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Fast-track registration of designs

OHIM's Designs Department has opened the way for an accelerated registration of Community designs fulfilling certain criteria. Applicants needing quick protection for their designs are given the chance to have their applications jump the normal queue of incoming mail provided their applications are submitted in good quality, the fees are paid by current account and the documents for the priority claims (if any) are attached.

The criteria to be fulfilled by a Community design application to qualify for fast-track registration are based on the following reasons:

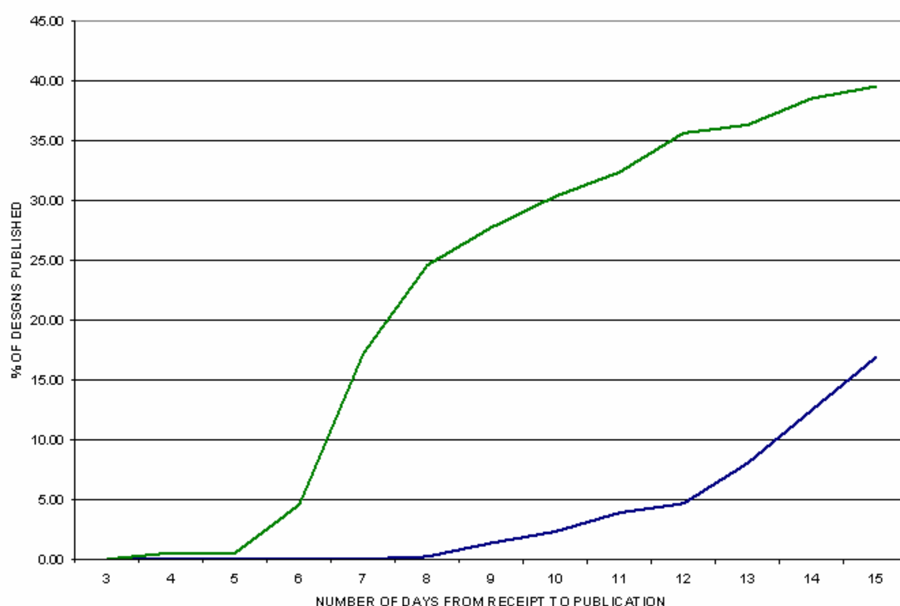
1. The application must be submitted in good quality in order to minimise the likelihood of deficiencies. The preferred way is e-filing because it avoids deterioration of the views. Normal mail may be acceptable as well, but fax is excluded from fast-tracking because, with faxes, OHIM must await the expiry of the one-month period for filing a confirmation copy before moving on to registration.

2. The fees must be paid by current account because this is currently the only method which permits instant verification of the payment by OHIM.

3. The application must either not include a priority claim, or must be accompanied with the priority documents. Otherwise, OHIM is obliged to wait for the subsequent submission of the correct priority documents, which could take months.

Incoming Community design applications matching these criteria are flagged upon receipt by the Designs Department and the examiners are instructed to deal with the flagged applications first.

Latest statistics show that since the introduction of fast-tracking on 23 September 2008, 30% of the Community designs were registered and published within 10 days. The following graph shows the percentage of Community designs published within a given number of days from receipt of the application. The blue line reflects the situation before the introduction of the fast-track registration, whereas the steeper green line, indicating a much higher percentage of early registrations, shows the data on 13 October this year.



All applications not qualifying for fast-track registration are still processed in accordance with the quality standard of OHIM, which requires that 80% of all Community designs are registered and published within six weeks.

Fast-track registration will become even more efficient when the new e-filing system for Community designs becomes available in 2009 because it features an automatic screening routine in combination with an automatic processing of applicants' data, which will further reduce the duration of the registration and publication process. Furthermore, the new e-filing system will allow other forms of payment such as credit cards which will further increase the proportion of applications qualifying for fast-track treatment.

The James Nurton interview with Magnus Hallin, CEO, Awapatent, Sweden

James Nurton is a specialist intellectual property journalist from the UK and is currently the managing editor of the leading global magazine for IP owners, Managing Intellectual Property.

This month, James Nurton talks to IP practitioner and CEO of the Swedish firm Awapatent, Magnus Hallin, about developing a portfolio of brands, CTM opposition strategies and trends in trade mark litigation.

How did you become involved in IP work?
I'm a lawyer and after district court service I worked for a law firm for one-and-a-half years, and was mainly involved in litigation. I then joined Awapatent and got involved in IP work. I realised IP would be important in the future and indeed the importance and value of IP has increased constantly.

My work in IP has been quite general – from trade mark prosecution and advice to patent litigation and licensing. I have been very involved with portfolio development for our larger clients and since November last year I have been heading up the firm.

What does portfolio development involve?
Everything from trade mark selection to handling the portfolio and protecting trade marks and designs, through to enforcement, customs issues and using unfair competition law. We are generally providing guidance for larger Swedish companies but also advising multinational firms regarding work in Sweden, Denmark and elsewhere in Europe.

What role does the CTM play in clients' portfolios?
It depends what stage the client is at and how quickly and where the product will be launched. Timing and cost issues are involved and the result of the search is important – we have to ask: where are the obstacles? Nowadays there are always obstacles but you have to find your way around them. If it's a weaker trade mark, we also have to consider how absolute grounds are assessed in different countries.

Once those issues are considered, most clients like to use the Community systems. It's only when you have a trade mark that will only be launched nationally that you don't consider it.

The obstacles you face are a disadvantage of the CTM system – there are 27 national registries where there could be obstacles. But for many Nordic companies, only a part of the EU is relevant, so sometimes you go ahead with the CTM system anyway.

And are you then able to resolve problems easily?
The cooling-off period is a very practical way to find amicable solutions. You can still have a CTM though in practice it is limited to part of the EU.

If I have a criticism, it is that the opposition system is a bit too slow. It is good to have the cooling-off period extended but opposition proceedings can take too much time. That is a disadvantage for clients, as they need certainty. It could be improved by significantly speeding up the adversarial part – too much time is taken after the correspondence has been exchanged until the decision.

What aspects of the CTM system are good?
Generally it works well. The CTM system is much more cost-effective than national filings and the quality of decisions is generally good. It is a well-functioning office. But in oppositions it can be hard to predict the outcome as the decisions are not always consistent.

Do you also make use of the Community design?
We deal with this quite a lot. For our clients working with brands, total protection is important using the trade mark and design systems, and copyright and marketing and unfair competition law. So we look into all these areas when selecting a trade mark and deciding how to protect it.

The design system in the Nordic region used to be used more for technical devices, and was normally handled by patent attorneys. It is a big change in recent years that it is used much more to protect brands. It's taking some time for attitudes to change, as industry didn't see it as a part of protection for brands.

How many CTMs do you file?
At the firm we file about 200 a year. We have around 300 staff in total, including about 150 attorneys, in 11 offices. Like many of the firms in Sweden, we are quite big! One of the factors is that there are fewer, bigger firms unlike in say Germany where there are many smaller ones. Another explanation is that Swedish entities spend a lot of money on R&D so there is always a lot of patent work, and a strong international aspect.

What is the most unusual trade mark you have worked on?
We filed an application for part of a coupling for lorries. We knew it would be very difficult to protect a shape mark like that, as the practice on shapes was not very clear. In the end we did not take the application through to registration.

Some of our clients are interested in non-traditional trade marks. For example, the cosmetics companies are interested in shape marks and even smells, and there are a lot of discussions about protecting colours. Getting a colour trade mark can be very difficult, but there are often discussions about it.

What trends do you see in trade mark litigation?
What we have seen is that Sweden has been a logistics centre for the Nordic states, which means that a lot of counterfeits come through the country. But that has changed and is less of a problem now, as customs has become more effective: even if you haven't filed an application, they will sometimes take action.

In the grocery industry, there is a big issue where the supermarkets launch their own branded products to the detriment of the branded products of other companies. It is a sensitive issue and a difficult one for the branded product owner to take up with its customer. There was a specific body set up to resolve these disputes and nowadays the parties often try to find amicable solutions.

We have a couple of cases before the Supreme Court. One is over a design for a wheel walker, and one is about non-use of a registered trade mark. We expect the decisions within the next year, though it is possible that questions will be referred to the European Court of Justice. It used to be quite uncommon for the Supreme Court to hear IP cases but now there is about one a year, reflecting the new issues arising and the greater interest in IP.

What changes do you expect in the future?
There is no doubt that brands will continue to be very important and their value is steadily increasing. There is a trend towards fewer brands and having very strong brands that will be successful. This means at the selection stage looking at how a brand can be protected, and using various IP rights. But being able to enforce is also very important, so there will be an increased focus on enforcement and doing it in a cost-effective way.

I am pleased with the initiative to have a common European patent court, and I wonder if this could become an IP court that also covers trade marks and designs. I think that would be a good initiative in the long term.

Community Trade Mark

The letter "H" at centre of trade mark dispute

OHIM's Cancellation Division has turned down an invalidity application against the "Hotel Collection" figurative Community trade mark registered by US department store group Macy's.

The Hotel Collection figurative mark was registered in 2005 for various classes including home furnishings and clothing. Subsequently, the international retailing group Metro filed an invalidity application on the ground that the trade mark was confusingly similar to their earlier mark, covering similar classes.

CTM No 3616349 registered by Macy's Merchandising Group, Inc.	CTM No 2641702, registered by MIP Metro Group Intellectual Property GmbH & Co, KG

The invalidity applicant argued that the contested CTM was registered with respect to goods that were identical or closely related to the ones the earlier CTM was registered for. Moreover the consumers addressed would immediately perceive that the earlier trade mark's dominant element, the letter "H", was completely incorporated into the contested CTM and accompanied by descriptive word elements only.

Macy's claimed that the only similarity between the trade marks involved was the use of a single letter "H", which on its own was weak. The further elements of the marks had nothing in common. The marks are visually, aurally and conceptually different, and there was no likelihood of confusion.

OHIM's Cancellation Division found that the similar element in the two CTMs, the letter "H", was represented in white on a black circular background in the contested CTM, whereas in the earlier trade mark it was shaded in two-tones, white and black, on its vertical bars and inserted in a coat-of-arms device.

The contested CTM further contained two word elements "HOTEL COLLECTION" which had no counterpart in the earlier trade mark. The element of visual, phonetic and conceptual similarity between the marks lay only in the fact that both contained the letter "H" as their central element. However, a single letter *per se* was generally devoid of distinctive character.

Rejecting the Invalidity Request, the Office concluded: "The similarity of the signs is an absolute prerequisite for reaching a finding of likelihood of confusion. Since the signs are dissimilar, one of the conditions of Article 8(1)(b) CTMR is not fulfilled and the application for a declaration of invalidity must be rejected. In any case, notwithstanding the fact that the goods in conflict are identical and similar, it is not probable, in the Office's opinion, that a typical consumer of these goods will, immediately and without pause for thought, identify the products in question as originating from the same source, or will assume that the applicant and the opponent are economically linked undertakings. In the absence of any claim or evidence as to distinctiveness acquired by virtue of use of the earlier sign, there is no likelihood of confusion even for identical goods."

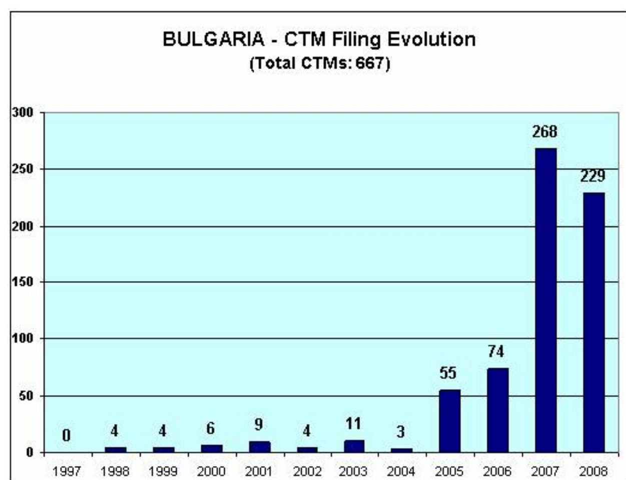
Country overview: Bulgaria & the Community Trade Mark

Bulgaria joined the EU in 2007 and has a population of 7.7m. Located in the heart of the Balkans, Bulgaria, which was founded in the 7th Century, is one of the oldest states in Europe. The country's main exports are light industrial products, foods and wines.

Bulgarian figures for GDP show that growth in the second quarter of this year, compared with the same period of 2007, was 7%, which is much stronger than the EU average.

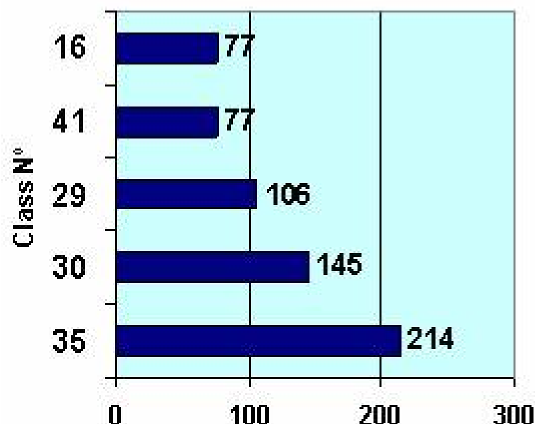
The service sector accounts for 62% of GDP followed by industry (32%) and agriculture (6%).

The first few Bulgarian CTMs were registered in 1998, and there was a significant rise in interest following accession to the EU in 2007. A total of 667 CTMs have been filed to date by Bulgarian companies, including 229 this year so far.

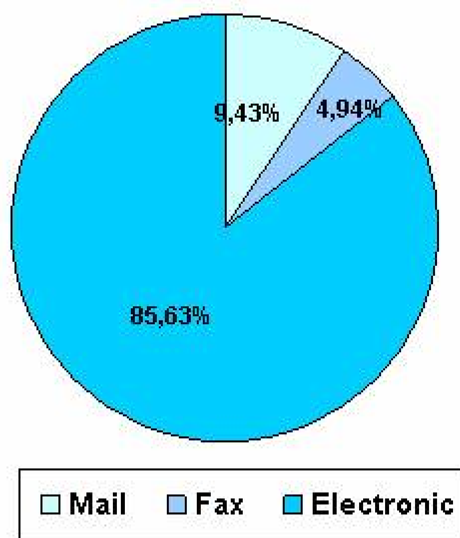


Word	Figurative	3-D	Colour	Other
36.87 %	62.31 %	0.71 %	0.04 %	0.06 %

Figurative marks are the most popular with Bulgarian enterprises and account for 59% of applications, followed by word marks (39%). The most popular goods and services applied for are in classes 35, 30 and 29.



The vast majority of Bulgarian trade marks (86%) are filed electronically, with fax accounting for 5% and mail 9%.



Top 10 Bulgaria-based owners by number of CTMs filed	
Company	CTMs
COPERNICUS EOOD	34
AKTSIONERNO DROUJESTVO "BULGARTABAC HOLDING"	17
SOPHARMA AD	16
VITTA FOODS LTD	16
Mobiltel EAD	14
Bella Bulgaria AD	11
DOMAINE BOYAR AD	11
KONSUL LTD	9
AKTSIONERNO DROUJESTVO "BULGARTABAC-HOLDING"	8
Ivanov	7

Top 10 representatives by number of CTMs received from Bulgaria-based applicants	
Representative	CTMs
Ivanov	50
Pakidanska	45
DR. EMIL GABRIEL BENATOV & PARTNERS	43
Kesova	21
PATENT UNIVERSE	20
Pavlov Pavlov	17
SWINDELL & PEARSON	8
BULINVENT LT	7
Carter	6
Peytcheva	6

Community Design

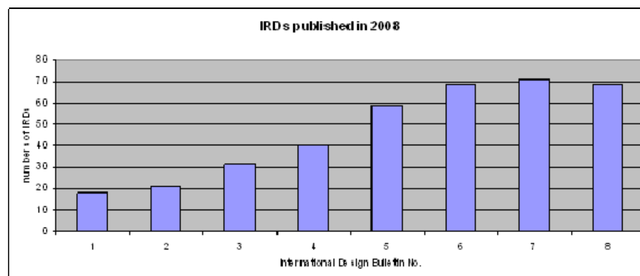
The WIPO/OHIM design link

Since the beginning of this year, applicants have been able to designate the European Community in an application for an International registration of a design (IRD) under the Geneva Act of the Hague Agreement administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva. Once the IRD has been published, and provided OHIM finds no ground for a refusal in the subsequent examination, this IRD confers on its holder the same rights in the territory of the Community as a registered Community design (RCD).

The link between WIPO's international and OHIM's Community design systems was established by a Council Decision approving the accession of the European Community to the Geneva Act of the Hague Agreement.[1] The details of how to operate the link were defined in two Regulations [2] reflecting the Council's aim for a cost efficient solution. In particular, it was settled that the whole IRD registration process should stay in the hands of WIPO, starting with the filing of the IRD applications to be done only directly with WIPO, and ending with the publication of the registrations exclusively by WIPO in the International Designs Bulletin. No files were to be exchanged between OHIM and WIPO other than those related to the payment of fees.

OHIM's role in this process is to fill the last gap between the publication of an IRD and its accomplishment as a fully enforceable design right equivalent to an RCD. This gap lies in the possible existence of grounds for refusal such as an incompatibility of the subject matter of the IRD with the definition of a design as stipulated in the Community Design Regulation. In order to uncover such a deficiency in a published IRD, the Regulation grants OHIM a period of six months from the date of publication to carry out an examination and notify WIPO of any finding.

The link between WIPO and OHIM in design matters has been working smoothly. In the first nine months of its operation WIPO published 378 IRDs in total, corresponding to around 3% of the number of RCD applications received by OHIM in the same period. The graph below above the numbers of IRDs published in each of the International Design Bulletins from February to September 2008:



OHIM did not find a ground for refusal in any of the published IRDs and hence statements of acceptance were communicated to WIPO for all of them.

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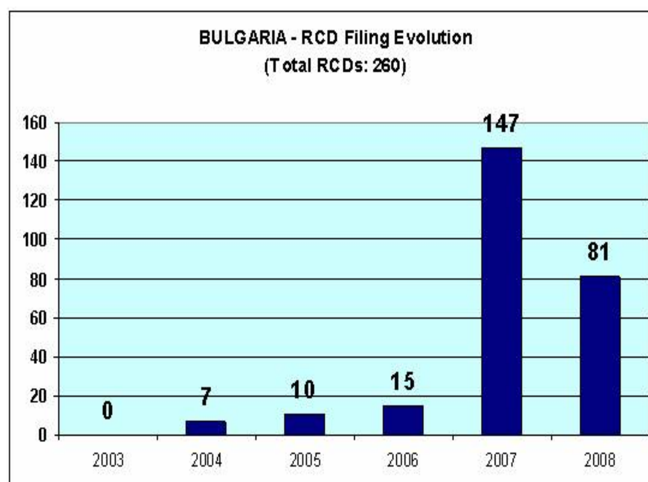
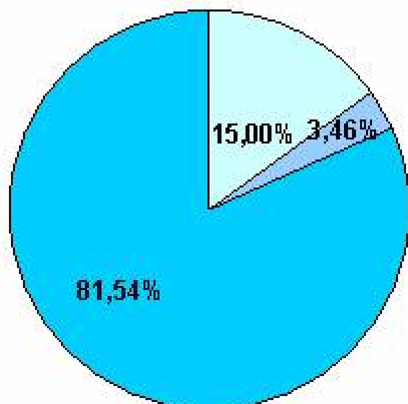
[1]Council Decision (EC) No 1891/2006 of 18 December 2006 , OJ L 386, 29.12.2006, p.28
[2]Council Regulation (EC) No 1891/2006 of 18 December 2006, OJ L 386, 29.12.2006, p.14; and Commission Regulation (EC) No 876/2007 of 24 July 2007, OJ L 193, 25.7.2007, p. 13

Country overview: Bulgaria & the Registered Community Design

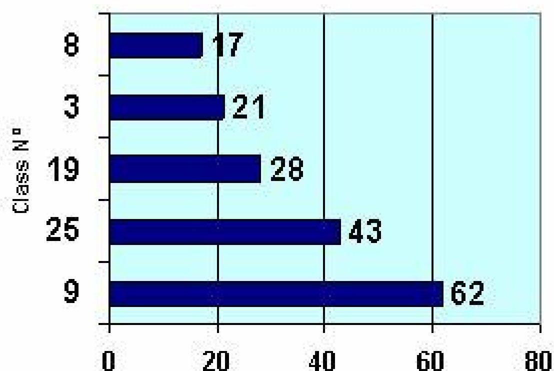
The first Bulgarian filings of RCDs were made 2004, and there have been just 260 to date, including 147 last year.

The most popular classes for RCDs are 62, 43 and 28. Filing via the Internet is the most popular route, accounting for 82%, followed by mail (15%) and fax (3%).





Top 10 representatives by number of RCDs received from Bulgaria-based applicants	
Representative	**RCDs**
DR. EMIL GABRIEL BENATOV & PARTNERS	63
Levicharova	44
J. VARBANOV & PARTNERS	16
ZLATAREVI Intellectual Property Agengy	14
Kesova	12
Pakidanska	11
PONS PATENTES Y MARCAS INTERNACIONAL, S.L.	10
Taushanova	10
Belièka	10
Benatov	7



Top 10 Bulgaria-based owners by number of RCDs filed	
Owner	**RCDs**
Stoev	38
Florina-Bulgaria AD	19
ALFAKOMERS AD	14
TESY OOD	12
FICOSOTA SYNTEZ OOD	11
Nikola	10
GIP - EOOD	7
MAK AD	7
Denima 2001 GmbH	6
Devin AD	6

E-business at OHIM

How deferred RCDs are handled in the OHIM e-business tools.

One of the interesting features of the RCD system for businesses is the provision for delaying the publication of the registered Design. Publication may be delayed for up to 30 months and your design may therefore remain confidential until you are ready to disclose it. You may even choose not to publish it at all and your registration will then lapse after the 30 month period.

From the registration of the deferred RCD to its publication, the RCD is kept secret and full protection can be enjoyed at the moment of the complete publication (in part A1 of the RCD Bulletin) backdated to the filing date.

What is published in RCD-ONLINE and the Bulletin?

Once registered, a deferred RCD is published in part A2 of the RCD bulletin. The views of the designs and the product indication and classification are not publicly available. Only the RCD number, the filing/priority date, the information about the holder and representative are published. This information also appears in RCD-ONLINE with a status: "Registered and subject to deferment (A2)".

2 ⊞ 000252721-0001

Name of owner:	RENAULT s.a.s.
Filing date:	11/11/2004
Locarno class-subclass:	12.08
Verbal element:	
Indication of the product:	Motor vehicles
Status:	Registered and fully published (A1) *This design has previously been published as "registered and subject to deferment (A2)"*

When a deferred RCD is then fully published on request of the RCD holder or their representative (this request should be done sending a communication to OHIM), the whole set of RCD information is then published in RCD-ONLINE. However, the fact that the RCD was deferred is still mentioned and the publication in part A2 of the RCD Bulletin is still available in the RCD-ONLINE publication section.

How to file a deferred RCD application online?

The request for deferment must be made on the application form and late requests will not be accepted. In the RCD e-filing form (please click at: http://oami.europa.eu/ows/rw/pages/QPLUS/forms/electronic/fileApplicationRCD.en.do) in the Design section you have to select the "Publication to be deferred" option. You have to attach and upload the images corresponding to the views of the Design.

Then in the following page of the form, the fees are automatically calculated. A deferment fee has to be paid instead of the publication fee. The publication fee will be required when the deferment ends, provided that the holder wishes the RCD to be fully published.

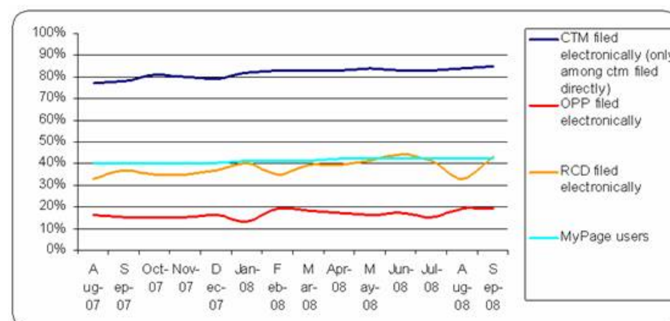
After the submission of the RCD application the designs will not be disclosed to third parties without explicit consent from the RCD holder.

Should you require any further information, please consult the OHIM website at:
http://oami.europa.eu/ows/rw/pages/RCD/index.en.do
or contact us at information@oami.europa.eu.

OHIM e-business roundup (2008)

Statistical summary

- The use of the CTM e-filing web form is steady at above 80 %.
- The use of RCD e-filing has decreased to 43%
- Oppositions against CTM applications received electronically stand at 19%.
- MyPage users represent around 40% of CTM Applications filed.



State of play of future projects

Service - New version of e-Communication:
Electronic communication will be expanded to include more official communications of OHIM.

Status - OHIM has started the final testing phase

Service - New version of CTM E-filing:
The current CTM e-filing service will be significantly improved.

Status - The system is being developed

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 - The system is being developed

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

Status - OHIM is going to start the testing phase

More News

OHIM in China

OHIM has been taking part in an intensive series of cooperation and knowledge-sharing activities with the Chinese IPR authorities and professional community.

The recent round of events included participating in a seminar on well-known trade marks for Chinese judges from the country's Supreme Court, practitioners and academics, in Shanghai on 7-8 Sepember. The People's Supreme Court, which plays a key role in the enforcement of trade marks in China is currently drawing up new interpretive guidelines. The seminar was held under the auspices of the EU-China cooperation project (IPR 2), which was launched earlier this year to help improve the effectiveness of intellectual property rights in China.

As a result of the close bilateral relationship between OHIM and the Chinese State IP Office, SIPO, the Office also took part in seminars on the European design protection system in Chongqing, capital of the homonym province, on 16-17 September, and in Shunde, Guangdong Province, on 18 September. The seminars allowed the Office to explain the Community design system to local industries in the automobile, home appliances, and machinery sectors among others.

Chongqing is a major manufacturing area for automobiles, motor-cycles and general machinery. Shunde, on its turn, is mainly a manufacturing centre for household appliances. Both industrial poles represent the new innovation-oriented economy that the Chinese government is fostering. In this context, the interest shown in IP matters, particularly on the Community design system, is increasing along with their competitiveness in world markets. Moreover, OHIM staff attended Shunde's industrial design fair (“China International Patent & Brand Expo” CIPBE, 2008).

The following week, OHIM took part in a workshop on the "Revision of the Chinese Patent Law", in Harbin, from 24-26 September, as the lead agency on designs matters.

The first course on the Community trade mark system, jointly organised by OHIM and the China Trademark Association, took place in Beijing on 10 October. The course, intended to be an annual event, arises from the memorandum of understanding signed between the two organisations, which enjoy very close cooperative relations.

OHIM staff also met representatives of the All-China Patent Agents Association in order to promote designs among patent attorneys. A series of training activities and other exchanges were agreed.

International seminar on the European Intellectual Property system at Shunde

OHIM welcomes ITMA delegates

Delegates to the autumn conference of the UK-based Institute of Trade Mark Attorneys , arriving for a reception at OHIM. The conference, which took place this year in Alicante , from 25-26 September, included presentations by OHIM President Wubbo de Boer and Vincent O'Reilly, Director of OHIM's Department for IP Policy. During their visit, delegates were given an illustrated talk on the history of OHIM by the Office's Vice-President Peter Lawrence.

Monthly statistical highlights September 2008

Community trade mark applications received	7 262
Community trade mark applications published	8 475
Community trade marks registered (certificates issued)	8 444
Community trade mark renewal applications	1 221
Registered Community designs received	5 838
Registered Community designs published	6 013

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

Case-law
Latest trade mark and design news from Luxembourg

Index
ECJ Judgments and Orders
NONE

ECJ Developments in pending cases
Camelo/Camel or Café Torrefacto C-136/08-P
RW Maple Leaf-I or RW Feuille D´Erable-I: C-202/08-P
RW RW Maple Leaf-II or RW Feuille D´Erable-II: C-208/08-P

ECJ Preliminary Rulings
NONE

ECJ Preliminary Rulings: Developments in pending cases
NONE

CFI Judgments and Orders
Paint Filter (3D): T-201/06
BioVisc: T-106/07
Exé: T-96/06
Capio/Capiox: T-325/06
Grammy: T-20/06
Wellbiz/Wild.biz: T-451/07
Elini/Cellini: T-67/06
Vantage CNM: T-171/07
Magic Seat: T-363/06
Car Silhouette - III: T-9/08
H/H: T-172/06
Substance for Success: T-58/07
Vorsprung durch Technik: T-70/06
The Coffee Store: T-323/05
Letter E: T-302/06
Mozart: T-304/06
Color Edition: T-160/07
Isdin: Joined cases T-354/07 and T-356/07
Dream it, Do it !: T-186/07
Stradivarius: T-340/06
Clover (HiQ with trefoil): T-37/06

CFI Judgments and Orders: Developments in pending cases
Botella Esmerilada Blanca or Frosted White Bottle -I: T-109/08
Botella Esmerilada Negra or Surface of a Bottle -II: T-110/08
Aurelia: T-136/08
Magic Butler: T-123/08

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

A-1: ECJ Judgments and Orders

NONE

A-2: ECJ: Developments in pending cases

Camelo/Camel or **Café Torrefacto** : C-136/08-P (appeal from T-138/06) – Office response filed (FR).

Keywords: Opposition: earlier right with reputation – Reputation: criteria and evidence – Opposition: likelihood of confusion (LOC).

The case is an appeal from a decision of the 5th Chamber of the CFI of 30.1.2008 in Case T-128/06 relating to a conflict between CTM application No 1 469 121, “Camelo” (figurative mark), and “Camel” (figurative mark). The CTM had been applied for for coffee in Class 30.

CTM application

Japan Tabacco Inc. had lodged a notice of opposition against the application based inter alia on its Camel brand which has been registered in Spain for tobacco and cigarettes in Class 34 since 1928. Reputation had been claimed within Article 8(5) CTMR. Whereas the Opposition Division had allowed the opposition under that provision, the Board had rejected it. On subsequent appeal, the CFI had confirmed the Board.

RW Maple Leaf-I or **RW Feuille D´Erable-I** : C-202/08-P (appeal from T-215/06; appeal lodged by CTM applicant) – Office response filed (FR).

Keywords: Absolute grounds for refusal: official emblems etc., Article 7(1)(h) CTMR.

The case is an appeal from a decision of the CFI of 28.2.2008 in T-215/06 relating to a CTM application for the figurative mark reproduced below containing a maple leaf. It had been applied for by a Belgian company for a range of goods and services in Classes 18, 25 and 40.

The application had been rejected under Article 7(1)(h) CTMR. The CFI , in the challenged decision, had allowed the application to proceed for the services but had confirmed rejection for the goods claimed. The plaintiff in the action is the CTM applicant.

RW Maple Leaf-II or **RW Feuille D´Erable-II** : C-208/08-P (second appeal from T-215/06; same background as above in C-202/08-P; appeal brought by the Office because t he CFI , in the challenged decision, had allowed the application to proceed for the services).

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

NONE

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

NONE

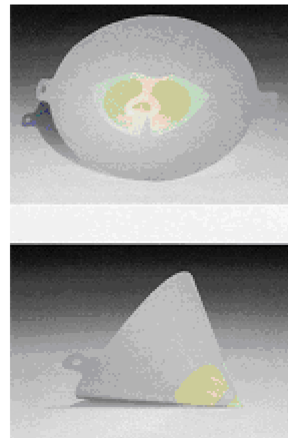
C:CFI Court of First Instance (CFI): Judgments and Orders on appeals against decisions of OHIM, Article 63 CTMR

C-1: CFI Judgments and Orders

Paint Filter (3D) : T-201/06 – Judgment of 10 September 2008 (action dismissed; Office practice confirmed).

Keywords: Types of signs/marks: 3D signs – Absolute grounds for refusal: distinctiveness – Distinctiveness: 3D sign with colour – 3D signs: perception of the relevant public – 3D signs: shape of the product itself – 3D product shape: impact of comparable goods on the market.

The action had been directed against a decision of the 2nd Board of 15.5.2006 in R 1387/2005-2 relating to a 3D application, a paint filter with a yellow tip.



The goods in respect of which registration had been applied for correspond to the following description: paint strainers and filters, made primarily of paper and paper board; paint strainers and filters made primarily of paper and paper board and incorporating a mesh fiber element (Class 16), and filters, strainers and mesh, all for straining paint (Class 21). The application had been rejected pursuant to Article 7(1)(b) CTMR. In essence, it had been held that the mark applied for was neither distinctive nor indicative of the origin of the goods, and that the application of a colour on the tip of the paint filter, whilst admittedly somewhat unusual, did not however enable a consumer to suppose that it was anything other than a simple coloration used to denote the thickness of the mesh, or a plain decoration. It had also been stated that the perception of the relevant public was not necessarily the same in the case of a coloured three-dimensional mark as it is in the case of a figurative or word mark.

Furthermore, the Office did not concur with the applicant's claim that the consumers of the goods designated were exclusively specialists, on the ground that the relevant public included car-body shop owners and workers. While they may have expertise, they cannot be said to be highly specialised or sophisticated. Lastly, the applicant's attempt to register the same mark in four different colours implied that the significance of the colour scheme was more decorative than distinctive. The 4th Chamber of the CFI agreed (Czúcz; Cooke; Labucka, rapporteur).

"(21) The criteria for assessing the distinctive character of three-dimensional trade marks, like the one at issue in the present case, are no different from those applicable to other categories of trade mark. However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the goods themselves as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the goods 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 (Case C-136/02 P Mag Instrument v OHIM [2004] ECR I-9165, paragraph 30; Storck v OHIM, cited above, paragraphs 26 and 27; and Henkel v OHIM, cited above, paragraph 36).

(22) According to settled case-law, the more closely the shape for which registration is sought as a trade mark resembles the shape most likely to be taken by the product in question, the greater the likelihood of that shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 39). Only a mark which departs significantly from the norms 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 (Case C-173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551, paragraph 31; Storck v OHIM, cited above, paragraph 28; and Case C-144/06 P Henkel v OHIM, cited in paragraph 18 above, paragraph 37).

(23) In the present case, as regards the shape of the mark applied for, it must be stated that it is very similar to competing goods on the market. Even if each manufacturer produces different filters, the three-dimensional shape in respect of which registration was applied for is a simple shape which is amongst those which come naturally to the mind of the consumer in relation to paint filters. As the Board of Appeal rightly found at paragraph 17 of the contested decision, the shape at issue does not have any element that can be said to depart perceptibly from one of the most common shapes of such a product."

BioVisc : T-106/07 – Judgment of 10 September 2008 (dismissed; Board practice confirmed).

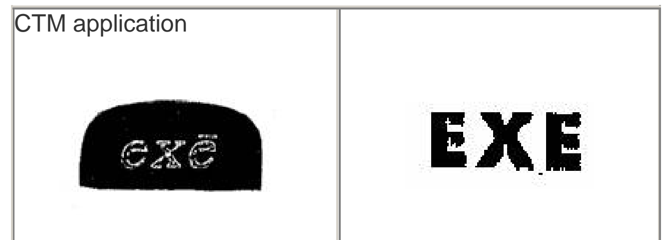
Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Marks at issue: BioVisc v PROVISC and DUOVISC.

The action had been directed against a decision of the 2nd Board of 8.2.2007 in R 0660/2006-2 relating to an opposition case between CTM application "BioVisc" (word mark) and the earlier rights "PROVISC" and "DUOVISC". The CTM had been applied for sterile solutions for intra-operative eye operations in Class 5. The opposition had been based on international registration No 553751 (PROVISC), with effect in Germany, Spain, France, Italy, Austria, Portugal and the Benelux countries, in respect of 'products for use in ophthalmology' in Class 5, and on international registration No 659615 (DUOVISC), with effect in Germany, Spain, France, Italy, Austria, Portugal and the Benelux countries, for 'ophthalmic pharmaceutical preparations' in Class 5. Whereas the Opposition Division had allowed the opposition on the ground that the marks were similar, the Board had rejected it. The 4th Chamber of the CFI (Czúcz; Cooke; Labucka, rapporteur) agreed relying on standard criteria.

Exé : T-96/06 – Judgment of 10 September 2008 (only in FR, GR; action dismissed; Office practice confirmed).

Keywords: Opposition: earlier right with reputation – Opposition: likelihood of confusion: (LOC) – LOC: comparison of goods – Comparison of goods: complementary goods.

The action had been directed against a decision of the 2nd Board of 11.1.2006 in R 1127/2004-2 relating to a CTM application for "exé" (figurative mark) which had been applied in Class 18 for leather goods, handbags, wallets and purses, key-rings, suitcases and traveler's bags, and in Class 25 for men's and women's footwear, leather clothes and belts.



It had been opposed on the basis of "EXE", word mark, registered in the UK , and used on the market as a business identifier in Greece , France , Ireland and Finland , for clothing in Class 25, with the exception of footwear. It had been claimed that the business identifier is well-known on the latter markets. The opposition had been allowed in relation to leather goods, handbags, wallets and purses in Class 18 and men's and women's footwear, leather clothes and belts in Class 25. It had been rejected for the remaining goods: key-rings, suitcases and traveler's bags in Class 18. The 5th Chamber of the CFI (Vilaras; Dehousse; Sváby, rapporteur) agreed. The reasoning can, as far as relevant in the action and to the extent that it relates to the earlier UK trade mark registration, be summarised as follows:

The opponent's articles of clothing included in Class 25 encompass the applicant's leather clothes and belts. These goods are therefore identical. As regards the applicant's 'men's and women's footwear' these are goods intended for wear by humans, both as protection from the elements and as articles of fashion and are, as such, often found in the same sections of large department stores or in the same retail outlets as articles of clothing. When seeking to purchase clothes, consumers will expect to find footwear in the same department or shop, and vice-versa. Moreover, many manufacturers and designers will design and produce both. This is especially the case in retail outlet chains or chain stores, which will often provide footwear and clothing articles under the same trade mark. Taking these factors into account, 'men's and women's footwear' are found to be similar to the opponent's goods.

The goods 'leather goods, handbags, wallets and purses' are closely related to 'articles of clothing' in the sense that they are likely to be considered by the consumers as accessories to articles of outer clothing (for example, women's handbags or purses that match with certain clothes or belts, etc.). Even if it is not unusual for clothing manufacturers to produce and market handbags directly, it is reasonable that a significant part of the public considers such goods 'complementary accessories', since they are closely co-ordinated with outer clothing and they may well be distributed by the same or linked manufacturers. Moreover, these goods can be found in the same shops. From the above, it was concluded that 'handbags, wallets and purses' are similar to the opponent's goods. The remaining contested goods were found to be dissimilar to those of the earlier trade mark.

Capio/Capiox : T-325/06 – Judgment of 10 September 2008 (action dismissed, Office practice confirmed).

Keywords: Opposition: proof of use (POU) – Opposition: likelihood of confusion (LOC) – LOC: comparison of goods in the medical area.

The action had been directed against a decision of the 2nd Board of 14.9.2006 in R 0061/2006-2 relating to CTM application “Capio”, word mark, which had been applied for for a range of goods in Class 10, namely surgical, medical, dental and veterinary apparatus and instruments, in particular apparatus for placing a suture; artificial limbs, eyes and teeth; orthopedic articles and suture materials. It had been opposed on the basis of several earlier rights in “Capiox” and “Capiox Pulse”, word marks, registered in Class 10, including the Finnish registration of 20 September 1990 (No 108926) of the trade mark CAPIOX for surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopedic articles and suture materials.

The Opposition Division had rejected the opposition for all the goods in issue. It had considered that POU of the Finnish registration had been furnished only as regards hollow fiber oxygenators with a detachable hard-shell reservoir. According to the Opposition Division, there was only a very low degree of similarity between those latter goods and the apparatus for placing a suture covered by the mark applied for. As regards comparison of the signs, the Opposition Division had found that the letter ‘x' at the end of the earlier mark was an important element of differentiation between the conflicting signs, given that use of that letter is very uncommon in Finland.

In contrast, the Board had annulled the said decision and had upheld the opposition in its entirety. The Board had limited its assessment of LOC to a comparison of the mark applied for with the Finnish trade mark No 108 926 and had found that, given the nature of the goods at issue, the relevant public was made up of Finnish professionals. The Board had confirmed that the opponent had substantiated genuine use of the trade mark CAPIOX in Finland only in respect of hollow fiber oxygenators with a detachable hard-shell reservoir. As regards comparison of the goods, the Board had found, in essence, that even though such oxygenators would have a different method of use from that of apparatus for placing a suture, they were closely linked. Those goods had a certain complementary character as they could be used simultaneously during surgery. The goods could be purchased through the same distribution channels and it was possible that a company could manufacture the goods at issue at the same time. As regards comparison of the signs, the Board had held that they had a high degree of similarity. Visually, the conflicting signs were composed of the same group of letters, namely ‘capio', arranged in the same order, the only difference being the letter ‘x' at the end. Phonetically, the presence of that letter ‘x' was also the only difference and, from a conceptual point of view, neither of the two signs seemed to have any apparent meaning. The Board had considered that, although the letter ‘x' was very uncommon in Finnish that was not the case in the medical field. Eventually, the Board had concluded that it was more than likely that the relevant public would believe that the conflicting signs came from the same undertaking or economically-linked undertakings. The 8th Chamber of the CFI (Martin s Ribeiro, rapporteur; Papasavvas; Wahl) in essence confirmed that decision.

Grammy : T-20/06 – Case closed; Order of 4 July 2008 .

Keywords: Opposition: proof of use (POU) – Opposition: earlier right with reputation, Article 8(5) CTMR – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 18.8.2006 in R 1062/2000-4 relating to a conflict between The National Academy of Recording Arts and Sciences (USA) and Mr. Grammatikopoulos (Greece). The latter had filed on 1 April 1996 a CTM application seeking to register the word mark “GRAMMY” Class 25 for clothing, footwear and headgear, and in Class 28 for gymnastic and sporting articles. An opposition had been filed on the basis of the following earlier rights:

Spanish registration No 1 503 240 of the word mark “GRAMMY”. It was filed on 2 July 1989 and registered on 16 October 1991 for the following services: Class 42: services of an association, in particular services of promotion of the artistic progress and success in the field of the artistic and scientific recording – German registration No 1 181 300 of the word mark “GRAMMY”. It was filed on 22 May 1990 and registered on 4 October 1991 for the following services: Classes 35, 41: services in the field of the music entertainment, namely promotion of artistic steps as well as artistic performances in the area of reproduced art and science towards the exhibition and operation of contests and grant of awards, prizes and certificates within the musical sector – French registration No 1 685 744 of the word mark “GRAMMY”. It was filed on 8 August 1991 with a priority as from 8 February 1991 and registered on 8 August 1991 for the following goods in Class 9: audio and video apparatus for entertaining activities. Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carries, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus – Italian registration No 632 658 of the word mark “GRAMMY”. It was filed on 8 August 1991 with a priority as from 8 February 1991 and registered on 30 September 1994 for the following goods in Class 9: scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carries, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus – United Kingdom registration No 1 472 730 of the word mark “GRAMMY”. It was filed on 7 August 1991 and registered on 27 November 1992 for the following goods in Class 9: sound recording and sound reproducing apparatus and instruments; video

recording and video reproducing apparatus and instruments; records, tapes and discs; video tapes and films; cinematographic films; computers and data processing apparatus; computer hardware, software and firmware; computer programmes; computer games; cameras; photographic apparatus and instruments; audio and video apparatus for entertainment purposes; parts and fittings for all the aforesaid goods.

In the first place, reputation within the meaning of Article 8(5) CTMR had been claimed but the opposition had also been based on Article 8(1) CTMR (LOC).

The Opposition Division had rejected the opposition partially on the ground of lack of POU, partially on lack of evidence with respect to reputation, and in this respect it then had concluded that there was no LOC because of the dissimilar goods and services. In contrast, the Board had allowed the opposition in full. Since the CTM applicant and plaintiff in the action had informed the court that it wished to discontinue proceedings, the case was closed.

Wellbiz/Wild.biz : T-451/07 – Case closed; Order of 11 July 2008 (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 2.10.2007 in R 1575/2006-1 relating to a conflict between CTM application No 2 225 175, "WELLBIZ", word mark, for services in Class 41 relating *inter alia* to seminars and workshops and personality training in the area of marketing, and "WILD.BIZ", word mark, registered in Class 41 for services relating to providing training and seminars. The opposition had been partially allowed, namely as regards the services mentioned above. Upon withdrawal of the opposition pending proceedings, the case was closed.

Elini/Cellini : T-67/06 – Case closed; Order of 10 July 2008 (FR).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 4th Board of 12.12.2005 in R 0725/2004-4 relating to a conflict between Rolex SA and Elini NV . The latter had filed an application for "Elini" (figurative mark) and had claimed goods in Class 14, namely jewellery, watches, watch straps, watch glasses, watch cases and watch chains and precious stones.

CTM application

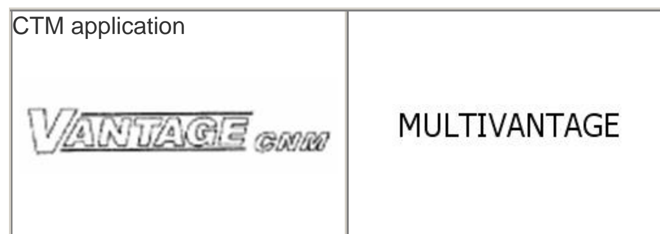
An opposition had been filed based on an earlier right in "Cellini" (figurative mark), registered inter alia in Class 14 for a wide range of goods, amongst which alloys of precious metal, amulets (jewellery), anchors (clock and watch-making), bracelets (jewellery), brooches (jewellery), buckles of precious metal, clock cases, clock hands (clock and watch-making), clocks, clocks and watches, electric clockworks, watch bands, watch cases, watch chains, watch crystals, watch glasses, watch springs, watch straps and wrist watches. Whereas the Opposition Division had rejected the opposition, the Board had allowed it in total. Upon withdrawal of the action, the case was closed.

Vantage CNM : T-171/07 – Case closed; Order of 2 June 2008 .

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

The action had been directed against a decision of the 2nd Board of 14.3.2007 in R 0156/2006-2 relating to CTM application "Vantage CNM" (figurative mark) which had been applied for in Class 9 for software for use in connection with integrated telecommunications network management, software for use in connection with analysing telecommunications networks, software for use in connection with analysing telecommunications network element performance, software for use in connection with ensuring the availability of sufficient bandwidth of telecommunications networks, software for use in connection with the configuration of telecommunications network elements; and in Class 42 for design and development of computer software.

CTM application



It had been opposed on the basis of CTM "MULTIVANTAGE", word mark, registered for goods and services in Classes 9, 38 and 42. The opposition had been rejected on the grounds that there is no LOC given the weakness of the earlier mark in relation to the goods and services at issue, on the one hand, and the differences which exist between the marks, on the other. Since the opponent and plaintiff in the action wished to discontinue proceedings, the case was closed.

Magic Seat : T-363/06 – Judgment of 9 September 2008 (action dismissed; Office practice confirmed).

Keywords: Opposition: likelihood of confusion (LOC) – Opposition: relevant public – Relevant public: attentiveness – LOC: impact of "reputation" of the earlier mark.

The action had been directed against a decision of the 1st Board of 7.9.2006 in R 0960/2005-1 relating to a conflict between an application filed by Honda Motor Europe Ltd which had been opposed by Seat SA. The mark for which registration had been sought is "MAGIC SEAT" (word mark), applied for "vehicle seats and vehicle seat mechanisms and parts and fittings and accessories for these goods" in Class 12. The CTM application had been opposed *inter alia* on the basis of figurative mark "SEAT", registered in Spain in Class 12 for "land vehicles, coupling and transmission components as well as other components and spare parts for land vehicles not belonging to other classes; apparatus for locomotion by land, air or water."

The opposition had been allowed, based on a finding that there was a likelihood of confusion between the trade mark applied for and the earlier mark, because the goods within Class 12 covered by the opposing mark(s) were identical and the conflicting marks similar. It had also been stated that the earlier mark had a high distinctive character in Spain on account of its reputation. The Board had added that, even if consumers did not directly confuse the two marks and noticed the differences between them, there was nevertheless a risk that consumers would associate them and assume that they had a common commercial origin. The 4th Chamber of the CFI (Czúcz, rapporteur; Cooke; Labucka) confirmed these findings.

(a) Comparison of marks

"(37) As regards the trade mark applied for, the Court finds that the word 'seat', reproduced in the word mark MAGIC SEAT, risks not being perceived by the relevant public, including those consumers who understand English, as the translation of the English word for seat, in so far as the word 'seat' immediately triggers an association with the name of the well-known Spanish car manufacturer Seat. Contrary to the applicant's assertions, it therefore risks being pronounced as a Spanish word with two syllables, and not as a monosyllabic English word.

(38) As to the applicant's argument that the Board of Appeal's assessment goes against the case-law according to which consumers will generally remember the beginning of a mark rather than the end, the Court would recall that that argument cannot hold in all cases (judgment of 16 May 2007 in Case T-158/05 Trek Bicycle v OHIM – Audi (ALL TREK), not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by those marks, since the average consumer normally perceives a trade mark as a whole and does not analyse the different aspects of it.

(39) Thus, as has been pointed out above, the word 'magic' will be perceived by the relevant public as a simple qualifier for the word 'seat' on account of its resemblance to the Spanish word 'mágico', which is purely laudatory. In that regard, it is settled case-law that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (Case T-129/01 Alejandro v OHIM – Anheuser-Busch (BUDMEN) [2003] ECR II-2251, paragraph 53, and Joined Cases T-117/03 to T-119/03 and T-171/03 New Look v OHIM – Naulover (NLSPORT, NLJEANS, NLACTIVE and NLCollection) [2004] ECR II-3471, paragraph 34). The argument that the relevant public will not pronounce 'magic seat' as a Spanish expression by virtue of the fact that the word 'magic' does not exist in that language must be rejected for the same reason."

(b) relevant public and level of attentiveness of the relevant public

"(61) The Court considers that the applicant, in putting forward those four factors, appears to be claiming that the relevant public's degree of attention is high, whether that public is professional or not, such that any confusion between the two conflicting marks would be avoided. In that regard, the Board of Appeal's assessment at paragraph 35 of the contested decision must be upheld, namely, that the likelihood of confusion between the two conflicting marks is in no way undermined by the fact that the public is mostly composed of specialists. As the Board of Appeal states, the trade in components and spare parts for motor vehicles is not restricted to authorised car dealers of one brand only, with the result that it cannot be ruled out that a Spanish car dealer or mechanic stocking up on components or spare parts from different manufacturers will assume that the goods marketed under the trade mark applied for come from Seat or from a manufacturer economically linked to Seat.

(62) Furthermore, although the relevant consumer's high degree of attention may, admittedly, lead him to be aware of the technical characteristics of car seats in order that he may ensure their compatibility with the relevant car model, it should be borne in mind that, taking into account the identity of the goods concerned, the similarity of the conflicting marks and the high distinctive character of the earlier trade mark, the fact that the relevant public may consist of professionals is not sufficient to rule out the possibility that they may believe that the goods come from the same undertaking or, as the case may be, from economically-linked undertakings (see, to that effect, ALADIN, paragraph 100). While the relevant public's high degree of attention implies that it will be well informed about vehicle seats and may thus avoid making mistakes regarding the compatibility of those seats with the relevant car model, it cannot prevent that public from believing that the seats bearing the MAGIC SEAT trade mark are part of a new range of products developed by the well-known Spanish car manufacturer Seat.

(63) Finally, as regards the argument based on the alleged failure by the Board of Appeal to take account of the expert statement of Mr G. from which it is clear, according to the applicant, that car seats are normally sold through an

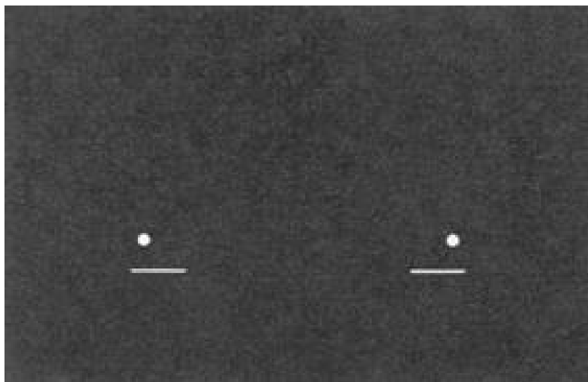
authorised dealer and sold either as original equipment or as aftermarket spare items, the Court finds that argument to be irrelevant because as particular marketing strategies for goods covered by the marks can vary over time and depend on the wishes of the proprietors of those marks, the prospective assessment of the likelihood of confusion between two marks cannot be dependent on marketing intentions, whether implemented or not, which are by their very nature subjective for the proprietors of the marks (judgment of 15 March 2007 in Case C-171/06 P T.I.M.E. ART v OHIM, not published in the ECR, paragraph 59).”

Car Silhouette - III : T-9/08 – Case closed; Order of 25 June 2008 (FR, DE).

Keywords: International Registration (IR): designation of the EU (IR-EU part) – IR-EU part: formal particularities – Absolute grounds for refusal: distinctiveness.

The action had been directed against a decision of the 4th Board of 6.11.2007 in R 1306/2007-4 relating to Volkswagen's designation of the EU within an International Registration. That International Registration was surrendered pending proceedings and, in consequence, the case was closed.

The representation of the mark had been the following:



Colours had not been claimed. Germany had been the Office of Origin, and the priority of the basic registration had also been claimed. The goods claimed had been motor vehicles in Class 12. The application had contained the following description: “The trademark illustrates the silhouette of a motor vehicle appearing in the dark through the use of an illuminated white dotted line and other areas of the vehicle that are also luminous.” German had been indicated as the second language for the purpose of the designation of the European Community.

On 9.10.2006, the examiner had issued a notice of provisional refusal of protection pursuant to Article 5 of the Madrid Protocol and Rule 113 CTMIR in conjunction with Article 7(1)(b) and Article 88(2) CTMR. He had stated that the mark was not eligible for registration because it lacked any distinctive character as it consisted exclusively of a schematic representation of a car and its lights. Also, the holder of the international registration was obliged to be represented before the Office and protection would be refused if a professional representative was not appointed within two months. The applicant had then filed a statement in German without translation into English despite an invitation to do so by the examiner. On 23.4.2007, the examiner had issued a refusal of protection pursuant to Articles 7, 38(2), 88(2) and 89(1) CTMR and Rule 11(3), 112(2) CTMIR for all the goods and services designated in the IR. The examiner further had refused to take into account the document in German and had stated that the failure to file a translation of it entailed refusal of “the application”.

The 4th Board had confirmed the decision on substance but had seen reason to elaborate in detail on the formal particularities underlying dealing with EU parts of international registrations. The Board said:

“(9) The contested decision shows several irregularities, which however do not influence the outcome of the case as the refusal of protection on the grounds of Article 7 (1) (b) CTMR has to be confirmed so that no other decision on substance than the contested decision can be taken (cf. CFI of 3 December 2003, T-016/02, ‘ TDI ', paragraph 97).

(10) The contested decision is correctly headed as an ex officio refusal of protection although Article 149 CTMR should have been quoted as the legal basis in addition, and Rule 112(4) CTMIR instead of Rule 112(2) CTMIR, which refers to disclaimers. The contested decision furthermore uses incorrect language insofar as it states that the CTM application is refused. The correct term is the refusal of protection of the international registration for the European Community (cf. Article 149(3) CTMR). This irregularity does not affect the legality of the decision as it is headlined as a refusal of protection, and quotes the correct absolute ground for refusal, namely Article 7(1)(b) CTMR.

(11) The contested decision is unclear as to whether the refusal was, in addition to Article 7(1)(b) CTMR, also based on Article 88(2) CTMR. This provision is quoted in the heading of the decision but no further mention of it is made in the body of the decision. The provisional refusal dated 9 October 2006 did mention that the holder had to appoint a professional representative under the said provision. That was obviously a mistaken, as the holder is vested in Wolfsburg, Niedersachsen, thus within the European Community.

(12) Although the holder failed to comply with the language rules before the examiner, the latter did not adequately deal with this subject in the contested decision. It is true that the holder of an international registration designating the European Community may not use the second language when replying to an ex officio provisional refusal on absolute grounds. This follows from Article 140 in conjunction with Article 115 CTMR and Rule 126 in conjunction with Rule 96(1) CTMIR, which allows the use of the second language in ex parte proceedings only if the first language is not a language of the Office.

(13) From the standpoint of the appellant, this is irrelevant as the Board will consider the statement of grounds including its attachment, namely the English translation of the statement of 5 December 2006 . From the standpoint of the examiner, it was, however, incorrect to refuse the application (*recte* : refuse the protection for the EC) on the ground that the

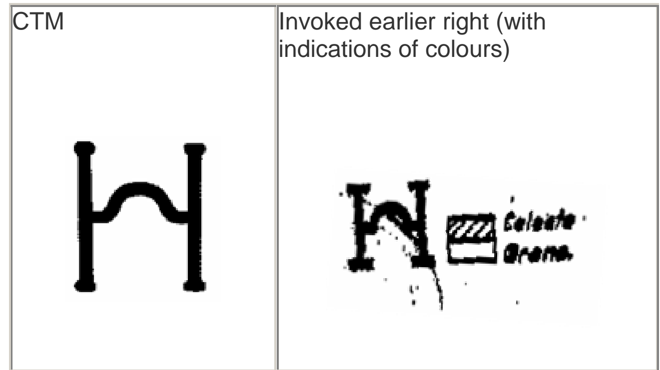
appellant did not translate the statement of 5 December 2006 into English. Under Rule 98(2) CTMIR, the document in the wrong language has to be disregarded and the holder has to be treated as if he has not replied at all to the notice of provisional refusal, which in itself is not a ground for refusal.

(14) An international registration under the Madrid Protocol must necessarily be based on a registration (or application) with the Office of Origin. Its protection may be refused under Article 5 of the Madrid Protocol on the grounds on which a national trade mark may be refused before a national office in accordance with the Paris Convention. This comprises the lack of distinctive character (corresponding to Article 7(1)(b) CTMR, cf. Article 6 quinquies (b)(1) of the Paris Convention). It is clear that an office designated in an international application may, or rather must, refuse protection of an international registration if it lacks any distinctive character. The existence of a basic registration is an inherent feature of the Madrid Protocol and a necessary feature of the Madrid Agreement and cannot, in itself, even be invoked under the notion of a previous national registration. The Madrid system is based on the principle that the designated offices are free to refuse protection on the applicable grounds for refusal and not bound by the mere fact that there is a basic registration. Therefore the appellant's references to the telle-quelle protection under Article 6 quinquies of the Paris Convention are devoid of relevance and the appellant also cannot expect the Office to accept the international registration solely because it is based on an existing basic registration, even if it is, as in the present case, obtained with a national office of a Member State of the EC. On the contrary, a lapse, such as a declaration of invalidity, of the basic registration would cause a lapse of the international registration (so-called central attack, Article 6(3) of the Madrid Protocol). In any case, the Boards are not bound by national registrations and their existence cannot oblige the Office to accept marks that are not registrable (Court of First Instance, Judgments of 27 February 2002 , T-106/00, 'Streamserve', paragraph 67; and of 14 June 2007 , T-207/06, 'Europig', paragraphs 40, 42)."

H/H : T-172/06 – Case closed; Order of 26 June 2008 (ES).

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

The action had been directed against a decision of the 4th Board of 24.4.2006 in R 0209/2004-4 relating to invalidation proceedings based on relative grounds initiated against CTM No 1 255 751, stylized letter H. It had been registered for a range of goods in Class3 1.



CTM	Invoked earlier right (with indications of colours)

It had been challenged on the basis of an earlier right in "H" (figurative mark), registered in Class 31. The CTM had been totally invalidated. Upon withdrawal of the action at pending proceedings, the case was closed.

Substance for Success : T-58/07 – Judgment of 9 July 2008 (only in FR, DE; action dismissed, Office practice confirmed).

Keywords: Type of marks: slogans – Absolute grounds for refusal: distinctiveness – Distinctiveness: slogans.

The action had been directed against a decision of the 4th Board of 9.1.2007 in R 0816/2006-4 relating to the application for "Substance for Success" in Classes 1, 40, 41 and 42 for a range of chemical products and services of a chemical manufacturer, including technical services and seminars. The application had been rejected on the ground that it is merely a laudatory advertising phrase and, thus, lacked distinctiveness under Article 7(1)(b) CTMR. The 4th Chamber of the CFI (Czúcz; Cooke; Labucka, rapporteur) confirmed the decision, relying on standard criteria.

Vorsprung durch Technik : T-70/06 - Judgment of 9 July 2008 (only in FR, DE; action dismissed, Office practice confirmed).

Keywords: Type of marks: slogans – Absolute grounds for refusal (AG): distinctiveness – Distinctiveness: slogans.

The action had been initiated against a decision of the 2nd Board of 16.12.2005 in R 0237/2005-2 relating to Audi AG´s CTM application "Vorsprung durch Technik" ('advantage based on technology') in Classes 9, 12, 14, 25, 28, 37 to 40 and 42. The application had been partially rejected on the ground that the slogan would be banal and would not convey more than a laudatory advertising message which could relate to any type of technology-related product. The 4th Chamber of the CFI (Czúcz; Cooke; Labucka, rapporteur) agreed, relying on standard criteria.

The Coffee Store : T-323/05 – Judgment of 9 July 2008 (only FR, DE; action dismissed, Office practice confirmed)

Keywords: Absolute grounds for refusal (AG): descriptiveness – AG: territorial aspects, Article 7(2) CTMR.

The case had been brought against a decision of the 2nd Board of 15.6.2005 in R 0855/2004-2 relating to CTM application “The Coffee Store”, word mark, for a range of goods and services in Classes 30, 32, 41 and 43. It had been rejected as regards Classes 30, 32 and 43 mainly on the ground that the sign at issue would not convey more than general information about a certain type of “vending point”, i.e. a generic indication of a type of shop, on the one hand, and a generic indication of the offered products and services on the other. The 5th Chamber of the CFI (Vilaras; Prek, rapporteur; Ciucá) agreed, relying on standard criteria.

Letter E : T-302/06 - Judgment of 9 July 2008 (only in FR, DE; action allowed; the decision will generate an effect on the examination of single letter applications).

Keywords: Types of marks: single letters – CTM applications: scope of examination on absolute grounds for refusal – Absolute grounds for refusal: assessment of the reference consumers.

The action had been directed against a decision of the 4th Board of 5.9.2006 in R 0805/2006-4 relating to a CTM application for the single letter “E” for a range of medicinal goods in Classes 5, 10 and 25. The application had been rejected on the ground that the simple letter E could convey a multitude of different information and, thus, is devoid of distinctive character within the meaning of trade mark law. The letter E could, for instance, be understood as a technical indication, an indication of a specific type or category of product, or of a specific size. As regards the assessment of the relevant public, it had been held that in respect of the claimed goods the relevant public would be a specialised one.

The 5th Chamber of the CFI (Vilaras; Prek; Ciucá, rapporteur) revoked the decision. It held, firstly, that notwithstanding that certain categories of signs generate greater difficulties in assessing their capacity as badge of commercial origin on the market there cannot be a standard rule that a specific category of signs lacked distinctiveness *a priori.* It follows from Article 74(1) CTMR *e contrario* that an ex officio examination on absolute grounds has to take place. Secondly, the Chamber referred to ECJ jurisprudence in BioID (C-37/03-P of 15.9.2005, ECR (2005) I-7975 paragraph 42), according to which the assessment of distinctiveness is an issue of fact. Absent any “household knowledge” as regards lack of distinctiveness in respect of the goods at issue and single letters in the eyes of the relevant public, the Office, in that individual case, had been under a duty to specify concrete facts in that regard; the rule in Picaro would not be applicable (CFI of 22.6.2004, T-185/02, ECR (2004) II-1739, paragraph 29). The Office had put forward the argument that part of the goods in question are products of mass consumption and, thus, the Picaro doctrine would be applicable to the end that in respect of that category of goods a generalised approach would suffice. The court dismissed this argument on the ground that the challenged decision had been solely based on the assumption of a specialised public.

Mozart : T-304/06 – Judgment of 9 July 2008 (dismissed; Office practice confirmed).

Keywords: CFI proceedings: restriction of the list of goods before the court – OHIM decision-making formalities, Article 73 CTMR: obligation to state reasons – Absolute grounds for refusal (AG): assessment – AG assessment: equal treatment? – AG assessment: protection of legitimate expectations? – AG assessment: impact of national practice – Absolute grounds for refusal: distinctiveness.

The case had been directed against a decision of the 2nd Board of 8.9.2006 in R 0097/2005-2 and concerned invalidity proceedings initiated against CTM “Mozart”, word mark, which had been registered in Class 30 for pastry and confectionery, chocolate products and sugar confectionery. A competitor had filed third party observations (under Article 41 CTMR) at the application stage. The application, however, had been allowed on 26.1.2000. On 27.9.2000, the Landgericht München-I (Munich Regional Court-I, Germany), as a CTM court within Article 91 CTMR, had informed the Office under Article 96(4) CTMR that, in proceedings before it between the CTM owner and a (different) competitor, a counterclaim for a declaration of invalidity of the CTM at issue had been filed, and on22.11.2000 the Landgericht München-I had sent a copy of its judgment of 15.11.2000, upholding the counterclaim and declaring CTM “Mozart” invalid.

On 14.11.2002, the competitor who had filed the Article 41 observations had filed a request for invalidation under Article 55 CTMR. On 8.9.2003 the Oberlandesgericht München (Higher Regional Court of Munich) had sent the Office a copy of its judgment of 26.7.2001 setting aside the judgment of 15 November 2000 of the Landgericht München-I and dismissing the counterclaim for a declaration of invalidity of the disputed mark. According to that letter, the judgment of 26.7.2001 had become final.

On 21.12.2004the Cancellation Division had declared the challenged CTM invalid, stating *inter alia* that the national appeal decision would not bear any impact on the European proceedings, and the Board had confirmed that decision. It had considered, essentially, that the mark applied for was ‘an objective indication that was purely descriptive of the products covered'. In that respect, it had noted that ‘detailed reasons were stated' in the Cancellation Division's decision and that the Board ‘agree[d] with its reasons and [had] little to add'. Since the CTM owner had acknowledged that the term ‘Mozartkugeln' was generic and descriptive in Germany and Austria, it was ‘hard to imagine that German and Austrian consumers, confronted with the name Mozart on the packaging of a product in a confectioners or the chocolate section of a supermarket, would not assume that it was Mozartkugeln that were being offered for sale'. The 5th Chamber of the CFI (Vilaras, rapporteur; Prek; Ciucá) confirmed these findings.

(a) CFI proceedings: restriction of the list of goods and services before the court?

"(25) It follows that, in principle, a restriction within the meaning of Article 44(1) CTMR to the list of goods or services contained in a Community trade mark application made after the adoption of the decision of the Board challenged before the Court cannot affect the legality of that decision, which is the only decision being challenged before the Court (see, to that effect, the order in BUDWEISER, cited in paragraph 23 above, paragraphs 40 to 48, and Case T-458/05 Tegometall International v OHIM – Wuppermann (TEK) [2007] ECR II-0000, paragraph 23).

(26) It must also be noted, however, that the decision of a Board can be challenged before the Court in relation solely to some of the goods or services in the list given in the CTM application concerned. In such a case, that decision becomes final in respect of the other goods or services on the same list.

(27) Having regard to that possibility, the Court has interpreted a statement made to it by a trade mark applicant, and therefore subsequent to the decision of the Board of Appeal, that it was withdrawing its application in respect of some of the goods covered by its initial application, as a statement that the contested decision was being challenged only in so far as it covered the remainder of the goods concerned (see, to that effect, Case T-289/02 Telepharmacy Solutions v OHIM (TELEPHARMACY SOLUTIONS) [2004] ECR II-2851, paragraphs 13 and 14), or as a partial withdrawal, where the statement was made at an advanced stage of the proceedings before the Court (see, to that effect, Case T-194/01 Unilever v OHIM (Ovoid tablet) [2003] ECR II-383, paragraphs 13 to 17).

(28) Such an interpretation of a restriction, before the Court, of the list of the goods and services covered by a CTM is possible only if the applicant confines itself to withdrawing one or more goods or services from the list, or one or more categories of goods or services which were included, as such, in that list. In such a case, it is clear that the Court is in fact being asked to review the legality of the Board´s decision not in so far as it relates to the goods or services withdrawn from the list but only in so far as it relates to the other goods or services remaining on that list.

(29) That situation should be distinguished from a restriction, before the Court, of the list of goods or services contained in a Community trade mark application, the object of that restriction being to change, in whole or in part, the description of those goods or services. In the latter case, it is possible that the alteration might have had an effect on the examination of the trade mark in question carried out at various stages by OHIM in the course of the administrative procedure. Accordingly, to allow that alteration at the stage of the action before the Court would amount to changing the subject-matter of pending proceedings, which is prohibited by Article 135(4) of the Rules of Procedure (see, to that effect, TEK , cited in paragraph 25 above, paragraph 25).

(30) In the present case, the applicant had sought registration of the disputed trade mark for four categories of goods, namely goods denoted as 'Pastry and confectionery, chocolate products, sugar confectionery'. The restriction set out in the applicant's alternative claim does not provide for withdrawal of one or more of those four categories from the list of goods covered by the mark at issue, but is intended to alter the description of all of the categories of goods concerned, by specifying that the goods falling within those categories are not to be presented in the form of balls of marzipan and praline coated in chocolate, called 'Mozartkugeln' – in German. As stated above, to hold that claim admissible at the stage of the action before the Court would amount to changing the subject-matter of the proceedings, which is prohibited (see, to that effect, TEK , cited in paragraph 25 above, paragraph 27).

(31) The applicant's alternative claim must therefore be rejected as inadmissible."

(b) Infringement of the first sentence of Article 73 and of the principles of protection of legitimate expectations, equal treatment and legality?

"(45) As regards the legal rules applicable in CTM matters, it should be noted that decisions concerning registration of a sign as a CTM which the Boards are called on to take under (the CTMR) are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the question whether a sign may be registered as a CTM must be assessed solely on the basis of that regulation, as interpreted by the Community Courts, and not on the basis of a previous practice of the Boards. Moreover, since the CTM regime is an autonomous system neither OHIM nor, as the case may be, the Community Courts are bound by a decision adopted in a Member State finding the same sign to be registrable as a national trade mark. Registrations already made in the Member States are therefore a factor which may only be taken into consideration, without being given decisive weight. Those considerations apply a fortiori to the registration of other marks (see Case T-127/02 Concept v OHIM (ECA) [2004] ECR II-1113, paragraphs 70 and 71 and the case-law cited).

(46) It follows from the preceding considerations that, when OHIM refuses registration of a sign as a Community trade mark, it must, in order to state the reasons for its decision, indicate the ground for refusal, absolute or relative, which precludes that registration and the provision from which that ground is drawn, and set out the facts which it found to be proved and which, in its view, justify application of the provision relied on. Such a statement of reasons is, in principle, sufficient to satisfy the requirements set out in paragraphs 43 and 44 above.

(47) In addition, the Court would point out that, when the Board confirms a lower-level decision of OHIM in its entirety, that decision, together with its statement of reasons, forms part of the context in which the Board's decision was adopted, which is known to the parties and enables the Court to carry out fully its judicial review as to whether the Board's assessment was well founded (see, to that effect, the judgment of 21 November 2007 in Case T-111/06 Wesergold Getränkeindustrie v OHIM – Lidl Stiftung (VITAL FIT) (not published in the ECR), paragraph 64).

(48) Also, more generally, it can be considered that sufficient reasons have been given for a decision where the decision refers expressly to another document that has been communicated to the applicant (see, to that effect, Joined

Cases T-551/93 and T-231/94 to T-234/94 Industrias Pesqueras Campos and Others v Commission [1996] ECR II-247, paragraphs 142 to 144; Case T-137/01 StadtsportverbandNeuss v Commission [2003] ECR II-3103, paragraphs 55 to 58; and Case T-146/04 Gorostiaga Atxalandabaso v Parliament [2005] ECR II-5989, paragraphs 135 and 136)."

(64) According to case-law, the principle of the protection of legitimate expectations extends to any individual in a situation where it is clear that the Community administration has, by giving him precise, unconditional and concordant assurances, emanating from authorised and reliable sources, led him to entertain justified hopes (see Case T-203/97 Forvass v Commission [1999] ECR-SC I-A-129 and II-705, paragraph 70 and the case-law cited, and Case T-319/00 Borremans and Others v Commission [2002] ECR-SC I-A-171 and II-905, paragraph 63). However, such assurances must comply with the applicable provisions and rules, since promises which do not take account of those provisions cannot give rise to a legitimate expectation on the part of the person concerned (see Case T-205/01 Ronsse v Commission [2002] ECR-SC I-A-211 and II-1065, paragraph 54, and Case T-329/03 Ricci v Commission [2005] ECR-SC I-A-69 and II-315, paragraph 79 and the case-law cited; see also, to that effect, Case 162/84 Vlachou v Court of Auditors [1986] ECR 481, paragraph 6).

(65) Likewise, observance of the principle of equal treatment must be reconciled with observance, specifically, of the principle of legality, also relied on by the applicant. According to the latter principle, no person may rely, in support of his claim, on an unlawful act committed in favour of another (Case 134/84 Williams v Court of Auditors [1985] ECR 2225, paragraph 14; see also, to that effect, Case 188/83 Witte v Parliament [1984] ECR 3465, paragraph 15).

(66) In the present case, the applicant did not indicate clearly in its application if it took the view that the considerations in the decision of the Third Board 10 April 2002, relied on in its arguments, were compatible or not with the criteria for the application of Article 7(1)(c) CTMR.

(67) In so far as the applicant's argument must be understood as meaning that, having regard to the considerations set out in the Third Board's decision of 10 April 2002, the Board was required, in this case, not to apply Article 7(1)(c) CTMR, although its application was justified, such an argument cannot be accepted. According to the case-law set out in paragraphs 64 and 65 above, if, in an earlier case, one of OHIM's Boards has committed an error of law in accepting the registrability of a sign as a Community trade mark, none of the principles relied on by the applicant preclude the adoption, in a later case comparable to the previous one, of a contrary decision (see, to that effect, Case T-106/00 Streamserve v OHIM (STREAMSERVE) [2002] ECR II-723, paragraph 67, and the judgment of 30 November 2006 in Case T-43/05 Camper v OHIM – JC (BROTHERS by CAMPER) (not published in the ECR), paragraph 95)."

Color Edition : T-160/07 – Judgment of 8 July 2008 (only in FR; action dismissed; Office practice confirmed).

Keywords: Cancellation proceedings: formalities – Cancellation formalities: legal interest to act as a precondition? – Absolute grounds for refusal: descriptiveness.

The action had been brought against a decision of the 2nd Board of 26.2.2007 in R 0231/2006-2 relating to invalidation proceedings initiated by a law firm in its own name against CTM "Color Edition", registered in Class 3 for, *inter alia* , cosmetics. Whereas the Cancellation Division had rejected the request, the Board had allowed it on the following grounds: The wording of and the motives behind Article 55 CTMR do not require any additional formal precondition (like a "specific legal interest") as regards filing of a request for invalidation on absolute grounds. On the contrary, the scope of possible requestors is unlimited since the said provision exists in the public interest. The mark at issue is descriptive for the goods claimed in that it does no more than conveying the general and directly understandable message that they consist of products containing different "tones" of colour for various cosmetic purposes. The 2nd Chamber of the CFI (Pelikánová; Jürimäe, rapporteur; Soldevila Fragoso) confirmed that stance.

Isdin : Joined cases T-354/07 and T-356/07 – Order of 26 June 2008 (only ES; case closed).

Keywords: CFI proceedings: impact of revocation of the challenged mark at pending proceedings – Opposition/invalidation on relative grounds – Revocation.

The case concerned three decisions of the 1st Board of 28.7.2007, namely R 0567/2006-1, R 0566/2006-1 and R 0565/2006-1, relating to invalidation proceedings initiated by Pfizer Ltd. against Isdin SA, proprietor of the following CTMs: "Fotoprotector Isdin" (No 1 075 597), "Isdin Pediatrics" (No 1 243 807) and "Isdin 14-8.000" (No 1 243 633). The goods which had been at issue in the proceedings are in Class 5. The earlier mark relied upon was "Istin", protected for a range of goods in Class 5. Whereas the Cancellation Division had partially allowed the requests, the Board had rejected them. The applicant for invalidity had subsequently lodged an appeal and, in parallel, had initiated revocation proceedings based on non-use against the CTMs in question which had been successful. Since the defendant declared that it would not appeal the respective decisions, the revocation became final. In consequence, the case at issue here was closed.

Dream it, Do it ! : T-186/07 - Judgment of 2 July 2008 (action dismissed; Office practice confirmed).

Keywords: General principles: basic function of a trade mark – Absolute grounds for refusal: relationship between Article 7(1)(b) and 7(1)(c) CTMR – Absolute grounds for refusal: distinctiveness – Distinctiveness: slogans.

The action had been brought against a decision of the 1st Board of 15.3.2007 in R 0635/2006-1 relating to a CTM application for the slogan “Dream it, Do it !” for the following range of services in Class 35: promoting and providing professional assistance to individuals for the exchange of socially progressive ideas regarding public entrepreneurship and with pattern-changing ideas in a variety of fields including social, economic and environmental disciplines; Class 36: financial assistance to individuals and organisations for the exchange of socially progressive ideas regarding public entrepreneurship and with pattern-changing ideas in a variety of fields including social, economic and environmental disciplines; charitable services (fundraising); in Class 41 for educational services, namely publishing, and in Class 45 for social services. The application had been rejected.

The Board had held, essentially, that the slogan applied for ‘transmit[ted] the message that the services applied for [would] allow the consumer to fulfill [his] dreams' and that it ‘animat[ed] the consumer to realise [his] dreams; it encourage[d] him to try to achieve them'. The Board had therefore concluded that the mark ‘function[ed] first and foremost as an incitement addressed to the relevant public aiming to promote the services in question' and that, therefore, ‘there [was] no reason to believe that the potential customer [would] see these words as forming a trade mark denoting a particular commercial source of the services concerned'. The Board had finally concluded that it followed that ‘the sign applied for as a whole [did] not have the capacity to communicate to the relevant consumers that [the] services with which it [was] to be used [were] those of the applicant and [could not] serve the basic function of a trade mark', and that the presence of an exclamation mark at the end of the expression constituting the trade mark applied for could not alter that finding, since it was a form of punctuation often used at the end of exhortatory and promotional formulas. The 5th Chamber of the CFI (Vilaras, rapporteur; Prek; Ciuca) confirmed the Board's decision.

(a) Basic function of a trade mark

“(21) According to case-law, the signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as being incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition (Case T-79/00 Rewe-Zentral v OHIM (LITE) [2002] ECR II-705, paragraph 26, and Case T-34/00 Eurocool Logistik v OHIM (EUROCOOL) [2002] ECR II-683, paragraph 37). That is true, in particular, for signs which are commonly used in the marketing of the goods or services concerned (LIVE RICHLY, cited in paragraph 13 above, paragraph 65).

(22) The registration of a mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use (Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 41, and LIVE RICHLY, cited in paragraph 13 above, paragraph 66).

(23) However, a sign which, like an advertising slogan, fulfils functions other than that of a trade mark in the traditional sense of the term is distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 only if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin (see Case T-216/02 Fieldturf v OHIM (LOOKS LIKE GRASS … FEELS LIKE GRASS … PLAYS LIKE GRASS) [2004] ECR II-1023, paragraph 25, and LIVE RICHLY, cited in paragraph 13 above, paragraph 66 and the case-law cited).

(24) Moreover, the distinctive character of a mark must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS, cited in paragraph 23 above, paragraph 26, and LIVE RICHLY, cited in paragraph 13 above, paragraph 67).”

(b) Relationship between Article 7(1)(b) and 7(1)(c) CTMR

“(36) The question of ascertaining whether that message is, or is not, directly descriptive of the services in question within the meaning of Article 7(1)(c) of Regulation No 40/94 is not, as such, relevant in the context of the absolute ground for refusal referred to in Article 7(1)(b) of that regulation. The absolute ground for refusal referred to in Article 7(1)(b) of Regulation No 40/94 concerns a separate issue, namely that of ascertaining whether the relevant public will see, in that message, an indication of the commercial origin of the services in question.

(37) That is not, however, the situation in the present case. Having regard to its content, the trade mark applied for will, undoubtedly, be perceived by the relevant English-speaking public as a promotional and advertising slogan, which could refer to services of various commercial origins. That is all the more probable as the trade mark applied for calls clearly to mind notions of action and dynamism, by following the first order, ‘dream it', with a second, short and urgent, order, ‘do it!', which refers to the idea of a swift achievement of that which has just been dreamed of. On account of the positive and attractive characteristics of the concepts of action and of dynamism, advertisements often refer to them, even in the context of goods or services for which those concepts do not appear, at first glance, to be relevant.”

Stradivarius : T-340/06 - Judgment of 2 July 2008 (only in IT, FR; action dismissed; Office practice confirmed).

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

The action had been directed against a decision of the 1st Board of 7.9.2006 in R 1024/2005-1 relating to CTM application “Stradivari 1715” (figurative mark) which had been applied for for a range of goods in Classes 14, 16 and 18.

<table>
<tr><td>CTM application
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It had been opposed on the basis of an earlier CTM, “Stradivarius” (figurative mark), which is registered for a range of goods in Classes 14 and 16. The opposition had been rejected on the grounds that the marks in question are dissimilar enough to prevent any LOC. The 8th Chamber of the CFI (Martin s Ribeiro; Papasavvas, rapporteur; Wahl) agreed, relying on standard criteria.

Clover (HiQ with trefoil) : T-37/06 - Case closed; Order of 9 April 2008 (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 2nd Board of 22.11.2005 in R 1130/2004-2 relating to an opposition case between CTM application “HiQ” (figurative mark) and several clover marks of Meggle.

<table>
<tr><td>CTM application
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The CTM had been applied for for micro-encapsulated oils not for the preservation of food stuffs; baby and infant food formulae; digestives for pharmaceutical purposes; medicinal drinks; flour for pharmaceutical purposes; meal for pharmaceutical purposes; albuminous milk; nutritional additives for medical purposes; vitamin preparations; dietetic substances including food and beverages adapted for medicinal purposes; biological and dietary food preparations; food supplements; food additives; medicinal oils in this class; nutritional and dietetic in Class 5. Further, for albumen for food; alginates for foods; butter; butter cream; cheese; coconut butter, fat and oil; desiccated coconut; corn oil; cream; crystallised fruits; edible fats and oils; eggs; products made from fish; preserved fish; tinned fish; frosted fruits; frozen fruits; fruit jellies; fruit preserved in alcohol; fruit salads; fruit pulp; preserved fruit; stewed fruit; gelatin for food; preserve garden herbs; jellies for food; vegetable juices for cooking; lard for food; maize oil; margarine; preserved meat; tinned meat; salted meat; milk products in this class; olive oil for food; palm kernel oil for food; palm oil for food; nuts in this class; pectin for food; protein for human consumption; rape oil for food; sesame oil; soup; suet for food; sunflower oil for food; tofu; preserved vegetables; tinned vegetables; whey; yoghurt, in Class 29. Finally, for aromatic preparations for food; beverages; biscuits; cakes; confectionary; coffee based preparations in this class; cookies; popcorn; breakfast cereals; couscous; flavourings, other than essential oils; glucose for foods; gluten for food; groats for human food; pasta; rice and rice products; malt extract for food; malt for food; mustard; muesli; oat-based food; pastries; puddings; pizzas; sago; seasonings; soy-based products in this class; starch products for food; tapioca; spices in Class 30.

The earlier rights are registered in Classes 1, 3, 5, 29, 30, 31, 32 and 33.

The CTM applicant did not submit any observations in reply. The Opposition Division had rejected the opposition on the ground of sufficient visual dissimilarity of the marks at issue in order to exclude LOC, and the Board had confirmed that finding. Since the opponent (plaintiff) withdrew the opposition pending proceedings, the case was closed.

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

Botella Esmerilada Blanca or **Frosted White Bottle -I** : T-109/08 (follow-up of T-190/04) – Office response filed (FR).

Keywords: Types of signs: specific (surface of a bottle) – Absolute grounds for refusal: distinctiveness.

The action relates to a decision of the 1st Board of 30.10.2007 in R 0097/2001-1 concerning CTM application No 32 532. On 1.4.1996, Freixenet SA had filed an application for a “specific” type of mark, neither figurative nor three-dimensional. The representation is the following:

In the description of the sign, it had been stated that the surface would be white but once the bottle is filled with wine it would show a specific golden appearance. The applicant had disclaimed any right in the shape; it had only claimed "the specific appearance of the surface". The goods claimed are wines in Class 33.

The application had been rejected on the ground of Article 7(1)(b) CTMR. On appeal, the 4th Board had confirmed that decision (in its decision of 11.2.2004 in R 0097/2001-4). On subsequent appeal, the CFI had revoked the Board's decision on the ground of infringement of the right to be heard, Article 73 CTMR (judgment of 4.10.2006 in Case T-190/04). The case then had been assigned to the 1st Board which, on substance, had reached the same conclusion as the 4th Board.

Botella Esmerilada Negra or **Surface of a Bottle -II** : T-110/08 (follow-up of T-188/04) – Office response filed (FR).

Keywords: Types of signs: specific (surface of a bottle) – Absolute grounds for refusal: distinctiveness.

The action relates to a decision of the 1st Board of 20.11.2007 in R 0104/2001-1 concerning CTM application No 32 540. On 1.4.1996, Freixenet SA had filed an application for a "specific" type of mark, neither figurative nor three-dimensional. The representation is the following:

The factual background is the same as above in T-109/08. The 4th Board had confirmed rejection on 11.2.2004 in R 0104/2001-4, and the CFI had revoked that decision on 4.10.2006 in Case T-188/04.

Aurelia : T-136/08 – Office response filed.

Keywords: CTM formalities: time limits – CTM formalities: request for restitution in integrum, Article 78 CTMR – Restitutio in integrum: standard of due care – Restitutio in integrum: responsibility of the representative.

The action is directed against a decision of the 1st Board of 9.1.2008 in R 1214/2007-1 relating to renewal formalities concerning CTM No 274 936, word mark "Aurelia". The registration had been due to expire on 19.6.2006. On 21.11.2005, the Office had reminded the owner's representative of the possibility to renew the registration, noting that the relevant request and the renewal fee had to be received before 2.7.2006 and adding that, upon payment of an additional fee for late payment, the original deadline could be extended until 2.1.2007. On 22.1.2007, the Office then had notified the representative of the expiry of the relevant deadline and of the subsequent removal of the CTM from the register, which had taken effect as of 19.6.2006.

On 5.3.2007, the owner had filed a request for a restitutio in integrum within Article 78 CTMR, explaining why it had been unable to observe the time-limit for the renewal of its registration. At the same time, it asked the Office to deduct the corresponding renewal and reinstatement fees from its current account.

By decision dated 1.6.2007, OHIM's Trade Marks and Register Department (TMRD) had dismissed the application for restitutio in integrum on the ground that the owner's representative had not shown all due care required by the circumstances with regard to the failure to observe the renewal of the time limit at issue. On subsequent appeal, the Board had confirmed the TMRD.

Magic Butler : T-123/08 – Office response filed (DE).

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

The action has been brought against a decision of the 1st Board of 7.1.2008 in R 1508/2006-1 relating to CTM application No 4 109 906, word mark "Magic Butler", which had been applied for for a range of goods in Classes 7 and 21. It had been opposed on the basis of two earlier rights in Community trade marks "Magic Bullet" and "The Magic Bullet", both registered as word marks in Class 7. The application had been rejected for all goods. The Board had stated that the marks would not be understood conceptually on non-English speaking markets within the European Union and, thus, had to be considered similar in the view of end-consumers in those markets.

NEW DECISIONS FROM THE BOARDS OF APPEAL

The cases can be found in our website.

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

Please note that the full number including slash has to be entered in our database under 'Appeal Nº', without the letter

'R'.

e.g. Case R 219/2004-1 has to be entered under 'Appeal Nº' as: 219/2004-1

I - Procedural issues

R 1939/2007-1 TEMPTATION FOR MEN YANBAL (fig.) / TENTATION

II - Ex-parte – Article 7(1)(b) CTMR

R 1768/2007-1 a device of a small container – 3D

III - Inter-partes – Articles 8(1)(b) and 108 CTMR

R1313/2006-G cardiva

I - Procedural issues

Opposition proceedings – proof of use – use not as registered – element which alters distinctiveness

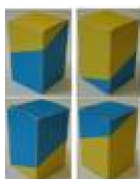
Decision of the First Board of Appeal of 29 July 2008 in Case R 1939/2007-1 (Spanish)

R 1939/2007-1 TEMPTATION FOR MEN YANBAL (fig.) / TENTATION – (es) – the Board considered that use of the earlier trade mark " TENTATION" in the form "TENTATIONS" did not alter the distinctive character of the registered trade mark, and that such use fell within the meaning of Article 15(2)(a) CTMR . It held that the addition of the letter "S" to the end of the trade mark did not substantially alter the visual appearance, the pronunciation or the conceptual impression of the trade mark for the Spanish consumer. The case was remitted to OHIM's trade mark department for further prosecution.

II - Ex-parte – Article 7(1)(b) CTMR

Absolute grounds for refusal – three-dimensional (3D) marks – distinctiveness – packaging

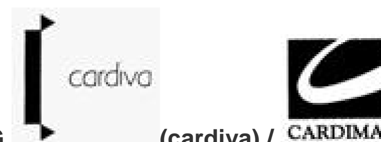
Decision of the First Board of Appeal of 24 May 2008 in Case R 1768/2007-1 (German)

R 1768/2007-1  **(a device of a small container – 3D) – (de) –** the Board decided that a 3D mark in the form of a box with yellow-blue packaging ´get-up´ (as illustrated) is distinctive for bulbs and cars' bulbs in Class 11. The contested decision was annulled and the sign applied for allowed.

III - Inter-partes – Articles 8(1)(b) and 108 CTMR

Opposition proceedings – scope of the proceedings – principle of complementary protection systems – conversion – national law – likelihood of confusion – similarity of signs – similarity of goods and services – specialized public

Decision of the Grand Board of 15 July 2008 in Case R 1313/2006-G (English)

R1313/2006-G 

(cardiva) / – (en) – in the case at hand, the figurative mark applied for ('cardiva') for Classes 10, 35 and 39 was opposed on the basis of the earlier CTM application 'CARDIMA' (fig.) for goods and services in Classes 9, 10 and 42.

Opposition proceedings were suspended because the earlier CTM application 'CARDIMA' was itself the subject to opposition proceedings based on three Spanish figurative trade marks owned by Cardiva S.L. and identical to the CTM application. The Opposition Division's decision restricted registration of the CTM application 'CARDIMA' to a limited list of services in Class 42, namely *'scientific, medical and surgical research and consultancy services'* .

The opponent informed the Office that, for the refused goods in Classes 9 and 10, conversion of the CTM application had been requested in several Member States. The Opposition Division considered that the opposition could not be considered as being based on the pending national applications, since the original earlier right on which the opposition was based had partially ceased to exist - the subsequent national applications (for Classes 9 and 10) being autonomous and independent, and indeed never cited as the basis of the opposition.

Thus, the Opposition Division considered that the only basis for the opposition was the CTM 'CARDIMA' registered for services in Class 42. It upheld the opposition for the contested goods in Class 10 namely *'surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopaedic articles; suture materials'* and rejected the opposition for the remainder, holding that the CTM application 'CARDIVA' could proceed for the services in Classes 35 and 39.

The CTM applicant filed an appeal against this decision partially to uphold the opposition. The opponent, in turn, asserted that the national rights resulting from conversion of its CTM application should also have been accepted as a basis for the opposition. As the case posed a question of major legal importance (i.e., whether an opposition, which

was originally based on a CTM application that was later converted into national trade mark applications and registrations for some of the goods and services, can be maintained as based on the national rights issuing from the said conversion), the case was remitted to the OHIM Grand Board of Appeal.

The Grand Board decided that the answer to this procedural question, which is not clear from the text of either the CTMR or the CTMIR, should be positive. When dealing with an opposition based on a CTM application filed against another CTM application, the Opposition Division must consider treat not only the CTM application but also potentially the national trade marks resulting from a conversion as the basis for the opposition.

The Grand Board's reasoning was made in light of Articles 8(2), 32, 108 (1), (2), (4), (5) and (6) CTMR (the principle that the Community and national trade mark systems are complementary) and specific case-law of the CFI (Case T-191/04 MIP METRO) . In holding that an opposition based on an earlier CTM application can be maintained on the basis of material trade mark registrations resulting from the conversion of the CTM application, the Grand Board's conclusion differed from Office practice (see Opposition Guidelines)

The Grand Board therefore revoked the contested Opposition Division decision in so far as it did not take into consideration UK trade mark registration No 2 295 544 for goods in Classes 9 and 10 and Benelux trade mark registration No 200 291 for goods in Classes 9 and 10.

As regards the comparison of the goods and the signs and the likelihood of confusion, the Grand Board thus held that the CTM application at issue must be compared with the list of goods of the earlier trade marks as registered both as for the CTM cited as an earlier right and for the national trade marks resulting from conversion of that CTM. The Grand Board found that the signs were similar from a visual and phonetic point of view and no conceptual comparison was possible; the goods covered by the contested trade marks were identical or highly similar and that the degree of attention of the relevant public was particularly high due to the fact that it is specialised in the medical sector. In light of these factors, the Board concluded that a likelihood of confusion exists, that the opposition must be upheld and the CTM application rejected for all the following goods: *'surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials'* (Class 10). The appeal was dismissed.