobacco in Class 34, and in Class 22. The opponent had claimed that there was a classic conflict under Article 8(1) and (2) CTMR but had also invoked reputation of the earlier brands. Whereas the Opposition Division had allowed the opposition based on Article 8(5) CTMR (risk of dilution), the Board had denied that such a risk had been shown to exist. It had held that there had not been sufficient argument to make it concretely credible, rather than merely hypothetical, that the sign applied for coffee would take unfair advantage of the goodwill of the invoked earlier brands. The 5th Chamber of the CFI (Vilaras; Martin s Ribeiro; Jürimäe) confirmed these findings.

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

100: T-425/07 - Office response filed (PL).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 4th Board in R 1274/2006-4 relating to CTM application No. 3 875 408 (shown below).





It had been applied for in Classes 16, 28 and 41 and had been partially rejected on the grounds that for the rejected goods the sign is devoid of distinctive character in that it can be understood as describing certain characteristics of the products at issue.

Coyote Ugly: T-161/07 - Further observations filed by the Office (ES).

Keywords: Opposition

The action is directed against a decision of the 2nd Board of 2.3.2007 in joined cases R 0165/2006-2 and R 0194/2006-2. It relates to a conflict between the CTM application "COYOTE UGLY" (figurative mark) and several earlier rights in the same word and in signs containing those words.

CTM application:



Invoked earlier rights:

COYOTE UGLY



The CTM had been applied for in: Class 9: magnetic data carriers and phonograph records; Class 41: entertainment services, services for discos, night clubs and cultural activities, and Class 42: cocktail lounge services, excluding any other services in this Class. The earlier rights are registered for, or, in the case of an unregistered right, cover, inter alia: Class 14: precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instrument; Class 16: paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks; Class 21: household or kitchen utensils and containers (not of precious metal or coated therewith); combs

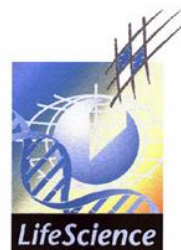
and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; Class 25: clothing, footwear, headgear; Class 32: beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages, and Class 34: tobacco; smokers' articles; matches. Further in Class 41: education; providing of training; entertainment; sporting and cultural activities; nightclub services, and in Class 42: providing of food and drink; restaurant, bar and catering services; hotel and motel services; provision of temporary accommodation; medical, hygiene and beauty care; veterinary and agricultural services, legal services; scientific and industrial research; computer programming. The opposition had been partially allowed as regards certain services. Both parties had appealed, and the 2nd Board had eventually allowed the opposition to a broader extent. The plaintiff in the current action is the opponent.

Life Science: T-413/07 - Office contribution filed.

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

The action is directed against a decision of the 1st Board of 2.8.2007 in R 1545/2006-1 relating to CTM application No. 3 585 957, "LifeScience" (figurative mark).

CTM application



Life Sciences Partners

The CTM application had been made for the following goods and services: Class 16: paper, cardboard and goods made from these materials, as far as included in Class 16; printing materials; writing stationery; typewriters and office requisites (except furniture); teaching materials (except apparatus); plastic materials for packaging. Class 35: providing advertising services; management of business affairs; provision of business administration services; office work; all the aforesaid services in particular in the field of technology transfer and innovation consultancy; organisation of trade fairs and exhibitions for commercial or advertising purposes; market research, analysis of market trends and market analysis in the field of national and international technologies. Class 36: insurance affairs; financial affairs, in particular in the field of risk capital procurement and financial support for technology transfer and consultancy on the associated financial support programmes; monetary transactions; real estate development services. Class 41: education; providing



of training; organisation of conferences as well as of seminars, workshops, lectures and other similar educational meetings; organisation of trade fairs and exhibitions for entertainment, cultural or sporting purposes. Class 42: engineering services; computer programming, other than for air conditioning and environmental technology; providing of expert opinion; research and consultancy (technical and legal) into industrial property matters; management and exploitation of copyright; exploitation of industrial property rights.

It had been opposed on the basis of "Life Sciences Partners", registered in the following classes: Class 35: advertising and sales promotion; business management; business administration; office functions; business management and organisation consultancy; business economics consultancy; drafting statistics; marketing manipulation, marketing research and marketing analysis; opinion polling; composing and operating databases; Class 36: insurances; financial affairs; monetary affairs; real estate affairs and acting as a intermediary for real estate sales; capital and other investments; consulting and acting as a intermediary in the field of granting of credits. The opposition had been partially allowed; the present action has been initiated by the CTM applicant.

Farben in Quadraten or Coloured squares: T-400/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: colour signs.

The action is directed against a decision of the 4th Board of 30.8.2007 in R 00030/2007-4 relating to CTM application No. 4 634 572 (shown below) which the applicant had denominated "Farben in Quadraten" (colors set out in squares). The applicant further had indicated that the sign is made up of 24 colours with each colour representing 4.2 % of the overall composition, had denominated each colour along the lines of a specific code (Munsell), and had stated that the colours were meant to be used in exactly the given composition and order.



The sign had been claimed for a range of goods and services in Classes 9, 16 and 42. It had been rejected on the grounds that it lacks distinctiveness (Article 7(1)(b) CTMR) for the claimed goods and services. The examiner and the Board had given different reasoning for their findings according to the respective type of good or service. As concerns the claimed services, examples from the internet had been used in order to demonstrate that service companies frequently use

colour compositions as decorative elements alongside their individual brands. As regards Class 16 goods, the sign will in the first place be understood as a generic indication, for instance, in which coloured specific products are available. As regards the goods claimed in Class 9, mainly instruments of controlling and/or monitoring or analysing something, the sign is perceived either as a decoration or, for instance, that the instrument is apt to analyse coloured material etc.

Optimum: T-424/07 - Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: burden of proof for distinctiveness.

The action is directed against a decision of the 2nd Board of 11.9.2007 in R 0288/2007-2 relating to CTM application No. 4 893 053, "Optimum", word mark, which the applicant had sought to register for the following list of goods (after amendment): biological material namely plant tissue genes and gene-sequences for agricultural purposes, in Class 1. The application had been rejected on the ground of lack of distinctiveness, more precisely on the grounds that: (a) the goods at issue ('biological material namely plant tissue genes and gene-sequences for agricultural purposes') address to a specialised public consisting of scientists specialized in the field of genetic engineering, including biologists, biotechnology engineers, etc.; (b) the mark applied for, Optimum, is neither a 'lexical invention' nor 'perceptibly different from a lexically correct construction'; (c) the basic Latin word Optimum which is assimilated in most Community languages, may be defined as '(1) (noun) a condition, degree, amount, or compromise that produces the best possible result; (2) (adjective) most favourable or advantageous; best: optimum conditions'. Since the mark applied for consists of the sole term Optimum, it would be perceived as a superlative. In this latter sense, the word is in fact a banal and widespread laudatory term, commonly-used for all kinds of goods or services (like 'best', 'excellent' or more colloquially 'top'); (d) the word is widely used, in a laudatory sense, in common parlance, especially in professional communications, in virtually all fields of business. Thus, the examiner had rightly held that the laudatory meaning of the word would be immediately understood both by average consumers and scientist or professionals, in any field of business or activity. Since Optimum is a common word defined in dictionaries and used in common parlance, no Internet search had been required to ascertain that bio-tech engineers – like any other consumer having received average high school education – would immediately and without any further thought understand the laudatory meaning of the sign applied for; and (e) although the word Optimum does not enable the consumer to imagine to what type of goods or services it refers, the fact nevertheless remains that, because it is commonly used, especially in professional communications, as a generic laudatory term, that word sign cannot be regarded as appropriate for the purpose of identifying the commercial origin of the goods which it designates and, therefore, of performing the essential function of a trade mark.

The Board had gone on to say that the CTM applicant's argument that the sign Optimum is not directly descriptive or commonly used in trade for the goods applied for, cannot alter the finding that the sign is devoid of distinctive character. If



the applicant claims that the trade mark sought to be registered is distinctive, despite the analysis of the Office, it is for the applicant to provide specific and substantiated information to show that the mark applied for has either an intrinsic distinctive character or a distinctive character acquired through use, since it is much better placed to do so, given its thorough knowledge of the market. Since the mark applied for has been found to be devoid of distinctive character within the meaning of Article (7)(1)(b) CTMR and since the existence of only one absolute ground of refusal is sufficient to refuse registration as a Community trade mark, it was held not to be necessary to further examine whether the sign applied for should be also refused to registration on the basis of Article 7(1)(c) CTMR.

Golf Fashion Master: T-294/07 - Office response filed (DE).

Keywords: Appeal proceedings: formalities – Appeal proceedings: costs upon withdrawal, Article 81(3) CTMR, Rule 94((7)(d) CTMIR.

The action is directed against a decision of the 1st Board of 23.5.2007 in R 0095/2007-1 relating to CTM application No. 3 136 041, “Golf Fashion Masters” (figurative mark), which had been applied for a range of goods in Classes 3, 9, 12, 18, 24, 25 and 28.



It had been opposed on the basis of two earlier rights in “Masters” trade marks which are registered in Classes 12, 25 and 28. The opposition had been allowed by the Opposition Division on 6 September 2006 (Decision No. B 691 503). On 9 January 2007, the Office had received a brief by the plaintiff's representative setting out grounds for an appeal which had allegedly been filed on 23 October 2006. The Office reported that on this date no such appeal had been received, nor had the statutory appeal fee been received. Subsequently, the plaintiff's representative had submitted a document showing that it had mailed a letter to the Office on 23 October 2006. In return, the Office reported that, on that date and by cover of that letter, two CTM applications had been filed but no appeal. By letter dated 16 April 2007, the representative withdrew the appeal. Subsequently, the 1st Board had taken the decision at issue here, holding that the appeal proceedings had been terminated by the withdrawal but that the appeal had been inadmissible and that the plaintiff had to pay the opponent's costs.

P & G Prestige: T-366/07 - Office response filed.

Keywords: opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 19.7.2007 in R 0681/2006-2 relating to CTM application No. 1 299 452, “P & G Prestige Beauté”.



Registration had been sought for, inter alia, the following goods: Washing and bleaching preparations, cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, preparations for body and beauty care, hair lotions; dentifrices, in Class 3. It had been opposed on the basis of “prestige” (stylised word), two earlier marks, registered in Class 3 for soaps, perfumes, cosmetic creams, lotions, bath foam, eyes and lips coloured pencils, lipsticks and rouges, face powder, cosmetic face colours, mascara, nail varnishes; false nails, eye shadows and foundation creams. The opposition had partially been allowed, namely for washing preparations, cleaning preparations; soaps; perfumery, essential oils, preparations for body and beauty care, hair lotions and for dentifrices.

Carte Bancaire Logo: T-414/07 - Office response filed (FR).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 6.9.2007 in R 0290/2007-1 relating to CTM application No. 5 225 776 (figurative mark, shown below).



It had been applied for for a range of goods and services in Classes 9, 35, 36 and 38, mainly in relation to banking and financial services including administration of cash dispensers. It had been rejected on the grounds of Article 7(1)(b) CTMR (lack of distinctiveness for the goods and services claimed).



Payweb-Card: T-405/07 and T-406/07 - Office response filed (FR).

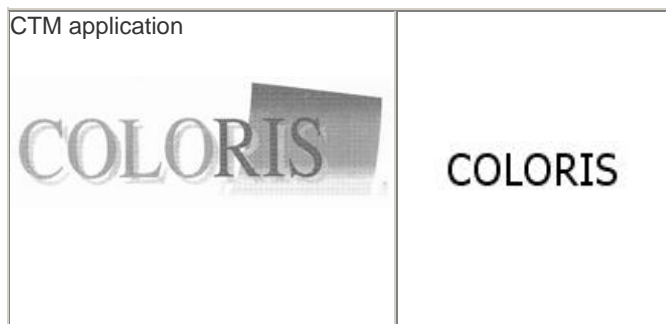
Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against decisions of the 1st Board of 10.7.2007 and 12.9.2007 in R 0119/2007-1 (T-405/07) and R 0120/2007-1 (T-406/07) relating to CTM applications No. 3 861 044 and No. 3 861 051 ("P@YWEB CARD" and "PAYWEB CARD"). The CTM applications had been made for for a range of goods and services in Classes 9, 36 and 38, mainly in the area of financial services. They had been rejected on the grounds that the signs lack distinctiveness because they merely describe the nature of the goods and services at issue.

Coloris: T-353/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 28.6.2007 in R 1060/2006-1 relating to CTM application No. 2 817 732, "Coloris" (figurative mark), for inter alia, the following goods in Class 2: paints, lacquers and dyes; thinners; enamels and aluminium powder for painting; binding preparations for paints, and in Class 16: paintbrushes, artists' materials, pencils and drawing implements.



It had been partially opposed on the basis of the earlier word mark "Coloris", registered in France in respect of the following relevant goods in Class 2: paints; varnishes (except insulating varnishes); lacquers (paints); preservatives against rust and against deterioration of wood; colorants; mordants (not for metal, not for seeds); raw natural resins; metals in foil and powder form for painters, decorators, printers and artists. The opposition had been allowed in respect of those goods for which the opponent had shown genuine use.

Allsafe: T-343/07 - Office response filed (DE).

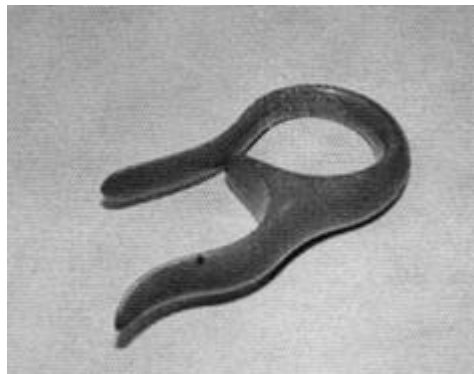
Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness/assessment: prior registrations in EU Member States – Distinctiveness/assessment: prior registrations in non-EU countries.

The action is directed against a decision of the 4th Board of 11.7.2007 in R 0454/2006-4 relating to CTM application No. 2 940 534, "Allsafe", word mark, 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 that the sign merely describes the function and/or purpose of the goods and services in question. Registrations in an EU Member State and in the USA are indications but not binding.

Handgriff or Handle: T-391/07 - Office response filed (DE).

Keywords: 3D signs: part of the product – 3D signs/part of the product: distinctiveness.

The action is directed against a decision of the 4th Board of 16.8.2007 in R 0361/2007-4 relating to CTM application No. 4 396 727, a 3D sign representing a handle, applied for in Classes 6 and 8 (in the latter for tools for gardening and agricultural purposes etc.).



It had been rejected for the goods in Class 8 on the grounds that all the respective tools have handles and for that reason the relevant consumers will not perceive any handle as a specific badge of origin.

Patrick Exclusive: T-370/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 26.7.2007 in R 1447/2005-2 relating to CTM application No. 2 946 424, "Patrick Exclusive" (figurative mark) which had been applied for in Class 25 for footwear, clothing and headgear.





It had been opposed on the basis of several earlier rights in "G. Patrick", word mark, registered in Class 24 and in Class 25 for the same range of goods. The opposition had been allowed in its entirety.

Unique: T-396/07 - Office response filed (FR).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 2nd Board of 3.9.2007 in R 0585/2007-2 relating to CTM application No. 5 312 392, "Unique", word mark, for a range of goods and services in Classes 9, 35 and 38 which may be categorised as relating to telephones and telecommunication. It had been rejected on the grounds of Article 7(1)(b),(2) CTMR in that the sign is laudatory as well as banal because an internet search had revealed that it is more or less frequently used in the respective sectors of business.

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

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Cancellation proceedings – res judicata – opposition rejected in other proceedings – principle of legal certainty – principle of legitimate expectations

Decision of the Second Board of Appeal of 30 January 2008 in Case R 0682/2007-2 (English)



R 0682/2007-2 (TIMI KIDERJOGHURT) / KINDER – (en) – in its grounds of appeal, the CTM proprietor referred to a prior decision of the Board which rejected an opposition between the very same marks at issue in this instance. It argued that, by virtue of *res judicata*, the Cancellation Division should have abided by the Board's verdict, because a claim decided by a court of competent jurisdiction generally has to be considered to have been exclusively resolved and has a binding effect on another claim in the same area of jurisdiction. The Board rejected this claim, noting that opposition decisions lack the negative effect of *res judicata* since they do not bar the admissibility of a subsequent invalidation action. Nevertheless, it noted that opposition decisions have the positive effect of *res judicata* in the sense that the findings of the previous final opposition decision cannot be entirely ignored when deciding a later invalidation action having the same parties, the same subject-matter and the same grounds. This is provided that such findings or decided issues are not affected by new facts, evidence or grounds adduced for the first time before the Cancellation Division. The Board explained that the reason for this is that the Office cannot go back on its previous decisions according to the general principle that the administration in particular is bound by its own acts when these have granted rights to the parties to the proceedings (*nemo potest venire contra factum proprium*). This obligation is also imposed on the Office by the general principles of legal certainty and protection of legitimate expectations of the party benefited by the previous decision, which is presumed valid and has become final and unappealable once the time-limits to appeal to the Courts have expired.



Opposition proceedings – evidence of use – time limit – complementary evidence – invoices – declaration

Decision of the Second Board of Appeal of 28 January 2008 in Case R 1394/2006-2 (English)

R 1394/2006-2 CLICK / CLIKS – (en) – the Board stated that the proof of use deadlines are not subject to the Office's discretionary power under Article 74(2) CTMR, and the 'Arcol' criteria are not applicable (judgment of the CFI in Case T-86/05, 'Corpo Livre', at paragraphs 47-49). However, late additional evidence of use may still be admitted where 'new factors emerge' (see 'Corpo Livre', at paragraph 50 and the CFI judgment in Case T-334/01, 'Hipoviton', at paragraph 56). Following the factual background of the 'Hipoviton' case, where the new factors emerged when the applicant challenged the extent of use, the new factor which emerged in the present case was that the applicant challenged, *inter alia*, whether the initial evidence submitted by the opponent was sufficient to prove the extent of use of the earlier mark. Therefore, the Board held, the invoices and internal sales statistics filed in response to dispel the applicant's doubts had to be taken into account.

The 'statutory declaration' drawn up under German law stated that it was given 'with the knowledge that a false statutory declaration is liable to punishment'. In order for such a statement to have full and complete independent probative value, within the meaning of Article 76(1)(f) CTMR, the interested party must prove that, under the applicable national law, such statement qualifies as a 'sworn' or 'affirmed' statement, or at least, has similar effects thereto. The declaration in the present case did not qualify as a 'statement in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up' pursuant to Article 76(1)(f) CTMR, because the opponent failed to prove that German law sanctions a false statement given before the Office in a pending CTM procedure in the same way as a false sworn statement made before the German authorities.

Restitutio in integrum – Article 78 CTMR

Appeal proceedings – restitutio in integrum – time limit – surcharge – fee – renewal

Decision of the Second Board of Appeal of 24 October 2007 in Case R 1139/2007-2 (English)

R 1139/2007-2 WHEN YOUR BANK SAYS NO, CHAMPION SAYS YES – (en) – the question to be answered in this case was whether the wording of Article 78(2) CTMR ("the omitted act must be completed within this period") includes the 25% surcharge for late payment of renewal fees in a case where the registration has not been renewed. The Board held that the actual act which had been omitted was the renewal of the application, not the payment of the additional fee for late renewal.

Appeal proceedings – restitutio in integrum – due care – renewal – representative

Decision of the Second Board of Appeal of 13 January 2008 in Case R 0989/2007-4 (English)

R 0989/2007-4 ELITE GLASS-SEAL – (en) – the Board dealt with the standard of due care (Article 78 CTMR) applicable to a professional representative when it had outsourced services (in this case, to Computer Patent Annuities Limited, which was entrusted with the payment of the renewal fee).

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

Examination proceedings – distinctiveness – descriptiveness – misspelling - combination

Decision of the First Board of Appeal of 17 January 2008 in Case R 1454/2007-1 (English)

R 1454/2007-1 ETHLETIC – (en) – the Board stated that this mark may be seen as a combination of the words 'ETHICAL' and 'ATHLETIC', noting that; the letters A and E do not substitute each other in the English language; the term 'ETHLETIC' differs from 'ATHLETIC' to the extent that it will not be seen as an obvious misspelling; and the mark does not convey any clear message and does not inform consumers about the characteristics of the goods at issue such as 'rubber, gutta-percha, gum, asbestos, clothing, footwear, headgear; games, toys and playthings; gymnastic and sporting articles not included in other classes' etc. (Classes 17, 25 and 28). Therefore, the Board held that the mark is not descriptive. No other grounds to consider it non-distinctive were invoked. The Board considered the mark registrable.

Examination proceedings – distinctiveness – logo

Decision of the First Board of Appeal of 7 February 2008 in Case R 1492/2007-1 (English)



R 1492/2007-1 (part of a spectacle frame) – (en) – the Board considered that a design on the side piece of a pair of spectacles (where the lens and the temples meet) may well function as a mark (including a three-dimensional mark) because consumers are used to seeing marks there. The Board considered that the mark was distinctive and remitted the file to the examiner for further processing.



III - *Inter-partes* – Article 8(1)(b) CTMR

Opposition proceedings – relative grounds for refusal – likelihood of confusion – dissimilarity of goods

Decision of the Second Board of Appeal of 28 January 2008 in Case R 1394/2006-2 (English)

R 1394/2006-2 CLICK / CLIKS – (en) – the Board held that the opponent's 'protective gloves' (Class 9) were dissimilar to the applicant's 'clothing' (Class 25), since they have a different nature, purpose and use, they require different means and methods of manufacturing and, thus, they normally come from different undertakings. The Board also noted that the respective goods' target public is different and they are distributed through different trade channels. It was further observed that the goods belong to entirely different market segments, and they are not in competition with each other. Additionally, the Board held that the opponent could not successfully rely on the overlapping features between sports clothing and protective clothing in favour of similarity. For these goods, even if the marks are visually and phonetically highly similar, there is no likelihood of confusion.

IV - *Inter-partes* - Cancellation / Invalidity CTM

Cancellation proceedings – bad faith – burden of proof

Decision of the Second Board of Appeal of 13 November 2007 in Case R 336/2007-2 (English)

R 336/2007-2 CLAIRE FISHER / CLAIRE FISHER – (en) – in considering an allegation of bad faith by a cancellation applicant, the Board held that:

- firstly, under Articles 5 and 6 CTMR any person may acquire a Community trade mark by registration. Property in a Community trade mark is acquired not by prior adoption and use but only by prior registration.

- secondly, the Community registration system is completed by rules (general and specific), necessary to bar registrations through misuse of the system and fraudulent misappropriations. The general rule is the provision of Article 51(1)(b) CTMR. The specific rules are the provisions of Articles 8(3), 11, 18 and 52(1)(b) CTMR, which incorporate the provision of Article 6 *septies* of the Paris Convention to prevent a specific but typical – so typical that its regulation by the Paris Convention was necessary – case of misappropriation that occurs when the trade mark is filed fraudulently by a disloyal agent or representative of the proprietor without his consent. In conclusion, the first applicant, provided he has acted in good faith and there are no relative grounds for refusal, becomes the owner of a Community trade mark.

- thirdly, "Article 51(1)(b) CTMR contains the general clause providing for the invalidity of a Community trade mark filed in bad faith. It seems clear that the mark filed by a disloyal agent without the proprietor's consent is an example of misappropriation and the mark filed in bad faith but the

agent's mark case is qualified by Article 52(1)(b) CTMR as a relative ground for invalidity unlike Article 51(1)(b) CTMR which qualifies the bad faith filing as an absolute ground for invalidity. The difference between absolute and relative grounds for invalidity are important since pursuant Article 55(1) CTMR the invalidity request based on absolute grounds may be submitted by any natural or legal person while that based on the relative ground of the agent's mark may only be filed by the proprietor. This important difference of qualification might be justified for the reason that the general clause of Article 51(1)(b) CTMR covers not only cases of misappropriations, where the qualification as an absolute ground is not justified, resulting in opening the *locus standi* to unconcerned persons when only the private interest of the damaged person is concerned, but also cases of misuse of the registration system with the wrong purpose not protected by the Community trade mark law, where the open *locus standi* or public action is justified by the protection of public interest."

- it is a general principle of law that good faith is presumed until the contrary is proved. Thus, the burden of proof of *mala fides* rests with the cancellation applicant.


- according to the undisputed statement of the contested decision, bad faith can be considered as meaning 'dishonesty which would fall short of the standards of acceptable commercial behaviour'. This notion of bad faith is not substantially different from that of 'honest practices in industrial or commercial matters' used by Article 12 CTMR, which limits the trade mark right allowing a third party the use of the mark in specific cases provided he uses it in accordance with honest practices in industrial or commercial matters. The condition requiring use of the trade mark to be made in accordance with honest practices in industrial or commercial matters must be regarded as constituting in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner (Case C-100/02 'Gerri', at paragraph 24).

- consequently, as the contested decision stated, there is bad faith when the CTM applicant intends through registration to appropriate the trade mark of a third party with whom it had contractual or pre-contractual relations, or, the Board adds, any kind of relation where good faith applies and imposes on the applicant the duty of fair play in relation to the legitimate interests and expectations of the other party. In such a hypothesis, the CTM applicant would have acted in bad faith in filing a CTM application; the filing would have been done fraudulently and would have constituted a misappropriation of another's trade mark, which according to the ancient rule *fraus omnia corrumpit* would completely justify the invalidity sanction of the registration laid down by Article 51(1)(b) CTMR.

In the present case, the Board agreed with the contested decision that there was no relationship between the CTM proprietor and the cancellation applicant at the time of filing the contested CTM on 12 October 1996, and that consequently the former had no *bona fide* duty to the latter at that time. It added that the mere creation or the simple adoption of a name is not a legal source of trade mark rights. The appeal was dismissed.

Cancellation proceedings – revocation – national court – suspension of the proceedings

Decision of the First Board of Appeal of 24 January 2008 in Case R 0285/2007-1 (English)


R 0285/2007-1  (Le MERIDIEN) / MERIDIANA – (en) – revocation proceedings cannot be conducted by the Office on its own motion. The Board held that, where the capacity of the cancellation applicant to request the revocation of the CTM depends on a national judgment, the Cancellation Division should suspend the proceedings or wait for the outcome.

V - Design cases

Design proceedings – overall impression

Decision of the Third Board of Appeal of 25 January 2008 in Case R 1391/2006-3 (English)

R 1391/2006-3  (animal foodstuff) /

 (animal foodstuff) – (en) – the Board considered that, in this case, the overall impression was dictated by the sum of all the design's characteristics, and not by just one of them. The difference between the two designs consisted of a different number of prongs but the Board stated that it could not see – when looking at the two designs from an overall perspective – how the fact that one design has five prongs instead of four may radically alter overall impression. It held that the different number of prongs might be enough for the challenged design to survive the strict novelty test under Article 5 CDR but certainly did not assist it in the framework of Article 6 CDR.

E-business at OHIM

How to save your draft e-filing or e-renewal and restore it later on

When using OHIM e-filing facilities (for CTM, RCD, renewal and opposition) users might need to save their draft application, renewal request or opposition in order to review it later, forward it or just keep it.

With a view to fulfilling this need, OHIM CTM/RCD e-filing, e-opposition and e-renewal for RCD and CTM provide a “save” option.

How do I save my draft?

Draft e-filings or e-renewals can be easily saved on the local PC of the user who is carrying out the e-filing. The save option should be used by clicking on **Save** located at the top and the bottom of the pages of the electronic form.

After clicking on **Save** a new page is displayed, which contains a message explaining that the page should be saved using the “save as” function of the browser. Then, in the File menu click on “Save as”.



In the window displayed, type in the name of the file, select where you want to save the electronic form and click on “Save”.

Thus, the electronic form has been successfully saved. The browser window can now be closed.

Please note that :

- *In e-opposition, the save option only works once all mandatory fields are complete.*
- *In e-filing RCD, the save option is named “Save to PC”.*

How do I restore a saved draft?

In order to restore a saved electronic draft, you should double click on the file created following the steps explained above. The electronic form re-opens.

To re-establish the connection with the OHIM system, you must click on the **Back** or **Continue** button.

Subsequently, you may continue with the filing process and submit the form.



Please note that:

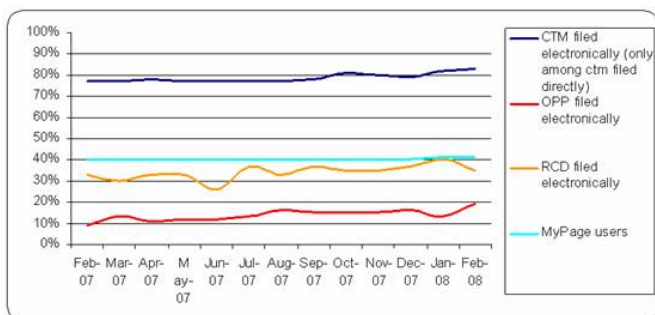
- You cannot work offline in the save htm form. In order to modify the information contained in the form, you must apply the procedure explained above to restore the connection with the OHIM system.
- The htm file created can be sent and used by any other users with an Internet connection.

For further clarification of the issue or for troubleshooting please contact our e-business hotline at e-businesshelp@oami.europa.eu

OHIM e-business roundup (2008)

Statistical summary

- The use of the CTM e-filing web form is steadily above 80%.
- The use of RCD e-filing is around 35%
- Increase of oppositions against CTM applications received electronically to 19%.
- MyPage users represent around 40% of CTM Applications filed.



State of play of future projects

Service - New version of e-Communication:

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

Status - OHIM has started the testing phase

Service - New version of CTM E-filing:

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

Status - OHIM has started the development phase

Service - New version of electronic filing of RCD applications

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

Status - OHIM has started the development phase

CTM watch:

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

Status - OHIM is going to start the testing phase

More News

Record year for Community trade marks and designs

OHIM has had another record year for applications for Community trade marks and designs, and 2007 also saw further significant improvements in productivity and timescales for registrations.

Over the past four years, the cumulative change at the non-profit-making EU agency has been dramatic, with a 50% increase in trade mark and design applications and a rise in productivity of almost 60%. Over the same period the average time to register a trade mark has fallen by one-third to 13 months, and the time taken to register a design has fallen by 60% to six weeks.

OHIM's annual report, published on 6 March 2008, shows that in 2007, demand for Community trade marks (CTMs) was up 13% on the previous year and applications for designs rose by 10%. Productivity in terms of registrations per member of staff was also up by 10%. The Office dealt with around 90 000 applications for the CTM and almost 80 000 applications for the Registered Community Design (RCD) during the year.

The continued growth in popularity of the CTM and the RCD with businesses, and more efficient working methods resulted in a total income in 2007 of around €200m¹ compared with an expenditure of around €138m. As a non-profit organisation, a first fee reduction was implemented in 2005 to pass on these savings to customers and the continued improvement in performance means that a further reduction is now envisaged by the European Commission.

¹ Figures are unaudited and provisional so are subject to change.

National search reports for CTMs become optional

National search reports, to check if Community trade marks applied for are similar or identical to trade marks already registered in individual EU Member States, became optional from 10 March 2008. From now on, national search reports will be produced only if requested by the applicant at the time the Community trade mark application is filed. The searches will be carried out in all 16 participating Member States and the fee will be €192. Community search reports and warning letters will continue to be sent out as before.



Meeting with users on new OHIM website

OHIM's new website project was presented to representatives of users at an ad hoc meeting in Brussels earlier this month. The meeting brought together OHIM staff and special advisors with an invited group of key users drawn from ECTA, INTA, Marques and the European Federation of Pharmaceutical Industries Associations, EFPIA.

The event, which was a follow-up to a previous ad hoc consultation at the end of 2006, presented the concept and layout of the new website, based on the front page and a sample inner page.

The new OHIM website, planned for completion in June, is currently under construction and a number of other intensive consultations are planned via usability tests and a presentation to the OHIM E-Business Users Group meeting on 11 April.

The home page design received a positive reaction from users, particularly with regards to the overall appearance, uncluttered layout, and focus on professional users. They recommended that further work be carried out on the inner pages to reduce the amount of information competing for the user's attention, and also suggested that the use of strong colours be reduced.

Review of trade mark system in Europe

The 15th meeting of the OAMI Users' Group, held in Alicante at the beginning of this month, was given more details of the European Commission's plan to carry out an overall assessment of the trade mark system in Europe, including the fees charged for Community trade marks.

A Commission representative said that the scope of this assessment was very broad, as it affected not only OHIM and the CTM system but also the functioning of national systems. This was necessary due to the time elapsed since the Harmonization Directive in 1989.

In parallel to this assessment, and as a result of it the Commission would in the coming months propose a substantial reduction of OHIM's application, registration and renewal fees in order to bring the budget of the Office, which is currently making a substantial surplus, back into balance for the future. An impact assessment, subject to conditions and quality checks, was required to accompany the proposal on fee reduction and this justified some delay to the fee reduction proposal, the Commission representative said. The planned review would include the functioning of Offices, financial aspects, and CTM Courts, and the Commission stressed the need have a dialogue with all the stakeholders involved.

The Users' Group meeting was attended by representatives from AIM, APRAM, BUSINESSEUROPE, CNIPA, ECTA, EFPIA, FICPI, ICC, INTA, MARQUES, and UNION. The meeting agenda included an overview of the main findings of the OHIM Users Satisfaction Survey covering the 2007 period. This showed a very good level of overall satisfaction with the Office, with the User Satisfaction Index improving by four points for representatives and six points for proprietors.

The change to national search fees for CTMs, which become voluntary from 10 March, was also among the items discussed. Under the new system OHIM reimburses the 16 participating national offices at a rate of €16 per search each, while the applicants are only charged €12 per search. A proposal by the European Commission to match the charges to applicants with the new search fee has not gained sufficient acceptance from member states. However, the meeting was told that the Commission was evaluating the system as part of its broader study.

Accepted payment methods

Following OHIM's decision to stop accepting cheques for design-related fees some users have sought clarification about a range of payment issues. The table below summarises the valid options currently available for making payments to the Office.

| | Bank transfer | Current account | Credit card * |
|--------------------------------|---------------|-----------------|---------------|
| CTM Application Fee | YES | YES | YES (1) |
| CTM Registration Fee | YES | YES | NO |
| CTM Renewal Fee | YES | YES | YES (2) |
| | | | |
| RCD Application Fee | YES | YES | NO |
| RCD Registration Fee | YES | YES | NO |
| RCD Renewal Fee | YES | YES | NO |
| | | | |
| All other fees payable to OHIM | YES | YES | NO |

* VISA/Mastercard only

(1) Only when using E-filing

(2) Only when using E-renewal

Monthly statistical highlights February 2008

| | |
|--|-------|
| Community trade mark applications received | 7 631 |
| Community trade mark applications published | 9 903 |
| Community trade marks registered (certificates issued) | 8 455 |
| Community trade mark renewal applications | 1 330 |
| | |
| Registered Community designs received | 6 049 |
| Registered Community designs published | 7 454 |

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