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## User satisfaction rises

For the fourth year running OHIM has commissioned a survey of user satisfaction with the Office's services. The full report covering 2008, which has been published on the website, shows a significant increase in overall satisfaction.

The annual User Satisfaction Survey, carried out by the leading independent survey organisation GfK Emer, allows users to give their views on how services have changed and provide feedback on the need for future improvements.

The increase in satisfaction in 2008 applies to all areas of the business, and is common to both proprietors and agents. The survey shows that there was a particular improvement in the perceived "accessibility of Office employees". However, there was a fall of 2% to 66% in the satisfaction among agents with the information provided by the Office. At the same time satisfaction with "information" among proprietors rose by 6% to 64%.

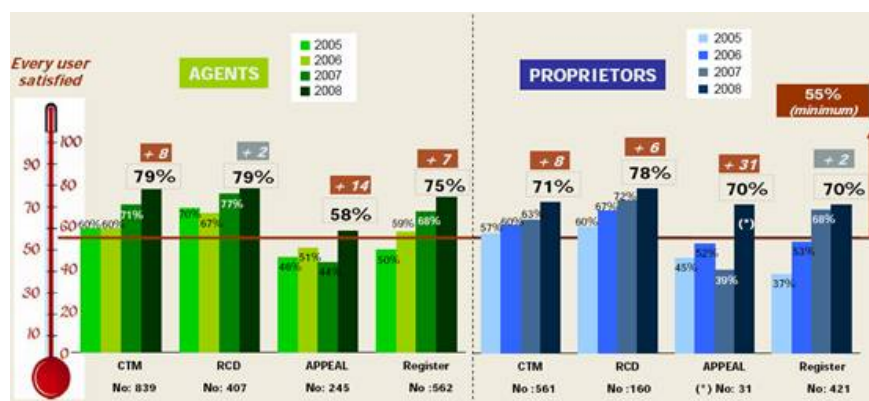
The 2008 survey was launched in early January, when all users who did business with the Office in 2008 received e-mail invitations to take part. This time the questionnaire was fine-tuned and shortened, and a record number of almost 1600 users responded – over 900 agents and almost 700 proprietors. OHIM would like to thank all those who took the time to take part in the survey, which is regarded as an important management tool to help deliver better services.

The first User Satisfaction Surveys were used to draw up the OHIM Service Standards, based on in-depth knowledge of the needs expressed by users. The results of the 2007 survey confirmed that the significant improvements in service achieved by the Office over recent years are important to users. The survey for 2008, will be used, once again, to determine the areas of improvement that are most important.

To ensure compatibility with previous surveys a number of questions used in previous years to draw up an Overall Satisfaction Index were retained in the survey for 2008. The results show there has been another rise in Overall Satisfaction with the index for agents at 72.5% (up 2.5%) and the index for proprietors at 70.2% (up 1.7%).

Both agents and proprietors continued to show high satisfaction levels in all areas covered by the survey with particular improvements in satisfaction in the core business and e-Business tools.

## Satisfaction with the OHIM core business



In previous surveys there has been a greater gap in the perceived satisfaction of agents and proprietors, with proprietors normally less satisfied with the Office's services. This year has seen that gap reduce and indicates an overall perception that the functioning of OHIM has improved compared with the previous year.



While overall satisfaction with OHIM was high, there were significant national differences. Satisfaction with OHIM was highest in Italy (86% for agents and 83% for proprietors), and lowest in the UK (63% for agents and 69% for proprietors).

For full details see:

[OHIM User Satisfaction Survey 2008 \(ppt\)\(EN\)](#)

### **The James Nurton interview with Olof Fickert, Herrero & Asociados**

**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.**

**Olof Fickert, partner of Herrero & Asociados in Madrid, talks about the success of the CTM, and discusses the changes to trade mark practice brought about by the Madrid Protocol and harmonisation**

#### **How did you start working in trade marks?**

It was a series of coincidences. I was born in Germany and my father was a well-known lawyer in construction and urban law. He wanted me to follow him but in reaction I switched to studying medicine and moved to Spain. While I was studying, my then girlfriend saw an advertisement for someone who had German, French and English languages to work as a translator. That was at an IP firm so I took the job part-time while continuing with my medicine studies. But I found the work interesting and I was drawn back to my roots and changed to studying law. I especially like working in trade marks because you can immediately see in the market what you are working on; it is really exciting.

#### **What types of work do you handle now?**

Our trade mark team has 35 professionals including our 15 trade mark attorneys. I now head the firm's patent department for foreign clients, but in the trade mark field I am still involved for our German clients as well as important international ones. I am grateful to have done both patent and trade mark work. It is important to have that global overview. I say that a trade mark is a name that you give to an invention that lasts forever.

I have become very involved in trade mark harmonisation, partly through chairing the INTA's subcommittee on the Madrid System during 2006 and 2007. We worked on some of the political aspects, including the negotiation of the safeguard clause. I think the Madrid System is an example of what has been the biggest and most important change in trade marks in my career – the fact that we're getting much more globalised. There are still colleagues who are reluctant to see the Madrid System coming in, but you must service the users and look beyond your own interests. I am a big supporter of both the Madrid and CTM systems that have developed over the past 20 years.

#### **Why do you think there is resistance to this?**

Some people are a bit short-sighted and do not realize that the main content of our profession is not just the filing of trade mark applications, but their prosecution by means of developing strategies, negotiations etc and last but not least the defence of the exclusive protective rights that are achieved. In Spain for example there was no multi-class system until 2002, so many trade mark applications were filed in all the classes. Also until 2002 there was *ex officio*

examination on relative grounds of refusal, but now the trade mark owner has to actively defend its own rights through oppositions. Many colleagues thought this was a terrible move but on the contrary it allows you to be a proper adviser, apply your knowledge and devise a strategy. I can see different approaches in my colleagues and especially the younger ones recognise that the skills have changed a lot and they act accordingly. I am totally convinced that the CTM and the Madrid System mean there will be more oppositions and more prosecution so we can concentrate on the real work of our profession.

One of the important tasks of INTA's Madrid System Subcommittee has been to convince colleagues in other countries, particularly in Latin America, to be more open to these developments. I'm sure that change will come in the next few years, especially with Spanish as the third language of the Madrid System. Countries such as Brazil and Chile are getting close and I expect them to join in the next few years.

#### **Do you always recommend that clients use the Madrid System?**

It always depends on the client's interests and size, while of course also bearing in mind its existing trade mark portfolio. Devising the best strategy is one of the important parts of our profession.

#### **How many trade marks do you file with OHIM on average (per month/year)?**

Our firm files about 320 per year or 26 per month. The first trade mark we filed was the application number 2543 for TRIM, in the name of the W. E. Bassett Company. The most unusual we have filed is number 3239514 AVE MARIA (figurative) which consisted of the image of the Virgin Mary bearing a crown made of cannabis leaves, which was refused on absolute grounds under Article 7.1 (f).

#### **Are you satisfied with the quality of examination at OHIM? And the speed?**

Yes, we are satisfied with both. The quality of the examination at OHIM is quite high. Furthermore, the examiners usually make a thorough examination of the cases, reasoning each issue. We note that the speed has been improved, although from time to time cases could be expedited even more.

The CTM is a very smooth way to achieve protection in 27 countries and OHIM is very user-friendly and open-minded.

#### **How could OHIM improve its service?**

There are some aspects that could be improved. In opposition proceedings, the notifications concerning limitation of goods/services in the contested applications should include *ex officio* the translation into the language of the opposition proceedings to expedite the procedure. In some cases the examiners are not helpful when requesting the re-classification of the goods/services in a CTM application and do not provide the applicant with an alternative wording.

#### **What aspect of the CTM system works best and what would you most like to see changed?**

Usually, the OHIM information service works quite satisfactorily and people attending do their best to solve the questions and do not hesitate to ask another examiner when



they have doubts about the correct response and inform the user accordingly later on.

The e-business system has represented an improvement in the quality at OHIM, although it is still quite frequent that the e-filing system gets seized up. OHIM databases also work quite well, although more searching options would be desirable, which would allow users to carry out better trade mark searches online, to find law cases and appeal decisions easily, etc. Online file consultation has also improved since, generally speaking, files can be seen complete, which undoubtedly is an advantage. The only negative aspect is that some CTM files are incomplete. In inter-party proceedings, the fact that OHIM requires two copies of all documentation to be filed represents an inconvenience for the parties.

One thing that needs to be improved in the Spanish national office is electronic access. The electronic filing of trade mark applications is already available, but trade mark renewals cannot be effected online. Another need is the establishment of opposition and examination guidelines, of course harmonised with the European ones, in order to improve the reliability of our trade mark system. There is a new director of the Spanish Trade Mark Office, Mr Alberto Casado, who is a great trade mark expert and well known from his OHIM times, and we are very optimistic concerning the further development of the Spanish PTMO.

#### **Have you ever had to enforce CTMs in the courts?**

We have repeatedly enforced CTMs before the Spanish Community Trade Mark Courts. Our experience has been very positive. Both in first and second instance the Alicante Courts – competent in Spain for enforcement of CTMs – do an extraordinary job. A very positive aspect of these courts is that they maintain prior opinions, so that it is more feasible to know what outcome a case will have from the beginning, something which is not always easy in national trade mark matters throughout Spain (though it is quickly becoming better).

#### **What is the biggest challenge facing trade mark owners?**

To achieve an adequate and efficient protection in accordance with their activity and its potential extension to other commercial areas. Legal advisers and representatives play an important role in this, assessing and informing in the right way within an internationally harmonised legal framework. There will be more and more user-friendly treaties and increasingly efficient and flexible client-attorney relationships.

However, the filing aspect will become less and less important for trade mark representatives. Today, for example, in Spain more than 50% of trade marks are filed by the applicant directly and not by representatives. But once these applicants face an office action they go to a specialist. So IP firms are changing and will have to change even more, but I am optimistic the profession will have a good future.

## **Community Trade Mark**

### **CTM ruled invalid with respect to sailing clothing**

The Community trade mark, “BALTIC MATCH RACE”, has been ruled invalid for clothing, footwear and headgear following an opposition application by the owner of the “BALTIC” CTM, a Swedish manufacturer of sailing clothing and safety equipment.

BALTIC MATCH RACE (CTM No. 4014131) was registered in 2005 by a German company, BMS Bernd-Michael Schröder Sailing Wear GmbH for a range of goods and services in classes 8, 25 and 28. The trade mark BALTIC (CTM No. 3779501) had been registered for goods in classes 9 and 25 earlier in 2005.

The owner of the earlier CTM, Baltic Safety Products AB, claimed that “BALTIC MATCH RACE” had been registered in bad faith, as both companies had exhibited at the METS trade fair in Amsterdam and the German firm was aware of his company.

Furthermore, due to the similarity of the names, and identical nature of the contested goods in class 25, there was a likelihood of confusion under Article 8(1)(b) CTMR. In addition, the trade mark “BALTIC” had been used for a long time and had become well known in the field of clothes and products for safety at sea among sailors and motorboat owners. They also sponsored a sailing race in Sweden named “BALTIC RACE”. Naturally, a customer would connect the contested trade mark “BALTIC MATCH RACE” with the applicant’s company and not with the German company’s goods.

OHIM’s Cancellation Division found that the claim of well-known character and reputation for the mark “BALTIC” in the relevant market sector was not proven as the only evidence provided was a printout from the website <http://www.baltic.se> containing information about the applicant’s company and products. However, while the term “BALTIC” was not particularly imaginative it would be seen as having normal distinctiveness by European consumers, many of whom would be unaware of its geographical significance.

The two trade marks produced similar visual and aural impressions and the contested goods “*clothing, footwear, headgear*” were in part identical and in part similar to the goods “*clothing*” protected by the earlier CTM.

The Cancellation Division found that it was very likely that the contested mark would be associated by the consumer with the earlier mark creating an impression that the respective goods originated from the same undertaking or economically-linked undertakings. Consequently, the request for a declaration of invalidity was upheld under Article 8(1)(b) in conjunction with Article 52(1)(a) CTMR and the contested CTM No 4 014 131 was declared invalid in respect of the goods “*clothing, footwear, headgear*”, in class 25. Since the application had succeeded on the grounds of likelihood of confusion, the “bad faith” claim was not examined.



**Country overview: Finland & the Community Trade Mark**



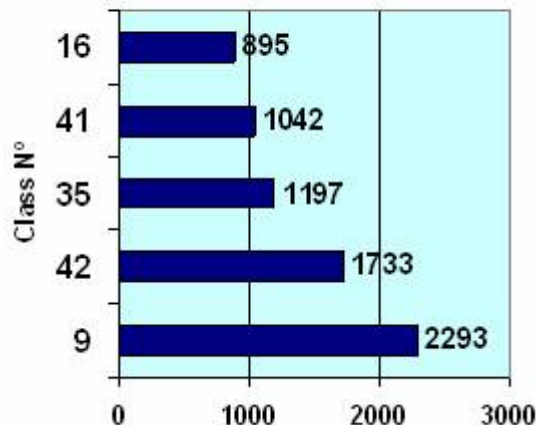
Finland, with a population of 5.3m, joined the EU in 1995. A country of forests and lakes, it is perhaps best known for its unspoilt natural beauty. However, Finland has also developed a modern, competitive economy, and is a world leader in telecommunications equipment. Main exports include telecoms equipment and engineering products, paper, pulp and lumber, glassware, stainless steel and ceramics.

Finnish figures for GDP show that growth in the third quarter of 2008 was steady – up 0.1% compared with previous quarter. The service sector accounts for 64% of GDP followed by industry (33%), and agriculture (3%).

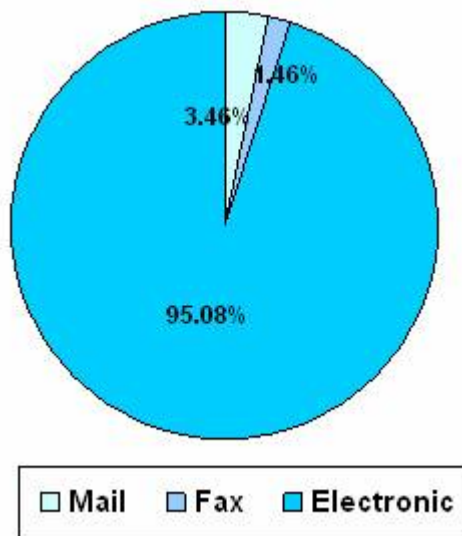
Finnish undertakings are strong supporters of the CTM system with almost 5 800 registrations to date. Last year, 752 Finnish CTMs were filed, an increase on 2007, and this year to date there have been 110.

marks (31%). The most popular goods and services applied for are in classes 9, 42 and 35.

**Finland - Top Classes Filed (Nice)**



The vast majority of Finnish trade marks (95%) are filed electronically, with mail accounting for 3% and fax for 1%



**Top 10 Finland-based owners by number of CTMs filed**

Company	CTMs
Nokia Corporation	221
ORION CORPORATION	162
Stora Enso Oyj	88
Valio Ltd	84
TeliaSonera Finland Oyj	81
Altia plc	47
RAUTARUUKKI OYJ	43
UPM-Kymmene Oy	42
Kone Corporation	39
Ravintoraisio Oy	34

**Finland - CTM Filing Evolution (Total CTMs: 5 787)**



Word	Figurative	3-D	Colour	Other	Sound
67.49 %	30.86 %	0.59 %	0.95 %	0.06 %	0.05 %

Word marks are the most popular with Finnish enterprises and account for 67% of applications, followed by figurative



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

Representative	CTMs
BERGGREN OY AB	1 000
BENJON OY	757
HEINONEN & CO	687
KOLSTER OY AB	484
BORENIUS & KEMPPINEN ATTORNEYS AT LAW LTD	152
FORSSÉN & SALOMAA OY	143
BORENIUS & CO OY AB	125
PAPULA OY	119
SEPPO LAINE OY	112
TAMPEREEN PATENTTITOIMISTO OY	109

## Community Design

### Questions to the ECJ in Design Matters

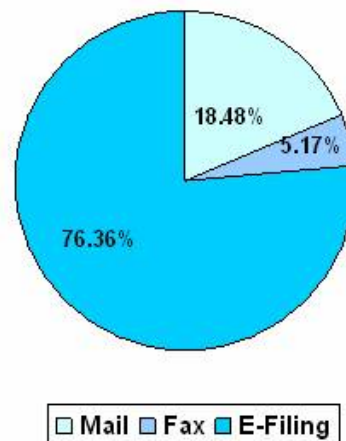
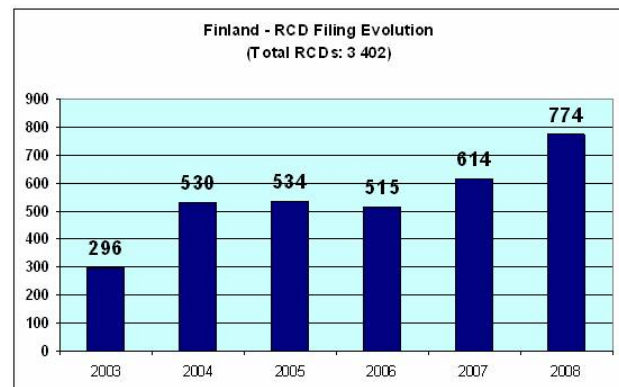
For the first time, the European Court of Justice (ECJ) has received a reference for a preliminary ruling in a case regarding a registered Community design. The Community design court of Spain, namely the *Juzgado de lo Mercantil Número Uno* in Alicante, has referred the following questions to the ECJ:

- Must Article 14(3) of [Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs be interpreted as referring only to Community designs developed in the context of an employment relationship where the designer is bound by a contract governed by employment law whose provisions are such that the designer works under the direction and in the employ of another? or
- Must the terms 'employee' and 'employer' in Article 14(3) of Regulation No 6/2002 be interpreted broadly so as to include situations other than employment relationships, such as a relationship where, in accordance with a civil/commercial contract (and therefore one which does not provide that an individual habitually works under the direction and in the employ of another), an individual (designer) undertakes to execute a design for another individual for a settled price and, as a result, it is understood that the design belongs to the person who commissioned it, unless the contract stipulates otherwise?
- In the event that the answer to the second question is in the negative, on the ground that the production of designs within an employment relationship and the production of designs within a non-employment relationship constitute different factual situations, (a) is it necessary to apply the general rule in Article 14(1) of Regulation No 6/2002 and, consequently, must the designs be construed as belonging to the designer, unless the parties stipulate otherwise in the contract? or (b) must the Community design court rely on national law governing designs in accordance with Article 88(2) of Regulation No 6/2002?
- In the event that national law is to be relied on, is it possible to apply national law where it places on an equal footing (as Spanish law does) designs produced in the context of an employment relationship (the designs belong to the employer, unless it has been agreed otherwise) and designs produced as a result of a commission (the designs belong to the party who commissioned them, unless it has been agreed otherwise)?
- In the event that the answer to the fourth question is in the affirmative, would such a solution (the designs belong to the party who commissioned them, unless it has been agreed otherwise) conflict with the negative answer to the second question?

### Country overview: Finland & the Registered Community Design

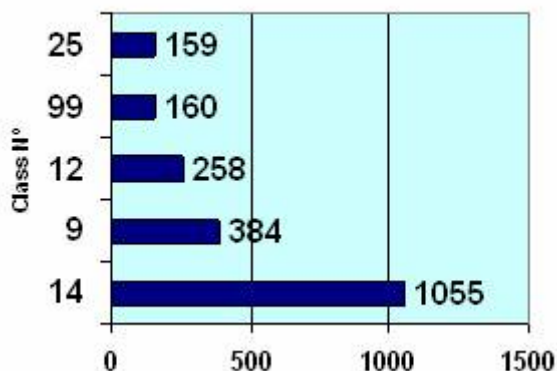
Finnish companies starting using the registered Community design as soon as it was first made available in 2004, with 300 filings in the first year. There has been a total of 3 400 Finnish RCD filings, including more than 770 last year and around 140 this year to date.

The most popular classes for RCDs are 14, 9 and 12. E-filing is the most popular filing route, accounting for 76%, with mail the next most popular at 18%. Filings by fax account for 5% of the total.





**Finland - Top Classes Filed (Locarno)**



**Top 10 Finland -based owners by number of RCDs filed**

Owner	RCDs
Nokia Corporation	1 068
Valio Ltd	107
Metsä Tissue Oyj	91
Rapala VMC Oyj	78
Nokian Tyres plc	72
Vaasan & Vaasan Oy	45
CREADESIGN OY	44
Oy Airam Electric Ab	43
Kone Corporation	41
Suunto Oy	40

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

Representative	RCDs
BERGGREN OY AB	723
Nokkanen	698
HEINONEN & CO	522
KOLSTER OY AB	247
OY JALO ANT-WUORINEN AB	232
MAXTON LANGMAACK & PARTNER	90
PAPULA OY	67
TAMPEREEN PATENTTITOIMISTO OY	61
Nieminen	55
BORENIUS & CO OY AB	53

**E-business at OHIM**

**What's happened to my "statuses" in CTM-ONLINE?**

OHIM has been improving its back office services for CTM management and one knock-on effect that users will notice is a change in the way in which status information on CTM files is reported.

The status information of the CTM files in CTM-ONLINE has changed to reflect the new way of processing the CTM application in the OHIM back office system. Users will see

that important steps in the process continue to be called "statuses", whereas tasks leading to these stages are listed as "sub-statuses".

**Statuses:** The term "status" is reserved for significant milestones such as "Examination of CTM application", "Publication", "Registration".

**Sub-statuses:** These are tasks which always belong to the significant milestones or "statuses" and indicate a job or action taken by OHIM. In CTM-ONLINE a sub-status identifies an individual task which is displayed together with a tick box. When the tick box is marked as "un-ticked" it means that the task is currently being executed and when it is "ticked" it indicates that the task has been completed (usually showing the date recorded in the system.)



In CTM-ONLINE, three scenarios are possible:

1- CTMs already registered are not affected and the history of statuses reflects the old status terminology. The associated glossary of statuses provides the explanations regarding those statuses.



2- CTM applications received from 20 February, 2009 will be treated using the new OHIM back office system. Hence their state will be displayed using the new terminology of "status" and "sub-status".





3- CTM applications received before 20 February, 2009 and not registered have part of the status information coming from the old back office system and most recent statuses coming from the new back office system. In CTM-ONLINE the actual status reflected is displayed using the new scheme and in the history of statuses the old statuses are separated from the new ones with a line.

The statuses of Oppositions are also changed in the same way and appear in the Opposition section in CTM-ONLINE.



Further information regarding the new statuses in CTM-ONLINE glossary is available by clicking at:

[http://oami.europa.eu/en/database/tm\\_status\\_euro.htm](http://oami.europa.eu/en/database/tm_status_euro.htm).

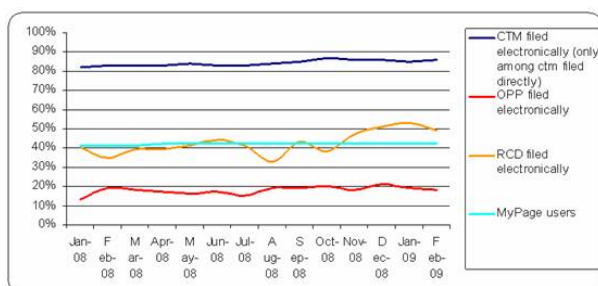
Clicking on the current status of the CTM application displays the interactive flowchart which shows the status of the selected CTM within the registration process.

Should you require any further information, please contact us at [information@oami.europa.eu](mailto:information@oami.europa.eu).

## OHIM e-business roundup (2009)

### Statistical summary

- The use of the CTM e-filing web form is steadily above 80 %.
- The use of RCD e-filing has decreased to 50%
- Oppositions against CTM applications received electronically is around 20%.
- MyPage users represent around 42% of CTM Applications filed



## State of play of future projects

### Service - New version of CTM E-filing:

Status - It is live since 02 February

### 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 is testing the system

### CTM watch:

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

Status - OHIM is going to start the testing phase

## More News

### Singapore Treaty comes into force

The Singapore Treaty on the Law of Trademarks, came into force on 16 March. A total of eleven jurisdictions have signed up to the Treaty, which aims to create a "modern and dynamic international framework for the harmonization of administrative trademark registration procedures".

Building on the Trademark Law Treaty of 1994 (TLT 1994), the new Treaty has a wider scope of application and addresses new developments in the field of communication technology.

The World Intellectual Property Organization, WIPO, described the entry into force as "good news for trademark owners around the world" as it opened the way for the branded goods industry to register and manage trademark rights cost-effectively and efficiently, and was "a particularly welcome development for companies seeking to generate cost savings, and maintain their market position in the current turbulent economic circumstances."

The Singapore Treaty was initially adopted by WIPO member states in Singapore on March 28, 2006.

Singapore Treaty contracting parties:

- Spain: Ratification - 18 February, 2009
- Singapore: Ratification - 26 March, 2007
- Switzerland: Ratification - 6 July, 2007
- Bulgaria: Accession - 21 January, 2008
- Romania: Ratification - 25 March, 2008
- Denmark: Ratification - 24 June, 2008
- Latvia: Ratification - 9 September, 2008
- Kyrgyzstan: Ratification - 12 September, 2008
- United States of America: Ratification - 1 October, 2008
- Republic of Moldova: Ratification - 16 December, 2008
- Australia: Ratification - 16 December, 2008

Summary of the Singapore Treaty (WIPO)

[http://www.wipo.int/treaties/en/ip/singapore/summary\\_singapore.html](http://www.wipo.int/treaties/en/ip/singapore/summary_singapore.html)



## Monthly statistical highlights February 2009

Community trade mark applications received	6 307
Community trade mark applications published	7 574
Community trade marks registered (certificates issued)	10 485
Community trade mark renewal applications	1 110
Registered Community designs received	3 792
Registered Community designs published	4 692

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

## Case-law

### Latest trade mark and design news from Luxembourg

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**ECJ Judgments and Orders**  
 Active Media Gate: C-57/08-P  
 Deitech: T-86/07  
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**ECJ Developments in pending cases**  
 NONE  
 Tomorrow Focus: T-90/06  
 Patentconsult: T-335/07  
 IFS: T-462/05  
 Bateaux Mouches: T-365/06

**ECJ Preliminary Rulings**  
 NONE  
 Vitro/Vitral: T-412/06  
 Giorgio Berverly Hills: T-228/06  
 Vitro: T-295/07

**ECJ Preliminary Rulings: Developments in pending case**  
 NONE  
**CFI Judgments and Orders: Developments in pending cases**

**CFI Judgments and Orders**  
 CFI Judgments and Orders  
 Insight: T-489/07  
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 Torre Albéniz: T-287/06  
 TG Torre: T-08/7  
 Torre de Frías: T-285/06  
 Torre de Benítez: T-16/07  
 Medtec/Metec: T-262/08  
 Coperture Ombreggianti: T-351/07  
 Manso de Velasco: T-259/06  
 Bud/Bud: T-225/06, T-255/06, T-257/06 and T-309/06  
 Hase: T-336/08  
 Republic: T-311/08  
 Mepos: T-297/08  
 Temacolor: T-295/08  
 Schoko-Rentier: T-337/08  
 COLOMÉ: T-341/08  
 Icon: T-389/08  
 Deutsche BKK: T-289/08  
 Aldi/Alpi: T-298/08  
 Often/Olten: T-292/08

## 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

**Active Media Gate** : C-57/08-P – Judgment of 11 December 2008 (only in FR; appeal dismissed; Office practice confirmed).

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

The case was an appeal from the judgment of 27.11.2007 of the CFI (Fifth Chamber) in Case T-434/05 relating to Fujitsu Siemens Computers GmbH's CTM application for the sign "ACTIVY Media Gateway" for a range of goods and services in Classes 9, 35, 38 and 42. It had been opposed based on several earlier trade mark applications and rights in "GATEWAY", word mark, applied for, or registered, respectively, in Classes 9, 35 and 38. The opposition had been rejected given the absence of similarity between the signs. The 5th Chamber of the ECJ (Ilesic, rapporteur; Tizzano; Kasel) confirmed these findings, relying on standard criteria.

### A-2: ECJ: Developments in pending cases

NONE

## B: European Court of Justice: Preliminary Rulings

### B-1: ECJ Preliminary Rulings

NONE

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

None

## 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

**Insight** : T-489/07 – Case closed; Order of 18 December 2008 .

Keywords: Opposition: likelihood of confusion (LOC).

The action had been brought against a decision of the 2nd Board of 20.9.2007 in Case R 1428/2006-2 relating to CTM 3 309 002, "Insight" (figurative mark).



CTM application

Net Insight



It had been applied for, inter alia, in Classes 35, 37 and 42. It had been opposed, as concerns these classes, on the basis of several earlier rights in word marks and figurative marks ("Net Insight"), registered in Classes 9, 37 and 41, and the opposition had been partially allowed. Since the parties reached an out-of-court agreement, the case was closed.

**GlobalRemote** : T-209/07 – Case closed, Order of 16 December 2008 (DE).

Keywords: Absolute grounds for refusal: descriptiveness.

The action had been directed against a decision of the 4th Board of 25.4.2007 in Case R 0272/2005-4 relating to CTM 1 466 499, shown below. It is registered in Classes 9, 38 and 42, *inter alia* for telecommunication.

The CTM had been challenged on the basis of a request for invalidation on absolute grounds, namely as being descriptive and devoid of distinctive character. The request had been rejected. Upon an out-of-court settlement, the invalidation request has been withdrawn, and the case was closed.

**Bomba/La Bamba** : T-372/06 – Case closed; Order of 19 December 2008 (DE).

Keywords: Opposition: likelihood of confusion (LOC).

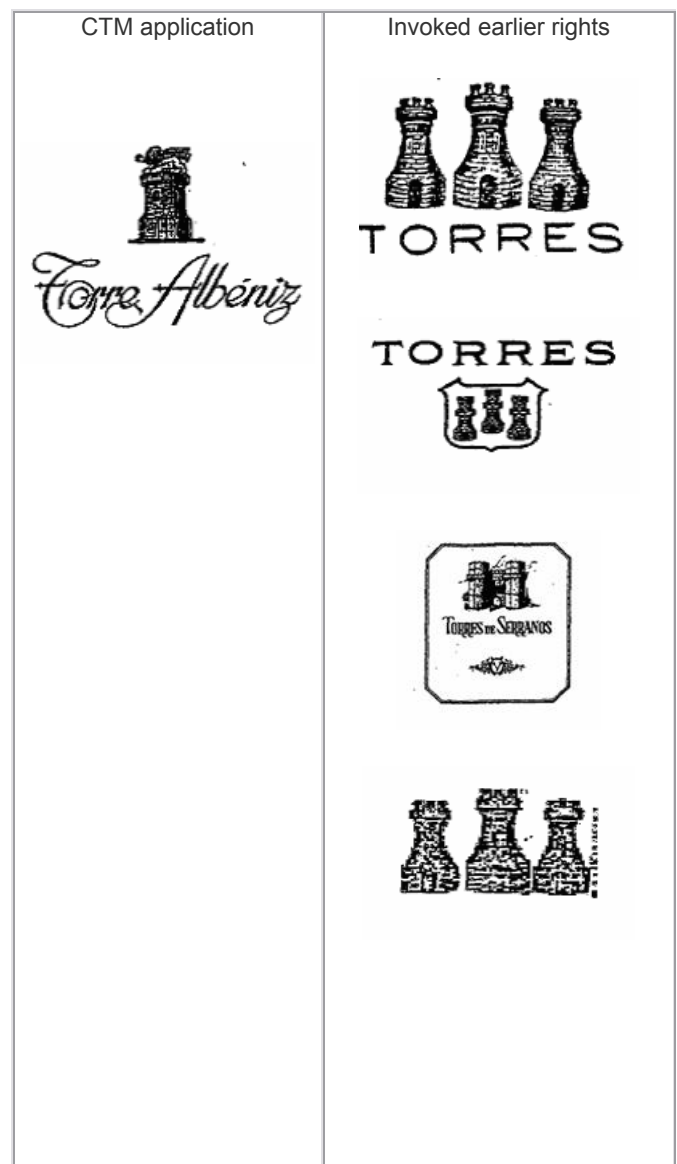
The case had been brought against a decision of the 2nd Board of 3.10.2006 in Case R 0184/2005-2 relating to a conflict between the marks "BOMBA" and "la bamba". The first had been applied for as a CTM, No 558 874, for beverages in Classes 32 and 33. It had been successfully opposed on the basis of an earlier right in "la bamba", registered for goods in Classes 29, 32 and 33. Since the

parties reached an out-of-court agreement, the case was closed.

**Torre Albéniz** : T-287/06 – Judgment of 18 December 2008 (action dismissed, Board decision confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: high recognition of the earlier mark on the market – Enhanced recognition: scope of relevance.

The case was an appeal from a decision of the 2nd Board of 27.7.2006 in Case R 0597/2004-2 relating to CTM application "Torre Albéniz" (figurative mark), applied for for goods and services in Classes 32, 33 and 39.



It had been partially opposed (Class 33) by Miguel Torres S.A. on the basis of 28 earlier rights in figurative 'Torres' marks, and in a series of earlier rights in the words "TORRES", registered inter alia for wines and brandy. The



opposition had been allowed by the Opposition Division but had been rejected by the Board on the ground that the marks are dissimilar enough to exclude LOC, notwithstanding that the earlier rights enjoy a high recognition on the relevant markets. In that regard, the Board had held, *inter alia*, that the fact that the word 'torre' is placed first in the mark applied for did not make that word dominant as compared with the other elements of that mark. The mark applied for is distinctive because of the logical and conceptual unit formed by the combination of the two words, 'torre' and 'albéniz', and the latter word, because it gives the tower an individual identity, is dominant in that mark.

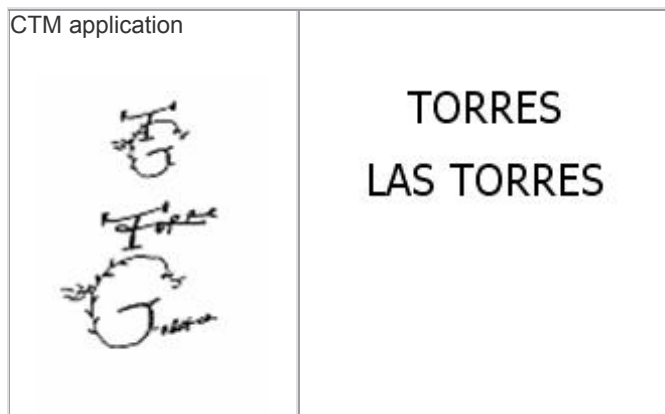
The Board had also held that while the fact that an earlier mark is well-known may strengthen its distinctiveness, that fact does not, in all circumstances, make more distinctive an identical or similar element in a compound mark to the extent that that element becomes the dominant component in the overall impression produced by the compound mark, where that element forms with the other components an indivisible logical and conceptual unit which can be entirely distinguished from and cannot be associated with the earlier mark which is well-known.

Next, the Board had held that the overall impression produced by the marks at issue was different, that the phonetic coincidence of the element 'torre' was offset by the element 'albéniz' and that, conceptually, the perception of the relevant public will vary according to whether or not it is familiar with the meaning of the word 'torre'. For those who understand the meaning of that word, there will be a conceptual difference, while for those who do not perceive any meaning in the word 'torre', the conceptual similarity is of little relevance. The 6th Chamber of the CFI (Meij, rapporteur; Sváby; Vadapalas) agreed.

**TG Torre** : T-08/7 – Judgment of 18 December 2008 (only in ES, FR; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: high recognition of the earlier right on the market.

The case was an appeal from a decision of the 2nd Board of 24.10.2006 in Case R 0168/2006-2 relating to CTM application "TG Torre" (figurative mark), applied for for alcoholic beverages in Class 33.



It had been opposed by Miguel Torres S.A. on the basis of a series of earlier rights in "TORRES" and "LAS TORRES", word marks, registered, *inter alia*, for wines and brandy. The opposition had been rejected on the ground that the marks are dissimilar enough to exclude LOC, notwithstanding that the earlier rights enjoy a high recognition on the relevant markets. The 6th Chamber of the CFI (Meij, rapporteur; Sváby; Vadapalas) agreed.

**Torre de Frías** : T-285/06 – Judgment of 18 December 2008 (only in ES, FR; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: high recognition of the earlier right on the market.

The case was an appeal from a decision of the 2nd Board of 27.7.2006 in Case R 1069/2006-2 relating to CTM application "TORRE DE FRIAS", word mark, applied for for alcoholic beverages in Class 33. It had been opposed by Miguel Torres S.A. on the basis of a series of earlier rights in "TORRES" and "LAS TORRES", word marks, registered, *inter alia*, for wines and brandy. The opposition had been rejected on the ground that the marks are dissimilar enough to exclude LOC, notwithstanding that the earlier rights enjoy a high recognition on the relevant markets. The 6th Chamber of the CFI (Meij, rapporteur; Sváby; Vadapalas) agreed.

**Torre de Benitez** : T-16/07 – Judgment of 18 December 2008 (only ES, FR; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – LOC: high recognition of the earlier right on the market.

The case was an appeal from a decision of the 2nd Board of 6.11.2006 in Case R 0036/2006-2 relating to CTM application "TORRE DE BENITEZ", word mark, applied for for goods in Class 33. It had been opposed by Miguel Torres S.A. on the basis of a series of earlier rights in "TORRES", word mark, registered, *inter alia*, for wines and brandy. The opposition had been rejected on the ground that the marks are dissimilar enough to exclude LOC, notwithstanding that the earlier rights enjoy a high recognition on the relevant markets. The 6th Chamber of the CFI (Meij, rapporteur; Sváby; Vadapalas) agreed.

**Medtec/Metec** : T-262/08 – Case closed; Order of 10 December 2008.

Keywords: Opposition: likelihood of confusion (LOC).

The case had been initiated against a decision of the 1st Board of 30.4.2008 in Case R 0817/2005-1 relating to CTM application "MEDTEC", word mark, applied for, *inter alia*, in Class 16 for instructional and teaching material (except



apparatus); in Class 35 for advertising; business management; business administration; arranging and conducting trade shows, exhibitions and congresses for commercial purposes, and in Class 41 for entertainment; publishing services; arranging and conducting trade shows, exhibitions and congresses for educational purposes.

It had been opposed on the basis of "METEC", word mark, covering, *inter alia*, in Class 16 printed matter; in Class 35 planning, arranging and conducting of fairs, exhibitions and presentations for economic and advertising purposes; compilation of information into data bases; systematization of data into computer data bases; advertising; management consultancy, and in Class 41 planning, arranging and conducting of fairs, exhibitions and presentations for cultural or educational purposes; planning and arranging congresses, conferences and teaching seminars; entertainment. The opposition had been successful. Since the CTM applicant (the plaintiff in the proceedings) informed the court that it had reached an out-of-court agreement, the case was closed.

**Coperture Ombreggianti** : T-351/07 – Judgment of 17 December 2008 (only IT, FR; action dismissed, Office practice confirmed).

Keywords: Types of signs: three-dimensional (3D)/shape of the good itself – Absolute grounds for refusal: distinctiveness/3D signs.

The action had been brought against a decision of the 1st Board of 28.6.2007 in Case R 1653/2006-1 relating to a 3D CTM application (an 'open air' garage, shown below); it had been applied for for a range of goods in Classes 6 and 19.



The application had been rejected on the ground that the shape will not be perceived as a badge of commercial origin, i. e. that the sign lacks distinctive character. The 2nd Chamber of the CFI (Pelikánová; Jürimäe, rapporteur; Soldevila Fragoso) agreed, relying on established case-law.

**Manso de Velasco** : T-259/06 – Judgment of 16 December 2008 (only in ES, FR; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The case had been initiated against a decision of the 1st Board of 29.6.2006 in Case R 0865/2005-1 relating to CTM

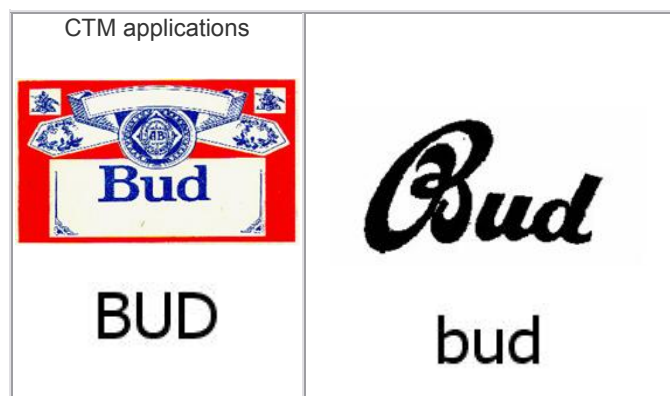
application "MANSO DE VELASCO", word mark, filed by a wine manufacturer for alcoholic beverages in Class 33. It had been opposed on the basis of "VELASCO", word mark, registered in Classes 30, 32 and 33, *inter alia*, for wines. The opposition had been successful at all instances, including the 3rd Chamber of the CFI (Azizi; Cremona, rapporteur; Frimodt Nielsen) which relied on standard criteria.

**Bud/Bud** : T-225/06, T-255/06, T-257/06 and T-309/06 – Judgment of 16 December 2008 (action allowed; impact on the interpretation of a party's claims before the Boards on the application of the Lisbon Agreement, and on bilateral agreements between Member States as regards business identifiers).

Keywords: Procedural law: interpretation of a party's claim(s) – Opposition: earlier rights – Earlier rights: other types of, Article 8(4) CTMR – Earlier rights: denomination of geographical origin – Appellations of origin: Lisbon Treaty – Opposition: proof of use as regards "other types of earlier rights".

The joined cases relate to a dispute between Budějovický Budvar, národní podnik, established in České Budějovice (Czech Republic), and Anheuser-Busch, Inc., established in Saint Louis, Missouri (United States), and the respective decisions of the 2nd Board of 14 June 2006 (Case R 0234/2005-2), of 28 June 2006 (Cases R 0241/2005-2 and R 0802/2004-2) and of 1 September 2006 (Case R 0305/2005-2).

On 1 April 1996, 28 July 1999, 11 April and 4 July 2000 Anheuser-Busch, Inc. had filed four CTM applications (respectively 24 711, 1 257 849, 1 603 539 and 1 737 121). One of these (1 257 849 = application No 1) concerned a figurative mark. The three others, 24 711, 1 603 539 and 1 737 121 (respectively, application No 2, application No 3 and application No 4), related to the word mark "BUD".



The goods in respect of which registration of the figurative mark had been sought are in Classes 16, 21, 25 and 32, namely in Class 16: paper, cardboard and goods made from these materials, 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; playing cards; printers' type; printing blocks; in 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; in Class 25: clothing, footwear, headgear; and in Class 32: beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages. The goods and services in respect of which registration of the word mark had been sought are within Class 32 (application No 2), Classes 32 and 33 (application No 3), and Classes 35, 38, 41 and 42 (No 4).

'Budvar' had filed notices of opposition in respect of all the goods specified in the CTM applications and had relied, first of all, under Article 8(1)(b) CTMR, on international figurative mark 361 566 registered for 'all types of light and dark beer', effective in Austria, Benelux and Italy. It had further relied, under Article 8(4) CTMR, on an appellation of origin 'bud' (appellation of origin 598), registered under the Lisbon Agreement, on 10 March 1975, with the World Intellectual Property Organisation (WIPO) in respect of beer, and effective in France, Italy and Portugal. In addition, in relation to the CTM applications Nos 1, 2 and 3, Budvar had also relied on an appellation of origin 'bud' protected in Austria, in respect of beer, under a bilateral convention.

By its decisions, the Opposition Division had fully rejected three oppositions, and had rejected one opposition in part. By three decisions of 14 June (Case R 0234/2005-2), 28 June (Case R 0241/2005-2) and 1 September 2006 (Case R 0305/2005-2), the Board had subsequently dismissed the appeals brought by Budvar in relation to registration applications No 1, 2 and 3. By a decision of 28 June 2006 (Case R 0802/2004-2), the Board had upheld the appeal brought by Anheuser-Busch in relation to CTM application No 4 and had dismissed the opposition filed by Budvar in its entirety. In the four decisions, the Board had stated first of all that Budvar no longer appeared to refer to the international figurative mark No 361 566 as the basis of its opposition, but solely to the appellation of origin 'bud'.

The Board then had held, in essence, first, that it was difficult to see how the sign BUD could be considered to be an appellation (or designation) of origin, or even an indirect indication of geographical origin. The Board concluded that an opposition could not succeed under Article 8(4) CTMR on the basis of a right that was presented as an appellation of origin, but was in fact not one at all. Secondly, the Board had held, applying by analogy the provisions of Article 43(2) and (3) CTMR and of Rule 22 CTMIR, that the evidence provided by Budvar to show use of the appellation of origin 'bud' in Austria, France, Italy and Portugal was insufficient. Thirdly, the Board had stated that the opposition had also to be rejected on the ground that Budvar had not demonstrated that the appellation of origin in question gave it the right to prohibit use of the word 'bud' as a trade mark in Austria or France.

The 1st Chamber of the CFI (Tiili; Dehousse, rapporteur; Wiszniewska-Bialecka) annulled the Board's decisions.

Before the CFI, after having given a summary of the historical background of the dispute between the parties in these

proceedings, Budvar had relied, in essence, on a single plea in law alleging an infringement of Article 8(4) CTMR. Budvar's single plea in law had two parts. In the first part, Budvar challenged the Board's conclusion that the sign BUD could not be considered to be an appellation of origin. In the second part, Budvar disputed the Board's assessment that the conditions of Article 8(4) CTMR are not satisfied in the present case.

*(a) The validity of the appellation of origin 'bud'*

"(79) Article 8(4) CTMR allows for opposition proceedings to be brought against an application for a Community trade mark on the basis of a sign other than an earlier trade mark, the latter situation being covered by Article 8(1) to (3) and (5) (Joined Cases T-57/04 and T-71/04 Budějovický Budvar and Anheuser-Busch v OHIM (AB GENUINE Budweiser KING OF BEERS) [2007] ECR II-1829, paragraph 85). Under Article 8(4) CTMR, pursuant to the Community legislation or the law of the Member State governing that sign, the rights derived from the sign must have been acquired prior to the date of the application for registration of the Community trade mark or to the date of priority claimed for the CTM application. Again, pursuant to the Community legislation or the law of the Member State governing the sign, the sign must confer on its proprietor the right to prohibit use of a subsequent trade mark."

"(82) When examining the contested decisions it is necessary to make a distinction made between the appellation of origin 'bud' registered under the Lisbon Agreement and the appellation 'bud' protected under the bilateral convention. The European Community is not a party to either the Agreement or the convention.

(83) The contested decisions state that the Board examined whether the sign BUD 'is an appellation of origin at all'. In that connection, the Board held that the opposition at issue could not succeed under Article 8(4) CTMR on the basis of a right 'presented as an appellation of origin', but which in fact 'is not ... an appellation of origin at all'. Further, the Board of Appeal held that the question whether the sign BUD was treated as a protected appellation of origin, *inter alia* in France pursuant to the Lisbon Agreement, 'is of secondary importance'. It follows that the Board ruled on the very classification as an 'appellation of origin', without examining the extent of the protection of the appellation of origin at issue in the light of the claimed national rights.

(84) First – without needing to examine, in connection with the first part of the plea, the effects of the Lisbon Agreement on the protection of the claimed earlier right under French law – the Court points out that the registration of appellations of origin under that agreement is made at the request of the authorities of the contracting countries, in the name of natural or legal persons, public or private, having, according to their national legislation, a right to use such appellations. In that context, the authorities of the contracting countries may, within a period of one year from the receipt of the notification of registration, make a declaration, with an indication of the grounds therefor, that they cannot ensure the protection of an appellation of origin (Article 5(1) and (3) of the Lisbon Agreement).



(85) Secondly, the appellation of origin registered under the Lisbon Agreement cannot be deemed to have become generic for as long as it is protected as an appellation of origin in the country of origin. Where that is the case, the protection conferred on the appellation of origin is ensured, and it is unnecessary to seek any renewal (Article 6 and Article 7(1) of the Lisbon Agreement).

(86) Thirdly, under Rule 16 of the Regulations under the Lisbon Agreement, when the effects of an international registration are invalidated in a contracting country and the invalidation is no longer subject to appeal, that invalidation must be notified to the International Bureau by the competent authority of the contracting country. In that event, the notification is to indicate the authority which pronounced the invalidation. It follows that, under the Lisbon Agreement, the effects of a registered appellation of origin can be declared invalid only by an authority in one of the contracting countries party to that agreement.

(87) In the present case, the appellation of origin 'bud' (No 598) was registered on 10 March 1975. France did not declare, within the period of one year from the date of receipt of notification of the registration, that it could not ensure the protection of that appellation of origin. When the contested decisions were adopted, the effects of the appellation of origin had been declared invalid by a judgment of the Tribunal de grande instance in Strasbourg of 30 June 2004. However, as is clear from the documents placed on the file, Budvar has lodged an appeal, the effect of that appeal being to suspend the effect of that judgment. It follows that, when the contested decisions were adopted, the effects of the appellation of origin at issue had not been declared invalid, in France, by a decision against which there is no appeal.

(88) As is apparent from the fifth recital in the preamble to Regulation No 40/94, Community law relating to trade marks does not replace the laws of the Member States on trade marks (Case T-318/03 Atomic Austria v OHIM – Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ) [2005] ECR II-1319, paragraph 31). Accordingly, the CFI has held that the validity of a national trade mark may not be called in question in proceedings for registration of a CTM (Case T-6/01 Matratzen Concord v OHIM – Hukla Germany (MATRATZEN) [2002] ECR II-4335, paragraph 55; Case T-186/02 BMI Bertollo v OHIM – Diesel (DIESELIT) [2004] ECR II-1887, paragraph 71; Case T-269/02 PepsiCo v OHIM – Intersnack Knabber-Gebäck (RUFFLES) [2005] ECR II-1341, paragraph 26; and Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 88).

(89) It follows that the system set up by Regulation No 40/94 presupposes that OHIM takes into account the existence of earlier rights which are protected at national level. Accordingly, Article 8(1), read in conjunction with Article 8(4) CTMR, provides that the proprietor of another sign used in the course of trade of more than mere local significance and which is effective in a Member State may, subject to the specified conditions, oppose the registration of a Community trade mark (see, by analogy, ATOMIC BLITZ, paragraph 88 above, paragraphs 31 and 32). To ensure that protection, Article 8(4) CTMR refers specifically to 'the law of the Member State governing' the claimed earlier right.

(90) Since the effects of the appellation of origin 'bud' have not been declared definitively to be invalid in France, the Board of Appeal ought, under Article 8(4) of Regulation No 40/94, to have taken account of the relevant national law and the registration made under the Lisbon Agreement, and did not have the power to call in question the fact that the claimed earlier right was an 'appellation of origin'.

(b) *The appellation 'bud' protected under the bilateral convention*

“(93) It is clear from the wording of Annex B of the bilateral agreement that the word 'bud' was described as being an 'indication'. It is not clear from that agreement that the indication 'bud' was specifically designated as an 'appellation of origin'. Moreover, it is not clear from that agreement that the word 'bud' was considered to be a geographical name or to refer to particular qualities of the product concerned.

(94) It must be pointed out, in that regard, that, under Article 2 of the bilateral convention, if the indications or appellations concerned relate directly or indirectly to the source of a product, that is sufficient to permit it to be listed under the bilateral convention and thereby to enjoy the protection conferred by the bilateral convention. That definition is, in that respect, wider than that adopted by the Board. The Board held that an 'appellation of origin' is a 'geographical indication which informs consumers that a product originates from a specific place, region or territory and that it possesses certain characteristics attributable to the geographical environment in which it was produced, including natural and human factors' (the Board of Appeal's decision of 14 June 2006 (Case R 234/2005-2), paragraph 19, and by reference thereto in the other contested decisions).

(95) In light of the foregoing, it must be held that the Board made two errors. First, the Board held, wrongly, that the protection of the name 'bud' was specifically attached to its status as an 'appellation of origin' under the bilateral convention. Secondly, on any view of the matter, the Board employed a definition of 'appellation of origin' which does not correspond to the definition of the indications protected under that convention.

(96) The fact that Budvar may have presented the claimed right as an 'appellation of origin' did not prevent the Board from undertaking a comprehensive assessment of the facts and documents presented (see, to that effect, ATOMIC BLITZ, paragraph 88 above, paragraph 38). That is particularly important when the appropriate classification of an earlier right may impact on the effects of that right within opposition proceedings. It must be recalled, in that regard, that OHIM may be required to take into account, *inter alia*, the national law of the Member State where the earlier mark on which opposition is based is protected. In that event, OHIM must of its own motion obtain information, by whatever means appear to it to be necessary for that purpose, on the national law of the Member State concerned, if such information is necessary to assess the applicability of the ground for refusal of registration at issue and, in particular, to assess the correctness of the facts pleaded, and the probative value of the evidence submitted by the parties. The restriction of the factual basis of the examination by OHIM does not preclude it from taking into consideration, in addition to the facts expressly put forward by the parties to the opposition



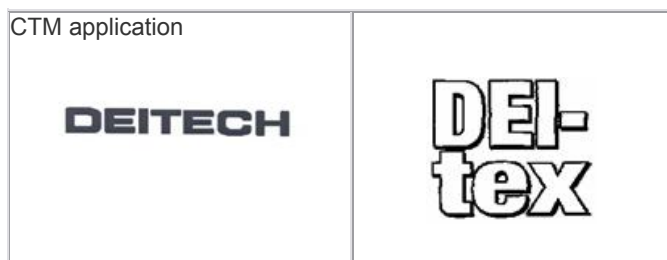
proceedings, facts which are well known, that is, which are likely to be known by anyone or which may be learnt from generally accessible sources (Case T-185/02 Ruiz-Picasso and Others v OHIM – DaimlerChrysler (PICARO) [2004] ECR II-1739, paragraph 29, and ATOMIC BLITZ, paragraph 88 above, paragraph 35). Those principles apply to the present case. The Board had the information needed to undertake a comprehensive assessment of the facts.”

“(98) Furthermore, the bilateral convention is still effective in Austria for the purposes of protecting the appellation ‘bud’. In particular, the documents lodged in the proceedings do not show that the Austrian courts have held that Austria or the Czech Republic did not intend to apply the principle of the continuity of treaties to the bilateral convention, following the break-up of the Czechoslovak Socialist Republic. Moreover, there is no indication that Austria or the Czech Republic have denounced that convention. In addition, the ongoing proceedings in Austria have not led to the adoption of a final judicial decision. In those circumstances, for the same reasons as set out in paragraphs 88 and 89 above, the Board ought to have taken into account, pursuant to Article 8(4) CTMR, Budvar’s claimed earlier right without calling in question the actual classification of that right.”

**Deitech** : T-86/07 – Judgment of 16 December 2008 (only in DE, FR; action partially allowed; law of the case).

Keywords: Opposition: formalities – Formalities/earlier rights: required evidence – Opposition: proof of use (POU) – Opposition: likelihood of confusion (LOC) – LOC: comparison of goods – LOC: comparison of marks.

The action had been initiated against a decision of the 2nd Board of 22.1.2007 in Case R 0791/2006-2 relating to CTM application “DEITECH”.



It had been applied for, in Class 18, for goods of leather and imitations of leather, goods made from these materials, not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery, and in Class 25 for clothing, footwear and headgear. The application had been partially opposed by Heinrich Deichmann GmbH & Co KG on the basis of earlier rights in “DEITEX” (figurative mark), registered for clothing, footwear and headgear in Class 25.

The Opposition Division had rejected the opposition, *inter alia* on the following grounds: “In order to prove the existence, ownership and validity of German trade mark 397 22 945, the opponent submitted some documentation issued by Wila Business Information. Such documentation is not of an

official nature and therefore it is not sufficient to substantiate the said trade mark registration. Thus, the said German trade mark cannot be taken into account. The examination of the opposition takes into consideration the international trade mark 684 387 with effect in Austria, the United Kingdom and the Benelux. The submitted evidence as POU relates to Austria only (*the evidence of use in Germany had not been considered*). It consists of three brochures and a statutory declaration by Mr. H., purchasing agent of the opponent for Austria. Mr. H. declares that the earlier trade mark has been extensively used since 1998 for footwear and provides sales figures and turnover generated by sales of shoes in Austria from 2001 to 2005. No evidence was filed concerning use of the earlier trade mark in the United Kingdom or the Benelux.”

“The statement in question, which comes from a purchaser agent, is not supported by adequate evidence. Indeed, the appearance of the trade mark in three brochures does not constitute convincing proof that the trade mark in question was effectively put on the market during the five years preceding the publication of the contested application. Thus, the evidence lacks sufficient indications demonstrating genuine use in Austria during the period of five years preceding the date of publication of the mark applied for. Given that the opponent did not submit any evidence concerning the use of its trade mark in the United Kingdom or the Benelux, it is concluded that the opposition must be rejected pursuant to Article 43(2) and (3) CTMR. In any case, even if the opponent had proved genuine use of the earlier trade mark in connection with ‘footwear’ in Austria, the opposition would still fail under Article 8(1)(b) CTMR. This is because the trade marks feature dissimilarities that exclude any likelihood of confusion.”

On subsequent appeal, the Board had revoked that decision only as regards the evidence of the existence of the earlier German registration. It had confirmed that overall the invoked earlier rights had not been put to genuine use anywhere. The 1st Chamber of the CFI (Tiili; Dehousse, rapporteur; Wisniewska-Bialecka) disagreed in part, namely as regards “shoes” in Class 25, and, in consequence, revoked that part of the challenged Board decision.

**Focus Radio/Focus Milenium** : T-357/07 – Judgment of 16 December 2008 (action dismissed, Office practice confirmed).

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

The action had been brought against a decision of the 4th Board of 30.7.2007 in Case R 0269/2005-4 relating to CTM application “FOCUS Radio”. The goods and services in respect of which registration had been applied for are in Classes 9, 16, 35, 38, 41 and 42, namely in Class 9: computers and data-processing apparatus; memories for data processing equipment; computer software, in particular for the scanning, displaying, processing and output of multimedia data on computer networks, including the internet; machine-readable data carriers of all types containing information, and sound and image-recording carriers, in particular floppy discs, CD-ROMs, DVDs, chip cards, magnetic cards, video cassettes, compact discs and video discs; collections of



information recorded on data carriers; data banks; in Class 16: printed matter, printed materials, periodicals, newspapers, books, bookbinding material, posters, stickers, calendars, signboards and models of paper, cardboard, photographs and photographic products; paper, cardboard, stationery and office requisites (except furniture), instructional and teaching material (except apparatus).

In Class 35: database services, namely collating, storing, providing and updating of data and other information; e-commerce services, namely the arranging, concluding and handling of commercial transactions via online shops; advertising, including radio, print and internet advertising; advertising agency services; rental of advertising space on the internet; marketing, for others, in particular on digital networks ("Webvertising"), market research and analysis; distribution of samples, sales promotion; public relations; arranging advertising events; in Class 38: radio broadcasting; telecommunications; connecting computer systems to data networks, telephone installations and telephone networks; providing information to others, broadcasting information via wireless or cable networks; online services, namely sending of messages and information of all kinds; email data services (electronic mail); internet services, namely providing of information on the internet.

In Class 41: publication of printed matter, in particular newspapers, periodicals and books, and teaching and instructional material including stored sound and image information, also in electronic form; production of sound and image recordings on sound and image carriers; showing and rental of sound and image recordings; production of radio broadcasts, production of radio programmes; multimedia services, namely production of multimedia presentations; entertainment, in particular radio entertainment; conducting entertainment events, live events, training events and cultural and sporting events, and in Class 42: computer programming and design of computer programs (computer software); maintenance and upgrading of computer programs, and on-line updating services; research and development in the field of data processing; design, development and consultancy in the field of computer hardware, consultancy in the field of computer hardware; network operator and provider services, namely arranging and leasing access time to computer databases; creating, design and constructing of internet presentations; design, processing and maintenance of internet content; providing documentation.

It had been opposed on the basis of several earlier rights in "FOCUS MILENIUM", covering goods and services in, respectively, Classes 9, 16 and 41, and corresponding to the following descriptions, in Class 9: scientific, nautical, geodetic, electric, photographic, film, optic, weighing, measuring, signposting, for control (inspection), assistance (rescue) and teaching apparatus and instruments; apparatus for registration, transmission, reproduction of sound or images; magnetic registry supports, acoustic discs, automatic distributor machines and mechanisms for pre-payment machines; cash registers, calculators, equipment for processing information and computers; fire extinguishers; in Class 16: paper, cardboard and paper and cardboard goods not included in other classes; printed matter; bookbinding goods; photographs; stationery; adhesives (glues) for stationery or house purposes; artists' materials; paint brushes, typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic

materials for packing (not included in other classes); playing cards; printer's type, printing blocks; clichés, and in Class 41: education; teaching; leisure; sport and cultural activities.

The Opposition Division had upheld the opposition in part. It had considered the goods concerned in Classes 9 and 16 and the services concerned in Class 41 to be identical, and that 'connecting computer services to data networks' in Class 38, and 'consultancy in the field of computer hardware' in Class 42, designated in the trade mark application, were similar to the 'computer' goods covered by the opposition. Having found that the marks FOCUS MILENIUM and FOCUS Radio were similar, the Division had concluded that there was LOC in respect of those identical or similar goods and services. However, it had rejected the opposition as regards the services in Class 35, the services in Class 38, with the exception of 'connecting computer services to data networks', and the services in Class 42, with the exception of 'consultancy in the field of computer hardware', finding that those services differed from the services covered by the marks FOCUS MILENIUM.

The Board then had annulled that decision in part. It had found that the opposition could be upheld only in respect of the identical goods and services, since the signs in question are only similar to a low degree. It therefore rejected the opposition as regards the services in Classes 38 and 42. It had also found that some of the goods in Class 9 and some of the services in Class 41 were only similar, and that, accordingly, the opposition had to be rejected also in respect of those goods and services.

Consequently, the goods and services in respect of which the CTM application had been rejected are the following: Class 9: computers and data-processing apparatus; memories for data-processing equipment; machine-readable data carriers of all types containing information, and sound and image-recording carriers, in particular floppy discs, CD-ROMs, DVDs, chip cards, magnetic cards, video cassettes, compact discs and video discs; collections of information recorded on data carriers; Class 16: printed matter, printed materials, periodicals, newspapers, books, stickers, calendars, office requisites (except furniture), instructional and teaching material (except apparatus); Class 41: entertainment, among other radio entertainment; conducting entertainment events, live events, cultural and sporting events. In reply to a written question from the CFI, the OHIM had confirmed that the service 'conducting training events', in Class 41, was one of the services for which the trade mark applied for could be registered. The 1st Chamber of the CFI (Tiili, rapporteur; Dehousse; Wiszniewska-Bialecka) confirmed these findings.

**Tomorrow Focus** : T-90/06 – Judgment of 11 December 2008 (only in DE, FR; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The case had been initiated against a decision of the 1st Board of 17.1.2006 in Case R 0116/2005-1 relating to CTM application "Tomorrow Focus", word mark, applied for for a



range of goods and services in Classes 9, 16, 35, 38, 41 and 42.



It had been partially opposed on the basis of the figurative trade mark “FOCUS”, registered in Classes 9 and 42. The opposition had been allowed with respect to part of the goods in Class 9 and related services in Class 42. The 5th Chamber of the CFI (Vilaras; Prek, rapporteur; Ciucá) confirmed these findings, relying on standard criteria.

**Patentconsult** : T-335/07 – Judgment of 16 December 2008 (only in DE, FR; action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: descriptiveness.

The action had been directed against a decision of the 4th Board of 25.6.2007 in Case R 0299/2007-4 relating to CTM application “PATENTCONSULT”, word mark, which had been applied for for a range of services in Classes 35, 41 and 42, mainly for the various possible services of patent attorneys. It had been rejected as being descriptive, and the 2nd Chamber of the CFI (Pelikánová, rapporteur; Jürimäe; Soldevila Frago) confirmed these findings, relying on standard criteria.

**IFS** : T-462/05 – Judgment of 10 December 2008 (allowed; on substance: law of the case; in respect of formal issues: the case will have an impact on the accurateness of the assessment of descriptiveness).

Keywords: Types of signs: combination of letters (abbreviations) – Absolute grounds for refusal (AG): distinctiveness/descriptiveness – AG: relevant public – AG: evidence and “burden of proof”.

The action had been directed against a decision of the 1st Board of 14.9.2005 in Case R 1157/2004-1 relating to CTM application “IFS” which had been applied for in Class 12 for steering and power steering, both for vehicles and parts therefor, excluding independent front suspension. It had been rejected on the ground that the sign applied for was descriptive of the goods concerned for the purposes of Article 7(1)(c) CTMR. Registration of the sign IFS was refused on the ground that the relevant public – consisting of specialised English-speaking consumers including vendors or purchasers of motor vehicles, who are well informed and interested in the technical aspects of the construction of a vehicle – would perceive it as an acronym of the expression ‘independent front suspension’, designating an essential characteristic of

the goods concerned. The 7th Chamber of the CFI (Forwood; Sváby, Moavero Milanese, rapporteur) took a different view.

(a) *Relevant public*

“(28) In paragraphs 20 and 22 of the contested decision, the Board defined the relevant public as being made up of specialised English-speaking consumers composed of knowledgeable vendors or purchasers of motor vehicles with an interest in the more technical aspects of the construction of a vehicle.

(29) OHIM contends that ‘vendors’ should be understood to mean professionals specialised in the sale of motor vehicles, including both vehicle manufacturers and commercial establishments in which vehicles are repaired, serviced, bought and sold, while ‘purchasers’ are consumers with sufficient semi-professional technical skills to be able to assemble or repair a vehicle themselves.

(30) It should be noted that the relevant public must be defined in the light of the list of goods as limited by the applicant in its letter of 12 October 2004. In fact, that limitation of the list of goods covered was accepted by the OHIM examiner and by the Board and cannot be called into question in this action.

(31) Accordingly, having regard to the fact that – as stated in paragraph 2 above – the applicant is no longer seeking registration of the mark at issue in respect of ‘vehicles and parts thereof’, but in respect of ‘steering and power steering, both for vehicles and parts therefor, excluding independent front suspension’, the relevant public must be made up of consumers interested in the purchase of steering and power steering for vehicles and of other vehicle parts (and not the purchase of vehicles as such), and may consist both of vehicle manufacturers, and garage-owners responsible for the repair of vehicles, and, to a lesser extent, of people with sufficient knowledge and technical skills to be capable of repairing their vehicle themselves. The relevant public is, on any view, a public with sound knowledge of technical aspects in the manufacture and repair of vehicles sector.”

(b) *Descriptiveness in the case in issue*

(32) Paragraphs 27 to 29 of the contested decision show that, in order to establish whether the trade mark applied for should be refused registration pursuant to Article 7(1)(c) CTMR, the Board first examined whether, from the point of view of the relevant consumer, the sign IFS describes a characteristic which that consumer would take into account when purchasing a steering or power steering system as part of a motor vehicle. The Board went on to find that this was indeed the case since the sign IFS is used to describe one of the essential characteristics of the goods covered, namely the existence of an independent front suspension system in a steering system and in the vehicle equipped with that steering system.

(33) It is therefore necessary to examine whether, as the applicant claims, the steering system and the independent front suspension system are independent of one another, despite their proximity in the same vehicle, or whether, as OHIM maintains, given that the steering may need to be



adapted for independent front suspension, use of the sign IFS in respect of steering and power steering would be perceived by the relevant public as descriptive of an essential characteristic of those goods, namely that they are intended to be assembled on vehicles equipped with independent front suspension.

(34) In that second situation, the relevant public would be able to associate the sign IFS with steering and power steering systems designed to be fitted to vehicles with independent front suspension.

(35) In that connection, it is for the OHIM examiners and, on appeal, for the Boards to examine the facts of their own motion in order to determine whether or not the mark applied for is covered by one of the grounds laid down in Article 7 CTMR for refusal of registration. It is the task of those bodies to establish in their decisions the accuracy of such facts, unless the facts alleged are a matter of common knowledge (Case C-273/05 P OHIM v Celltech [2007] ECR I-2883, paragraphs 38 and 39). In addition, the legality of the Board of Appeal's decision is assessed by the Court in relation to the factual and legal situation existing at the time when the decision was adopted and on which that decision was based.

(36) In the contested decision, after referring to all the extracts from internet sites used by the examiner to demonstrate that the sign IFS was descriptive of independent front suspension, the Board emphasised the fact that the documents cited included advertisements extolling the benefits of independent front suspension, and went on to infer from this that, since the professionals whom the relevant customer would approach would draw his attention – or are likely to do so – to the existence of an independent front suspension system in a steering or power steering system and in the vehicle equipped with that steering system, the examiner was right to conclude that the word mark IFS might serve to designate an essential characteristic of the goods in respect of which registration is sought.

(37) It is to be noted that, as the Board indicates in paragraphs 25 and 28 of the contested decision, the documents referred to by the examiner concern only the meaning of the acronym 'IFS' or the benefits of independent front suspension. By contrast, none of those documents mention the reasons for which one of the characteristics of the steering or power steering of a vehicle would be its compatibility with independent front suspension.

(38) In that regard, OHIM merely stated that it was logical for any specialist in mechanics, aware of the interference caused by divergent movements of the wheels, to assume that a steering or power steering system called 'IFS' is designed to achieve specific technical results, namely to be fitted to independent front suspension (also known as 'IFS') and to isolate the vibrations and strains caused by the vertical movement of the wheels as opposed to the lateral movement operated by the steering. When requested at the hearing to indicate precisely the paragraphs of the documents relied upon in the contested decision in support of the findings of the Board that steering or power steering was designed to be compatible with independent front suspension, OHIM stated that it was unable to refer to a specific document, and referred generally to the series of documents appended to the examiner's letter of 13 August 2004.

(39) Accordingly, it is not possible to identify, from among the documents relied upon by OHIM, those which show that there is a technical link between the goods covered and independent front suspension, in the sense that those goods are designed to be compatible with such suspension. Consequently, the accuracy of that fact has not been established for the purposes of the case-law referred to in paragraph 35 above.

(40) It must be concluded, therefore, that the documents on which the Board of Appeal based the contested decision do not prove, *per se*, that the relevant public, as defined in paragraph 31 above, would perceive the sign IFS as descriptive of one of the characteristics of the goods covered and that, in consequence, registration of the trade mark applied for would be contrary to Article 7(1)(c) CTMR."

**Bateaux Mouches** : T-365/06 – Judgment of 10 December 2008 (only in FR; action dismissed, Board decision confirmed).

Keywords: Absolute grounds for refusal: distinctiveness – Absolute grounds for refusal: terms which became generic in the trade, Article 7(1)(d) CTMR – Distinctiveness: acquired on the market.

The case had been brought against a decision of the 1st Board of 7.9.2006 in Case R 1172/2005-1 relating to an invalidation case initiated against CTM "Bateaux Mouches", word mark, which had been registered in Classes 39, 41 and 42, *inter alia*, for services of tourist boats. The challenge had been based on the consideration that the term had become generic in the trade, in France, for tourist boats operating on rivers. Whereas the Cancellation Division had rejected the invalidation request, the Board had partially allowed it. Notwithstanding that the term initially, in 1950, had been a national French trade mark, it has been established that it meanwhile had become generic for a specific part of the tourist business, namely the said navigation of tourist boats. The 7th Chamber of the CFI (Forwood; Sváby; Moavero Milanesi, rapporteur) confirmed these findings.

**Vitro/Vitral** : T-412/06 – Judgment of 10 December 2008 (only in ES, FR; action dismissed, Office practice confirmed).

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

The case had been initiated against a decision of the 2nd Board of 13.10.2006 in Case R 1364/2005-2 relating to CTM application "Vitro" (figurative mark).



CTM application	
	<b>Vitral</b> <b>VITRAL</b>

The application covered, *inter alia*, the following goods and services in Class 19: glass for use in buildings (glass blocks), glass for windows, safety glass, insulating glass; in Class 20: glass furniture and covers, silvered glass, mirrors. A notice of opposition had been filed, directed against the Class 19 goods in the CTM application and based on a CTM and several national earlier rights in "VITRAL", word mark, registered in Class 19. The opponent had not submitted a copy of the registration certificates or of any equivalent official document within the prescribed time limit set by the Opposition Division. Consequently, it had failed to substantiate the existence, validity and scope of protection of the national trade marks and, thus, the opposition had only been considered as duly substantiated in respect of the opponent's CTM No 651 745 "VITRAL". Nonetheless, the CTM had been considered sufficient to allow the opposition, based on standard criteria, and the 7th Chamber of the CFI agreed (Forwood; Moavero Milanesi, rapporteur; Truchot).

**Giorgio Beverly Hills** : T-228/06 – Judgment of 10 December 2008 (action allowed; law of the case).

Keywords: Opposition: likelihood of confusion (LOC).

The case had been an appeal against a decision of the 2nd Board of 21.6.2006 in joint cases R 0107/2005-2 and R 0187/2005-2 relating to a conflict between WHG and Giorgio Beverly Hills Inc., the CTM applicant and plaintiff in the proceedings. The trade mark in respect of which registration had been sought had been the word sign "GIORGIO BEVERLY HILLS". The goods in respect of which registration had been applied for are, *inter alia*, in Class 25, namely clothing, footwear, headgear. The opposition lodged by WHG had been based on, *inter alia*, the earlier German word mark "GIORGIO", registered in Class 25 for clothing (with the exception of hosiery).

By its decision, the Opposition Division had upheld the opposition to the extent that it was based on that earlier German trade mark, on the ground that there was LOC between that mark and the mark applied for. By the contested decision R 0187/2005-2, the Board had dismissed the CTM applicant's appeal. After noting that the word 'giorgio' was the dominant element in the two trade marks in conflict, the Board had decided that they were similar from both the visual point of view as well as the phonetic and conceptual points of view. In particular, it had held that, in view of the fact that designers and manufacturers of clothing and other accessories often opened stores in various locations, the words 'beverly hills'

would be perceived by the majority of consumers as alluding to the goods in question since they would understand them as a reference to the famous shopping quarter of Los Angeles, in the USA, one of the preferred places of famous designers and manufacturers. Having regard to the similarity of the goods covered by the trade marks in question and the similarity of the signs concerned, the Board had concluded LOC.

The 7th Chamber of the CFI (Forwood; Moavero Milanesi, rapporteur; Truchot) disagreed, attaching different weight to the words "beverly hills".


"(25) Contrary to what OHIM essentially submits, the words 'beverly hills' do not have weak distinctive character. Thus, the Court has already held that those words, which refer to a particular geographical place with which the target public is familiar, are not descriptive of the goods in question (GIORGIO BEVERLY HILLS, paragraph 49).

(26) The documents provided by the intervener regarding knowledge of Beverly Hills as a shopping district were submitted for the first time before the Court. Those documents are therefore inadmissible, since it follows from Article 63(2) of Regulation No 40/94 that facts not submitted by the parties before OHIM cannot be submitted at the stage of the appeal brought before the Court of First Instance, which is called upon to assess the legality of the decision of the Board of Appeal by reviewing the application of Community law made by that board, particularly in the light of the facts which were submitted to the latter. By contrast, the Court of First Instance cannot carry out such a review by taking into account matters of fact newly produced before it (Case C-29/05 P OHIM v Kaul [2007] ECR I-2213, paragraph 54)."

**Vitro** : T-295/07 – Judgment of 10 December 2008 (only in FR, ES; action dismissed, Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 31.5.2007 in Case R 1640/2006-2 relating to CTM application "VITRO", word mark, which had been applied for for a range of goods in Class 19.

CTM application	
	<b>Vitral</b>

It had been opposed on the basis of "VITRAL", word mark, registered for a range of products in Class 19. The opposition had been allowed, relying on standard criteria. The 7th Chamber of the CFI (Forwood; Moavero Milanesi, rapporteur; Truchot) confirmed these findings.

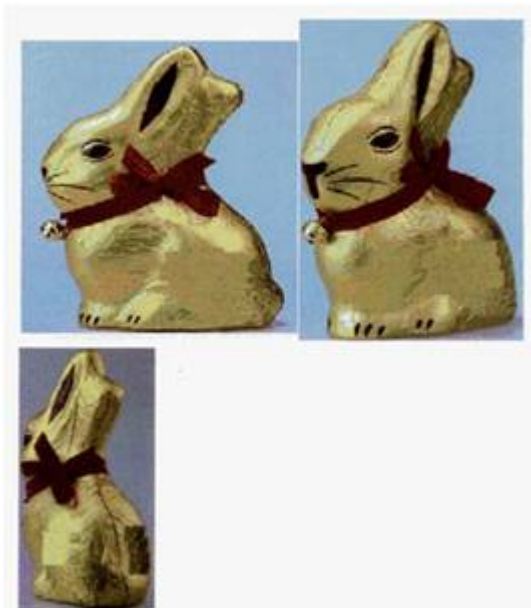


## C-2: CFI Judgments and Orders: Developments in pending cases

**Hase** : T-336/08 – Office response filed (DE).

Keywords: Types of signs: three-dimensional (3D)/shape of the product itself – Absolute grounds for refusal: distinctiveness/3D signs – Distinctiveness: acquired on the market.

The case has been brought against a decision of the 4th Board of 11.6.2008 in Case R 1332/2005-4 relating to CTM application 3 844 446, a 3D rabbit, applied for for chocolate products in Class 30.

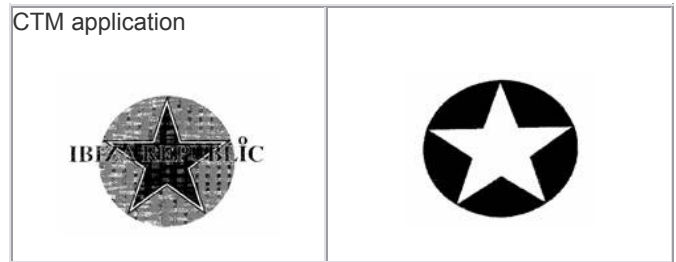


The applicant had sought to rely on distinctiveness acquired in the market place but had shown evidence only as regards Germany . The Board had held, firstly, that chocolate rabbits are devoid of inherent distinctiveness because such a shape is commonplace in the trade, products of that kind are being sold in particular in the Easter season, and, secondly, that acquired distinctiveness must be demonstrated for the whole European Union.

**Ibiza Republic** : T-311/08 – Office response filed (FR).

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

The case is an appeal filed against a decision of the 2nd Board of 7.5.2008 in Case R 1135/2007-2 relating to CTM application 3 868 072, “ Ibiza Republic ” (figurative mark) which had been applied for for a range of goods and services in Classes 25, 41 and 42.



It had been partially opposed on the basis of an earlier French right in a ‘star brand’ (as shown above), registered in Class 25. Notwithstanding that the goods at issue are identical, the opposition had been rejected on the ground of dissimilarity of the marks.

**Mepos** : T-297/08 – Office response filed.

Keywords: Formalities: deficiencies of a CTM application – Time limits: restitutio in integrum.

The case was brought against a decision of the 2nd Board of 23.5.2008 in Case R 0437/2008-2 and relating to CTM application 5 770 383 of the figurative sign “MEPOS”.



The goods and services in respect of which registration had been sought are in Class 9. By letter dated 27.3.2007, the Office had informed the applicant that although the mark appeared to have been filed in colour, the application did not contain any colour claim or other indication in that regard. Accordingly, the examiner required the applicant to remedy that deficiency within a period of two months from receipt. At the same time, the applicant was informed that the Office had issued a note explaining the relevant changes in OHIM’s practice in this area, which applied as of 7.12.2005, citing also the page of the Office’s web-page where that note could be located.

On 25.4.2007, the applicant had submitted observations in reply. It clarified that the mark had been filed in black and white and that, therefore, no colour was claimed. On 26.7.2007, the examiner rendered a decision refusing the CTM application pursuant to Rule 9 (4) CTMIR. On 27.8.2007, the applicant informed the Office that the deficiencies with regard to the colour claim had been remedied, making reference to its observations of 25.4.2007 and requested the Office to suspend the effects of its decision of 26.7.2007 concerning the refusal of the CTM application.

On 17.9.2007 the applicant sent a reminder and on 20.11.2007 requested information about the current status of the CTM application. On 4.3.2008, the applicant filed a notice



of appeal against the contested decision, together with a statement of grounds and a request for restitutio in integrum. As those documents were filed in German, the Registry of the Boards granted the applicant a term of one month, that is, until 4.4.2008, to translate the documents in the correct language. The applicant complied with that request within the allotted term. By its decision, the Board had dismissed both the applicant's appeal and the request for restitutio in integrum, holding, first, that the appeal was deemed not to have been entered due to the late payment of the appeal fee and, second, that the applicant had failed to invoke a valid cause of non-compliance with the time-limit justifying the acceptance of its request for restitutio in integrum.

**Temacolor** : T-295/08 – Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action has been directed against a decision of the 1st Board of 7.5.2008 in Case R 0808/2007-1 relating to CTM application 4 095 915, word mark "TEMACOLOR", for paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordant; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists. It had been opposed on the basis of several earlier rights in "FEMA-Color", registered in Class 2 for paints, varnishes and lacquers. The opposition had been allowed.

**Schoko-Rentier** : T-337/08 – Office response filed (DE).

Keywords: Types of signs: three-dimensional ('3D') – 3D signs: product as such – 3D product as such: distinctiveness.

The action has been brought against a decision of the 4th Board of 12.6.2008 in Case R 0780/2005-4 relating to CTM application 4 098 489, a 3D animal in colours (as shown below), applied for chocolate and chocolate products in Class 30.

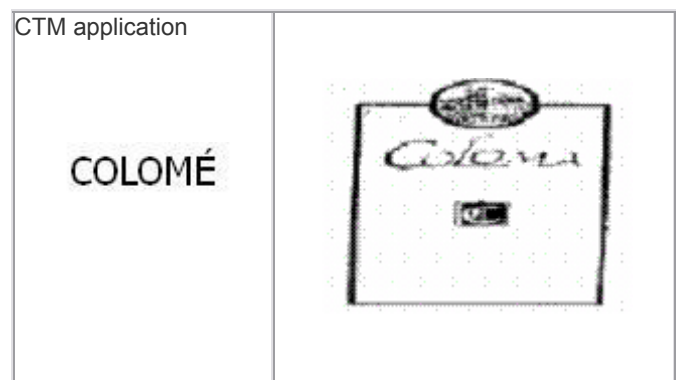


The application had been rejected on the ground of lack of distinctive character since, in the sweets trade, the representation of animals is commonplace and the same holds true as regards the claimed colours (gold, brown etc.).

**COLOMÉ** : T-341/08 – Office response filed (ES).

Keywords: Opposition/invalidation: likelihood of confusion (LOC).

The case has been brought against a decision of the 1st Board of 21.5.2008 in Case R 1030/2007-1 relating to CTM 2 140 283, "COLOMÉ", word mark, registered in Class 33. It had been challenged on the basis of several earlier rights in "COLOMA" (figurative mark).



The earlier rights cover wine. The opposition had been fully allowed, in particular taking into account that the goods are identical.

**Icon** : T-389/08 – Office response filed.

Keywords: Formalities: entitlement.

The action has been directed against a decision of the 2nd Board of 3.7.2008 in Case R 0778/2007-2, relating to CTM application 2 197 440 "ICON", word mark, for goods in Classes 9, 18 and 25 that are irrelevant in the context of these proceedings. On 19.4.2002, AXO Sport (UK) Limited ('the original opponent') had filed an opposition based on UK trade mark registration 2 243676, word mark "IKON". The earlier mark had been registered on 9.2.2001 in the name of 'AXO Sport (UK) Limited' in respect of goods in Class 9.

On 12.10.2006, the CTM applicant had informed the Office that the company 'AXO Sport (UK) Limited' had been dissolved in April 2006. The CTM applicant said that it had been making attempts at purchasing the earlier mark from the Treasury Solicitor, until it discovered that the earlier mark had in the meantime been transferred from the company 'Serval Marketing Limited' to an individual, Stephen Turner (the intervener in the case). This assignment had been recorded in the register of the UK Office on 3.8.2006.



The CTM applicant also observed that two separate companies 'AXO Sport (UK) Limited' (identified by the company no. 02532771) and 'Serval Marketing Limited' (identified by the company no. 04060611) had swapped their names on 14.11.2001 that is, before the opposition had been filed on 19.4.2002. As a result, the company identified by the company name 'AXO Sport (UK) Limited' which had lodged the opposition was in fact the company no. 04060611 rather than the company no. 02532771. According to the CTM applicant, the fact that the companies switched names implies that the identity of the opponent and the identity of the registered proprietor of the earlier mark cannot be the same. On 19.4.2002, the company no. 04060611 (AXO Sport (UK) Limited) was not shown to be either the proprietor of the earlier mark or an exclusive licensee thereof. On that date, the genuine proprietor was Serval Marketing Limited. As a result, it was claimed that the opposition should be dismissed because the opponent lacked *locus standi*.

On 20.2.2007, AXO Sport (UK) Limited submitted a document showing the recordal of the assignment of the earlier mark to Stephen Turner in the register of the United Kingdom Trade Mark Office. In its decision, the Opposition Division had considered that the opposition was admissible and well-founded in respect of all goods. The subsequent appeal had been dismissed on the following grounds: The opposition was filed by a company named 'Axo Sport (UK) Limited' which had changed its name to 'Serval Marketing Limited' on an earlier date, on 14.11.2001. The change of name was not recorded in the register of trade marks. Nevertheless, a change of name has no effect either on the legal entity of the original opponent or on the ownership of the earlier mark. As a result, the omission to register the change of name did not affect the original opponent's entitlement to file an opposition.

**Deutsche BKK** : T-289/08 – Office response filed (DE).

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

The case has been brought against a decision of the 4th Board of 29.5.2008 in Case R 0318/2008-4 relating to CTM application 4 724894, "Deutsche BKK" (word mark), which had been applied for for a range of services in Classes 36, 41 and 44, mainly relating to health and health care issues. The applicant had filed material meant to demonstrate that the sign applied for had acquired distinctiveness on the market. The material had been found insufficient and, in consequence, the application had been rejected: "Deutsch(e)" means German, and "BKK" is an abbreviation for Betriebs-Krankenkasse, which means sickness insurance scheme for a company or an enterprise.

**Aldi/Alpi** : T-298/08 – Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 14.5.2008 in Case R 1301/2007-1 relating to CTM application 3 360 914, word mark "ALDI", which had been, *inter alia*,

applied for for telecommunications services etc. in Class 38. It had been opposed in that regard on the basis of several earlier rights in "ALPI", registered *inter alia* in Class 38 for telecommunications services etc. The opposition had been successful.

**Oftten/Olten** : T-292/08 – Office response filed (ES).

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

The action has been brought against a decision of the 2nd Board in Case R 0484/2007-2, relating to CTM application 2 798 270, word mark "OFTEN", which had been applied for for a range of goods and services in Classes 3, 9, 14, 16, 18, 25 and 35. It had been opposed on the basis of earlier rights in "OLTEN" (word mark and figurative marks), registered for goods in Class 14. POU had been shown for watches, and in this respect the opposition had been allowed.

## NEW DECISIONS FROM THE BOARDS OF APPEAL

The cases can be found in our website.

See also the Boards of Appeals 2006 case-law overview; <http://oami.europa.eu/ows/rw/pages/OHIM/OHIMPublications.en.do>, which provides an annual overview of selected decisions grouped by type of decision.

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

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

### Relative Grounds – Article 43 CTMR

R 663/2008-1 – CONQUISTADOR/Conquistador

### Relative Grounds – Article 43 CTMR

*Relative grounds – opposition proceedings – proof of use – belated facts and evidence – substantial procedural violation – translation – reimbursement of the appeal fee*

**Decision of the First Board of Appeal of 28 January 2009 in Case R 663/2008-1 – CONQUISTADOR/Conquistador [figurative mark] (English)**

**R 663/2008-1 – CONQUISTADOR/Conquistador [figurative mark]** This decision deals with various questions regarding procedural matters.



First of all, the Board confirmed that it is left to the discretion of the Opposition Division whether the opponent has to submit a translation of the evidence of use into the language of the proceedings. In exercising its discretion, the Office has to balance the interests of both parties. In the present case, the invoices, packaging and labels submitted are self-explanatory and do not need to be translated. The brochures, extracts of the wine guide and Internet pages do not need to be translated either as they show pictures of bottles of brandy 'El Conquistador' which are self-explanatory.

After being invited to do so by the Office, the opponent submitted several documents concerning proof of use of the earlier trade mark. However, the Opposition Division did not forward all evidence submitted to the applicant. Consequently, it based its decision on an incomplete factual basis and infringed the applicant's right of defence as laid down in Article 73 CTMR, having failed to give the applicant the possibility to take a position on the above-mentioned documents submitted by the opponent.

During the appeal proceedings, the opponent submitted further evidence regarding proof of use, which was accepted by the Board as supplementary evidence. It held that the supplementary evidence is likely to affect the outcome. Furthermore, it is both in the public interest and in the interest of both parties concerned to have the dispute between the conflicting marks examined and decided on, based on the merits. The evidence filed by the opponent before the Opposition Division was challenged by the applicant. In spite of this, the opponent had no possibility of filing further evidence at the opposition stage of the proceedings. It was thus obliged to file an appeal and submit supplementary evidence before the Board.

The case has been remitted to the Opposition Division for further prosecution; the appeal fee refunded.