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User Satisfaction Survey II

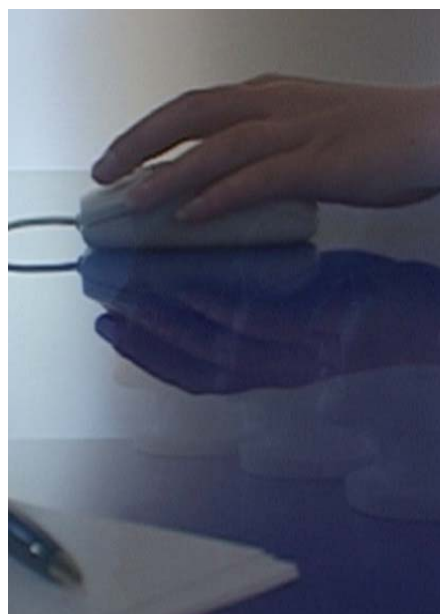
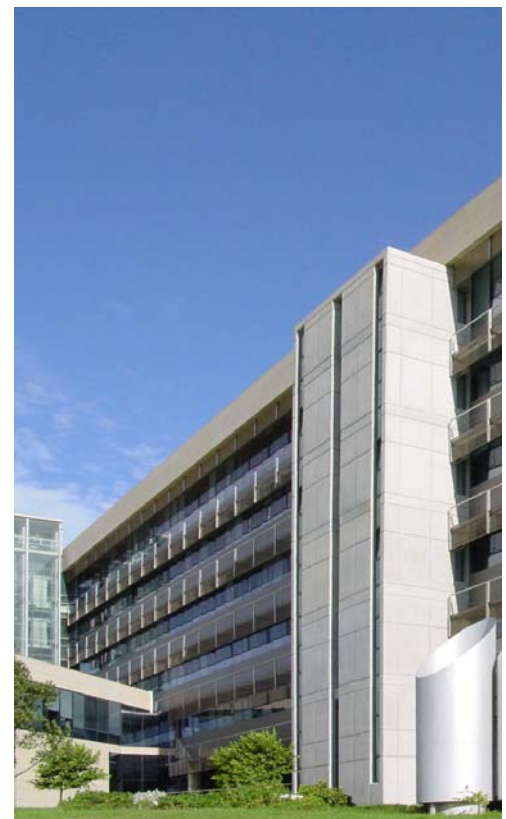
Given the overall positive impressions and feedback provided in this first survey, the OHIM has decided to repeat the exercise and the second User Satisfaction Survey will be carried out from December 1 to December 31, 2006, again by GfK, one of the world's leaders in satisfaction surveys.

The survey is open to anyone who used the OHIM Community Trade Mark and/or Design systems between July 1, 2005 and June 30, 2006.

In the very near future, GfK will send an e-mail to all relevant users, containing a link to a personal web-based questionnaire which will be available in the 5 languages of the OHIM (Spanish, German, English, French and Italian). Users may answer in the language of their choice, and the questions will cover not only satisfaction with Community trade mark and design procedures but also complaints, availability of information, communication and the OHIM's image in general.

To ensure that the survey reflects the users' point of view, GfK will stress that the questions should be answered from the point of view of an individual user of the Office's systems, not as a company, firm or association. The personal experiences, reflections and opinions of users are important to the Office.

As with last year's survey, the results will be examined and interpreted by a special "User Satisfaction" Task Force headed by Ms. Ingrid Desrois, Special Adviser to the OHIM. Based on the feedback received from all participants, the Task Force will prioritize objectives and propose improvements to the Management of the OHIM.



All the information you will provide and, in particular, your personal details and e-mail address, will be treated as strictly confidential

Further reports on the implementation of the Action Plan resulting from the 2005 User Satisfaction Survey and developments relating to the 2006 Survey will be published in future Alicante News issues.



Community Trade Mark
The LEGO Decision

Country Overview Spain & the Community Trade Mark

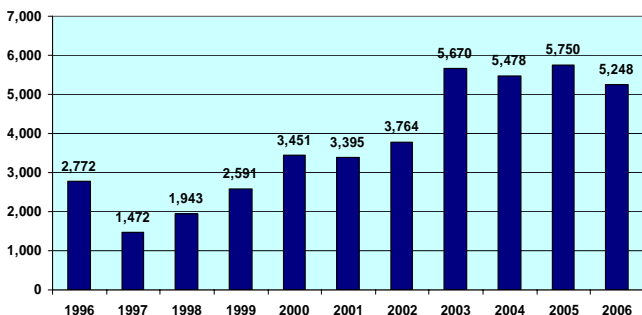


Spain has a population of around 4 000 000 people and joined the European Union in 1986.

The Spanish economy is around 66% service, 29% industrial and 5% agricultural based. In agriculture, the country is particularly active in the production of wine grapes, olives and grain, among other products, and also boasts a wide range of products and services in areas as diverse as ship-building and the production of pharmaceuticals.

In terms of Community trade mark filings, businesses based in Spain have applied for a total of 41,500 CTM applications since 1996. This is 8.1% of all CTM applications filed at the OHIM and places Spain in 4th position in the overall ranking of Community trade mark filings.

SPAIN - CTM Filing Evolution
Total CTMs: 41,534

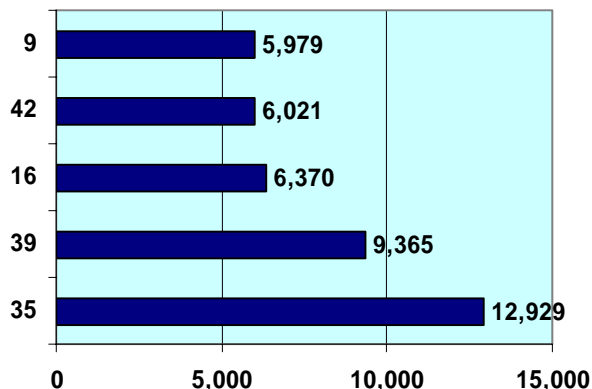


Word	Figurative	3-D	Colour	Other	Sound
37.34%	61.76%	0.90%	0.00%	0.00%	0.00%

Spain files more figurative than word marks, with around 60% of the former making up the overall total of CTM applications filed by Spanish based firms. Around 37% are word marks and just less than 1% are 3-D filings.

Services included in Class 35 of the Nice classification can be found in nearly 13,000 CTM applications from Spanish based firms, followed by services in Classes 39 and then paper goods in class 16.

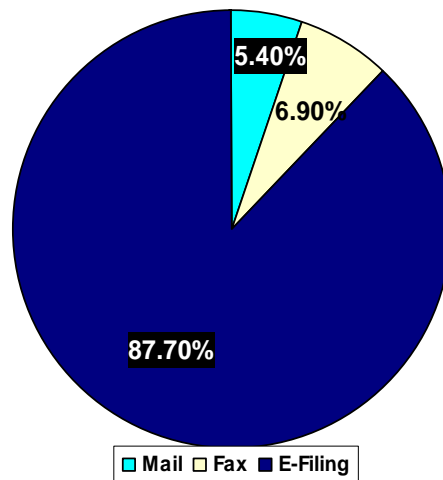
SPAIN - Top Classes Filed (Nice)



As with almost every CTM filing country, 2006 has seen a sharp increase in the use of e-filing for applications.

Spain has gone from a 45% e-filing rate in 2005 to almost 88% in 2006. Mail and fax filings combined make up only 12% of all CTMs originating from companies based in Spain, making the country one of the world's top CTM e-filing countries.

The number of fax and mail filings has steadily decreased over the course of the year.



Top 10 Spanish-based owners by number of CTMs filed

Company	CTMs
Banco Bilbao Vizcaya Argentaria, S.A.	299
El Corte Inglés, S.A.	277
Bankinter, S.A.	104
Telefónica, S.A.	94
Fábricas Agrupadas de Muñecas de Onil, S.A. (FAMOSAS)	90
Laboratórios Phergal, S.A.	90
Banco Santander Central Hispano, S.A.	84
Almirall-Prodesfarma, S.A.	82
Laboratorios Indas, S.A.	70
Comercial Masoliver, S.A.	67



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

Representative	CTMs
Ungría López	3,085
Udapi & Asociados	2,609
Herrero & Asociados	2,138
Clarke, Modet & Cía., S.L.	1,833
J. Isern Patentes y Marcas	1,519
Pons Patentes y Marcas	1,413
Elzaburu	991
Propi, S.L.	756
Duran - Corretjer	730
Henson & Co.	725

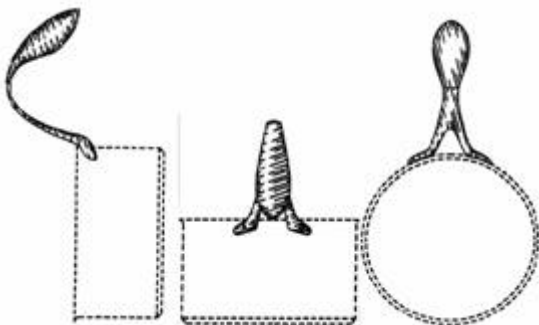
Community Design

INVALIDITY DECISIONS: A case involving an RCD with a disclaimed element

ICD 000002202/ RCD No. 000123013-0001

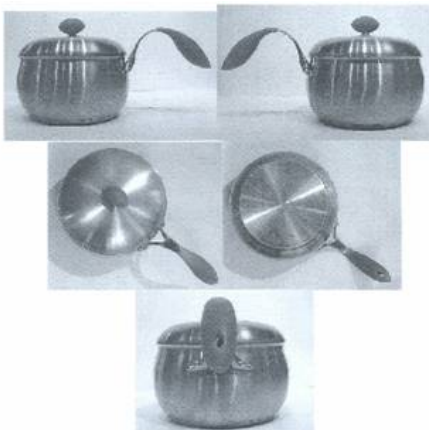
On 24/08/06 the Invalidity Division of the Designs Department released a decision regarding a RCD containing a disclaimed element, which could therefore not be taken into consideration in the evaluation of novelty.

The RCD had been registered in relation to the "saucepan handles" products with the design represented in the following view:



RCD No. 000123013-0001

The earlier UK design registration shows the design of a "saucepan" represented as follows:



UK design 2102637

The subject-matter of the RCD was the handle of the saucepan only, not the saucepan itself, this item having been disclaimed by the use of dotted lines in the graphical representation of the RCD. Since then the saucepan does not form part of the RCD, the features of the "higher position" of the handle and the balance with the saucepan" alleged by the Holder are not part of the RCD either and they could not be taken into consideration. Comparing the handle of the RCD with the handle of the prior design no significant difference could be discerned. The RCD and the prior design were identical. The RCD was not new in the meaning of Article 5 RCD

The RCD was declared invalid on the ground of Article 25(1)(b) CDR due to lack of individual character.

The decision may be found at

[http://oami.europa.eu/pdf/design/invaldec/ICD_000002202_decision_\(EN\).pdf](http://oami.europa.eu/pdf/design/invaldec/ICD_000002202_decision_(EN).pdf)

Important step toward EU accession to the Hague Agreement

On Wednesday 25 October 2006, the Committee of Permanent Representatives of the Council of the European Union ('COREPER') adopted two proposals presented by the Commission in order to link the 'Community Design' system with the international design registration system of the World Intellectual Property Organisation ('WIPO').

In particular, COREPER approved the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, and adopted the proposal for a Council Regulation amending (EC) No 6/2002 and (EC) No 40/94 necessary to give effect to this accession.

This decision has been confirmed by the Council, which is expected to deal with this item as an "A" part of its agenda in one of its next meetings. The subsequent amendments to the Implementing Regulation and the Fee regulation will probably be dealt with during the 1st semester 2007. Therefore, the current legislative process is likely to establish the link during the 3rd or 4th quarter 2007.

Filing date lost if representations sent by RCD e-filing cannot be processed

The e-filing system has been created in order to allow customers to complete an electronic application form and to provide the associated attachments directly online, without needing any further data processing from the Office, in order to speed up the procedures and to guarantee a quick registration of the designs.

Consequently, the data relating to the designs sent by e-filing must be in a format capable of being immediately processed by the system. This refers especially to the format of the representations of the designs, and in particular to the fact that each view of a design has to be reproduced in one single attachment. If this is not done, the filing date of the design will be lost.



In accordance with Article 4(d) CD IR, where the application is filed by electronic means, the reproduction of the designs as well as the manner of identifying the different views of each design shall be in a data format determined by the President of the Office.

In Article 3(2) of his Decision No EX-03-8 of 25 June 2003 concerning the electronic filing of Community design applications, the President of the Office established that where more than one view per design is filed, the different views of each design shall be identified in the manner prompted by the electronic application form.

When indicating the number of views a user wishes to submit, the system automatically creates the necessary fields where the attachments need to be enclosed. This is explained in the on-line help for the e-filing for a Registered Community Design available at (<http://oami.europa.eu/efdsng/en/default.htm>). In particular Section 8 of this on-line guide, in the paragraph headed 'Format of the views', requires that "each attachment must contain one view".

In cases where the views of a design are not each sent through a single attachment, in accordance with Article 10(1)(c) CD IR the Office shall notify the applicant that a date of filing cannot be granted because the application does not contain a representation of the design pursuant to Article 4(1)(d) CD IR.

Country Overview: Spain & the Registered Community Design

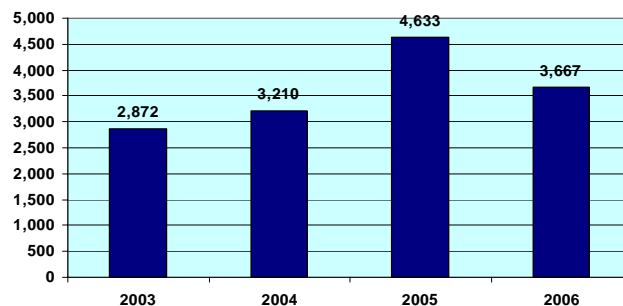


Spain has a population of around 40 000 000 people and joined the European Union in 1986.

The Spanish economy is around 66% service, 29% industrial and 5% agricultural based. In agriculture, the country is particularly active in the production of wine grapes, olives and grain, among other products, and also boasts a wide range of products and services in areas as diverse as ship-building and the production of pharmaceuticals.

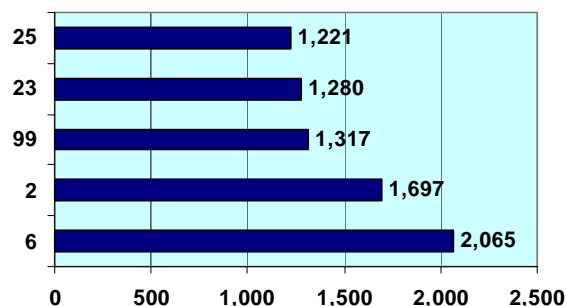
In terms of filings, applicants based in Spain have applied for the registration of over 14,000 Community designs since the year 2003, placing them in 6th place in the overall world ranking. Spanish based RCD filers account for almost 7% of all RCDs filed with the OHIM since 2003.

SPAIN - RCD Filing Evolution
Total RCDs: 14,382



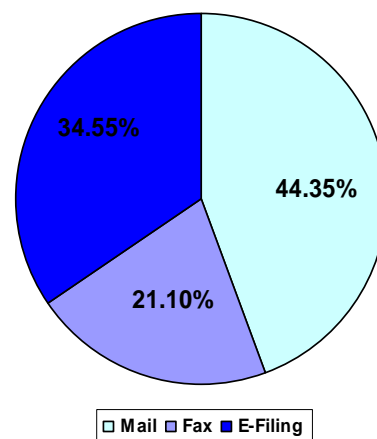
The furniture industry is the main source of registered Community design filings made by Spanish-based firms with more than 14% of all designs received coming from this sector. Textile goods, sanitary equipment and construction materials make up the remainder of the top five ranking, along with a variety of class 99 products.

SPAIN - Top Classes Filed (Locarno)



Although electronic filing in the field of registered Community designs is steadily increasing, the preference of designers to file their designs by post or by fax still outranks the electronic filing option significantly.

At present, Spanish based firms file nearly 35% of their RCDs online, which is significantly above the worldwide average, though mail filings at 44% and faxed filings at 21% make for the bulk of RCDs filed by Spanish based companies.





Top 10 Spanish-based owners by number of RCDs filed

Owner	RCDs
Pikolinos Intercontinental, S.A.	385
Univermoble, S.A.	369
festina Lotus, S.A.	314
Roca Sanitario, S.A.	236
Emboga, S.A.	207
International Trading Design, S.L.	192
Baño y Diseño, S.L.	179
Rioma, S.A.	161
Universal de desarrollos Electrónicos, S.A.	139
Alambra Internacional, S.A.	131

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

Representative	RCDs
J. Isern Patentes y Marcas	1,183
Ungría López	905
Herrero & Asociados	831
Clarke, Modet & Cía., S.L.	770
Oficina Ponti	662
Isern Cañadell	455
Fernández Lerroux	405
Garrigues Agencia de Propiedad Industrial e Intelectual, S.L.	373
Dr. Ing. M. Curell Suñol I.I., S.L.	355
Udapi & Asociados	312

Case-law

LATEST TRADE MARK AND DESIGN NEWS FROM LUXEMBOURG

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

A-1: ECJ Judgments and Orders

(-)

A-2: ECJ: Developments in pending cases

Eurohypo: C-304/06-P (appeal from T-439/04) – Office response filed.

Keywords: Procedural law: CFI proceedings: presentation of facts for the first time - Board of Appeal proceedings/examination of facts of its own motion: scope – Absolute grounds for refusal: relationship – Descriptiveness: definition.

The action initially had been directed against a decision of the 4th Board of 6.8.2004, R 829/2002-4, which rejected CTM application EUROHYPO for "financial affairs, monetary

affairs, real estate affairs; provision of financial services, financing analysis, investment affairs, insurance affairs".

The CFI had confirmed the Board decision of 3. 5. 2006, T-439/04 (see for details Alicante News May 2006).

B: ECJ: Preliminary Rulings

B-1: ECJ Rulings

Europolis : C-108/05 - Ruling of 7 September 2006 .

Keywords: Distinctiveness (Article 3(3) of the TM Directive) – Distinctiveness: acquired "through use" – Distinctiveness: linguistic areas – Distinctiveness: territorial particularities (Benelux).

The case concerned a reference from the Gerechtshof te's-Gravenhage. "Europolis" had been applied for in the Benelux office for a range of services in Classes 36 and 39, namely "insurance; financial affairs; monetary affairs; real estate affairs; transport; packaging and storing of goods; travel arrangements". The Dutch word "polis" normally refers to an insurance agreement. As regards an argument put forward in the alternative by the applicant, it was stated that for acquisition of distinctive character in the market place, it suffices that the sign at issue is perceived as a trade mark in a substantial part of the relevant territory. The First Chamber of the ECJ (rapporteur: Cunha Rodriguez) held:

"1. Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the registration of a trade mark can be allowed on the basis of that provision only if it is proven that that trade mark has acquired distinctive character through use throughout the territory of the Member State or, in the case of Benelux, throughout the part of the territory of Benelux in which there exists a ground for refusal.

2. As regards a mark consisting of one or more words of an official language of a Member State or of Benelux, if the ground for refusal exists only in one of the linguistic areas of the Member State or, in the case of Benelux, in one of its linguistic areas, it must be established that the mark has acquired distinctive character through use throughout that linguistic area. In the linguistic area thus defined, it must be assessed whether the relevant class of persons or at least a significant proportion thereof, identifies the product or service in question as originating from a particular undertaking because of the trade mark."

B-2: ECJ: Developments in pending cases

(-)



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

C-1: CFI Judgments and Orders

Bud/Bit or Anheuser-Busch: T-350/04, T-351/04, T-352/04 - Judgment of 19 October 2006 (action dismissed; Office practice confirmed).

Keywords: CFI procedure: legal claims; nature of references - Opposition: earlier right - Opposition: earlier mark with reputation, Article 8(5) CTMR - Opposition: likelihood of confusion ("LOC") - LOC: specific conditions under which product is sold - LOC: enhanced recognition of the earlier mark and identical products.

The action had been directed against decisions of the 2nd Board of 22.6.2004 in cases R 447/2002-2, R 451/2002-2 and R 453/2002-2. They concerned three CTM applications, namely the word BUD in Class 32, "American Bud" (fig; set out below as CTM application 2) and "Anheuser Busch" (fig.; set out below, CTM application 3), the latter two in Classes 16, 25 and 32.

CTM application 2	CTM application 3
	
<p>Earlier rights: BIT</p>   	

Bitburger Brauerei had lodged oppositions on the basis of several earlier rights set out above, in Class 32, and on the well-known mark BIT for beer, including non-alcoholic beer, brochures, beer mats, advertising cards, posters, ballpoint pens, T-shirts, ties, towels, sweatshirts and blousons. The opposition division concerned had rejected the oppositions, partially on formal grounds and partially on substance (no likelihood of confusion despite of a very high recognition of the earlier mark on the German market and identity of products). Some of the invoked marks had not been considered "earlier" since they have the same filing date as the challenged CTM applications. The Board subsequently had confirmed these findings. The Fifth Chamber of the CFI (Vilaras, Dehousse, Sváby) dismissed the action.

(a) Nature of statements of grounds to be made before the CFI

"I – Reference to pleadings before OHIM

(32) Anheuser-Busch, at the end of its statements in response, refers generally to all the arguments, facts and evidence submitted to OHIM in its pleadings dated 30 March 1999, 2 February 2000, 18 July 2000, 18 November 2002 and 19 August 2003 .

(33) It should be recalled in this respect that, under Article 44(1) of the Rules of Procedure of the Court of First Instance, which applies to intellectual property matters by virtue of Articles 130(1) and 132(1) of those rules, applications must include a brief statement of the grounds relied on. It is settled case-law that although specific points in the text of the application can be supported and completed by references to specific passages in the documents attached, a general reference to other documents cannot compensate for the failure to set out the essential elements of the legal argument which must, under those provisions, appear in the application itself (Case T-183/03 *Applied Molecular Evolution v OHIM (APPLIED MOLECULAR EVOLUTION)* [2004] ECR II-3113, paragraph 11).

(34) That case-law can be applied to the response of the other party to opposition proceedings before the Board of Appeal, intervener before the Court of First Instance, under Article 46 of the Rules of Procedure, which applies to intellectual property matters in accordance with the second subparagraph of Article 135(1) of those rules (Case T-115/02 *AVEX v OHIM – Ahlers (a)* [2004] ECR II-2907, paragraph 11).

(35) It follows that Anheuser-Busch's statements in response, in so far as they refer to pleadings submitted to OHIM, are inadmissible to the extent that the general references in them cannot be linked to the pleas and arguments put forward in the statements in response.

II – References to certain decisions of the Boards of Appeal of OHIM

(36) At several points in their pleadings, Bitburger Brauerei and Anheuser-Busch refer to the decision-making practice of the Board of Appeal of OHIM.



(37) It should be recalled in this respect that the decisions concerning registration of a sign as a Community trade mark which the Boards of Appeal of OHIM are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the lawfulness of those decisions must be assessed solely on the basis of that regulation and not on the basis of a previous decision-making practice of those boards (Case C-37/03 P *BioID v OHIM* [2005] ECR I-0000, paragraph 47, and Case C-173/04 P *Deutsche SiSi-Werke v OHIM* [2006] ECR I-0000, paragraph 48).

(38) The references made by Bitburger Brauerei and Anheuser-Busch are therefore ineffective."

(b) LOC: impact of the fact that beer is ordered orally

"(109) In view of the differences already noted between the trade marks applied for and the earlier German marks Nos 505 912 and 39 615 324 (BIT) it must be held that, despite the existence of a slight degree of visual and aural similarity, there is no likelihood of confusion in this case, despite the fact that the products concerned are identical or similar and even though the earlier marks may have a high degree of distinctive character.

(110) The arguments put forward by Bitburger Brauerei cannot call that conclusion into question.

(111) First, as regards the conditions under which the products in question are sold and, in particular, the question whether those products are essentially ordered orally and whether the noise factor may affect consumers' aural perception, suffice it to observe that the arguments put forward by Bitburger Brauerei are mere statements which are not based on any evidence which has been produced, at the appropriate time, in the proceedings before OHIM.

(112) Furthermore, Bitburger Brauerei has not furnished the slightest proof to show that its goods are generally sold in such a way that the public does not perceive the mark visually. In that regard, it must be borne in mind that, even if bars and restaurants are not negligible distribution channels for the products of Bitburger Brauerei, it is common ground that the consumer will be able to perceive the marks at issue visually in such places, inter alia by examining the bottle served to him or by other means (glasses, advertising posters etc.). Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets. Thus, clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves (see, to that effect, Case T-3/04 *Simonds Farsons Cisk v OHIM* [2005] ECR II-0000, paragraphs 57 to 59). It follows that the argument of Bitburger Brauerei relating to the conditions under which the products in question are sold must, in any event, be rejected."

Cafon/Daflon: T-442/05-Removed (Order of 6 October 2006).

Keywords: CFI procedure: withdrawal of CTM application at pending proceedings— Opposition.

The action had been directed against a decision of the 1st Board of 26.9.2005 in R 98/2005-1 by which it had allowed an opposition against CTM application Cafon. Plaintiff withdrew CTM application at pending proceedings; plaintiff to bear the costs.

Steninge Slott/Steninge Keramik: T-499/04 - Judgment of 17 October 2006 (action dismissed; Office decision confirmed).

Keywords: Opposition: comparison of goods.

The action had been directed against a decision of the 2nd Board of 25.10.2004 in R 394/2003-2 on an opposition case concerning CTM application "Steninge Slott" for certain glass products in Class 21. It had been opposed on the basis of the Swedish mark "Steninge Keramik" registered for flowerpots made of ceramics, in Class 21. An opposition division had allowed the opposition. At the appeal stage, the CTM applicant restricted the scope of his claim to "design products of glass and crystal for household and indoor decoration". In consequence, the Board had allowed the appeal, holding that the restriction of the list of goods and services in the CTM application would exclude porcelain goods from the scope of protection, and because of the low degree of similarity of the marks at issue. The Second Chamber of the CFI (Pirrung, Forwood, Papasavvas) confirmed that decision.

Galzin/Calsyn: T- 483/04 - Judgment of 17 October 2006 (action allowed; particular case: confirmation of Office practice confirmed in that the decision of the Opposition Division concerned has been re-established).

Keywords: CFI procedure: possible heads of claim (OHIM) – Opposition/proof of use: broad specification - Opposition: comparison of pharmaceutical goods – Opposition: comparison of marks - Likelihood of confusion: pharmaceutical products.

The action had been directed against a decision of the 4th Board of 7.9.2004 in R 295/2003-4 in an opposition case concerning CTM application "Galzin" for pharmaceutical preparations for the treatment of Wilson's disease, in Class 5. The invoked earlier French mark is "Calsyn", registered for pharmaceutical and medical preparations, more specifically calcium-based preparations, in Class 5. Whereas an opposition division had allowed the opposition in its entirety, the 4th Board had rejected it on the grounds that the products are not intended to treat similar diseases, that both consumers and medical professionals would pay particular attention to the marks identifying pharmaceutical products, and that the marks would differ phonetically. Before the CFI, the OHIM did not take a stance but deferred to the assessment of the court as to whether there is a likelihood of confusion. The Fifth Chamber of the CFI (Vilaras, Martins Ribeiro, Jürimäe) revoked the Board's decision, considering the goods similar and the marks similar enough to give rise to a risk of confusion.

(a) CFI procedure: possible heads of claim



“(13) It is appropriate to bear in mind the case-law to the effect that nothing prevents OHIM from endorsing a head of claim of the applicant's or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate for giving guidance to the Court (Case T-107/02 *GE Betz v OHIM – Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, paragraph 36, and Case T-379/03 *Peek & Cloppenburg v OHIM (Cloppenburg)* [2005] ECR II-0000, paragraph 22). On the other hand, it may not seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application or put forward pleas in law not raised in the application (see, to that effect, Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 34, and *Cloppenburg*, paragraph 22).”

(b) Broad specification and proof of use

“(26) It is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established (Case T-126/03 *Reckitt Benckiser (España) v OHIM – Aladin (ALADIN)* [2005] ECR II-2861, paragraph 44).

(27) It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition (*ALADIN*, paragraph 45).

(28) It must be borne in mind that the earlier mark was registered for ‘pharmaceutical and medical preparations, more specifically calcium-based preparations’. That description obviously covers a category of goods, namely pharmaceutical preparations in general, which is sufficiently broad for it to be possible to identify within it various sub-categories capable of being viewed independently. The concept of pharmaceutical preparation covers goods which are sufficiently different in their intended purpose and end consumers, according to their specific therapeutic indications, and in their channels of distribution, depending on whether they are available on medical prescription or over the counter, for it to be possible to identify within it various sub-categories.

Moreover, the applicant has itself identified separately in the description of the goods under its mark the sub-category corresponding to ‘calcium-based preparations’.

(29) In those circumstances, the Court finds that proof of genuine use of the earlier mark has been made out only in respect of part of the goods or services coming within a broad category of goods capable of including various independent sub-categories.

(30) It follows that by taking into account, for the purposes of considering the opposition, only ‘calcium-based pharmaceutical preparations’, the Board of Appeal applied correctly Article 43(2) and (3) of Regulation No 40/94. “

(c) Pharmaceutical products and the consumers` perception

“(77) As regards the overall assessment of the likelihood of confusion, the Court observes that the Board of Appeal found that, although there is a certain degree of similarity between the goods and between the marks, it was not sufficient to give rise to a likelihood of confusion between the goods sold under each of those marks. To reach that conclusion, the Board of Appeal found, inter alia, that, given the nature of the goods, the public including both consumers of medicinal products and medical professionals would pay particular attention to the signs identifying the goods.

(78) It must be borne in mind that it is settled case-law that, for the purposes of that overall assessment, the average consumer of the category of goods concerned is deemed to be reasonably well informed and reasonably observant and circumspect. According to that same case-law, it should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer*, paragraph 26).

(79) The Court finds that the level of attention of the average consumer of pharmaceutical preparations must be determined on a case-by-case basis, according to the facts in the case-file, especially the therapeutic indications of the goods in question. Likewise, the Court finds that, in the case of medicinal products subject to medical prescription such as those being considered in the present case, that level of attention will generally be higher, given that they are prescribed by a physician and subsequently checked by a pharmacist who delivers them to the consumers.

(80) However, the fact that the relevant public is composed of persons whose level of attention may be considered high is not sufficient, given the similarity between the goods and the conflicting signs, to exclude the possibility that the public might believe that those goods come from the same undertaking or, as the case may be, from economically-linked undertakings. The Court notes that the Board of Appeal's conclusion that there is no likelihood of confusion was founded on an incorrect assumption, namely that there were significant differences between the signs, especially from a phonetic standpoint, and that those differences were likely to offset the degree of similarity existing between the goods. That assessment cannot be accepted since, as stated in paragraphs 74 and 75 above, the conflicting signs have strong visual and phonetic similarities.



(81) In those circumstances, the Court finds, contrary to the conclusion in the contested decision, that, in terms of the overall impression, given the similarity of the goods concerned and the visual and phonetic similarities of the two marks, the apparent differences between the marks are not sufficient to eliminate the existence of a likelihood of confusion on the part of the relevant public.”

Vitacan/Vitacin: T-383/04 - Removed from the register; Order of 27 September 2006 (DE).

Keywords: Opposition: comparison of goods.

The action had been directed against a decision of the 2nd Board of 23.7.2004 in R 1014/2001-2 by which the Board had rejected CTM application Vitacan (for milk drinks, cacao drinks, chocolate drinks and fruit drinks etc., in Classes 29, 30 and 32) on the basis of the earlier German right Vitacin, registered for teas, in particular fruit teas, in Class 30. The Board had held that the goods are similar since they all belong to the sector of non-alcoholic beverages. The parties have settled the issue out of court and have requested the case be removed from the register.

Map&Guide: T-302/03 - Judgment of 10 October 2006 (only DE, ES, IT, FR; action dismissed, Office practice confirmed).

Keywords: Absolute grounds for refusal: relationship between the various sub-paragraphs of Article 7(1) CTMR, in particular (b) and (c) CTMR.

The action had been directed against a decision of the 2nd Board of 1.7.2003 in R 1046/2001-2. The CTM application at issue is “map&guide” (word mark) for a range of goods and services in Classes 9, 41 and 42, *inter alia* for computer software and programming and providing programs for data processing. It had been rejected for everything except for Class 41, based on Article 7(1)(b) CTMR. The Second Chamber of the CFI (Pirrung, Meij, Pelikánová) confirmed the findings. It further confirmed that the absolute grounds for refusal exist in the public interest.

Armafoam/Nomafoam: T-172/05 - Judgment of 10 October 2006 (action dismissed;

Office practice confirmed).

Keywords: CFI procedure: representation by a German Patentanwalt at the hearing (only if supervised and accompanied by applicant's lawyer) - CFI procedure: (legal) argument raised for the first time before the court – Opposition/earlier CTM: likelihood of confusion only in part of the EU – Comparison of marks: language aspects.

The action concerned a decision of the 1st Board of 23.2.2005 in R 552/2004-1 relating to a conflict between CTM application word “Armafoam” for a range of products in Cass 20. The invoked earlier right, word mark “Nomafoam”, is registered for a range of products in Classes 17, 19, 20, 27 and 28. The Board had allowed the opposition on the grounds that there existed a likelihood of confusion.

(a) Likelihood of confusion: territorial aspects

“(33) Finally, it follows from the unitary character of the Community trade mark laid down in Article 1(2) of Regulation No 40/94 that an earlier Community trade mark is protected in the same way in all Member States. Earlier Community trade marks may therefore be relied on in opposition to any subsequent application to register a trade mark which infringes their protection, even if it does so only in the perception of the consumers of part of the Community. It follows that the principle laid down in Article 7(2) of Regulation No 40/94, according to which it suffices, in order for registration of a trade mark to be refused, that an absolute ground for refusal exists only in part of the Community, also applies by analogy to a relative ground for refusal under Article 8(1)(b) of Regulation No 40/94 (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 59; *ZIRH*, paragraph 36; Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM – Naulover (NLSPORT, NLJEANS, NLACTIVE and NLCollection)* [2004] ECR II-3471, paragraph 34; and Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 33).

(34) Firstly, with regard to the definition of the relevant public, it is to be noted, as did the Board of Appeal (paragraphs 8 and 9 of the contested decision) and the parties, that the goods which are the subject of the trade mark application and the goods covered by the earlier mark are likely to be marketed to a very wide public, both professional and non-professional. The relevant public is therefore composed of all consumers within the Community.”

(b) CFI procedure: presentation for the first time, by the parties, of legal arguments; presentation, by the Office, of legal arguments different from the Board

“(37) OHIM, whilst sharing the Board of Appeal's conclusion that the goods are similar, arrives at that conclusion with different reasoning. Unlike that body, it takes the view that it is not the goods in the trade mark application that encompass certain goods covered by the earlier mark but, rather, it is the goods covered by the earlier mark, in particular ‘products [listed in Class 20] of plastic not included in other classes’ – a category which, according to OHIM, is unlimited both as to the kind of plastic used and as to the use to which the goods made of plastic are put – that encompasses the goods covered by the trade mark application.

(38) The intervener submits that the applicant's arguments relating to the goods are inadmissible before the Court of First Instance under Article 135(4) of the Rules of Procedure since they were not raised in the proceedings before OHIM. In the alternative, the intervener shares the view of the Board of Appeal that, with regard to the goods covered, the wording of the trade mark application is so broadly couched as to



encompass the goods covered by the earlier mark in Class 20. The intervener produced a number of commercial documents which it had previously produced to OHIM.

(39) With regard, firstly, to whether the applicant's arguments concerning the goods are, as alleged, inadmissible, it is to be borne in mind that the purpose of an action brought before the Court pursuant to Article 63(2) of Regulation No 40/94 is to obtain a review of the legality of decisions of the Boards of Appeal (see Case T-247/01 *eCopy v OHIM (ECOPY)* [2002] ECR II-5301, paragraph 46, and Case T-311/01 *Éditions Albert René v OHIM – Trucco (Starix)* [2003] ECR II-4625, paragraph 70 and the case-law cited). Pursuant to Article 74 of Regulation No 40/94, the review must be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal (Case T-194/01 *Unilever v OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 16, and Case T-57/03 *SPAG v OHIM – Dann and Backer (HOOLIGAN)* [2005] ECR II-287, paragraph 17). Furthermore, under Article 135(4) of the Rules of Procedure, the parties' pleadings may not alter the subject-matter of the proceedings before the Board of Appeal.

(40) It is therefore necessary to consider whether, by claiming for the first time before the Court of First Instance that the goods covered by the marks are different, the applicant has altered the subject-matter of the proceedings.

(41) It is clear that, where it is based on Article 8(1)(b) of Regulation No 40/94, opposition to the registration of a Community trade mark requires OHIM to adjudicate on whether the goods and services covered by the conflicting marks are similar or identical.

(42) That is also the case even where OHIM, or one of the parties to the proceedings, considers it unnecessary to examine whether the goods or services in question are identical or similar because of the considerable differences between the marks, which, in any event, rule out a likelihood of confusion. Next, the fact that, in the present case, the applicant agreed in the proceedings before the Opposition Division that the goods covered by the marks may potentially be identical, since it stated before the Board of Appeal that the question whether the goods are similar could be left undecided on account of the alleged differences between the marks, did not in any way divest OHIM of the power to adjudicate on whether the goods covered by those marks are similar or identical. Likewise, therefore, that fact has not deprived the applicant of the right to challenge, in the factual and legal context of the dispute before the Board of Appeal, the findings of that body on this point (see, by analogy, Case T-360/03 *Frischpack v OHIM (shape of a cheese box)* [2004] ECR II-4097, paragraphs 32 to 35).

(43) Clearly, the applicant's arguments relating to the comparison of the goods before the Court of First Instance do not depart from the context of the dispute as it was brought before the Board of Appeal. Indeed, the applicant merely questions that body's findings and its reasoning on this point. It follows that the applicant has not altered the subject-matter of the proceedings by those arguments, which are therefore admissible before the Court. "

(c) Comparison of marks

"(60) The Court considers that the Board of Appeal's assessment is well founded, at the very least as far as non-English-speaking consumers are concerned, in relation to whom it is not necessary to make a conceptual comparison of the marks. The applicant's submission that non-English-speaking consumers will, in the same way as their English-speaking counterparts, automatically identify the suffix 'foam', an English word, and understand its meaning and therefore identify it as descriptive of the goods covered by the marks, is manifestly wrong. Nor, moreover, is that submission substantiated by evidence in the file.

(61) With regard to the visual and phonetic comparison of the marks, the Board of Appeal concluded, in essence, that there are great similarities as far as the non-English-speaking public is concerned (paragraphs 11 to 19 of the contested decision). It noted that the marks have six letters and three syllables in common out of a total of eight letters, each mark having four syllables, and that, although placed at the beginning of the marks, the prefixes 'ar' and 'no' are not liable to call into question the visual and phonetic similarity of those marks. The intervener and OHIM share that view.

(62) As far as the English-speaking public is concerned, the Board of Appeal considered that the descriptive nature of the suffix 'foam' is more liable than not to increase the overall visual and phonetic similarity of the marks for that public (paragraphs 16 and 17 of the contested decision). OHIM considers, on the other hand, that the descriptive nature of that suffix would lead that public to focus on the first components of the marks, 'arma' and 'noma', which are sufficiently differentiated.

(63) The applicant maintains that, on account of their position at the beginning of the marks, the prefixes 'ar' and 'no' clearly differentiate those marks visually and phonetically. It also claims that the prefixes 'arma' and 'noma', which, in its view, are the dominant components of the marks, are clearly visually and phonetically differentiated.

(64) The Court finds that the only visual and phonetic differences between the marks that can objectively be detected by the non-English-speaking public derive from the prefixes 'ar' and 'no'.

(65) Admittedly, the first component of word marks may be more likely to catch the consumer's attention than the following components (see, to that effect, Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81, and Case T-112/03 *L'Oréal v OHIM – Revlon (FLEXI AIR)* [2005] ECR II-949, paragraphs 64 and 65). However, that consideration cannot apply in all cases (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 50, and Case T-117/02 *Grupo El Prado Cervera v OHIM – Héritiers Debuschewitz (CHUFADIT)* [2004] ECR II-2073, paragraph 48). It cannot, in any event, undermine the principle expressed in the case-law cited at paragraphs 29 to 32 above that the examination of the similarity between the marks must take account of the overall impression given by them, since the average consumer normally perceives a mark as a whole and does not examine its individual details.



(66) In the present case, the Court agrees with the Board of Appeal, the intervener and OHIM that, for the non-English-speaking public, the difference between the prefixes 'ar' and 'no', despite their position at the beginning of the marks, is unlikely to remove the impression of great visual and phonetic similarity given by those marks, which arises both from the fact that they are identical in length (each having eight letters and four syllables) and from the fact that, setting aside the abovementioned difference, those marks are absolutely identical both visually (six letters in the same order: 'm', 'a', 'f', 'o', 'a', 'm') and phonetically ('ma', 'fo', 'am').

(67) It follows that, visually and phonetically, the marks are similar, at the very least as far as the non-English-speaking public is concerned. Accordingly, and taking account of the fact that, for that public, a conceptual comparison of those marks is irrelevant, it must be concluded that, for those people, the marks are similar."

Polished bottle – I: T-188/04 - Judgment of 4 October 2006 (FR; Board of Appeal decision quashed on procedural grounds).

Keywords: Office proceedings: right to be heard, Article 73 CTMR - Distinctiveness: specific type of sign (transparent surface of a bottle).

The action had been directed against a decision of the 4th Board of 11.2.2004 in R 104/2001-4. The decision was revoked on formal grounds (dealing with and assessing of empirical material and evidence).

Polished bottle – II: T-190/04 - Judgment of 4 October (FR; Board of Appeal decision quashed on procedural grounds).

Keywords: Office proceedings: right to be heard, Article 73 CTMR - Distinctiveness: specific type of sign (transparent surface of a bottle).

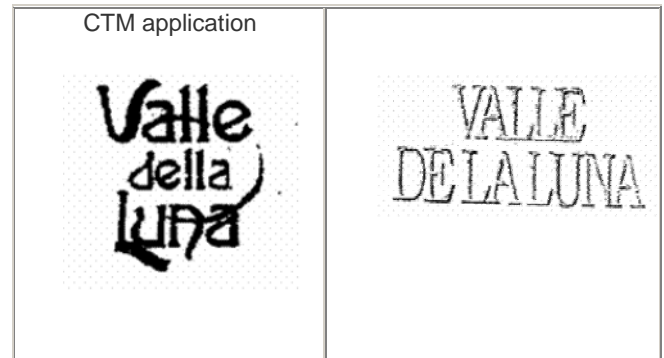
The action had been directed against a decision of the 4th Board of 11.2.2004 in R 97/2001-4. The facts are the same as in T-188/04 (above).

Valle della Luna: T-96/05 - Judgment of 4 October 2006 (only FR, IT; action dismissed; Board decision confirmed).

Keywords: CFI procedure: minor mistake of the Board does not lead to revocation of the decision - Boards of Appeal procedure: proof of use of earlier right at the appeal stage – Proof of use: use of a mark different as registered - Comparison of goods: non-alcoholic and alcoholic beverages.

The action concerned a decision of the 1st Board of 24.11.2004 in R 269/2004-1. The CTM application at issue (set out below) had been applied for beers and a range of

non-alcoholic beverages in Class 32. The invoked earlier right is registered for wines and sparkling wines in Class 33.

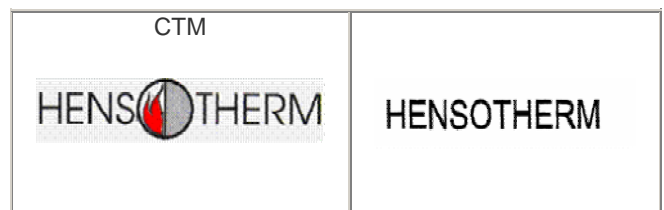


The 1st Board had accepted new evidence concerning use of the invoked earlier right produced for the first time at the appeal stage. It had made a mistake as concerns the assessment of the relevant criteria concerning the use requirement. The Third Chamber of the CFI (Jaeger, Azizi, Cremona) held that the overall result of the decision had not been flawed by the said error.

Hensotherm: T-366/04 – Order of 6 September 2006 (only FR, SV; manifestly unfounded).

Keywords: CFI proceedings: summary dismissal of an appeal, Article 111 of the Rules of Procedure – Cancellation: relative grounds for invalidity.

The action had been brought against a decision of the 1st Board of 12.7.2004 in R 614/2003-1 by which the Board had rejected, on formal grounds, the appeal against a decision of a cancellation division to declare the CTM invalid.



The CTM had been registered for a range of products in Classes 2 and 17. The invoked earlier right is registered for a range of products in Class 2.

Energia: T-172/04 - Judgment of 27 September 2006 (only in ES, FR; action dismissed, Office practice confirmed).

Keywords: Opposition procedure: evidence not filed before the Office – Opposition: likelihood of confusion.

The action had been directed against a decision of the 1st Board of 12.3.2004 in R 676/2002-1. It had concerned CTM application "energía" as shown below (fig.; colours orange, white, green and black) which covered a range of goods and services in Classes 9, 38 and 42.

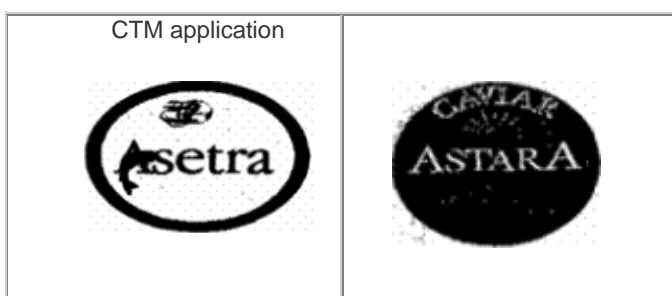


An opposition had been lodged based on the Spanish word mark "Emergea", registered for a range of goods and services in Classes 28, 36 and 38. The opposition had been allowed as regards services in Class 38. The 1st Chamber of the CFI (García-Valdecasas, Cooke, Trstenjak) confirmed that evidence available at the relevant time but not filed before the Office cannot be filed before the court. On the substance, it confirmed the findings of the Board.

Asetra/Caviar Astara: T-252/04 - Judgment of 11 July 2006 - (only in FR; appeal allowed; no decision taken yet with respect to a possible change of the practice of the Office, pending ECJ in Arcol/Carpol, C-29/05-P).

Keywords: Boards of Appeal: procedure; scope of examination; material produced for the first time at the appeal stage – Opposition procedure: language – Opposition procedure: standard letters – Opposition: likelihood of confusion; criteria.

The action had been directed against a decision of the 2nd Board of 19.4.2004 in R 479/2003-2 in a conflict between CTM application Asetra (fig.) for a range of goods and services in Classes 29, 31 and 35, and Caviar ASTARA in Classes 29 and 31.



The notice of opposition had initially been filed in a wrong language. Upon request, the opponent filed a translation into an available language. Evidence concerning, inter alia, the validity of the earlier right had not been translated. In the course of proceedings, the Opposition Division issued a standard letter, allowing 4 months for completion of the file. The said standard letter contains information concerning translations. No material was filed. After the applicant had responded, its brief was forwarded to the opponent under a standard letter in which it is stated that the opponent is only entitled to comment on the applicant's response. The opponent then filed translations concerning evidence.

The Opposition Division rejected the opposition on the grounds that the formally necessary evidence concerning the validity of the invoked earlier right had been filed out of time. In its appeal, the opponent again attached the necessary material in its translated version. The 2nd Board rejected the appeal. On subsequent appeal, the First Chamber of the CFI (Cooke, García-Valdecasas, Labucka) overturned the Board's decision (arguing functional continuity; see also La Baronnie, Case T-323/03, directly below, and also Dr. No, Case T-435/05).

La Baronnie/Baronia: T-323/03 – Judgment of 10 July 2006 (only in FR; appeal allowed; no decision taken yet with respect to a possible change of the practice of the Office, pending ECJ in Arcol/Carpol, C-29/05-P).

Keywords: CFI proceedings: material produced for the first time before the Board of Appeal – Boards: principle of functional continuity - Opposition: proof of use – Proof of use: particularities of national renewal (immaterial) - Right to a trade name, Article 8(4) CTMR: evidence of existence.

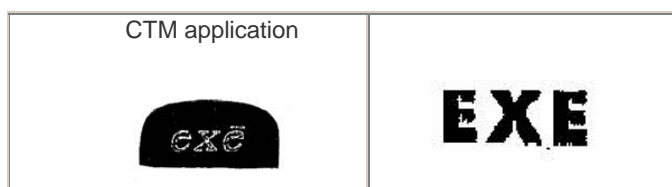
The action concerned a decision of the 2nd Board of 9.7.2003 in R 57/2003-2 in a conflict between CTM application La Baronnie in Class 33 and the earlier Spanish mark Baronia, registered for "all kinds of wine" (Class 33), and the trade name La Baronia de Turis. Before the Opposition Division, the opponent had filed evidence of use from 1929 onwards (gold medal awarded at Barcelona International Fair) but, except for one label, nothing for the relevant 5-year period (1996-2001). Specific material proving the validity of the claimed right to a trade name had not been filed either. Evidence had been filed at the appeal stage but had been rejected. The First Chamber of the CFI (Cooke, Garcia-Valdecasas, Trstenjak) held that new material may be filed before the Boards of Appeal because of the "functional continuity" in relation to the examiner or Opposition Division, respectively (see also Dr. No, T-435/05).

C-2: CFI: Developments in pending cases

Ex : T-96/06 - Office response filed (EL).

Keywords: Opposition: comparison of goods – Comparison of goods: textiles, leather ware and "fashion".

The action is directed against a decision of the 2nd Board of 11.1.2006 in R 1127/2004-2 relating to CTM application "exé" applied for a range of products in Classes 18 and 25. It had been opposed on the basis of various earlier rights covering the word "EXE", for a range of products in Class 25.



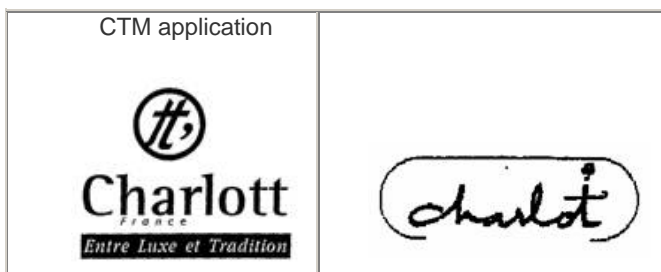


The opposition had been allowed in relation to leather goods, handbags, wallets and purses (Class 18) and men's and women's footwear, leather clothes and belts (Class 25), mainly on the grounds that the leather goods at issue are fashion items, often chosen for their ability to combine well, aesthetically, with clothing.

Charlott: T- 169/06 - Office response filed (FR).

Keywords: Opposition: proof of use – Proof of use/textiles: catalogues – Proof of use: Internet.

The action is directed against a decision of the 2nd Board of 24.4.2006 in R 223/2005-2 on an opposition case concerning CTM application Charlott (fig.) applied for a range of products in Class 25. It had been opposed on the basis of the earlier Portuguese mark Charlot (fig.) registered for clothing, in Class 25.



Whereas the Opposition Division had rejected the opposition on the grounds that the evidence shown did not demonstrate genuine use on the relevant market, the Board had considered the provided material sufficient. The said material comprised catalogues and use of the sign on the Internet.

Aturion/Urion: T-146/06 - Office response filed (ES).

Keywords: Opposition: comparison of goods – Comparison of goods: pharmaceutical products – Opposition: comparison of marks – Comparison of marks: impact of a conceptual meaning.

The action is directed against a decision of the 1st Board of 3.2.2006 in R 227/2005-1 concerning CTM application "Aturion" applied for specific pharmaceutical products in Class 5 (for treatment of cardiovascular diseases). It had been opposed on the basis of the French mark "Urion" for pharmaceuticals relating to metabolism. The Board had rejected the opposition on the grounds that there is no likelihood of confusion. The marks are not confusingly similar since, as regards a conceptual comparison, the earlier right conveys a meaning. As concerns the products, a likelihood of confusion is unlikely because of the different areas of application of the pharmaceuticals at issue.

Bocksbeutel: T-180/06 - Office response filed.

Keywords: Hierarchy of law: EU law relating to wine and the CTMR – Community collective mark - Distinctiveness: 3D-signs; shape of the product.

The action is directed against a decision of the 1st Board of 25.4.2006 in R 479/2004-1 concerning CTM application 2 323 301 applied for as a collective CTM for a range of products and services in Classes 32, 33 and 42. The specific shape of the bottle applied for is reserved for certain producers under Regulations (EC) No. 1493/99 and No. 753/02. The CTM applicant is an association of wine producers from one of the protected areas.



The Board had rejected the application on the grounds that the shape lacks distinctive character pursuant to Article 7(1)(b) CTMR. The wine bottle applied for has been in use for centuries in the area where the applicant is located.

Past Perfect: T- 133/06 - Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness.

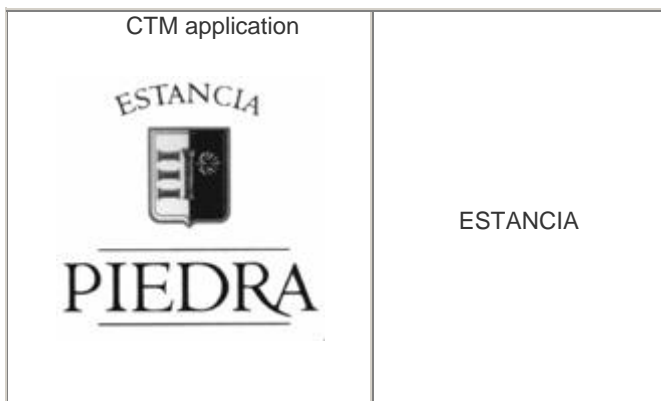
The action is directed against a decision of the 1st Board of 3.2.2006 in R 150/2005-1 concerning rejection of two joined requests for a declaration of invalidity. The challenged CTM is Past Perfect, registered for a range of products in Class 9, mainly for musical recordings of all kind. The Board had affirmed the rejection of the claim made that the CTM is descriptive since it describes good music from the past, inter alia, classical music.



Estancia Piedra-II: T-160/06 - Office response filed.

Keywords: Cancellation/formalities: authorization of the representative – Cancellation: relative grounds for invalidation.

The action is directed against a decision of the 2nd Board of 28.3.2006 in R 361/2005-2 concerning CTM Estancia Piedra (fig.) in Class 33 (alcoholic beverages) against which a request for cancellation had been lodged based on "Estancia", registered for alcoholic beverages, spirits and liquors.



The representative of the applicant for cancellation had not filed an authorisation along with the request; the authorisation had been provided subsequently. The Board had held that at cancellation a minor formal requirement can be complied with subsequently during proceedings on the grounds of procedural economy and the principle of proportionality. If a request for cancellation is rejected on formal grounds of this nature, the applicant concerned can re-file.

Estancia Piedra-I: T-159/06 - Office response filed.

Keywords: Cancellation/formalities: authorisation of the representative – Cancellation: relative grounds for invalidation – Comparison of goods and services.

The action is directed against a decision of the 2nd Board of 28.3.2006 in R 363/2005-2 relating to CTM 2 127 868 (same representation as in Estancia Piedra-II, above). The CTM is registered for services via worldwide computer networks in Class 35. The invoked earlier right is the word mark Estancia (same as in Piedra Estancia-II, above), registered for alcoholic beverages in Class 33. The cancellation division concerned had declared invalid the CTM on the grounds that the goods and services are similar because they are complementary.

Bauhaus: T-106/06 - Office response filed.

Keywords: Opposition: comparison of marks.

The action has been directed against a decision of the 4th Board of 31.1.2006 in R 92/2004-4 by which the Board had rejected an opposition based on the earlier right "Bauhaus" (fig.) against figurative CTM application BAU HOW on the grounds that the marks at issue are dissimilar.

The CTM application had been filed for a range of goods and



services in Classes 7, 8, 11, 19, 20, 36, 37 and 40. The earlier Benelux right is registered for a range of goods and services in Classes 1, 2, 6, 7, 8, 9, 11, 12, 16, 17, 19, 20, 21, 25, 27, 31 and 40.

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EX-PARTE

Article 7(1)(b) and (c)

Examination proceedings – absolute grounds for refusal – distinctiveness – descriptiveness – letter

Decision of the First Board of Appeal of 8 September 2006 in Case R 0394/2006 (German)

R 0394/2006-1 E – de – an individual letter, even when it appears in a conventional script and style, with no graphic design or secondary elements cannot be denied distinctive character for the goods and services requested. The mere fact that they are expressly included in the statutory list contained in Article 4 CTMR means that letters have the abstract capability to serve as trade marks. A denial of specific distinctive character requires a concrete finding that the targeted public will not understand the letter as an indication of origin in respect of certain goods, The mark applied for is devoid of distinctive character for goods in Classes 7, 9 and 19, mainly in the area of wind power plants, since it will not be perceived as an indication of origin but rather as a technical indication or a type definition. Furthermore it is descriptive according to Article 7(1)(c) CTMR since the single letter "E" will be seen by the relevant

public as an often used indication (abbreviation) of Energy or Electricity. The Board dismissed the appeal.

INTER-PARTES

Article 8(1)(b)

Opposition proceedings - relative grounds for refusal - dissimilarity of goods and services – similarity of goods and services - purpose of the goods and services – similarity of the signs

Decision of the First Board of Appeal of 5 October 2006 in Case R 1324/2005 (German)

R 1324/2005-1 Epican / EPIGRAN – de – there was similarity found between “food supplements not for medical purposes, mainly consisting of vitamins, amino acids, minerals and trace elements; dietetic substances not adapted for medical use, namely amino acids and trace elements” in Class 5 and “beauty and body care products” in Class 3, due to their complementarity, the fact that they are being sold in the same outlets and that they can substitute each other. On the other hand no similarity was established between the same products in Class 3 and “pharmaceutical and veterinary preparations; vitamins and minerals for medical purposes” in Class 5, since it was held that their purpose was different. Considering that the signs were found to show enough similarities, likelihood of confusion was established in respect of the application's non-medical products.

Opposition proceedings - Relative grounds for refusal - dissimilarity of goods and services – similarity of goods and services - purpose of the goods and services - similarity of the signs

Decision of the First Board of Appeal of 5 October 2006 in Case R 1069/2005 (German)

R 1069/2005-1 Epican Forte / EPIGRAN – de
see R 1324/2005-1 above

Opposition proceedings - relative grounds for refusal - similarity of goods and services - likelihood of confusion - visual similarity - phonetic similarity - conceptual dissimilarity – identity of goods and services

Decision of the First Board of Appeal of 5 October 2006 in Case R 1272/2005 (English)



R 1272/2005-1 MANNA / et al. – en – the Board found identity and close similarity to the opponent's goods in respect of the applicant's goods in Classes 5, 29, 30, 32 and that in respect of the applicant's “catering services, delivery of

cooked dishes” in Class 42, there was a high degree of complementarity between those services and the opponent's consumer foodstuffs and beverages in Classes 29, 30 and 32, since the latter may be offered on a take-away basis in canteens and the same undertaking may provide a home delivery service. The comparison between, on the one hand, the word mark applied for, ‘MANNA’, and, on the other hand, the earlier word mark and the dominant verbal element of the earlier figurative mark ‘MANÁ’, reveals a certain degree of visual similarity between them. In addition, the two signs have their first three letters in common, namely ‘man’. In that regard, it must be recalled that, generally, the consumer's attention is directed, above all, to the start of the word. As regards the phonetic comparison, despite the presence of the tonic accent which means that stress is on the vowel ‘a’ in the second syllable of the earlier mark, the signs in question are similar. Finally, conceptually the marks are different since only the earlier mark refers in Spanish to the food miraculously produced for the Israelites in the desert in the book of Exodus. Nevertheless, the Board considered that since the mark applied for bears a strong resemblance visually and phonetically to the earlier marks and since the visual element is particularly important in the selection of products, such as those at issue, which are often viewed on display and self chosen, the conceptual difference will not counteract the strong visual similarity and the phonetic similarity existing between the conflicting signs. Thus the Board shared the findings of the contested decision as to the existence of likelihood of confusion and dismissed the appeal.

Opposition proceedings - relative grounds for refusal - dissimilarity of goods and services - similarity of the signs

Decision of the First Board of Appeal of 5 October 2006 in Case R 1138/2005 (German)

R 1138/2005-1 WILDCAT PLUS / WILDCAT – de – the application is identical in its dominant element to the earlier mark “WILDCAT”. The component “PLUS” is, because of its quality-describing function, only of lesser importance, so that the marks are similar to a considerable degree. In relation to the goods concerned, however, no general rule exists to the effect that raw material necessary for the production of another product is similar to that second product. At the end of the day, the most important criterion within the framework of likelihood of confusion is the perception of the relevant public of whether the goods are manufactured under the control of the same or a connected enterprise. This was not the case here. Thus despite the high similarity between the signs at hand there was held to be no likelihood of confusion.

Opposition proceedings - relative grounds for refusal - identity of goods and services - visual similarity - phonetic similarity - likelihood of confusion

Decision of the First Board of Appeal of 9 October 2006 in Case R 0823/2005 (German)



R 0823/2005-4 SinnLeffers / Sinn – de – the application's horological and chronometric instruments were held to be identical to the opponent's watches and other chronometric instruments. The signs are visually and phonetically similar considering that the earlier mark is identically included at the beginning of the younger mark. Also the fact that the part "Leffers" is written with a capital letter differentiates it from the first part "Sinn", the latter thus being emphasized. Despite the fact that the term "Sinn" does not hold a dominant position in the younger mark, it nevertheless has at least an equally strong position according to paragraph 36 of the "Thomson Life" judgment of the European Court of Justice in case C-120/04. It is therefore sufficient that even though the common element does not dominate the younger mark, it at least equally determines the mark. In view of the identity of the products under comparison, it was decided that likelihood of confusion had to be confirmed.

Opposition proceedings - relative grounds for refusal - identity of goods and services - likelihood of confusion - visual similarity - phonetic similarity - conceptual dissimilarity

Decision of the Fourth Board of Appeal of 18 October 2006 in Case R 0268/2005 (German)

R 0268/2005-4 FOCUS RADIO / FOCUS – de – the application's signboards and paper, cardboard models ; paper , cardboard, stationery are identical to the opponent's paper, cardboard and paper and cardboard products. The signs are visually, phonetically and conceptually similar considering that the earlier mark is identical to the first part of the younger mark. The result that the earlier mark "FOCUS" is similar to the younger mark and prevails over the latter in case of identical goods, is in conformity with the jurisprudence of the Court of First Instance. In all cases decided so far with "A+B against A" or "A against A+B", likelihood of confusion was confirmed by the Court when there was a high similarity between the relevant goods and services. Again, in the present case the criteria of the ECJ judgment "Thomson Life" apply. Likelihood of confusion was confirmed.

Inter-partes

Article 8(4)

Opposition proceedings - relative grounds for refusal - likelihood of confusion - sign used in the course of trade - mere local significance - national law - evidence of use - used in the course of trade - new evidence

Decision of the First Board of Appeal of 14 September 2006 in Case R 0792/2005 (English)

R 0792/2005-1 GREMCO / GREMCO – en – the opponent grounded its opposition on an earlier sign used in the course of trade under French law. The contested decision held that no adequate evidence had been provided in order to prove sufficient use in the course of trade. The opposition was

rejected. The Board noted that in order to ascertain whether the sign invoked has more than mere local significance, it must apply not only geographical criteria, such as data relating to the location of the company or its customers, but also qualitative and quantitative criteria. The Board considered that it had sufficient evidence to come to the conclusion that actual use was made of more than mere local significance. Even though the evidence may not have been adequate before the Opposition Division, the Board was finally satisfied, taking into consideration the supplementary evidence filed before it, which it took into consideration in accordance with its discretionary power under Article 74(2) CTMR and the third sentence of Rule 50(1) CTMIR. It is clear that the opponent would sustain damage to its registered company name GREMCO S.A. if the applicant were to use the identical sign GREMCO as a trade mark in France for identical or similar goods. In addition, the use of the trade mark applied for would be precisely within the same market in which the opponent is doing business in France. The use of the registered company name, as demonstrated by the opponent, covers the same kind of goods to be manufactured and sold by it. These goods are identical with the goods applied for by the applicant. Both would be direct competitors. For these reasons, taking into account the sum of the evidence filed, the Board considered that sufficient evidence of use of more than mere local significance was provided. The opponent fulfilled all the criteria of Article 8(4) CTMR and the requirements under French law of unfair competition. The Board annulled the contested decision, upheld the opposition and rejected the trade mark applied for.

Opposition proceedings - relative grounds for refusal - likelihood of confusion - sign used in the course of trade - national law - evidence of use - used in the course of trade

Decision of the Second Board of Appeal of 25 September 2006 in Case R 0585/2005 (English)

R 0585/2005-2 ZETIA / ZELTIA S.A. – en – the opponent was a user of an unregistered earlier trade name in Spain and brought an opposition under Article 8(4) CTMR against the CTMA, since he claimed that under Spanish law he was entitled to prohibit use of a subsequent trade mark. The opposition was accepted. The contested decision is not disputed insofar as it found that the sign applied for is similar to the earlier trade name which designates activities related to the goods and services for which the application seeks protection (Class 5). The national law of a Member State to be applied by OHIM is not a matter of fact but a matter of law by its very nature, and it is the law applicable to the current case. The degree of difficulty of this issue has prompted the OHIM to try the issue as a matter of fact, but that approach has been overruled by the Court of First Instance in the 'Atomic Blitz' case T-318/03 . Article 8(4)CTMR requires the application of the national law since it refers expressly to the law of the Member State governing that sign , namely, the sign on which the opposition is based. In the present case the sign was an unregistered trade name used in Spain, the protection of which is guaranteed by national and international law. Users of a trade name can obtain the remedy of injunction, preliminary or final, in a civil action for unfair competition although such an injunction cannot be obtained in civil action for infringement of the exclusive right, since this is



only conferred by the registration. In this way, users of unregistered names can obtain, in Spain, the effective protection which the Paris Union and WTO Members are bound to grant against the acts of confusion pursuant to Articles 8 and 10bis.3 of the Paris Convention, according to the wording and purpose of which the national and Community law must be interpreted. Also protection against unfair competition is considered by OHIM to be equivalent to a right to prohibit the use of a later trade mark in the sense of Article 8(4) CTMR, since an injunction may be obtained in civil action for unfair competition. Consequently, the opponent has the right to prohibit the use of a subsequent trade mark under the Spanish law within the sense of Article 8(4) CTMR and is entitled to oppose the contested CTM application as the contested decision found. Given the similarity of the activities and goods concerned and the high similarity of the conflicting signs, the relevant public is likely to confuse the signs and to attribute a common origin to such activities and goods. Thus the appeal was rejected and the contested decision confirmed.

PROCEDURAL ISSUES

Examination proceedings – absolute grounds of refusal – withdrawal – suspensive effect – appealable decision – communication about the possibility of appeal – enlarged board – reimbursement

Decision of the Grand Board of Appeal of 27 September 2006 in Case R 0331/20056 (English)

R 0331/2006-G OPTIMA – en – the first instance examiner refused the application for registration in Classes 9 and 16 of the word 'Optima' on the basis of Article 7(1)(b) and (c) CTMR. The applicant did not appeal against this decision, but instead withdrew the application within the two-month appeal period after the letter of rejection had been received. The applicant asked for clarification after noticing that on OAMI-ONLINE its application appeared as having been rejected and not withdrawn. The Office's Trade Mark Department informed the applicant by letter that since the application had been rejected in its entirety, there was nothing left to be withdrawn. The applicant filed an appeal against this letter. The Grand Board considered that the letter concerned was a notification of a 'decision' subject to appeal. The letter informed the applicant for the first time that its request for the withdrawal of its applied-for mark was refused. The letter itself thus resulted in the notification of a decision that terminated proceedings in this respect, even if it did not contain any communication indicating that an appeal could be filed. As far as the subject of the appeal was concerned, the Grand Board commented that the use of the term 'at any time' in Article 44(1) CTMR, clarified the fact that a withdrawal was permissible during any phase of the proceedings, that is to say, not only during the examination proceedings, but also, in particular, during ongoing opposition and appeal proceedings.

It added that the appeal proceedings had a suspensive effect, and that a contested Office decision at first instance could not take legal effect until the period to lodge an appeal was over or the decision handed down by the Board of Appeal had confirmed the first instance decision. Thus, the decision to

refuse the registration of an applied-for mark could not have the consequence of terminating the examination proceedings until the two-month period in which to appeal was over. In the present case, the period for filing a notice of appeal against the decision of the examiner rejecting the application had not yet expired at the point in time when the applicant's withdrawal was received by the Office. Thus it was still possible for the applicant to withdraw its application. The Grand Board stressed that the present appeal was against the decision of the examiner not to accept the withdrawal and not against the decision to reject the mark applied for. It added that the decision to reject the mark applied for had not been challenged; therefore, it had to be considered that as from the expiry of the two-month appeal period, it was a decision that would remain in the files. The Grand Board did not find that the Trade Mark Department committed a substantial procedural violation as it merely followed the applicable guidelines. The appeal fee was not reimbursed. The Grand Board annulled the appealed decision. It noted that the application had been withdrawn and instructed the Trade Mark and Register Department to correct this in the records.

Appeal proceedings – appeal deemed not to have been filed – fee

Decision of the First Board of Appeal of 10 October 2006 in Case R 0203/2005 (German)

R 0203/2005-1 BLUE CROSS MEDICARE / BLUE CROSS – de – the appeal is deemed not filed, not only when the appeal fee has arrived too late, but also when the supplement for late payment arrives after the 10 day dead-line.

Absolute grounds of refusal – examination proceedings – appeal proceedings – statement of grounds – time limit – translation- distinctiveness -continuation of proceedings

Decision of the Fourth Board of Appeal of 29 September 2006 in Case R 0269/2006 (Swedish)

R 0269/2006-4 ATEENWORLD – sv – the examiner refused the application for all the goods and services applied for. This decision was rendered in Swedish. The applicant filed a notice of appeal (consisting of an English version of the official Appeal Form) and he also filed a statement of grounds of appeal in English. Then the appellant filed a request for continuation of proceedings and at the same time paid the fee for that request. Attached to this request was a Swedish translation of the statement of grounds. The notice of appeal had to be filed in Swedish. The notice of appeal, filed on the official form, complied with that requirement. The statement of grounds of appeal however, did not comply with the language requirements, as it was drawn up in English. Nevertheless a translation of the statement of grounds into the language of proceedings could still be filed within one month, counted from the date of submission of the original document. The appellant missed this time limit to file a translation, but was granted continuation of proceedings.

It was pointed out that Article 78(a) CTMR excludes from continuation of proceedings the time limits for filing an appeal and for filing the statement of grounds of appeal. However, the missed time limit is the time limit under Rule 96(1) of the Implementing Regulation (filing a translation) and that is not excluded. The appeal was also well-founded. The refusal was based on the argument that the mark applied for refers to 'a world of teenagers'. The Board fails to see how this could be descriptive or non-distinctive for financial services, travel information, information about sports events, information about restaurants and hotels etc. The sign 'ATEENWORLD' is at most suggestive for goods and services that appeal to persons in the teenage. The sign applied for is very capable of serving as an indicator of commercial origin in the sense that all the goods and services applied for come from one single undertaking. The Board annulled the contested decision.

E-Business at OHIM

E-Business Users Group Meeting

On 27 October, the E-Business Users Group met in the OHIM headquarters to discuss e-business issues and collect useful feedback and comments to develop services better meeting users' needs. The agenda (http://oami.europa.eu/en/office/events/pdf/usersgroup_october_2006.pdf) dealt with aspects relating to existing OHIM e-business services and future ones.

The OHIM explained that the performance of CTM and RCD e-filing systems was being monitored. This task is carried out by shadow users in United Kingdom, Germany, France, Spain and Italy electronically filing 5 CTM and 5 RCD applications per day. The first provisional results show that an average of 15 minutes are needed to realise one filing. Further details on this initiative will be published in future Alicante news issues.

The new services were discussed, in particular the future RCD e-renewal system and e-caveat for e-mail notification when a change of status of a selected CTM application has occurred.

Moreover, the OHIM will soon be testing the Online Access to CTM Files service with e-business users. The E-Business Users group will also be consulted for the improvements to MYPAGE.

The E-Business Users Group meeting, organised twice a year, proved to be very useful. The next meeting will be held during 2nd quarter 2007.

New Technical E-business Helpline

In order to improve the accessibility and support for all e-business applications (MYPAGE, e-filing, e-opposition, e-renewal, CTM-ONLINE and RCD-ONLINE), the OHIM has created a specific helpline for all **technical** incidents.

This technical helpline can be reached by e-mails sent to the following mailbox: e-businesshelp@oami.europa.eu

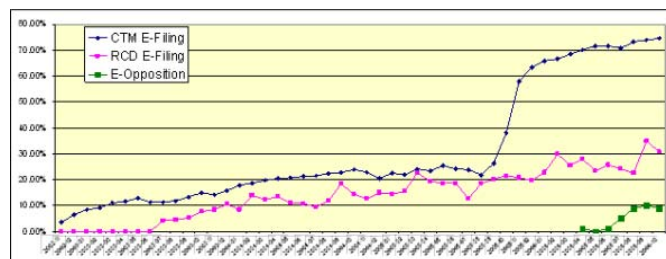
For urgent matters you may also call the newly created Helpline phone number on: + 34 965 139 400 from 7:30 a.m. to 7:30 p.m. on the days that the Office is open to the public.

Non-technical queries relating to e-business services should be directly sent to the Information Centre at information@oami.europa.eu

The OHIM E-Business Roundup (2006)

Statistical summary

- The use of the CTM e-filing web form is slightly increasing over 70%
- Around 10% of opposition against CTM application are received electronically
- The number of MYPAGE users has increased to over 1700 and maintaining the rate of 77% of e-communication users.



State of play of future projects

Service - B2B e-filing CTM:

The objective of this service is to set up a system allowing the direct exchange of CTM applications from the IP management software used by the applicants and the OHIM systems. This tool will use a TM-XML (www.tm-xml.org) format and offer a web service or FTP for the transmission of data.

Status - The OHIM has set up its system.

Service - New version of E-Communication:

Electronic communication will be enhanced to more official communications of the OHIM.

Status - The development is going to start.

Service - New version of CTM E-filing:

The current CTM e-filing service will be significantly improved.

Status - The OHIM is preparing the requirements

Service - Electronic filing of RCD applications:

The current RCD e-filing service will be significantly improved with a view to solving the problem of large attachments, among other things. RCD e-filing will also be accessible through MYPAGE and changes will be made to harmonise it with CTM e-filing.

Status - The OHIM has started the analysis phase.

Service-E-renewal RCD:

The objective is to provide an electronic tool for renewing Registered Community Designs.

Status - The OHIM has started the analysis phase.

Service - Trade mark classification help tool (EUROCLASS):

The OHIM is working together with the EU IP Offices to develop an online service to help with the classification of goods and services. This tool will contain all the accepted classification terms of the participating offices.

Status - This service is in its pilot phase with the first volunteer offices (UKPTO, Swedish Office). The first pilot is online

Service - Search for a representative for CTM or RCD procedures (FindRep):

The current CTM-AGENT database will be improved offering enhanced search criteria. MYPAGE users will have the possibility to change personal details directly.

Status - This service is in development

Service - Online access to CTM files:

CTM file documents will be viewable through CTM-ONLINE. A restricted access is applied to documents of unpublished CTM. Mechanism has been put in place to ensure confidentiality of documents indicated as such.

MYPAGE users will also have the possibility to request inspection of files electronically.

Status - This service is in development following initial delays.

More News**Meeting with Spanish Federation of Design Promotion Entities on 18 October 2006, Valencia**

On 18 October 2006, the OHIM met with representatives of design centres located throughout Spain's autonomous regions in order to identify ways of cooperation. The OHIM and the Federation agreed on the need for Spanish companies to be made more aware of the competitive advantage constituted by design rights and that these should be protected nationally, internationally and Community-wide. After an exchange of opinions, the Federation and the OHIM agreed on an action plan mainly consisting of providing mutual information for their respective websites.

Czech Bar Association visit to OHIM, 27 October 2006

On 27 October, four members of the IP section of the Czech Bar Association visited the OHIM to be up-dated on the latest Community trade mark and Community design case-law and to find out more about OHIM's web services and facilities.

Annual visit of ANDEMA (Asociación Nacional de Defensa de la Marca) to OHIM, 31 October 2006

In its fight against all forms of trademark usurpation in defence of industrial and intellectual property rights, ANDEMA met for another year with the OHIM to be up-dated on the latest developments at the OHIM and to receive answers to numerous requests (mainly regarding the CTM, delay of certificates and the Boards of Appeal). With respect to the latter, the aspect of coherence of the Boards' decisions as well as the link between decisions of the European Court of Justice, the national courts and the Boards of Appeal were discussed. In relation to the Community trade mark, questions on the effective use of a trade mark in cases of opposition procedures and the registrability of colours and containers were answered.

10th anniversary of the Boards of Appeal

On Friday 27 October 2006 the OHIM celebrated the 10th anniversary of its Boards of Appeal. It was mainly a ceremony for the staff of the Boards and the other departments of the OHIM. Some former Members were present (Messrs. Sandri and Ferrão), and Mrs Sunström and Mandel, former Chairpersons of the 2nd and the 1st Boards respectively, accepted to share their personal views and experiences regarding their time in Alicante. President de Boer, Mr Enäjärvi (Chairman of the Administrative Board) and Mr Maier (President of the Boards), also addressed the audience and put the (relatively short) history and the future challenges of the Boards forward into perspective. Representatives of the NGO's such as Marques (Mrs Graulund), Ecta (Mrs Curell), Union (Mr Pereira da Cruz), Unice (Mr Bauer), ICC ICC (Mr Luis Maria Gutierrez de Quijano), AIPPI (Evelyne Roux) and GRUR (Dr Schaeffer) then expressed their points of view and expectations for the future. Fast, coherent and predictable decisions were the main desire of the users. For the last part of the programme, a panel discussion took place between the participants. Finally, glasses were raised during the cocktail that followed and a toast was made to a long and happy life for the Boards.

Visit of OHIM to Japan and Korea, 30 October to 3 November 2006

An OHIM delegation travelled to Tokyo, Osaka and Seoul in order to further increase the knowledge and use of the Registered Community Design system among both agents and the private sector. In Japan, the OHIM held two seminars on the Community Design in collaboration with AIPPI Japan. The accent of these half day seminars was put on the RCD jurisprudence, i.e. invalidity and infringement cases.

The OHIM representatives then visited Korea and spoke on both the Community Trade Mark and Community Design before Korean industry at a seminar hosted by the EU Delegation to South Korea in Seoul. The audience was mainly composed of members of the Korean International Trade



Association, the Korean Federation of Industry, the Korean Chamber of Commerce and the Korean Institute of Design Promotion. Finally, the OHIM participated in a seminar on the Community Design hosted by both the LES Group Korea and AIPPI Korea.

Requesting copies of applications and certificates from the OHIM

Currently the OHIM has a backlog in the Inspection Section that supplies copies of CTM and RCD documents. The OHIM is working diligently to reduce this backlog by streamlining procedures and increasing resources.

OHIM would like to request the collaboration of its users to speed up the reduction in backlog through two concrete measures:

1. **Always use the inspection application form available online**
(http://oami.europa.eu/pdf/forms/inspection_en.pdf)
The lay-out of the inspection form is very clear and all the relevant information is summarised in one page. By using this form, you will enable OHIM to process the request more efficiently.
2. **Wait before sending a reminder**
With the current backlog, it is taking us on average seven weeks to process an inspection request. Each reminder that is sent also has to be correctly processed and this in itself is time consuming as it will be keyed in and double checked against the original request. If at all possible, please do not send a reminder before seven weeks have passed from your original request. This will lead to a better delivery time in general.

Within the context of OHIM's drive to give quality service, we aim to eliminate this backlog within the shortest time possible.