



Contents

The James Nurton interview with Lone Prehn, Partner and European Trade Mark Attorney, Zacco, Denmark
Page 1

Community Trade Mark
Tarzan's trade mark yell
Page 2

Country Overview: Poland & the Community Trade Mark
Page 3

Community Design
Invalidity claims at Community design courts
Page 4

International enforcement of RCDs: the Procter and Gamble saga
Page 4

Country Overview: Poland & the Registered Community Design
Page 6

Case-Law
Latest Trade Mark and Design News from Luxembourg
Page 7

New Decisions from the Boards of Appeal
Page 19

E-Business at OHIM
RCD E-Renewal
Page 20

E-business fact-finding visits
Page 21

The OHIM E-Business Roundup (2007)
Page 21

More news

Monthly Statistical Highlights October 2007
Page 21

Editorial Team:

Reg Rea, David García, Ian Harrington

Contributors to this edition:

James Nurton, Herbert Meister, Wouter Verburg, José Izquierdo, Patricia Vantsiouri, Nicolas Vigneron, Nicasio Agustina and Mikael Wesslegard

Trade marks and designs: the international dimension

Globalisation means that companies are increasingly interested in obtaining international protection for their intellectual property rights. This month's Alicante News looks at how OHIM is forging closer links with the main trade mark and design offices in the US, Japan, and China.

International businesses naturally seek to safeguard their trade marks and designs in the most comprehensive manner possible. This can mean dealing with a number of different registration bodies, all of them with potentially different approaches to this important issue.

For a number of years OHIM has been exchanging information with the US Patent and Trademark Office and the Japan Patent Office in order to try and minimise these differences. Last month, the Chinese Trade Mark Office took part as observers in the sixth annual trilateral meeting, held in Tokyo, and an agreement was made to hold annual workshops in China, and share information on IT and business practices.

So what is the motivation for this type of international contact, and can it really lead to tangible benefits for the business community? OHIM President Wubbo de Boer believes that the major trade mark and design offices have a duty to try to make their approaches as consistent as possible.

"The users who come to OHIM for trade mark and design protection in the 27 countries in the EU are people who deal with offices all over the world. They have a right to expect that we do not confront them with unnecessary differences in practice", says de Boer.

In fact, many of the problems faced by the international trade mark and design offices are similar, as are the solutions being implemented. Processes are being simplified, bureaucracy reduced, and there is a move towards more electronic filing and better online information.

These similarities have led to an agreement to draw up a list of common benchmarks so that the performance on issues such as timescales for registration or the introduction of teleworking, for example, can be compared.

The harmonization of trade mark classifications is also moving forward. There is currently a common classification database with 7 000 terms in it. This is only a fraction of the number needed if businesses are to have confidence that a classification agreed with the US or Japanese offices will be accepted by OHIM, and vice versa. Work is continuing to expand the database by adding new terms on a monthly basis.

"We are making progress, perhaps not as fast as some would like, but here at OHIM we are trying to focus on the most frequently-used terms, and also on seeing if we can expand the international acceptance of the common list. For the moment we are three, but Australia and Canada are also showing a lot of interest", says de Boer.

The James Nurton interview with Lone Prehn, Partner and European Trade Mark Attorney, Zacco, Denmark

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.

How long have you been working in trade marks?

I have been working in trade marks since 1990. I started with a relatively small company called Lehmann & Ree, which merged with Hofman-Bang & Boutard, which then merged with Stockholms Patenbyrå and Bryns Patentkontor to become Zacco. I became a partner in 1999. I also work as an attorney-at-law in our corresponding law firm Zacco Attorneys and I am a member of the Board of the Danish Patent Agents Society, a WIPO panellist, a panellist with the Danish dispute resolution board and the Czech Arbitration Court.

What first appealed to you about working in trade marks?

The creativity of this specific area of law. I've always been interested in languages – and comparing words and the knowledge and meaning of words. That tickles me and I enjoy it. It never gets dull! In my 17 years in the business, no two days have been alike. It is in constant development.



What sort of clients do you have?

We have a range, from big clients such as Lego and Nestlé to smaller Danish clients. They all have different types of questions and different approaches.

How many CTMs do you file?

In our Denmark office, this year until now we have filed about 150 Community trade mark and about 70 Community design applications. I am not sure how many were filed by our sister companies. About 50 out of the 150 were EU designations of international applications.

What works well about the CTM?

Everything! It may sound more intellectual to be critical but I must say that we are very satisfied users. The system is parallel in many ways to the practice in Denmark. We've been pleased with the working from the start. I think it's fantastic that it's been such a success.

What could be improved?

There are not many things but the opposition decisions could be quicker. That is the biggest thing. Another point is that when we designate the EU in the Madrid Protocol, if an opposition is filed, the opposition is sent to the applicant and not the representative. That is a nuisance as the applicant may get confused or think they have done something wrong.

Another thing is that it is difficult to get an extension of terms: you need a very good explanation. And finally in opposition proceedings where the other party requests proof of use, you have to waste time and money to do that when it is not always necessary. For example, we had a case with the famous PRINCE cigarettes where we used a lot of time and money to prove that the trade mark is in use. We would have liked the opposition division to rule at an early point that it is in use.

We very much welcome the changes to make the search reports optional. At the moment you receive a rainforest every time you have a search report and it is useless.

What do you think about the use requirements?

Now that 27 countries are covered by one registration and you can just fulfil the use requirement in, say, Malta it becomes increasingly difficult to clear marks.

As it is relatively easy to file an application, there are lots of CTMs filed, which might make it difficult for applicants seeking protection. So we have to work out coexistence agreements and so on, for example when we try to settle opposition proceedings amicably.

Do you file many non-traditional marks?

No, not really. They are not very typical; this is not what our clients normally do. But it's interesting and funny and a challenge when they do come up.

Do you use electronic services?

We use electronic filing, electronic renewal and electronic opposition. But we don't use MYPAGE as it wasn't practical for us. We have a department that receives mail and orders it so we still prefer to receive mail from OHIM by fax. The reason is we don't want to have to check lots of websites every day to see who is sending us mail. It is not as user-friendly as receiving it on a plate. If we found a way that would be more practical that would be fine.

Do you find it easy to have contact with examiners?

They're very open. A delegation of IP assistants have just been visiting Alicante and were given direct numbers of Danish examiners working there. You can always reach them – except during the siesta!

What are the biggest challenges for practitioners?

It's a challenge for us to keep abreast of recent practice. We need to know what is the current practice – so we consult resources such as Alicante News, the ECTA News, Darts-IP, online blogs and so on. It's of vital importance. The OHIM Guidelines are also very valuable for that, but it's a shame that EURONICE is not being updated anymore. We are looking forward to EUROREGISTER being on its way.

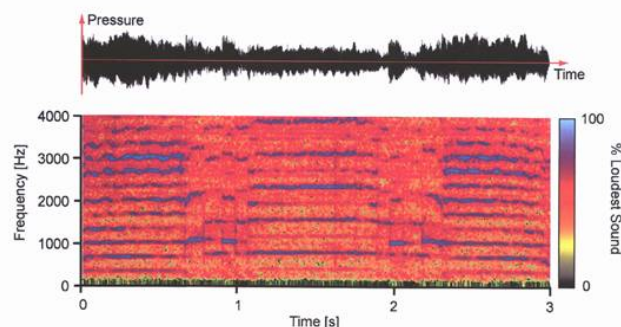
An issue that has yet to be tested is seniority claims. We haven't really seen yet whether we can rely on letting them lapse. We are recommending that clients have the seniority recorded and let the national applications lapse. A lot of rights are not being renewed now, which is of course one of the values of the CTM, but we don't have any decisions on this practice yet.

Community Trade Mark Tarzan's trade mark yell

We all know that Tarzan of the Apes, the character created by US novelist Edgar Rice Burroughs, has a distinctive call – at least in the film versions of the story.

Over the years, OHIM has received three applications to register this call – made famous by US film star Johnny Weissmuller – as a Community Trade Mark.

The first application, in February 2004, included a graphic representation of the call. This was refused by OHIM examiners on the grounds that it did not comply with the requirement that the graphic representation of the mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective and concise. OHIM's independent Boards of Appeal confirmed the objection of the examiner on its [decision 27 September, 2007](#).



- Application for a sonogram now refused by the Boards of Appeal

However, a second application for a musical notation, also made in February 2004, was accepted for registration as it complied with the above formalities and the "yell" which it described was judged to be distinctive.



- Application for a musical notation

In addition, a third application, made in May 2006, combining a sonogram with an MP3 sound file is currently going through the registration process. It has been published so that interested parties have a chance to decide whether or not to object. This has been made possible by a change in legislation in 2005, which means that the Office is able to accept sonograms provided they are accompanied, at the time of the filing, by an MP3 sound file.

The refusal of the original 2004 application has generated intense media interest. Can sounds be trade marks? The answer is clearly yes. In fact, over the past ten years OHIM has registered around 40 sound marks.

OHIM trade mark lawyer Wouter Verburg says: "We are getting increasing interest in this area – everything from Tarzan's call to a lion's roar. If they comply with the formalities and are distinctive they can be registered, and we now accept MP3 files as part of this process, provided they are filed together with the sonogram. As technology moves on we have moved too."

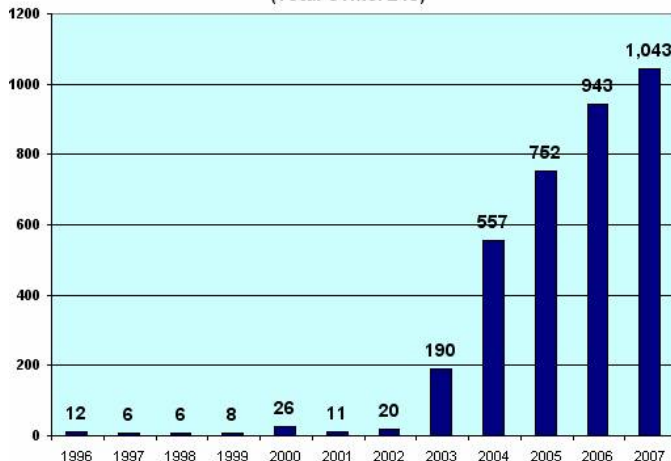
Country Overview: Poland & the Community Trade Mark



Poland joined the EU in May 2004, and has a population of 38m. Economic performance has been strong over the past year with GDP 6.9% higher in the second quarter compared with the same period in 2006. The service sector accounts for almost 64% of GDP followed by industry (32%) and agriculture (4.5%).

Since 1996, Poland has filed a total of 3 574 CTMs, with the numbers filed annually rising steadily year on year. A record total of 1 043 have been filed already in 2007.

POLAND - CTM Filing Evolution
(Total CTMs: 248)

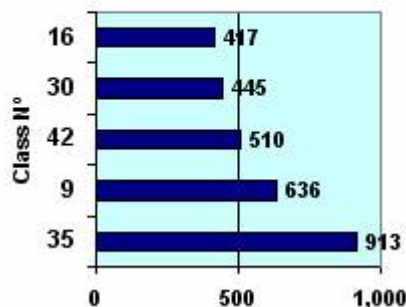


Word	Figurative	3-D	Colour	Other
61.56%	36.60%	1.14%	0.14%	0.22%

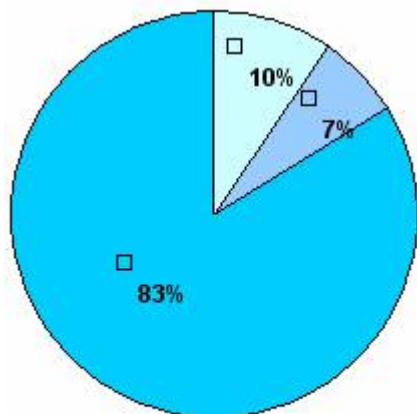
More than 60% of trade mark applications by Polish enterprises are for word-based marks, with almost all the remainder figurative marks (37%).

The most popular goods and services applied for by Polish businesses are in classes 35, 9 and 42.

POLAND - Top Classes Filed
(Nice)



E-filing is by far the most popular route for Polish businesses and their intermediaries. This year, including International Registrations, 83% of all CTM filings were made electronically, while fax accounted for 7%.



□ Mail □ Fax ■ Electronic

Top 10 Poland -based owners by number of CTMs filed

Company	CTMs
KAMIS-PRZYPRawy S.A.	32
Gielda Papierów Wartościowych w Warszawie S.A.	29
TYMBARK S.A.	29
ASA Sp. z o.o.	25
Nepentes Sp. z o.o.	21
V&S Luksusowa Zielona Góra S.A.	21
XL Energy Marketing Sp. z o.o.	20
AGROS NOVA Sp. z o.o.	19
Pol-Nil S.A.	19
Agencja Wydawnicza 'Technopol' Spółka z ograniczoną odpowiedzialnością	18

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

Representative	CTMs
KANCELARIA PATENTOWA 'PROPERTY' TOMASZEWSKA I SYN	109
Rumpel	68
KANCELARIA PATENTOWA PATENTBOX S.C. ROMUALD SUSZCZEWICZ, PIOTR SUSZCZEWICZ	63
DRESZER GREEDA & PARTNERS SP.J. PATENT-SERVICE KANCELARIA	54
POLSERVICE PATENT AND TRADEMARK ATTORNEYS OFFICE	52
JAN WIERZCHOŃ & PARTNERZY, BIURO PATENTÓW I ZNAKÓW TOWAROWYCH SP. J.	49
KANCELARIA PATENTOWA DR W. TABOR SP.J.	49
KANCELARIA PATENTOWA CHRYSYAN PRZYBYLSKI	48
Kulikowska	48

Community Design

Invalidity claims at Community design courts

While most RCD invalidity claims are dealt with by OHIM directly, using its powers under the Community design regulation, the validity of registrations can also be challenged before a competent Community design court.

When this happens, the competent court is bound to inform the Office of the date on which the counterclaim has been filed, and the Office must record this fact in the register of Community designs (Article 86(2) CDR).

Until now, it seems that few courts have been active in hearing invalidity counterclaims, with only 32 notifications issued, the majority by the Spanish courts based in Alicante.

Since the Register of Community designs is centralised at OHIM, any decision affecting the validity of its registered designs must be reflected there, particularly if a court judgment declares the RCD invalid.

The importance of the user community having access to judgments and decisions from courts dealing with both registered Community trade marks and designs was underlined at a recent symposium for trade mark and design judges held in Alicante and hosted by OHIM.

For more details see [Community design courts and invalidity counterclaims: first experiences](#).

International enforcement of RCDs: the Procter and Gamble saga

Procter & Gamble has undertaken legal action to enforce its Registered Community Design ("RCD") 000097969-0001 in different jurisdictions under the Community designs Regulation ("CDR").



P&G sued **Reckitt Benckiser** alleging that Reckitt's "Air Wick Odour Stop" sprayer infringed its design.



Alicante News reported early in the year that different decisions had been or were about to be taken. While P&G acted as plaintiff in all cases, the defendant was, in each jurisdiction, the local Reckitt subsidiary. Most decisions were the result of the plaintiff's request for provisional measures to stop the defendant from further marketing.

The situation has moved with the final decision of the Austrian **Oberste Gerichtshof** (Supreme Court) on **22/05/07** and the judgment by the **UK Court of Appeal** on **10/10/07**. Both found that Reckitt's sprayer did not infringe P&G's design. However, other courts reached different decisions in this saga.

Decisions in favour of P&G

In France, P&G obtained on **05/04/06** an injunction (ordonnance de référé) from the **Tribunal de commerce d'Evry**, since the differences between both designs were insignificant for the "informed consumer", compared to the similarities between them. The **Cour d'appel de Paris** partially confirmed the decision on **17/01/07** since Reckitt's model reproduces the essential elements of P&G's. Only an attentive examination allows some differences to be perceived. The fact that an action was filed in the UK on the merits was found not to be an obstacle for the French injunction.

In Germany, the 8th civil chamber of the **Landgericht Hamburg** (Hamburg Regional court) ordered an interim injunction on **28/04/06**, confirmed on **12/07/06**. In Belgium, the President of the **Rechtbank van eerste aanleg te Brussel** (Brussels Tribunal of First Instance), adopted on **11/05/06** interim measures to stop the defendant. The order was later confirmed (**10/11/06**).

On **13/07/06**, the **Tribunale de Milano** stopped the marketing of Reckitt's sprayer. It found that P&G's design was partially reproduced by Reckitt in the most significant elements.

Decisions in favour of Reckitt

The **Oberste Gerichtshof** settled the "P&G" saga in Austria some months before the British decision. It confirmed the

decision by the **Oberlandesgerichts Wien**. The following are some of the highlights of the judgment:

- regarding the requirements for protection under Article 4 (1) CDR, a complete compliance of the elements of the two designs is irrelevant for the fulfillment of the requirement of **individual character**, so that the **overall impression** of the designs and not their elements as such is crucial.
- the **scope of protection** is greater for designs with a high degree of individual character and is less for those that are less "individual". This inverse relationship means that the questions should be handled using the same criteria.
- as regards the **informed user**, the evaluation should be carried out primarily from the perspective of the target group, toward which the design has an impact.

The Supreme Court of Austria ruled that a different overall impression was produced.

The judgment of the UK **Court of Appeal** has been wrongly reported to be the first judgment of an appellate court of the EU in full proceedings related to RCD. This is so in the UK, but not in the EU. Spain's **Tribunal de Marca Comunitaria**, the appellate court in Alicante, ruled on **25/04/06** in the case **Panini España SA v. Kellogg's España SL**.

The UK Court of Appeal found that Reckitt's design did not infringe the RCD. It found that:

- the **informed user** is not quite the same sort of person as the "person skilled in the art" of patent law. For purposes of registrability, the notional informed user is to be taken as aware of other similar designs which form part of the "design corpus".
- the term "clearly" appearing in Recital 14th CDR does not apply to the infringement test. This meant that since Article 10(1) CDR refers to a "**different overall impression**", this does not mean "clearly different". Different policy considerations exist in the tests referring to "individual character" and "scope of protection".
- the **informed user** is not the same as the "average consumer" of trade mark law. The informed user is more discriminating. While the High Court based its judgment on the so-called "imperfect recollection" test, the Court of Appeal disagreed.
- smaller differences will be enough to create a different overall impression where **freedom of design** is limited. In this respect, the degree of freedom is not that of a particular party but the degree of choice of a designer in creating his design.
- the **test of infringement** ("overall impression") is inherently rather imprecise, while you need to cover not

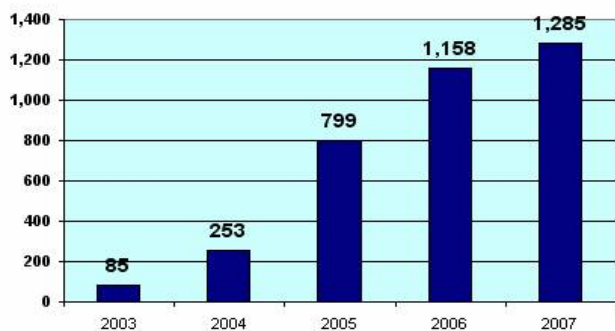
only exact imitations but also things which come "too close".

Country Overview: Poland & the Registered Community Design

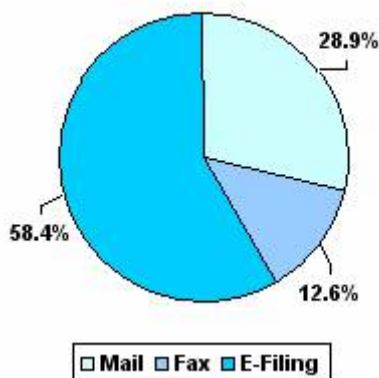
Polish filings of RCDs took off in 2004 after entry into the EU and have grown rapidly year on year. This year is set to be another record, with filings already topping 1,285.

The most popular classes for Polish design owners are 6, 25, and 9. In common with other countries, there has been a big move to using the Internet to transact business, and this year e-filing accounts for over 58% of Polish RCDs. Mail, at 29%, is the second most popular route, and just under 13% of applications come by fax.

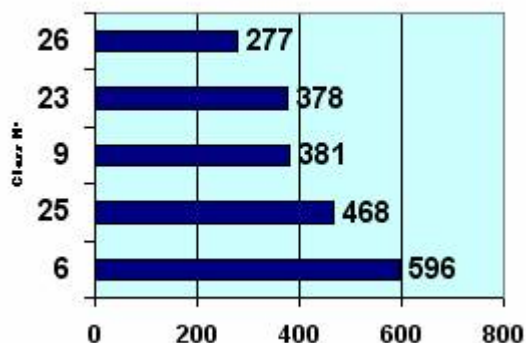
POLAND - RCD Filing Evolution



POLAND - Filing Preferences



POLAND - Top Classes Filed (Locarno)



Top 10 Poland-based owners by number of RCDs filed

Owner	RCDs
Fabryka Dywanów 'Agnella' S.A.	129
ALURON Sp. z o. o.	123
SKOFF Sp. z o.o.	101
Mebelplast S.A.	67
Sanitec Ko ^o Sp. z o.o.	51
KORONA S.A.	54
TYMBARK S.A.	54
European Trading and Distribution Sp. z o.o.	48
VALVEX S.A.	47
Hager Polo Produkcja Sp. z o.o.	45

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

Representative	RCDs
Błaszczuk	159
KANCELARIA RZECZNIKA PATENTOWEGO ANDRZEJ RYGIEL	141
PATENT-SERVICE KANCELARIA	107
KANCELARIA PATENTOWA ROMAN SZYMAŃSKI	99
KANCELARIA PATENTOWA KLAR MIROSŁAW	90
KANCELARIA PATENTOWA PIOTR JANKOWSKI	84
KANCELARIA PATENTOWA PATENTBOX S.C. ROMUALD SUSZCZEWICZ, PIOTR SUSZCZEWICZ	65
Hubisz	62
Rumpel	60
Bocheńska	58



Case-law

LATEST TRADE MARK AND DESIGN NEWS FROM LUXEMBOURG

Index

ECJ Judgements and Orders CFI Pending Cases

Playing cards or Naipes: C-311/05-P
 Figurative Tabs (red/white): C-144/06-P
 Quicky: C-193/06-P

ECJ Judgements: Pending cases
 Nasdaq:C-320/07-P (appeal from T-47/06)

ECJ Preliminary Rulings: Pending cases
 Fincas Tarragona : C-328/06 Statement A.G.
 Pago, C-301/07 – Office contribution

CFI Judgements and Orders
 Omega3/Puleva: T-28/05
 WinDVD Creator: T-105/06
 Loudspeaker Bang & Olufson: T-460/05
 Vogue Portugal: T-481/04
 La Mer: T-418/03
 Pure Digital: T-461/04
 Reckitt Benckiser Tabs: T-02, T-03, T-49/05 etc.
 Encuanta: T-49/06

Brillo's : T-275/07
 Gerovital Aslan : T-163/07
 USA Track & Field : T-103/07
 Light & Space : T-224/07
 222-333-555: T-200/07; T-201/07; T-202/07
 Aprile: T-179/07
 Flugbörse: T-189/07
 Pranahaus: T-226/07
 Tequila Sombrero Negro : T-182/07
 Vantage/Multivantage: T-171/07
 Payless ShoeSource: T-173/07
 TDI : T-174/07
 Motown: T-143/07
 Dream it: T-186/07
 Wristwatch/Position Mark Lange Uhr: T-186/07
 Bomba/La Bamba: T-372/06
 Visible White : T-136/07
 PPT/ PPTV : T-118/07
 Madridexporta: T-180/07

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

Playing cards or Naipes: Judgement of 4 October 2007; appeal from T-160/02, T-161/02 and T-162/02 (only in FR, ES; appeal dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: characteristics of playing cards, for playing cards (negative).

The case is an appeal from the aforementioned three decisions of the CFI of 11. 5. 2005, Naipes v OHIM = ECR II-1643. In these decisions, the CFI had confirmed three invalidation decisions by the 2nd Board directed against three Community trade marks where each had consisted of a characteristic symbol of a playing card, in the Spanish pack, for playing cards.



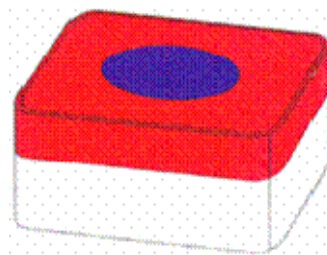
In its decisions R 0771, R 0770 and R 0766/2000-2, the Board had held that the signs at issue would lack distinctiveness for playing cards, and in respect of the fact that two of them (knight and king) formed part of the Spanish pack which is in constant use in Spain, that these signs were descriptive within Article 7(1)(c) CTMR. The 2nd Chamber of the ECJ (Timmermans; Schiemann; Makarczyk, rapporteur; Bay Larsen; Toader) agreed.

Figurative Tabs red/white: C-144/06-P – Judgement of 4 October 2007 (appeal from

T-398/04; dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: figurative representation of the product as such.

By its appeal, plaintiff (Henkel KGaA) had sought to have set aside the judgement of the CFI of 17 January 2006 in case T-398/04 Henkel v OHIM, not reported in the ECR, dismissing its action for annulment of the decision of the 2nd Board of 4 August 2004. In all of the said decisions, the application, as a CTM, for the sign set out below had been rejected on the basis of Article 7(1)(b) CTMR.



The figurative representation of a washing tablet (not a 3D sign) had been applied for in classes 1, 3 and 21. The 8th Chamber of the ECJ (Juhász, rapporteur; Malenovsky; Danwitz) confirmed the rejection relying on established criteria developed in the area of washing tablets.

Quicky: C-193/06-P - Judgement of 20 September 2007 (only in FR; appeal allowed; CFI judgement in T-74/04 revoked; law of the case).



Keywords: Opposition: likelihood of confusion (LOC). – LOC: comparison of marks. – Comparison of marks: scope of the visual test.

The initial decision had been taken by the 2nd Board on 17. 12. 2003 in R 0922/2001-2 by which the Board had allowed an opposition against a CTM application filed by Nestle SA (fig.; Rabbit Quicky) which had been applied for a range of goods in classes 29, 30 and 32. It had been opposed on the basis of two earlier rights in the word marks Quick and Quickies, registered in classes 29, 30 and 42. The CFI had confirmed the decision in T-74/04 (not published).



As regards weighing of the figurative element in the CTM application against the word part, the 3rd Chamber of the ECJ (Rosas; Cunha Rodriguez; Löhmus; Ó Caoimh, rapporteur, and Arabadjiev) requested a more detailed approach, revoked the CFI decision and remitted the case back.

A-2: ECJ: Developments in pending cases

Nasdaq: C-320/07-P - Appeal from T-47/06; Office contribution filed.

Keywords: Opposition: mark with a reputation. – Reputation mark: risk of dilution.

The action is an appeal from a CFI judgement handed down on 10. 5. 2007 in T-47/06. The case concerns CTM application “nasdaq” (fig; as shown below) which had been applied for a range of goods in classes 9, 12, 14, 25 and 28, namely: Protective helmets for sports, cycling, motorcycling, motor racing, skiing, protective goggles for sports and pads for protecting body and limbs against accidents for personal use, time recording apparatus in class 9; vehicles, in particular bicycles and mountain bikes in class 12; clocks, chronometers, sports chronometers in class 14; clothing, in particular sportswear, clothing for gymnastics, ski boots and après-ski boots, sports shoes in general in class 25, and for skis, ski poles, anti-vibration plates for skis, snowboards, boards for surfing on snow and on water, ski bindings and ski wax, stationary exercise bicycles, gymnasium equipment and apparatus in class 28.



It had been opposed on the basis of the word mark Nasdaq registered for: Computer programs amongst others in the field of the analysis of securities prices; stock exchange, finance; computer apparatus, in particular closed circuit apparatus for the generation and the dissemination of securities information as well as closed circuit CRT terminals for use therewith as well as computer programs for the access to securities information in class 9; documentation and manuals related to computer programs and computer apparatus in class 16; stock exchange price quotation services; listings of securities for quotations for sale or information purposes in class 35; financial services, amongst others, providing and updating an index of security values, securities, fixed incomes (such as bonds) and derivative products (such as options, warrants and swaps); as well as classification, analysis and reporting thereof in class 36; telecommunication services, amongst others electronic transmission of messages and data related to securities in class 38, and for computerized securities information and retrieval services, being general computer services in class 42.

The Board had allowed the opposition based on Article 8(5) CTMR on the grounds that the earlier mark is famous in the European Union and that there would be a risk of dilution if the marks at issue co-existed on European markets.

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

None

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

Fincas Tarragona: C-328/06 – Statement of the Advocate General of 13 September 2007 (not available in EN).

Keywords: Well-known marks within Article 6bis Paris Convention. – Well-known mark: territorial scope. – Article 4 Trade Marks Directive 89/104. – Marks with local recognition: Article 6 TM Directive 89/104. - Article 16 Trips.

The case is a reference from the Juzgado Mercantil 3 de Barcelona in an infringement action initiated by Mr. Nuno who holds Spanish trade mark Fincas Tarragona for real estate services, against Mr. Monleó Franquet, of Tarragona, a real estate agent. The latter brought a counter claim for cancellation on the grounds that he would own an earlier right in the mark “Fincas Tarragona” since he is trading under that sign, in the said area of business, since 1978. He further claimed that the sign would be well-known in the region of Tarragona. The referring judge had asked the ECJ whether the respective wording of Article 4 TM Directive 89/104 (well-known “in” a Member State) would also apply to a region or a city. Advocate General Paolo Mengozzi suggested answering in the affirmative (“also applicable in a territorially restricted manner”).



Pago: C-301/07 - Office contribution filed (internal document).

Keywords: CTM infringement: Article 9(1)(c) CTMR. – Reputation of a CTM: territorial scope.

The questions referred to the ECJ under Article 234 EC by the Austrian Oberster Gerichtshof had been raised in the context of infringement proceedings between Pago International GmbH and Tirolmilch registrierte Genossenschaft mbH, on appeal from the Oberlandesgericht Wien, which had been seized of the case on appeal from Handelsgericht Wien. Pago is the proprietor of a figurative CTM, registered inter alia for fruit drinks and fruit juices. An element of the mark is the representation of a green glass bottle with a distinctive label and lid. Next to the bottle, a glass with fruit juice, adorned with the same label, is depicted.

The referring Court explains that due to the use of such bottles over a number of years, the trade mark is widely known in Austria. Tirolmilch has been marketing for a number of years in Austria a fruit and whey drink called “Lattella”. While initially sold in cartons, the drink is now being packaged in glass bottles which resemble in several respects the one depicted in Pago’s CTM. Moreover, in the advertising for its drink, Tirolmilch shows a bottle next to a full glass. According to the referring Court, there is however no likelihood of confusion since the bottle labels used by the parties bear different names which are both widely known in Austria. Pago seeks an injunction prohibiting Tirolmilch from promoting, offering for sale, marketing or otherwise using its drink in the bottles at issue and advertising a representation of the bottles together with a full glass of fruit juice. It claims that Tirolmilch uses without due course, and takes unfair advantage of, the distinctive character and the repute of the Community trade mark which has a reputation in Austria (Article 9(1)(c) CTMR). Tirolmilch contends that the application for protective measures must be rejected because Pago’s Community mark has a reputation only in Austria and not in a “substantial part” of the Community. By order dated 12 June 2007, the referring Court decided to stay the main proceedings and referred to the Court of Justice the following questions:

- Is a Community trade mark protected in the whole of the Community as a “trade mark with a reputation” for the purposes of Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark if it has a “reputation” only in one Member State ?
- If the answer to the first question is in the negative: is a mark which has a “reputation” only in one Member State protected in that Member State under Article 9(1)(c) of Regulation 40/94, so that a prohibition limited to that Member State may be issued?

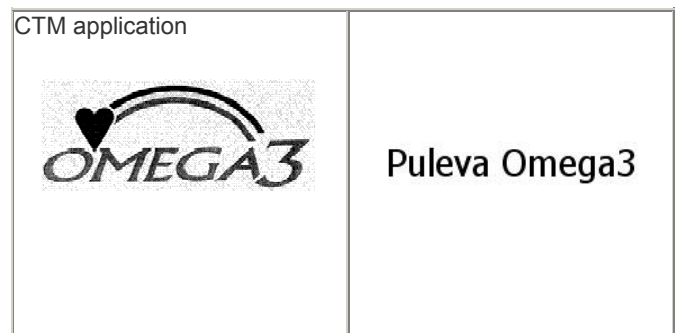
C:CFI Court of First Instance (CFI): Judgments and Orders on appeals against decisions of the OHIM, Article 63 CTMR

C-1: CFI Judgments and Orders

Omega 3/Puleva: T-28/05 – Judgement of 18 October 2007 (only in FR; action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 6. 10. 2004 in R 0117/2001-4 relating to CTM application “Omega 3” (fig; coloured), applied for in class 29 for margarine. It had been opposed on the basis of the earlier Spanish mark “Puleva Omega3”, word combination, registered in class 29.



The CTM application had been rejected on the grounds that because of the similarity of the goods and marks at issue there would be a risk of confusion on the Spanish market. The 5th Chamber of the CFI (Vilaras, Dehousse; Sváby) confirmed these findings.

WinDVD Creator: T-105/06 – Judgement of 17 October 2007 (action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: requirement of *ex officio* examination; limitations. – Absolute grounds for refusal: distinctiveness.

The action had been directed against a decision of the 2nd Board of 31. 1. 2006 in R 0987/2005-2 relating to the CTM application shown below which had been applied for a range of goods in class 9, namely: Computer software for use in downloading, transmitting, receiving, extracting, encoding, decoding, playing, storing and organising audio, video, text and other data via local and global computer, cable and wireless networks.

WinDVD Creator

The application had been rejected on the grounds that the sign at issue is devoid of distinctive character for the goods at



issue because it is descriptive. The 3rd Chamber of the CFI (Jaeger; Tiili; Czúcz) confirmed these findings.

(a) Ex officio examination of absolute grounds for refusal

“(41) It must be recalled that, under Article 74(1) of Regulation No 40/94, OHIM examiners and, on appeal, the Boards of Appeal of OHIM are required to examine the facts of their own motion in order to determine whether the mark registration of which is sought falls under one of the grounds for refusal of registration laid down in Article 7 of that regulation. It follows that the competent bodies of OHIM may be led to base their decisions on facts which have not been alleged by the applicant for the mark (Case C-25/05 P Storck v OHIM [2006] ECR I-5719, paragraph 50). – (42) Whilst it is in principle the task of those bodies to establish in their decisions the accuracy of such facts, such is not the case where they allege facts which are well known. An applicant for a trade mark against whom OHIM relies on such well-known facts may challenge their accuracy before the Court of First Instance (Storck v OHIM, paragraphs 51 and 52).

“(43) Accordingly, it is necessary to examine whether the Board of Appeal was right to hold that it was common knowledge that the average consumer would associate the word ‘win’ with the operating system Windows. 44 It is common ground that Windows, the operating system of Microsoft Corporation, is commonly used in the information technology field by average personal computer users. There is no doubt that among those personal computer users, including even those who use a computer for their personal or professional activities on a daily basis, there are many who are unfamiliar with both the technical details of the functioning of the Windows operating system and information technology language in general. Although it is true that not all personal computer users have such specific knowledge in the field, the word ‘win’ where it appears in relation to computers, and in particular software, will automatically and immediately be understood by the majority as an abbreviation or a shortened reference to Windows. Thus, an average personal computer user will be led to believe that the word ‘win’ refers to the Windows system in the context of information technology.”

(b) Relevant public and basic considerations as regards the sign at issue

“(30) Therefore, the relevant public consists of average consumers who are members of the general public, as any consumer may be interested in purchasing the goods concerned. Furthermore, according to Article 7(2) of Regulation No 40/94, paragraph 1 is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community. Thus, the relevant public, with respect to which the absolute ground for refusal should be assessed, is English-speaking average consumers, since the sign at issue is composed of elements of the English language. 31 Account must also be taken of the fact that the level of awareness of the relevant public in the field of computer goods is relatively high in relation to signs, and in particular marks, likely to indicate a commercial origin guaranteeing the compatibility of the goods purchased with their computing equipment (see, to that effect, Case T-130/01 Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS) [2002] ECR II-5179, paragraph 24). – (32) According to the case-law, for a sign to

be caught by the prohibition in Article 7(1)(c) of Regulation No 40/94 there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (PAPERLAB, paragraph 25).

“(33) Furthermore, if a mark which consists of a neologism or a word produced by a combination of elements is to be regarded as descriptive for the purpose of Article 7(1)(c) of Regulation No 40/94, it is not sufficient that each of its components may be found to be descriptive. The word or neologism itself must also be found to be so (see Joined Cases T-367/02 to T-369/02 Wieland-Werke v OHIM (SnTEM, SnPUR, SnMIX) [2005] ECR II-47, paragraph 31, and the case-law cited). 34 In addition, a sign consisting of a neologism or of a word composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive of the characteristics of those goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts. That assumes that, because of the unusual nature of the combination in relation to the goods or services, the neologism or word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (see SnTEM, SnPUR, SnMIX, paragraph 32, and the case-law cited). In that connection, the analysis of the term in question in the light of the appropriate lexical and grammatical rules is also relevant (see, to that effect, Case T-222/02 HERON Robotunits v OHIM (ROBOTUNITS) [2003] ECR II-4995, paragraph 39, and Case T-173/03 Geddes v OHIM (NURSERYROOM) [2004] ECR II-4165, paragraph 21).”

Loudspeaker Bang&Olufson : T-460/05 - Judgement of 10 October 2007 (action allowed; the judgement may lead to a more detailed and individual approach to 3D signs).

Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: 3D signs. – 3D signs/technical goods: relevant public. – 3D signs: shape of the product itself. – Shape of the product: specific requirements as regards distinctiveness.

The action had been directed against a decision of the 1st Board of 22. 9. 2005 in R 0497/2005-1 relating to a 3D CTM application, the shape of a loudspeaker. It had been applied for a range of goods in class 9: Electric and electronic apparatus and appliances for analogue, digital or optical reception, processing, reproduction, regulation or distribution of sound signals, loudspeakers, and in class 20: Music furniture.



Whereas the Board had rejected it relying on standard criteria, the 3rd Chamber of the CFI (Jaeger; Tiili; Czúcz) demanded a more individual assessment.

(a) Relevant public

“(29) In this case, the goods covered by the mark applied for are electric and electronic apparatus and appliances for analogue, digital or optical reception, processing, reproduction, regulation or distribution of sound signals, loudspeakers and music furniture. It must therefore be considered that the relevant public is made up of all average Community consumers, given that any consumer may be interested in purchasing the goods in question. 30 The applicant takes the view, however, that the relevant public is a restricted public with a higher level of attention than that of average consumers since the goods in question are top-of-the-range, high-value products within the electronics market which are marketed exclusively through a selective distribution system. 31 It must be stated, however, that in determining the relevant public account cannot be taken of the way the applicant uses a distribution system or of other circumstances of no consequence to the right conferred by the Community trade mark. For the purposes of assessing the distinctiveness of a sign, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing method is immaterial. Since a marketing method is purely a matter of choice for the undertaking concerned, it may change after the Community trade mark has been registered and cannot therefore have any bearing on the assessment of the sign’s registrability (see, to that effect, Case T-355/00 DaimlerChrysler v OHIM (TELE AID) [2002] ECR II-1939, paragraph 42, and Case T-15/05 De Waele v OHIM (Shape of a sausage) [2006] ECR II-1511, paragraphs 28 and 29). According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T-110/02 Axions and Belce v OHIM (Brown cigar shape and gold ingot shape) [2003] ECR II-1897, paragraph 36).

“(32) However, the level of attention of the relevant public is likely to vary according to the category of goods or services in question (Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26, and Case T-305/02 Nestlé Waters France v OHIM (Shape of a bottle) [2003] ECR II-5207, paragraph 34). – (33) As regards everyday consumer goods, the average consumer’s level of attention is less than that

paid to durable goods or, simply, goods of a higher value or for more exceptional use. 34 In this case, it must be borne in mind that, in the light of the nature of the goods concerned, in particular, their durable and technological nature, the average consumer displays a particularly high level of attention when purchasing such goods. The objective characteristics of the goods in question mean that the average consumer purchases them only after a particularly careful examination.”

(b) Assessment of distinctiveness

“(35) Accordingly, the distinctive character of the trade mark must be assessed in relation to the perception of the average consumer who exhibits a particularly high level of attention when he prepares and makes his choice between different goods in the category concerned (see, to that effect, Case C-361/04 P Ruiz-Picasso and Others v OHIM [2006] ECR I-643, paragraph 40 and 41). – (36) So far as concerns the examination of distinctive character, according to case-law, the criteria for assessing the distinctive character of marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark (see Case C-24/05 P Storck v OHIM [2006] ECR I-5677, paragraph 24, and the case-law cited). 37 None the less, for the purpose of applying those criteria, the relevant public’s perception is not necessarily the same in the case of a three-dimensional mark, which consists of the appearance of the product itself, as it is in the case of a word or figurative mark, which consists of a sign unrelated to the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see Case C-136/02 P Mag Instrument v OHIM [2004] ECR I-9165, paragraph 30; Case C-173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551, paragraph 28, and Case C-24/05 P Storck v OHIM, paragraph 25.)

“(38) In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (Mag Instrument v OHIM, paragraph 31, and Case C-25/05 P Storck v OHIM, paragraph 28).

“(39) In the present case, as the Board of Appeal stated in paragraph 12 of the contested decision, the mark applied for is ‘a vertical, pencil-shaped column, with a long, rectangular panel attached to one side. The point of the “pencil” joins to a flat base.’ – (40) The examination of all the presentational features referred to above which make up the mark applied for leads to the conclusion that the shape of the mark is truly specific and cannot be considered to be altogether common. Thus the body of the loudspeaker is formed of a cone which looks like a pencil or an organ pipe the pointed end of which joins to a square base. In addition, a long rectangular panel is fixed to one side of that cone and heightens the impression that the weight of the whole rests only on the point which barely touches the square base. In that way, the whole creates a striking design which is remembered easily.



“(41) All those features distance the trade mark applied for from the customary shapes of the goods falling within the same category which are commonly found in trade and generally have straight lines with right angles. In that respect, it is indeed stated in paragraph 14 of the contested decision that ‘there is [no] doubt that the mark applied for is striking in some aspects.’ It is then specified: ‘...compared to a normal loudspeaker, it is inordinately tall and narrow. Furthermore, the core of the speaker is, unusually, a tube, which joins to an inverted cone. The apex of the cone is attached to a square base.’ 42 Accordingly, the mark applied for departs significantly from the customs of the sector. It has characteristics which are sufficiently specific and arbitrary to retain the attention of average consumers and enable them to be made aware of the shape of the applicant’s goods. Thus this is not one of the customary shapes of the goods in the sector concerned or even a mere variant of those shapes, but a shape having a particular appearance which, having regard also to the aesthetic result of the whole, is such as to retain the attention of the public concerned and enable it to distinguish the goods covered by the trade mark application from those of another commercial origin (see, to that effect, Case T-128/01 DaimlerChrysler v OHIM [2003] ECR II-701, paragraphs 46 and 48, and Shape of a bottle, paragraph 41). – (43) Even if the existence of specific or original characteristics does not constitute an essential condition for registration, the fact remains that their presence may, on the other hand, confer the required degree of distinctiveness on a trade mark which would not otherwise have it.”

Vogue Portugal: T-481/04 - Judgement of 4 October 2007; action allowed. The case related to old Office practice, i.e. well before ECJ in *Arcol/Capol* caused a change (ECJ judgement of 13 March 2007, C-29/05-P = OHIM v Kaul; not yet published in ECR); the present CFI decision, thus, does not generate a new legal situation.

Keywords: Board proceedings: scope of required examination; Article 74(2) CTMR. - Board proceedings: facts raised for the first time at the appeal stage. - Opposition: earlier right. - Earlier right: whether earlier where the CTM applicant holds a national trade mark predating the invoked right. - Opposition: likelihood of confusion (LOC). - LOC: whether LOC in the case of co-existence (> 30 years) of two identical marks at the national level. - Opposition/co-existence of marks at the national level: argument of *exceptio doli* (unclean hands). - Opposition: proof of use (POU).

The action had been directed against a decision of the 2nd Board of 27. 9. 2004 in R 0328/2003-2 relating to CTM application *Vogue* (word) which had been applied for a range of goods and services in class 9: Software; CD-ROM; video and audio cassettes; electronic, optical and digital publications; optical apparatus and products including eyewear – glasses and sunglasses; class 14: Jewellery and horological instruments; class 16: Printed matter (magazines, newsletters and books; computer programmes); paper (posters, paper patterns); class 25: Clothing, and in class 41: Electronic information and entertainment services accessible through global or non-global computer networks. - It had been opposed based on the trade mark “*Vogue Portugal*” (word) registered in class 25 for footwear since 1967, and on the

trade name “*Vogue Sapantaria*”, used on the market, for footwear.

The opposition had been allowed by the opposition group concerned. At the appeal stage, the CTM applicant had argued that it would hold an international registration of 3 December 1951, with effect in Portugal, covering class 25 goods. The Madrid part of 1951 would in any event be earlier in Portugal than the invoked rights. In fact, the said rights have co-existed for some 30 years. The Board dismissed the appeal on the grounds that the arguments concerned had not been presented before the opposition group. The 3rd Chamber of the CFI (Jaeger; Tiili; Czúcz) allowed the appeal, relying on the *Arcol/Capol* doctrine:

“(19) In the present case, the Board of Appeal stated that, while it might be admissible in appeal proceedings to allow the parties to develop and supplement arguments that have been raised at first instance, ‘it seems wrong in principle and contrary to the wording of Article 74(2) [of Regulation No 40/94] to allow them to plead entirely new facts and arguments’. It therefore held that the applicant’s arguments were inadmissible. - 20 However, the Board of Appeal thereby misconstrues Article 74(2) of Regulation No 40/94. That provision, under which OHIM may not take into account facts that were not pleaded or evidence that was not submitted in due time by the parties, grants the Board of Appeal, when presented with facts and evidence which are submitted late, a discretion as to whether or not to take account of such information when making the decision which it is called upon to give (Case C-29/05 P OHIM v Kaul [2007] ECR I-0000, paragraph 68). - (21) Therefore, instead of exercising the discretion which it thus has, the Board of Appeal wrongly considered itself to be lacking any discretion, in the present case, as to whether to take account or not of the facts and evidence at issue (see, to that effect, OHIM v Kaul, paragraph 69). - (22) Moreover, as the Board of Appeal did not examine the facts and evidence at issue, or the applicant’s arguments relating thereto, and merely held them inadmissible, the Court cannot substitute itself for OHIM in the assessment of their relevance in the present case and therefore cannot rule on OHIM’s reasoning in that regard.”

La Mer: T-418/03 – Judgement of 27 September 2007 (action dismissed; Office practice confirmed).

Keywords: Opposition proceedings: scope of required examination (in the case of a multitude of earlier rights). - Opposition: proof of use (POU). - Opposition: likelihood of confusion (LOC). - LOC: application, by analogy, of Article 7(2) CTMR.

The action had been directed against a decision of the 2nd Board of 23. 10. 2003 in R 0814/2000-2 relating to an opposition case between CTM application “*La Mer*”, word, for a range of goods in class 3, and a range of earlier rights in “*Laboratoire de La Mer*”, registered in classes 3, 5, 29 and 31. The opposition had been allowed in full, and the 5th Chamber of the CFI (Vilaras; Martins Ribeiro; Jürimäe) agreed.



(a) *Proof of use*

“(51) It should be noted that, according to the ninth recital in the preamble to Regulation No 40/94, the legislature considered that protection of earlier marks is not justified except where they are actually used. Consistently with that recital, Article 43(2) and (3) of Regulation No 40/94 provides that an applicant for a Community trade mark may request proof that the earlier mark has been put to genuine use in the territory where it is protected during the period of five years preceding the date of publication of the trade mark application against which an opposition has been filed (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 34; Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 36, upheld on appeal by Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, and Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 25). – (52) Under Rule 22(2) of Regulation No 2868/95, evidence of use must concern the place, time, extent and nature of use of the earlier trade mark (VITAFRUIT, cited above at paragraph 51, paragraph 37, and VITAKRAFT, cited above at paragraph 51, paragraph 27).

“(53) For the interpretation of the notion of genuine use, account must be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a Community trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of that provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (VITAFRUIT, cited above at paragraph 51, paragraph 38, and Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-2787, paragraph 32).

“(54) As is apparent from paragraph 43 of the judgment in *Ansul*, cited above at paragraph 38, there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it was registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Moreover, the condition of genuine use of the mark requires that that mark, as protected on the relevant territory, be used publicly and outwardly (*Ansul*, paragraph 37, and *Sunrider v OHIM*, cited above at paragraph 51, paragraph 70; *Silk Cocoon*, cited above at paragraph 53, paragraph 39; VITAFRUIT, cited above at paragraph 51, paragraph 39; HIPOVITON, cited above at paragraph 53, paragraph 33; and VITAKRAFT, cited above at paragraph 51, paragraph 26).

“(55) When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of

those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*Ansul*, cited above at paragraph 38, paragraph 43, and *Sunrider v OHIM*, cited above at paragraph 51, paragraph 71; VITAFRUIT, cited above at paragraph 51, paragraph 40, and HIPOVITON, cited above at paragraph 53, paragraph 34).

“(56) As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (VITAFRUIT, cited above at paragraph 51, paragraph 41, and HIPOVITON, cited above at paragraph 53, paragraph 35).

“(57) To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark (*Ansul*, cited above at paragraph 38, paragraph 39, and the order in *La Mer Technology*, cited above at paragraph 45, paragraph 21; VITAFRUIT, cited above at paragraph 51, paragraph 42, and HIPOVITON, cited above at paragraph 53, paragraph 36).

(58) The Court of Justice also added, in paragraph 72 of *Sunrider v OHIM*, cited above at paragraph 51, that it is not possible to determine a priori and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down. Thus, the Court has held that, when it serves a real commercial purpose, even minimal use can be sufficient to establish genuine use. 59 The Court of First Instance has stated that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*HIWATT*, cited above at paragraph 51, paragraph 47, and VITAKRAFT, cited above at paragraph 51, paragraph 28).

(60) It is in the light of those considerations that it is necessary to examine whether the Board of Appeal was correct to take the view that the evidence submitted by the other party in the proceedings before OHIM showed genuine use of the earlier mark.” – The CFI reached a positive result.



(b) LOC in part of the Union only (sufficient)

“(105) 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 pleaded in opposition to any subsequent application to register a trade mark which infringes their protection, even if it does so only in relation to 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, that it suffices, in refusing to register a trade mark, 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 (MATRATZEN, cited above at paragraph 102, paragraph 59; ZIRH, cited above at paragraph 103, paragraph 36; Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM – Naulover (NLSPOORT, 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). – (106) In the present case, the trade marks on which the opposition was based are national trade marks registered in Greece, France and the United Kingdom, and an international registration having effect in Italy and Portugal claiming priority of the French registration (see paragraph 4 above). The contested decision was based only on the earlier French mark, which the parties do not dispute. Accordingly, the examination must be restricted to France.”

Pure Digital: T-461/04 - Judgement of 20 September 2007 (action dismissed; Office practice confirmed).

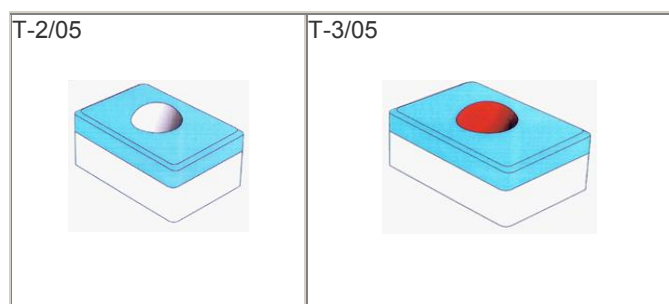
Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: acquired on the market.

The action had been directed against a decision of the 2nd Board of 16. 9. 2004 in R 0108/2004-2, relating to CTM application Pure Digital (word). It had been applied for a range of goods and services in class 9: Electric and electronic apparatus for use with multi-media entertaining systems; installation apparatus for receiving, recording and displaying sound, video and digital information; digital video adapters and interactive video adapters for use with computers, video apparatus; computer hardware, software for use with multi-media and graphics applications; speakers, amplifiers, decoders, DVDs and digital radio systems; computer hand-held devices and communication devices; cards, sound cards, cartridges, tapes, discs, cassettes and other data carriers all for the recordal of data, sound and images; in-car entertainment system namely in-car navigation needs, in-car radios or graphics run on any display system in a car; parts and fittings and electronic components for all the aforesaid goods; and in class 38, namely: Telecommunication of information, computer programmes and computer and video games and programmes; electronic mail services; provision of telecommunication access to computer databases and the internet. – It had been rejected on the grounds that it would solely be descriptive of the nature of the goods and the ways of rendering the claimed services. The 3rd Chamber of the CFI (Jaeger, Azizi; Cremona) confirmed these findings.

Reckitt Benckiser Tabs: Joined Cases T-2/05, T-3/05, T-49/05, T-118/05 and T-119/05 – Cases closed; Order of 5 September 2007.

Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: washing tablets.

The actions had been brought against the decisions of the 2nd Board of 19 October 2004 (Case R 978/2002-2 and Case 979/2002-2), 11 November 2004 (Case R 41/2004-2), and of 17 December 2004 (Case R 46/2004-2 and Case R 43/2004-2). The Board had rejected a number of applications for trade mark protection for washing tablets. Plaintiff had informed that it wished to discontinue proceedings; in consequence, the cases have been removed from the court register.



Encuenta: T-49/06 - Order of 7 September 2007 (action inadmissible; only ES; FR).

Keywords: Article 63 CTMR – CFI proceedings: entitlement to bring an action.

Initially, the case had been an opposition case between the Confederación Española de Cajas de Ahorro which had filed CTM application “Encuenta” in classes 16, 36 and 38, and Bankinter S.A. which had relied on their earlier right in “ecuenta bankinter” for a similar range of products and services. The opposition had been allowed in full. The subsequent appeal had been rejected on the grounds that it had been filed out of time. The CFI proceedings had been initiated by the CTM applicant's lawyer in his own name, represented by another lawyer. Plaintiff in the proceedings had sought to rely on the “general authorisation” filed with the Office to the end that that authorisation would also allow the representative to bring actions in his own name but “on behalf of his client”. The 3rd Chamber of the CFI (Jaeger, Azizi, Cremona) a *limine* declared the action inadmissible.

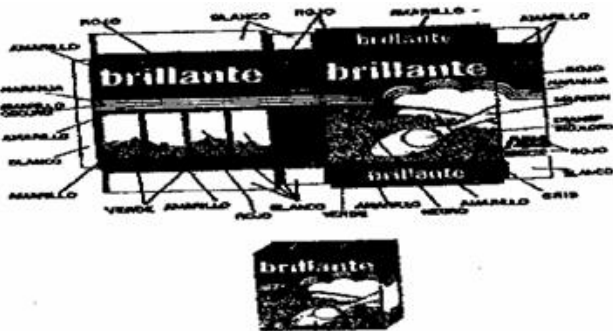


C-2: CFI Judgments and Orders: Developments in pending cases

Brillo's: T-275/07 - Office response filed (ES).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 21. 5. 2007 in R 0493/2006-2 relating to CTM application 2.984.995, word BRILLO'S. It had been applied for a range of products in classes 29, 30 and 31. It had been opposed on the basis of two earlier rights in "brillante" (fig.), registered in classes 29 and 30 (shown below).



The opposition had been rejected on the grounds that the marks at issue are clearly dissimilar. The additional argument of the opponent that its marks would enjoy reputation had also been rejected on the grounds that for the application of Article 8(5) CTMR there must be at least a minimum of similarity between the marks at issue.

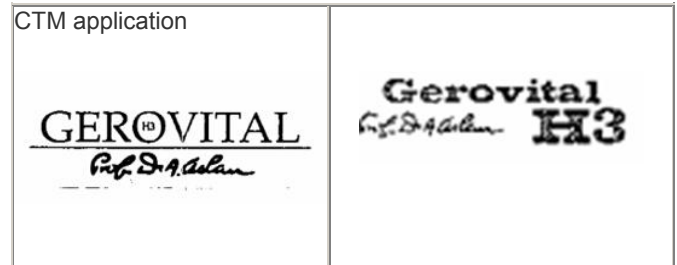
Gerovital Aslan: T-163/07 - Office response filed.

Keywords: Opposition/Invalidation on relative grounds: likelihood of confusion (LOC). – Opposition/cancellation proceedings: argument of *exceptio doli generalis* (unclean hands).

The action is directed against a decision of the 2nd Board of 27. 2. 2007 in R 0271/2006-2 relating to cancellation proceedings concerning CTM 986.034. The CTM at issue is Gerovital Aslan (fig.) which had been applied for a range of goods in class 3: Make-up removing milks, tonic lotions, moistening day creams for greasy skins, moistening day creams for dry skins, nourishing night creams, massage creams, soothing creams for the eyes, beauty masks, hand creams, hair lotions, body milks, creams against cellulitis, sulphur and tar based shampoos, hair balsams, bath gel, anti-

wrinkle creams, all these products containing in their formulations procaine hydrochloride or by-products from the procaine hydrochloride hydrolysis, and in class 42: Cosmetic parlour services rendered by specialized operators; cosmetology research services.

CTM application



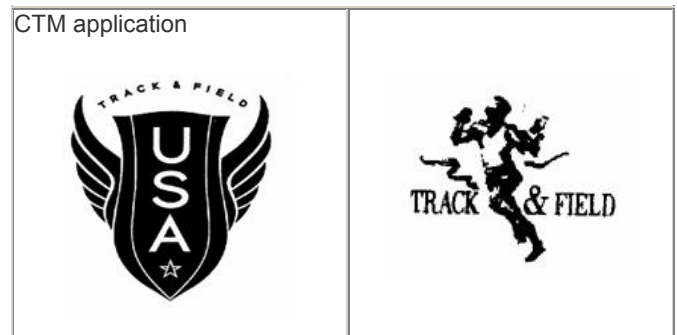
It had been challenged on the basis of a request for invalidation on relative grounds based on Gerovital H3 Aslan (fig.), a Danish trade mark (but owned by a national from the same state as the CTM owner, Romania), registered in class 3. The CTM holder had argued that the proprietor of the earlier Danish right had acquired it in bad faith and that, in consequence, the said trade mark cannot be invoked against the CTM. The invalidation request had been allowed; as regards the argument of unclean hands, the Board had held that any challenge concerning an invoked earlier right must be brought at the national level.

USA Track & Field: T-103/07 - Office response filed (ES).

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

The action is directed against a decision of the 4th Board of 18. 1. 2007 in R 1061/2005-4 relating to CTM application "USA Track & Field" (fig.) which had been applied for a range of goods in class 25.

CTM application



It had been opposed on the basis of Track & Field (fig.) registered in class 25. Whereas the opposition group concerned had allowed the opposition, the Board had allowed the appeal and had rejected the opposition, mainly on the grounds that the marks at issue are dissimilar



Light & Space: T-224/07 - Office response filed.

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 30. 3. 2007 in R 1631/2006-1 concerning CTM application 5.147.756, word combination "Light & Space", which had been applied for a range of goods in class 2, namely: Paints, varnishes, lacquers; driers including curing driers, thinners, colouring matters, all being additives for paints, varnishes or lacquers; preservatives against rust and against deterioration of wood; priming preparations (in the nature of paints); wood stains. - It had been rejected on the grounds that the word combination at issue would describe the nature and/or desired function of the goods at issue.

222-333-555: T-200/07, T-201/07, T-202/07 - Office response filed (PL).

Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: numerals.

The actions are directed against three decisions of the 4th Board of 22. 3. 2007 in R 1276, R 1277 and R 1278/2006-4 relating to three CTM applications for combinations of numerals (222; 333; 555) for goods in class 16. They had been rejected on the grounds that such combinations, in that sector of business, cannot serve as indicators of individual source.

Aprile: T-179/07 - Office response filed.

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

The action is directed against a decision of the 2nd Board of 22. 3. 2007 in R 1076/2006-2 relating to CTM application 3.800.232 (Aprile; fig.; shown below). It had been applied for a range of goods in classes 18 and 25.



It had been opposed on the basis of "Anvil", word, registered for a range of goods in class 25. The opposition had been rejected on the grounds that the marks at issue are clearly dissimilar.

Flugbörse: T-189/07 - Office response filed (DE).

Keywords: Absolute ground for refusal: relevant point in time for assessment. – Cancellation proceedings: compilation of grounds for invalidation and of revocation grounds in one request.

The action is directed against a decision of the 4th Board of 22. 3. 2007 in R 1084/2004-4 relating to CTM 81.406, word Flugbörse, which is registered for a range of goods and services in classes 16, 39 and 42, inter alia for travel agency services. The requestor had claimed invalidation on the grounds that the mark at issue is descriptive for the claimed goods and services; in the alternative it had claimed revocation on the grounds that the mark had become generic. The CTM had been invalidated for most of the registered goods and services. In contrast to the CTM holder who had stated that, at the time of the application, the term "Börse" had only been used in relation to the financial sector, and that subsequent changes in the use of the term (shift to the travel and transport sector) are immaterial, the Board had stated that distinctiveness of a sign must not only be present at the date of the CTM application (1 April 1996) but also at the date of registration. With respect to the latter (29 October 1998) it had found that at that date the term had already been in generic use, in the respective sector of business, in Germany.



Pranahaus: T-226/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 18. 4. 2007 in R 1611/2006-1 relating to CTM application 4.839.916, Pranahaus (word), applied for a range of goods and services in classes 9, 16 and 35 (specific retail services in the area of mail order business). It had been rejected on the grounds that the sign would merely indicate the nature of the goods and services offered namely specific products and treatment in the sector of alternative medicine. Prana, in yoga, means breath or universal energy, and the term is commonly used to generically indicate a specific type of alternative Asian medicine.



Tequila Sombrero Negro: T-182/07 - Office response filed.

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

The action is directed against a decision of the 1st Board of 7. 3. 2007 in R 1285/2005-1 relating to CTM application 2.722.122 (fig.; set out below). It had been applied for in class 33 for “alcoholic beverages, spirits, in particular Tequila”.

(CTM application)




It had been opposed on the basis of three earlier rights (fig; shown below) which are registered in class 33 for spirits and liquors and for spirits of Mexican origin, namely Tequila.

The opposition had been rejected on the grounds that overall the marks at issue are clearly dissimilar. A comparison cannot be reduced to the one slightly common element, a sombrero.

Vantage/Multivantage: T-171/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC). – LOC: relevant consumers (telecommunication). – LOC: comparison of signs. – LOC: weak signs.

<p>CTM application</p> 	<p>Multivantage</p>
--	---------------------

The action is directed against a decision of the 2nd Board of 14. 3. 2007 in R 0156/2006/-2 relating to CTM application Vantage (fig.). It had been applied for a range of goods and services in classes 9 and 42. The said CTM application had been opposed on the basis of an earlier CTM, word Multivantage, registered in classes 9, 38 and 42. The opposition had been rejected in full. The Board, inter alia, gave the following grounds:

The relevant public is the public throughout the Community. This public has an average degree of attentiveness as far as the earlier mark's services of telecommunication are concerned, and a higher degree of attentiveness as concerns the remainder of the goods and services covered by both marks. The goods and services are identical because the earlier mark's list of goods and services encompasses that of the mark applied for. The word “MULTI” is a generic term that is frequently used in most of the Member States and the word “VANTAGE” refers in English to “the quality of having a superior or more favourable position” or to “an advantage”. As such, the word “VANTAGE” is laudatory and is therefore of weak distinctive character. The laudatory meaning of the word “VANTAGE” will be understood throughout the Community either because it has close equivalents in some languages of the Community or because the specialised public is deemed to have a good command of the English language. The two conflicting signs are weak, and their distinctiveness lies in the combination of their elements. Visually and phonetically, the signs are dissimilar because of the differentiating elements they display. Conceptually, the signs differ insofar as one of them refers to “MULTI”, meaning much or many, and are conceptually similar insofar as they both refer to the concept of “VANTAGE”. However, the impact of that similarity will be reduced due to the descriptiveness of the prefix “MULTI” and the low degree of distinctiveness of the word “VANTAGE”. Taking into account the low distinctive character of the common element “VANTAGE”, the additional elements contained in the signs contribute to a finding that they are globally dissimilar. - The judgement of the ECJ of 6 October 2005, in Case C-120/04, Medion AG v Thomson Multimedia Sales Germany & Austria GmbH, “Thomson Life”, ECR 2005 p. I-8551, does not assist the plaintiff (= CTM applicant), because the distinctiveness of the term “LIFE” was never called into question in the said decision.

Payless ShoeSource: T-173/07 - Office response filed.

Keywords: Cancellation proceedings: change of party. - Revocation: non-use. – Use requirement: use in relation to export. - Use requirement: use in one Member State. – Use requirement: impact of the “Council Minutes” (OJ OHIM 1996, 615). - Non-use: burden of proof.

The action is directed against a decision of the 1st Board of 28. 2. 2007 in R 1209/2005-1 relating to CTM 186.163 (in the contested decision the Board erroneously referred to 186.136). The CTM at issue is “Payless ShoeSource” (fig.) which had been registered for a range of goods and services in classes 25, 35 and 42. The revocation request had been submitted by a lawyer in his own name. The cancellation group concerned had allowed the request for revocation in part.

Payless ShoeSource

At the appeal stage the initial requestor for revocation had been substituted by a commercial company; the said initial requestor is now acting as its representative. The Board had



accepted the change of party and had subsequently confirmed the initial decision.

The Board had confirmed that the CTM had been genuinely used in the Community within the meaning of Articles 50(1)(a) and 15 CTMR in relation to the following goods in class 25: footwear; boots; shoes and slippers; soles; insoles; non-slipping devices; heel pieces; heel grips; welts, tips and iron footings; all for footwear. – That there is evidence on file that the CTM had been used for shoes in Italy by a third party authorized by the CTM proprietor. In the years 2000-2004 the CTM proprietor had ordered more than 1 million of shoes to be produced by subcontractors in Italy. The shoes had been placed in boxes bearing the CTM and then exported to the United States, where they had been sold through the CTM proprietor's own chain of shoe stores. – That use in one single Member State, such as Italy, satisfies the "genuine use" criterion under Article 15(1) CTMR as this is confirmed by the Joint Statements by the Council and the Commission entered in the minutes of the Council meeting at which the CTMR was adopted (Joint Statements by the Council and the Commission of 20 October 1995, No B. 10, OJ OHIM 1996, 615). - That the CTM registration is displayed in black and white on the shoe boxes rather than in colours as in the registration does not alter its distinctive character within the meaning of Article 15(2)(a) CTMR. – That use of the sign "PaylessShoeSource" had been made as a trade mark rather than as a company name.

Further: What is decisive is that the CTM registration had been affixed in the European Community on the packaging of the goods for export purposes. In turn, the seat of the CTM proprietor (in or outside the Community) is irrelevant. In the same manner as importing goods into the Community always constitutes use of the trade mark, Article 15(2) CTMR provides symmetrically that the affixing of a trade mark on the goods solely for export purposes is sufficient as well to preserve the trade mark rights, even though the goods are not put on the market in the Community. - Proof that the CTM proprietor had given its consent to the Italian shoe and shoe box manufacturers can be deduced from the evidence on file. - The evidential value of the statutory declarations is corroborated by additional documents supplied by the CTM proprietor. It is immaterial that the original declaration of Mr G., dated 31 March 2004, had been lost as it had been validly replaced by a declaration of identical content, dated 6 December 2006.

TDI: T-174/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness.

The action is directed against a decision of the 1st Board of 7. 3. 2007 in R 1479/2005-1 relating to CTM application 842.302, word TDI. It had been applied by Volkswagen AG a range of goods and services in classes 4, 7 (inter alia, engines) and 37. By a decision of 16. 11. 2001, the examiner in charge had rejected the application on the grounds that such type of combinations would be common place in technical markets. By its decision of 12. 3. 2003, the 4th Board had revoked that decision on formal grounds, inter alia, that the said argumentation would apply to land vehicles but

not within other contexts, and had remitted the case back. In 2005, another examiner rejected the application relying on a broader basis of argumentation. That decision had been confirmed by the 1st Board.

Motown: T-143/07 - Office response filed.

Keywords: Revocation: non-use. – Use requirement: criteria for services.

The action is directed against a decision of the 2nd Board of 15. 2. 2007 in R 0523/2006-2, a revocation case. The CTM at issue is "Motown" (206.243), registered for a range of goods and services in classes 9, 41 and 42. Revocation had been requested in respect of various services. Whereas the cancellation group concerned had allowed the request only partially, the Board gave way as initially claimed.

Dream it, Do it: T-186/07 - Office response filed.

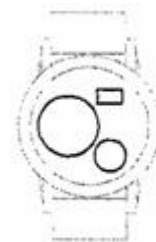
Keywords: Absolute grounds for refusal: distinctiveness. – Distinctiveness: slogans.

The action is directed against a decision of the 1st Board of 15. 3. 2007 in R 0635/2006-1 relating to CTM application 3.844.792, the slogan "Dream it, Do it!", which had been applied for a range of services in classes 41 and 45. It had been rejected on the grounds that the slogan would simply invite to take advantage of what is offered, i. e. it is devoid of distinctiveness since it is applicable to everything.

Wristwatch or Positionsmarke Lange Uhr: T-152/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness. – Shape of the product or part thereof/distinctiveness: specific requirements. - Acquired distinctiveness: evidence.

The action is directed against a decision of the 1st Board of 15. 2. 2007 in R 1176/2005-1 relating to CTM application 2.542.694 (as shown below) which, in German, had been denominated "Positionsmarke". It had been applied for in class 14, inter alia, for luxury watches and parts thereof.



The applicant had filed a description in which it had been stated that the dotted lines in the representation would not form part of the mark; they are only meant to demonstrate the

position of the mark on the respective products. The application had been rejected on the basis of Article 7(1)(b) CTMR. The Board had held that the case law relating to specifically higher requirements as regards distinctiveness, applicable in respect of signs consisting of the shape of the product or a part thereof, also apply to the sign at issue ("position of parts of the product on the product"). These conditions are not met, and distinctiveness acquired on the market has not been proven.

Bomba/La Bamba: T-372/06 – Office answered questions of the court (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 3. 10. 2006 in R 0184/2005-2 relating to CTM application 558.874 Bomba, word, which had been applied for a range of goods in classes 32 and 33. It had been opposed by Eckes-Granini on the basis of their brands "la bamba", registered for a range of products in classes 29, 32 and 33. The opposition had been allowed in full.

Visible White: T-136/07 - Office response filed.

Keywords: Absolute grounds for refusal: descriptiveness.

The action concerns a cancellation case and is directed against a decision of the 4th Board of 15. 2. 2007 in R 0165/2005-4 relating to CTM Visible White (word) which is registered in class 3 for toothpaste and mouthwash. Whereas the cancellation division concerned had rejected the request for invalidation on the grounds that combining the word "visible" with "white" would lead to an unusual juxtaposition, the Board had invalidated the CTM. It had held that the sign does no more than describe the desirable result of an application of the products at issue.

PPT/ PPTV: T-118/07 – Office response filed.

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

The action is directed against a decision of the 1st Board of 17. 1. 2007 in R 1040/2005-1 relating to CTM application 1.758.382, PPT (word), which had been applied for a range of goods in class 41: Video cassette distribution services on a revenue sharing or use fee basis; rental of videos and DVDs; rental of video recorders and DVD players; distribution of video tapes; rental of videos, DVDs, video recorders and DVD players on-line via the global computer network.

CTM application

PPT



It had been opposed on the basis of a Portuguese trade mark and a logo used in the course of trade, PPTV (fig.), protected for "education, training, entertainment and sporting and cultural events", also in class 41. Whereas the opposition group concerned had allowed the opposition, the Board had held to the contrary and had allowed the CTM application.

Madridexporta: T-180/07 - Office response filed (ES).

Keywords: Absolute ground for refusal: descriptiveness. – Distinctiveness acquired in the course of trade: evidence.

The action is directed against a decision of the 1st Board of 7. 3. 2007 in R 0944/2006-1 relating to CTM application 4.659.553, "Madridexporta" (fig.). It had been applied for a range of goods and services in classes 16, 35, 36, 38, 39, 41 and 42.

MADRIDEXPORTA

It had been rejected, inter alia, on the grounds that the sign describes the origin of the goods and services or the place in which they are being offered.

NEW DECISIONS FROM THE BOARDS OF APPEAL

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

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

Procedural Questions – Filing Date – Articles 26, 27 CTMR – Rule 9 CTMIR

Graphic representation – filing date

Decision of the Fourth Board of Appeal of 27 September 2007 in Case R 708/2006-2 (English)

R 708/2006-4 TARZAN YELL (sound mark) – the Board noted that graphic representation serves a dual purpose, namely to define the precise subject-matter of protection granted to the trade mark proprietor and to allow the competent authorities and the public to ascertain what is protected (in particular, allowing third parties to know what is protected by their competitors). Furthermore, a graphic representation must be 'self-contained'. The interested public must be able to understand the sign registered on their own and without any additional technical means. Consequently, the Board held that a spectrogram cannot fulfil these requirements since it is not possible to transform such a spectrogram into sound in the brain and no technical means exist to convert a spectrogram into a sound identical to that which produced it. Therefore, the Board held that the examiner was correct in refusing to attribute a filing date for the application.

Absolute Grounds for Refusal – Article 7(1)(c) CTMR

Acronym – descriptive character

Decision of the First Board of Appeal of 16 September 2007 in Case R 390/2007-1 (English)

R 390/2007-1 CFROI – the Board held that a sequence of letters which does not form a word is in all probability an acronym. Such an acronym must be assessed in connection with the goods and services applied for. Specialists in the banking and financial sector would understand the sign as an acronym for 'Cash Flow Return on Investment'. Consequently, the Board held that the sign lacked distinctive character (Article 7 (1) (b) CTMR).

Invalidity Proceedings – Article 25(1)(e) CDR

Invalidity Proceedings – use of a distinctive sign on a subsequent design

Decision of the Third Board of Appeal of 18 September 2007 in Case R 137/2007-3 (English)

R 137/2007-3 CONTAINERS – the Board dismissed the appeal and upheld the contested decision declaring the registered Community design invalid (Invalidity Proceedings No ICD 2954, RCD No 339 312 – 0003). It confirmed that the owner of a trade mark may prohibit the affixing of the sign protected by its trade mark on the packaging by third parties. If such packaging is a registered Community design, such a design may be declared invalid.

Invalidity proceedings – use of a distinctive sign on a subsequent design

Decision of the Third Board of Appeal of 18 September 2007 in Case R 267/2007-3 (English)

R 267/2007-3 CONTAINERS – the Board dismissed the appeal and upheld the contested decision declaring the registered Community design invalid (Invalidity Proceedings

No ICD 2947, RCD No 339 312 – 0002). It confirmed that the owner of a trade mark may prohibit the affixing of the sign protected by its trade mark on packaging by third parties. If such packaging is a registered Community design, such a design may be declared invalid.

E-Business at OHIM RCD E-Renewal

A new e-business tool has joined the OHIM family. Since 1 November, RCD e-renewal has been available online for the first Community designs, registered in 2003.

The initial renewal period is open until the end of April 2008 for the first RCDs, but electronic applications are already starting to arrive.

The electronic renewal facility for RCDs is very similar to the one existing for CTMs:

- An electronic renewal form is available for all users in German, English, French, Spanish and Italian.
- An RCD renewal manager, which displays all RCDs pending for renewal is accessible to users of MYPAGE.

Renewal Applicant Information

Applicant ID Number Add

Name of legal entity or first name and surname I am the representative (following the definition in Art 78 CDR) appointed for the renewal procedure. Please refer to the help file for more information.

Address

Street and number

City

Postal Code

Country

Postal Address (if different)

At least one of the following fields must be filled in

Telephone number(s)

Fax number(s)

e-mail address

RCD(s) to be renewed

Enter RCD No Include Search RCD-ONLINE

Design Number	RCD	Verbal Element	Holder	Expiry	Locarno Class-subclass	Renewal
<input type="checkbox"/> 000000013-0001			Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.)	01/04/2008	18.01	First

Delete selected

Payment of fees

Total renewal fee: **90.00 EUR** Detail

The RCD renewal process is very simple, easy and quick. Clicking on the RCD e-renewal link displays the form. Applicants introduce their details and then select the specific RCD numbers or the RCD application number (no need to type 0) to renew, and click on the "include" button. The fee to be paid is automatically calculated and the next step is to select one of the options for payment - current account or bank transfer. When this process is completed, click on "submit and order" so the form can be validated by OHIM.

The system returns a confirmation screen and the completed form in PDF format.

Finally, the status of the renewal can be monitored via RCD-ONLINE in clicking in the specific renewal section. Since mid-September, RCD-ONLINE is refreshed everyday.

For further information, please consult the e-renewal online help at

https://secure.oami.europa.eu/RCDERW/htm/en/RCDERWHelpPage_en.html or contact us at information@oami.europa.eu.

If you experience a technical problem when using the tool, contact the OHIM E-Business Hotline at e-business@oami.europa.eu

E-business fact-finding visits

OHIM has launched a series of fact-finding visits to intensive users of OHIM's e-business tools in order to better understand their expectations and needs, as well as their working methods.

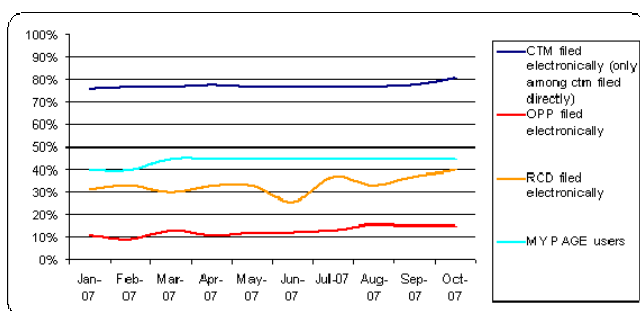
Electronic business services have been at the forefront of the Office's drive to become a fully interactive, accessible and user-friendly e-office, for some time.

OHIM Deputy Director Etienne Sanz de Acedo says: "The knowledge of our users and their feedback are essential to continue improving and developing our services. The information we gather will help us improve our current e-business tools and plan for future developments."

The OHIM E-Business Roundup (2007)

Statistical summary

- The use of the CTM e-filing web form is maintained between 75% and 80%.
- The use of RCD e-filing has increased above 35%.
- 15% of oppositions against CTM applications are received electronically.



State of play of future projects

Service - New version of e-Communication:

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

Status - OHIM has started the testing phase

Service - New version of CTM E-filing:

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

Status - Development phase is about to start.

Service - New version of electronic filing of RCD applications

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

Status - OHIM has completed the requirements.

CTM watch:

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

Status - OHIM has started the development phase.

Service - Online handling of opposition procedures:

Opposition proceedings will be handled electronically via MYPAGE. It will be possible for the parties to exchange documents via this new tool.

Status - OHIM has completed the requirements.

More News

Monthly Statistical Highlights October 2007

Community trade mark applications received	8.403
Community trade mark applications published	10.360
Community trade marks registered (certificates issued)	6.836
Community trade mark renewal applications	1.243
Registered Community designs received	4.690
Registered Community designs published	5.227

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