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Opposition Proceedings: the case for change

A number of measures have been introduced to streamline the handling of opposition proceedings, which are launched when a Community Trade Mark is challenged in the three-month period after publication.

This year the Office expects to deal with around 15,000 opposition files, around half of which will be resolved during the "cooling off period", when the opposing sides are encouraged to reach an agreed settlement.

The changes, which took effect on 17 September, will:

- simplify the admissibility check process
- provide decisions on the awarding of costs when either an opposition or a CTM application is withdrawn
- reduce the administrative burden in asking for repeated renewals of suspensions

The Office is now also strictly enforcing the rule (79a CTM IR) that copies are provided of all documents submitted in *inter partes* proceedings, unless the documents are transmitted by fax. If the required copy is not provided, the document will be rejected.

The streamlined admissibility process involves checking that all absolute requirements are met; that the opposition is based on at least one existing trade mark or pre-existing right that complies with the relative requirements for admissibility; if the extent of the opposition has been properly indicated; and, in cases where the opposing side is from outside of the European Union, whether or not they are represented. In addition, the Office will now accept class numbers as sufficient indication of the goods and services in the earlier rights on which the opposition is based.

These changes in the admissibility examination only affect oppositions against direct CTM applications. Different legal rules apply for oppositions against designations of the EC under the Madrid Protocol, and the admissibility checks for these oppositions will remain unchanged.

Up until this change the Office could in some cases have been checking several trade marks in an opposition procedure. A problem with just one of them resulted in a deficiency letter being issued, causing a delay of some three months.

Director of the trade marks and cancellations department Beate Schmidt says: "We found we were issuing deficiency letters in nearly 15% of cases – sometimes for minor omissions – whereas in only one or two per cent of cases do oppositions fail for this kind of reason. Now applicants for Trade Marks should get earlier information about disputed registrations."

A move to providing cost decisions when oppositions or CTM applications are withdrawn – unless the Office is informed in advance that a cost agreement has been reached – will allow OHIM to close the files earlier without affecting the ability of the parties involved to reach voluntary cost agreements.

The procedure for requesting a renewal of suspensions has also been made more flexible. In order to avoid repeated requests for suspensions every two months, when a suspension is renewed it will be for a period of one year, with provisions for either of the parties to opt out and end the suspension on giving 14 days' notice.

"The combined effect of these changes will be to make opposition proceedings more transparent and efficient, and give CTM applicants earlier warning of oppositions," says Schmidt.

The James Nurton Interview with Peter Kjaer

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*. He has collaborated with the OHIM for many years in the preparation, drafting and revision of editorial content for a number of the Office's publications and, in March 2007, he began publishing a monthly Alicante News interview with CTM and RCD users, giving readers a first-hand insight into how the OHIM and its services are perceived by those dealing directly with the Office.

This month, James interviews Peter Kjaer, deputy general counsel of the LEGO Group, the world's sixth largest manufacturer of toys, which is headquartered in Billund, Denmark.

**How many CTMs do you file?**

Since we are a one-brand company, we probably don't file as many trade marks as many other companies. We typically file about one to five CTMs a year, and have approximately 5,000 trade mark registrations in total. We protect our main brand LEGO and our main sub-brands, such as MINDSTORMS and BIONICLE.

The LEGO logo has changed slightly a couple of times in its lifetime. It was adopted in the 1940s and has been present in its current form since the 1970s.

Is it easy to protect?

In general, yes. We don't have many issues with the LEGO word or logo compared to other trade marks.

Do you file directly?

Typically we file through local advisers in Alicante. It's both a resource and expertise issue: given the relatively low number of filings per year, it makes sense.

Are you happy with the speed and service at OHIM?

We're pretty happy with it. The Danish PTO is considered to be very quick but it's not really a comparison. Many PTOs are much slower. OHIM is reasonably fast on average.

What about the fees?

The fees have recently been lowered. Wearing my trade mark portfolio administrator's cap, I can say that lower fees is a good thing. But I can also see the risks of reducing fees further – people may file CTMs instead of national marks and that would block the system. However, we would certainly not want the fees to be any higher.

Where are improvements needed?

The one area where it is obvious to work further is speed. There is room for improvement and OHIM's directors have said it is working on speeding up the registration process. I don't see any other area for improvement.

Do you use electronic filing?

We use it but not a lot. But it is just a matter of getting accustomed.

What has been your experience with filing 3D marks?

We have registrations for an eight-knob brick as a 3D mark – which has been one of the most interesting and challenging trade mark experiences we have had in the company. We started to see cancellation actions in both the CTM and national systems. It is very challenging to maintain the marks because of the issue of alleged functionality. We don't think it's functional but others do.

We think it's important because we tend to consider the eight-knob brick as something that consumers associate with the LEGO Group, and we don't like to see other companies using it as a source indicator. We also think that it's particularly distinctive so we definitely think that the mark should stay on the register. There are also other elements we might consider.

Do you see this as a test case for 3D marks?

It is a test case but it is also the obvious one for us – we think it is the one LEGO element that most people associate with the LEGO Group. Since the Grand Board did not agree there

is a bit of a conflict there. We thought an oral hearing would have been efficient for us and we did not get that. We're now at the Court of First Instance so we will see what happens there.

Do you file other non-traditional marks?

We tend to consider the colours as part of what people recognize but they are not normally registered.

Do you register Community designs?

We don't have a lot and we also use national registrations. We don't go as much as for trade marks. There is a much lower number of countries. But we'll probably see the number of registrations increasing in coming years.

Do you prefer the CTM or the national route?

It will depend on the mark and the expected use of the mark. We often use the CTM as opposed to national marks, but things like slogans might be filed nationally because of the language. As a rule we use the CTM system in Europe: the number of countries we can get in one go and the price is fairly competitive.

What are the disadvantages of the CTM?

It's quite an administrative task to be able to prove use in a number of countries – it is expensive and time-consuming to conduct consumer surveys. It is probably unavoidable though and we wouldn't want less proof of use as that would lead to registrations clogging the system.

Do you use the Madrid Protocol?

We do use it and it depends on the type of mark. For a mark we want globally protected, we would probably file an international registration and designate the CTM. We look at it case-by-case.

What's your background?

I've worked with LEGO since 1995 and my main experience has been outside the IP area. I currently head up the IP section of the legal department. I'm not so much into the details of trade marks but I have a good sense of how the company and customers think of them. My background is commercial. I came straight out of university to LEGO and my experience has been mainly in the commercial area.

How big is your IP department?

We have four lawyers and six paralegals working primarily in portfolio creation, administration and enforcement. They work with our outside advisers. There is a lot of administration regarding use and optimizing our abilities to enforce marks.

Is counterfeiting a big problem?

It depends on how you define it. We rarely see trade mark infringement. A lot of products coming out of China copy one element slightly, for example on the packaging. They are nearly identical but rarely use the LEGO logo. Typically they have a red square logo.

There is trade mark infringement outside of toys on other areas – such as spectacles and clothing. We do have a licensing business – covering children's clothing, shoes, bags, books, etc, so this is a concern.

How successful have your anticounterfeiting efforts been?

We have possibilities but they could be improved. In litigation



in China, we have to work through copyright, which is burdensome. Unfair competition protection, as in other countries, would be useful.

What was the first mark you registered at OHIM?

It was the LEGO trade mark along with 15 to 20 other trade marks or sub-marks. We went for registration on the first day the system opened.

What do you like about working in IP?

The IP area in general is very interesting. It is specialized so it requires a lot of deep knowledge. It is dynamic and trade mark work in particular is appealing to me as it is less technical than say patent work. Also, the LEGO brand is so associated with good memories for most people that it provokes a lot of positive comments.

The interesting thing and what sets LEGO apart is the system: even bricks purchased in the 1960s still work with the newest bricks so we stay consistent. The products have changed a lot and the LEGO group has invested in other areas – such as electronic products – and expanded into associated areas through licensing. But we keep coming back to the basics of the bricks.

What will be the biggest challenge for trade mark owners in the future?

Controlling our trade marks online and on the internet. It's so huge and easy for people to use others' trade marks. You see a lot of infringements, which you would not see in the real world, and which those who commit them would not see as infringements.

Community Trade Mark

CTM filed by an agent in his own name, without the owners' consent

The Cancellation Division of OHIM has found in favour of the applicants in a case where the owners of a registered trade mark asked for the registration of a similar CTM by a company with which it had a business relationship to be declared invalid.

The applicants showed they were the owners of the trade mark in question, used in the US for sports clothing and equipment since the 1960s, and contested the CTM registration by a company which had acted as its European representative or agent.

The CTM registration dated from 1999 and the request for a declaration of invalidity was filed in 2006 on the ground that the mark was filed by an agent in his own name, without the owners' consent - Article 52(1)(b) in combination with Article 8(3) CTMR. The CTM used the same combination of letters as the applicant's US registered mark, but in a different script.

In its decision, the Cancellation Division held that the purpose of the provision was to safeguard the legal interests of trade mark owners against the misappropriation of their trade marks by their commercial associates. In this context, the terms "agent" and "representative" should be interpreted broadly to

cover all kinds of relationships based on some contractual arrangement where the one party was representing the interests of another, regardless of the nomen juris of the contractual relationship between the parties.

Thus, it was sufficient for the purposes of Article 8(3) CTMR that there was some agreement of commercial co-operation between the parties of a kind that gave rise to a fiduciary relationship by imposing on the CTM applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the trade mark owner.

The decision ruled that Article 8(3) did not apply exclusively to identical marks for identical goods or services as this would render the provision largely ineffective by allowing the CTM applicant to simply modify the earlier mark or the specification of goods and services. In such a case, the interests of the owner would be seriously prejudiced, especially if the earlier mark were already in use and the variations made by the CTM applicant were not significant enough to rule out confusion.

For the same reasons, Article 8(3) not only covered cases where the respective specifications were strictly identical, but also applied where the goods and services in conflict were closely related or equivalent in commercial terms.

The decision concluded: "Taking into account that the applicants have proved they are the current owners of a registered mark in the United States, that there was an agency-like relationship between the applicants and the CTM proprietor, that the CTM was filed in the agent's name, that the CTM proprietor has neither submitted sufficient evidence showing that there was consent nor that it had a valid justification for the filing of the CTM and that the contested products, identical to the goods of the applicants', will be perceived as "authorized" goods whose quality is still somehow "guaranteed" by the original proprietor of the mark, the request must be upheld on the ground of Article 52(1)(b) in combination with Article 8(3) CTMR and the contested CTM must be declared invalid for all the relevant products. "

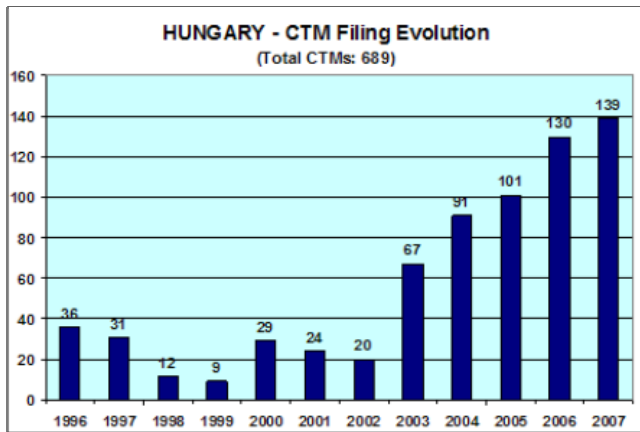
Country Overview: Hungary & the Community Trade Mark



Hungary joined the EU in May 2004, and has a population of just under 10m. After a strong performance in 2006, economic growth this year has dropped to around 1.8%. The private sector represents 80% of GDP, with services accounting for almost two-thirds of activity, followed by industry (32%) and

agriculture (3%). The main exports are machinery and transport equipment, foodstuffs, and chemicals.

Since 1996, Hungary has filed a total of 689 CTMs, with the numbers growing strongly since 2003, in anticipation of EU entry the following year.

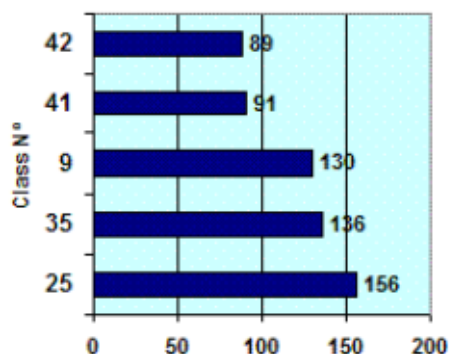


Word	Figurative	3-D	Colour	Other
52.69%	45.28%	1.89%	0.15%	0.00%

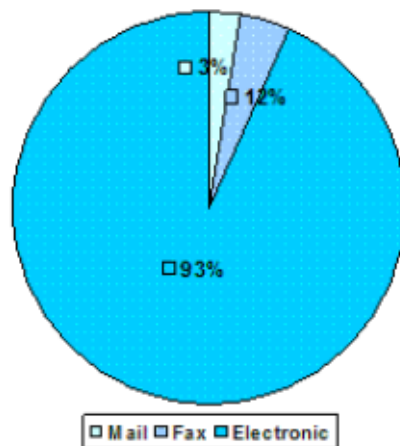
More than half the trade mark applications by Hungarian enterprises are for word-based marks (52.7%), with figurative marks following closely (45%).

The most popular goods and services applied for by Hungarian businesses are in classes 25, 35, and 9.

HUNGARY - Top Classes Filed (Nice)



Since 2005 onwards, e-filing has been more popular than fax or mail. This year, including International Registrations, 93% of all CTM filings were made electronically.



Top 10 Hungarian-based owners by number of CTMs filed

Company	CTMs
Providence 2003 Trade Mark Licensing Limited Liability Company	43
PJ HUNGARY SZOLGALTATÓ KORLATOLT FELELŐSÉGŰ TARSASAG	30
G-Star Raw Denim Kft	20
Zwack Unicum Nyrt.	20
URSA Salgótarján Glass Wool Close Co., Ltd.	17
EGIS GYÓGYSZERGYAR NYRT.	14
The Dream Merchant Company Kft	14
Országos Takarékpénztár és Kereskedelmi Bank Nyilvánosan Működő Reszvénytársaság	13
MOL Magyar Olaj- és Gazipari Nyilvánosan Működő Reszvénytársaság	12
MEDICO UNO PHARMA GYÓGYSZERKERESKEDELMI KFT	11

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

Representative	CTMs
DANUBIA SZABADALMI ES JOGI IRODA KFT.	74
SOCIETÀ ITALIANA BREVETTI S.P.A.	43
CARLOS POLO & ASOCIADOS	39
NOVAGRAAF NEDERLAND B.V.	37
PATENDER NEMZETKÖZI IPARJOGVEDELMI KEPVISELETI KFT.	32
ELZABURU	20
GEORG PINTZ & PARTNERS	20
Meszarosné Dónusz	20
Beszedes	17
CABINET LAVOIX	14

Community Design

Design protection: Just days away?

Wouldn't it be nice if clothes designers showing at Milan or Paris had to wait little more than 48 hours to have effective and enforceable protection for their creations? That day may not be very far off, according to José Izquierdo, assistant to the director in the designs department.

On 18 September, OHIM took a big step towards faster protection for designs of all kinds by moving from weekly to daily publication of the Community Designs Bulletin. "Once a design is published you can sue the pirates or take out an injunction. Time matters with design lifecycles getting shorter all the time", says Izquierdo.

Even before the latest change, OHIM has been meeting its target of publishing 80% of designs within eight weeks of the initial application. "In fact, in around half of cases, we have been managing to publish within three weeks. For some designs, daily publication could mean protection in less than a week", Izquierdo adds.

The change will also mean:

- the registration certificate will arrive more quickly
- the information will get onto the RCD ONLINE searchable database faster
- designers or trend watchers will get more up-to-date information

But surely, with deferred publication a possibility for those keen to wait until the last minute before unveiling their creations, design owners can already ensure they are protected by planning ahead. Possibly so, but it doesn't always happen, says Izquierdo. "Imagine what would happen if a major company wanted to launch a computer games console and had fixed the launch date before anyone realised they had failed to register the design. In that kind of case the clock is running."

In some industries new designs come out at breakneck speed and piracy is a constant risk. Textile and shoe design, for example – the largest category of Registered Community Designs after furniture – is another case in point. Izquierdo believes that designers want the security of getting their designs registered and published as quickly as possible, and OHIM has a responsibility to race to keep up with these changing needs.

So is even a week too long to wait? For some designers perhaps it is. Izquierdo says OHIM plans to look at ways of cutting down the time taken even further. "We think that it may be possible eventually to get the time period between application and publication to around 48 hours for many designs. Watch this space", he adds.

Trademark vs Design – "Flex"

The Invalidity Division of the Designs Department took two related decisions where an earlier figurative trademark (CTM 2275220, below left) had been invoked in an attempt to have two Community designs (RCD 473251-0001, -0004, below right) declared invalid. The CTM had been registered for

goods such as beds, spring mattresses etc. in the classes 6, 10, 17, 20 whereas in the RCD the product "ornamentation" was indicated.



In addition to the earlier CTM the claimant invoked various earlier Spanish trademark rights, however, the Invalidity Division did not take them into consideration, because the corresponding certificates were not translated into the language of the proceedings as required by Art. 29(5) CDR. The CTM certificate was accepted because it was "published in all official languages of the European Union by the Office."

The claimant requested the invalidation of the RCD on the basis of Art. 25(1)(e) CDR and argued that "the contested RCD deals with protecting a shape and outline of a decoration, completely confusable with the entirety of its trademarks".

According to Article 25(1)(e) CDR a Community design should be declared invalid if a distinctive sign is used in a subsequent design, and Community law or the national law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use.

The Invalidity Division considered that "where a sign is registered as a Community trademark in a Member State and the trademark is in force, it is presumed that it is a 'distinctive sign' in the meaning of Article 25(1)(e) CDR" and the right to prohibit the use of the distinctive sign follows from Article 9 of the CTMR, which stipulates that the proprietor of a registered trademark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with the trademark in relation to goods or services which are identical with those for which the trade mark is registered.

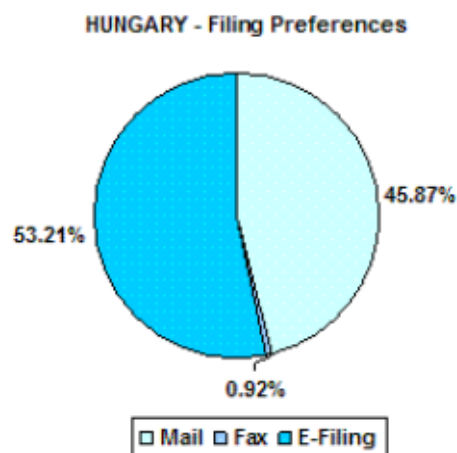
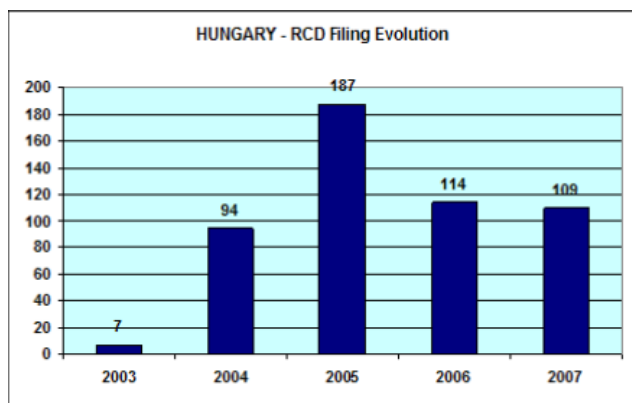
Furthermore, the Invalidity Division took the view that Article 25(1)(e) CDR does not apply where (1) the RCD does not contain a feature which could be perceived as a sign, or else where (2) this sign is not identical or similar to the sign of the CTM.

Subsequently, the Invalidity Division made a visual examination of the RCD and the CTM and found that "the RCD does not contain a figurative element which is visually identical or similar with stylized swan of the CTM." As regards phonetic perception it found that "there is an identity between parts of the RCD and parts of the CTM due to the common term 'flex'. However, the Invalidity Division considered that "the term 'flex' in relation to the goods of the CTM will be understood by the consumers as the usual short form of "flexible" describing a quality of these goods. Therefore, the consumer will not reduce the CTM to the term "flex" when dealing with said goods."

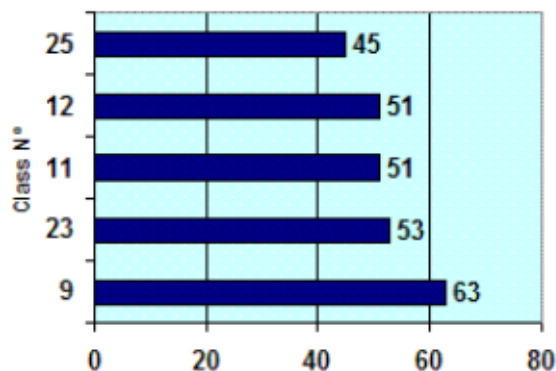
At the end, the Invalidity Division reached the conclusion that "the term 'flex' as the only element in common is not sufficient to constitute a similarity between a feature of the RCD and the sign of the CTM" and rejected the application for a declaration of invalidity.

Country Overview: Hungary & the Registered Community Design

Hungarian filings of RCDs took off in 2004 after entry into the EU and peaked the following year. Filings in 2007 look set to increase again, with almost as many filed in the year to September as in the whole of 2006. The most popular classes for Hungarian design owners are 9, 23, and 11. In common with other countries, there has been a big move to e-filing. In 2005, mail was the dominant route, whereas this year e-filing now accounts for more than half (53%) of Hungarian RCDs.



HUNGARY - Top Classes Filed (Locarno)



Case-law

LATEST TRADE MARK AND DESIGN NEWS FROM LUXEMBOURG

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

(-)

A-2: ECJ: Developments in pending cases

Hairtransfer : C-212/07-P – Appeal from T-204/04; Office response filed (DE).

Keywords: Absolute grounds for refusal: descriptiveness.

The action is an appeal from a decision of the CFI of 15.2.2007 in Case T-204/04 by which the CFI had confirmed a decision of the 2nd Board relating to CTM application Hairtransfer (word mark) for a range of goods and services in Classes 3, 8, 10, 21, 22, 26, 41 and 44. The said application had been rejected for goods and services in Classes 8, 22, 41 and 44 on the grounds that the term would merely describe apparatus used to remove or apply hair and related services.

B: European Court of Justice: Preliminary Rulings

B-1: ECJ Preliminary Rulings

(-)

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



Intel: C-252/07 - Reference from the UK Court of Appeal; Office contribution filed (internal document).

Keywords: Trade Marks Directive: Article 4(4): mark with reputation – Regulation 40/94 (CTMR): Article 8(5) CTMR – Reputation mark: risk of dilution.

The questions referred to the ECJ under Article 234 EC by the Court of Appeal (Civil Division) were raised in the context of national proceedings between Intel Corporation Inc. and CPM United Kingdom Ltd (CPM), on appeal from the High Court (Chancery Division), which was seized of the case on appeal from the Trade Marks Registry. Intel had lodged a request under the UK Trade Marks Act 1994, for the declaration of the invalidity of CPM's UK registration No. 2122181 of the word 'INTELMARK', which had been registered in respect of 'marketing and telemarketing services' in Class 35. The action was based on a number of earlier registrations concerning the word mark 'INTEL' and covering a range of goods and services in Classes 9, 16, 38 and 42. The grounds of invalidity were the provisions of the UK Act corresponding to Art. 4 (4) (a) of the First Council Directive 89/104/EEC of 21 December 1998 to approximate the laws of the Member States relating to trade marks ('TMD') and, more particularly, the 'dilution' of its reputed house mark 'INTEL'. According to the evidence, the mark 'INTEL' enjoys a huge reputation in respect of 'computers and computer-linked products', that is, for goods which are clearly dissimilar to the services of the contested registration and is 'unique' in the sense that it has not been used by anyone else for any other type of goods or services. By order dated 15 May 2007, the referring Court decided to stay the main proceedings and referred to the Court of Justice the following questions:

"For the purposes of Article 4 (4) (a) of the First Council Directive 89/104 of 21 December 1998 , where:

1. the earlier mark has a huge reputation for certain specific types of goods and services,

those goods and services are dissimilar, or dissimilar to a substantial degree, to the goods and services of the later mark,

the earlier mark is unique in respect of any goods or services,

the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the services of the later mark,

are those facts sufficient in themselves to establish (i) 'a link' within the meaning of paragraphs [29] & [30] of Adidas Salomon AG v. Fitnessworld Training Ltd, Case C-408/01, [2003] ECR I-12573 and/or (ii) unfair advantage and/or detriment within the meaning of that Article?

2. If no, what factors is the national court to take into account in deciding whether such is sufficient? Specifically, in the global appreciation to determine whether there is a 'link', what significance is to be attached to the goods or services in the specification of the later mark?

3. In the context of Article 4 (4) (a), what is required in order to satisfy the condition of detriment to distinctive character? Specifically, does (i) the earlier mark have to be unique (ii) is a first conflicting use sufficient to establish detriment to distinctive character and (iii) does the element of detriment to distinctive character of the earlier mark require an effect on the economic behaviour of the consumer?"

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

Europolis : C-108/05; Judgment of 7 September 2006 on reference from the Gerechtshof te 's-Gravenhage (Court of Appeal, The Hague). National judgment at final instance in this area (Gerechtshof Benelux; Brussels), in *Bovemij Verzekeringen N.V. v Benelux Merkenbureau* (Trade Marks Office), of 28 June 2007 (A 2005/1/16).

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

C-1: CFI Judgments and Orders

Exantin/Eloxatin : T-4/07 - Case closed (no need to adjudicate); Order of 13 July 2007.

Keywords: Opposition: likelihood of confusion.

The action had been directed against a decision of the 1st Board of 10.10. 006 in R1302/2005-1. Following withdrawal of the CTM application concerned, the case was closed.

Vixacor/Vitacor : T-326/05 – Case closed; Order of 9 July 2007.

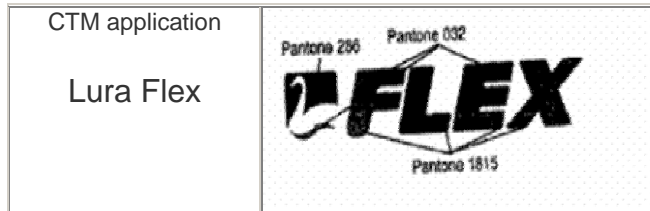
Keywords: Opposition: likelihood of confusion. The action had been directed against a decision of the 4th Board of 18.5.2005 in R0234/2003-4. Upon withdrawal of the action by plaintiff the case was closed.

Lura Flex : T-192/04 – Judgment of 11 July 2007 (action allowed; indirect impact on the Office's practice in that discretion under Article 74(2) CTMR – whether to allow belated material – Board's discretion must be exercised and reasoned).

Keywords: CFI proceedings: correct claims – Opposition proceedings: formalities – Opposition formalities: Article 74(2) CTMR, discretion – Opposition formalities: languages: translations – Translations: scope of formal requirements/enhanced recognition – Opposition: likelihood of confusion (LOC) – LOC: enhanced recognition of earlier mark: evidence/language – Opposition: comparison of goods – Opposition: earlier right with reputation, Article 8(5) CTMR.



The action had been directed against a decision of the 1st Board of 18.3.2004 in R0333/2003-1, relating to CTM application Lura Flex (word mark), applied for a range of goods in Classes 6 and 20. It had been opposed on the basis of earlier rights in Flex (figurative mark; in colour; as shown below), registered for a range of goods in Classes 6 and 20.



The opponent had claimed enhanced recognition, in fact reputation, of its brand but had not filed translation of the respective evidence into the language of the proceedings within the time limit set by the Office. The necessary translations had been filed afterwards; the Board, however, rejected this evidence from the outset. In its pleas, the plaintiff (opponent) had asked the court to direct the Office to refuse the CTM application.

(a) CFI proceedings (correct claim)

“(31) OHIM and Leggett & Platt contend that the applicant’s second head of claim is inadmissible since it asks the Court to direct OHIM to refuse registration of the CTM applied for, although such a direction falls outside the competence of the Court.

(32) The Court notes that it is settled case-law that in the context of an action brought before the Community judicature against a decision of a Board Appeal of OHIM, the latter is required under Article 233 EC and Article 63(6) CTMR to take the measures necessary to comply with any annulment judgment of the Community judicature.

(33) Accordingly, the Court is not entitled to issue directions to OHIM. On the other hand, it is for the latter to draw, where relevant, the conclusions from the operative part of judgments of the Court and the grounds on which they are based (Case T-331/99 Mitsubishi HiTec Paper Bielefeld v OHIM (Giroform) [2001] ECR II-433, paragraph 33).

(34) The applicant’s second head of claim must therefore be rejected as inadmissible in so far as it asks the Court to direct OHIM to refuse registration of the CTM applied for in respect of all the goods claimed in the trade mark application.”

(b) Evidence of enhanced recognition and language of the proceedings

“(47) Rule 16(3) of Regulation No 2868/95 provides that the evidence of the reputation of the trade marks on which the opposition is based may, if it is not submitted together with the notice of opposition or subsequent thereto, be submitted within such period after commencement of the opposition proceedings as OHIM may specify pursuant to Rule 20(2) CTMIR.

(48) In addition, Rule 17(2) of that regulation, concerning languages in opposition proceedings, provides that where the evidence in support of the opposition is not filed in the language of the opposition proceedings, as in the present case, the opposing party is to file a translation of that evidence into that language within the period specified by OHIM pursuant to Rule 16(3).

(49) It follows that the applicant was required to provide the Opposition Division with translations of the evidence of the reputation of its earlier marks before the expiry, on 29 December 2001, of the four-month period specified, in accordance with Rule 20(2), for submitting the facts, evidence and observations which the party concerned considers necessary to substantiate its opposition.

(50) It may be inferred from the reference in Rule 16(3) to Rule 20(2) on the one hand, and in Rule 17(2) to Rule 16(3) on the other, that the period set by the Opposition Division pursuant to Rule 20(2) for the submission of the particulars of the facts, evidence and arguments in support of the opposition also applied to the translations in the language of the opposition proceedings of the evidence of the reputation of the applicant’s earlier marks.

(51) It should be noted in that regard that, in its letter of 29 August 2001, the Opposition Division expressly pointed out to the applicant that all the documents were to be submitted in the language of the opposition proceedings, in this case in English, or be accompanied by a translation in that language, and that such a translation of any document or certificate already submitted in another language was also required, since documents which had not been translated in the language of the proceedings would not be taken into account.

(52) Although the applicant duly filed before the Opposition Division, on 20 December 2001, the particulars of the facts, evidence and arguments in support of its opposition, on that occasion it submitted the evidence and documents in support of the reputation of its earlier marks only in Spanish. It was not until 9 August 2002, that is, after the expiry, on 29 December 2001, of the four-month period set by the Opposition Division, that the applicant filed a translation of that evidence in English, the language of the opposition proceedings.

(53) The applicant submits in vain that the Opposition Division infringed Rule 18(2) and Rule 22(4) CTMIR by refusing to take into account the translations submitted, without first specifically calling upon the applicant to provide translations once it had established that there were none, or allowing the applicant a specific period within which to remedy the irregularity once it had been pointed out by Leggett & Platt.

(54) First, Rule 18(2), under which OHIM is to inform the opponent of any deficiencies affecting the notice of opposition and invite him to remedy that deficiency within a period of two months, which may not be extended, does not apply to the dispute, even by analogy, since that rule deals with grounds for the inadmissibility of the opposition (Chef, cited in paragraph 40 above, paragraph 36).

(55) However, the legal requirements concerning the presentation of the facts, evidence and observations and of



the documents submitted in support of the opposition, including their translations in the language of the opposition proceedings, are conditions relating to the examination of the substance of the opposition (Chef, cited above, paragraphs 37 and 52).

(56) The Opposition Division was therefore not obliged to point out to the applicant the deficiency constituted by its failure to file a translation of the evidence of the reputation of its earlier marks, as the absence of such a translation is not contrary to any provision of Regulation No 40/94 or of Regulation No 2868/95 that is covered by Rule 18(2) of the latter regulation (BIOMATE, cited in paragraph 45 above, paragraph 70).

(57) Secondly, OHIM did not infringe Rule 22(4), which allows it to invite the opposing party to submit, within a period specified by OHIM, a translation in the language of the proceedings of the evidence submitted in another language in support of its use of the earlier marks within the meaning of Article 43(2) and (3) CTMR.

(58) That latter provision, which allows the opponent to furnish proof, at the request of the trade mark applicant that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier mark on which the opposition is based has been put to genuine use, is manifestly inapplicable to the present case.

(59) The applicant, whose earlier marks were not registered until 1998, cannot claim a five-year use as at the date of the publication of the Community trade mark application, because that took place on 5 February 2001.

(60) In any event, the applicant did not properly request the application of Rule 71 of Regulation No 2868/95 under which OHIM may, when that is appropriate under the circumstances, grant an extension of a period specified by it if such extension is requested by the party concerned and the request is submitted before the original period expired.

(61) Since it was out of time in providing the Opposition Division with translations in the language of the proceedings of the evidence and documents supporting the reputation of its earlier marks, the applicant is to be regarded as having failed to submit that evidence in due time, within the meaning of Article 74(2) of Regulation No 40/94, so that OHIM could disregard it, pursuant to that provision."

(c) Material filed out of time – Possible acceptance – Discretion under Article 74(2) CTMR

"(62) Article 74(2) CTMR grants the Board of Appeal a wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take account of facts and evidence before it which, as in the present case, were submitted out of time before the Opposition Division (OHIM v Kaul, cited in paragraph 28 above, paragraphs 43 and 63, on which the parties were given an opportunity to submit their observations).

(63) Taking such facts or evidence into account is particularly likely to be justified where, first, the material which has been

produced late is, on the face of it, likely to be relevant to the outcome of the opposition and, second, the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (OHIM v Kaul, paragraph 44).

(64) Such a possibility for the Board of Appeal is likely to contribute de facto to ensuring that marks whose use could later on successfully be challenged by means of annulment or infringement proceedings are not registered (OHIM v Kaul, paragraph 48).

(65) In addition, by providing that the Board may exercise any power within the competence of the department of OHIM which was responsible for the decision appealed, Article 62(1) CTMR grants the Board power to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (OHIM v Kaul, paragraph 57).

(66) In the present case, from the outset the Board refused to allow the translations of the evidence and documents submitted by the applicant in support of the reputation of its earlier marks on the sole ground that taking account of them was automatically precluded owing to their submission out of time before the Opposition Division. Accordingly, it considered that it had no discretion to take account of the evidence at issue.

(67) It follows that the Board erred in law by declining from the outset to exercise its discretion in deciding whether or not to take account of the evidence and documents supporting the reputation of the applicant's earlier marks.

(68) It may be noted, as regards the relevance of the evidence at issue, that the Opposition Division expressly pointed out that it might not have concluded that there was no likelihood of confusion between the signs at issue if the applicant had pleaded, within the prescribed period, enhanced distinctiveness of its earlier trade marks owing to their widespread use and had submitted the necessary translations to prove that enhanced distinctiveness.

(69) Moreover, it is apparent from the contested decision that, for its part, the Board did not consider it to be irrelevant that the applicant had not adduced evidence of the reputation of its earlier marks within the period prescribed.

(70) It should also be noted, as regards the stage of the procedure at which the filing of the evidence took place, that the applicant filed the translations at issue with the Opposition Division on 9 August 2002 and brought the matter before the Board on 5 March 2003. The Board gave the contested decision on 18 March 2004.

(71) In those circumstances, the documents before the Court do not show that a time constraint could have prevented the Board of Appeal from taking into account the translations of the evidence of the reputation of the earlier marks on which the opposition was based.

(72) It follows from the foregoing that the contested decision is unlawful and that it must therefore be annulled. There is no need to examine the other pleas put forward by the applicant.”

Beverly Hills/Total : T-326/06 - Case closed; Order of 9 July 2007 .

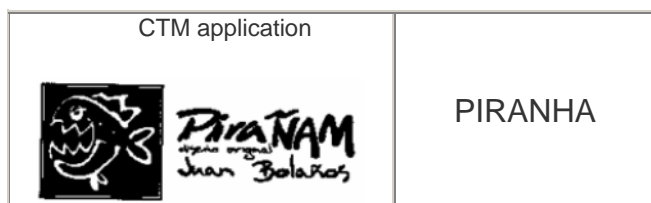
Keywords: Opposition: likelihood of confusion.

The action had been directed against a decision of the 4th Board of 5.9.2006 in R0848/2005-4. The Plaintiff informed the court that it did not wish to continue proceedings.

Piranha : T-443/05 - Judgment of 11 July 2007 (action allowed; law of the case).

Keywords: CFI proceedings: plea leaving decision to the discretion of the court (admissible) – Opposition: likelihood of confusion (LOC) – LOC: comparison of goods – LOC: comparison of marks – Comparison of marks: conceptual similarity.

The action had been directed against a decision of the 1st Board of 21.9.2005 in R1191/2004-1 relating to a figurative CTM application “PiraNam” (as shown below). It had been applied for a range of products in Classes 16, 21 and 25. The said CTM application had been opposed on the basis of a series of Spanish trade mark rights in the word PIRANHA, registered in Classes 18 and 25.



Whereas the Opposition Division had partially upheld the opposition as regards clothing, footwear and headgear in Class 25, the Board had rejected it in its entirety on the grounds that the goods at issue are dissimilar. The extended 4th Chamber of the CFI (Legal, Wisziewska-Bialecka, Vadapalas, Moavero Milanese and Wahl) revoked the Board's decision.

(a) CFI proceedings: plea leaving decision to the discretion of the court

“(21) As regards the form of order sought by OHIM which leaves the decision to the discretion of the Court, there is nothing to prevent the Office from endorsing one of the applicant's heads of claim or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate for giving guidance to the Court (Case T-107/2002 GE Betz v OHIM – Atofina Chemicals (BIOMATE) [2004] ECR II-1845, paragraph 36, and Case T-53/05 Calvo Growers v OHIM – Calvo Sanz (Calvo) [2007] ECR II-0000, paragraph 27). On the other hand, it may not seek an order annulling or altering the

decision of the Board of Appeal on a point not raised in the application or put forward pleas in law not raised in the application (Case T-379/03 Peek & Cloppenburg v OHIM (Cloppenburg) [2005] ECR II-4633, paragraph 22).

(22) Therefore, since OHIM merely leaves the decision to the discretion of the Court, its form of order is admissible.”

(b) Comparison of goods

“(37) In assessing the similarity of the goods, all the relevant factors relating to those goods should be taken into account, including, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (Canon, paragraph 35 above, paragraph 23). Other factors may also be taken into account such as, for example the distribution channels of the goods concerned (Case T-164/03 Ampafrance v OHIM – Johnson & Johnson (monBeBé) [2005] ECR II-1401, paragraph 53).

(38) According to Rule 2(4) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), as amended, the Classification of goods and services under the Nice Agreement is to serve exclusively administrative purposes. Goods and services may not therefore be regarded as being different from each other solely on the ground that they appear in different.

(39) It is in the light of those considerations that the legality of the contested decision must be determined.

(40) It should be noted that the Board held that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned. However, even a slight similarity between the goods concerned would have required the Board of Appeal to ascertain whether a high degree of similarity between the signs could have given rise, in the mind of a consumer, to a likelihood of confusion as to the origin of the goods. (...)

(42) First, the goods in Class 25 and those in Class 18 are often made of the same raw material, namely leather or imitation leather. That fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 55).

(43) Second, it is apparent that the distribution channels of some of the goods at issue are identical. However, a distinction must be made according to whether the goods in Class 25 are compared to one or other of the groups of goods in Class 18 identified by OHIM.

(44) On the one hand, as regards the second group of goods in Class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the Board of Appeal rightly held that the distribution channels were



different from those used for the distribution of goods in Class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 El Corte Inglés v OHIM – Pucci (EMILIO PUCCI) [2004] ECR II-4297, paragraph 43).

(45) On the other hand, as regards the first group of goods in Class 18, namely leather and imitation leather goods not included in other Classes such as handbags, purses or wallets, it should be noted that those goods are often sold with goods in Class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

(46) It must be recalled that the Court has also confirmed the existence of a slight similarity between 'ladies' bags' and 'ladies' shoes' (SISSI ROSSI, paragraph 42 above, paragraph 68). That finding must be extended to the relationships between all the goods in Class 25 designated by the mark applied for and the leather and imitation leather goods not included in other Classes, in Class 18, designated by the earlier mark.

(47) In light of the foregoing, it must be held that there is a slight similarity between the goods in Class 25 and the first group of goods in Class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

(48) As to whether clothing, footwear and headgear in Class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other Classes' in Class 18, it must be recalled that, according to the case-law, goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking (SISSI ROSSI, para 42 above para 60).

(49) Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

(50) The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in Class 25 and the various clothing accessories which complement them such as handbags in Class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the

perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

(51) It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in Class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in Class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in Class 18 which cannot be classified as slight.

(52) Therefore, the Board was wrong to hold that in this case there was no likelihood of confusion without having carried out a preliminary examination as to any similarity between the signs."

Tosca Blu/Tosca : T-150/04 - Judgment of 11 July 2007 (action dismissed; Office practice confirmed).

Keywords: Trips: Article 16(3) – Opposition: earlier mark notorious within Article 6bis Paris Convention ("PC") – PC: Article 6bis PC and Article 16(3) Trips – Earlier rights: mark with reputation within Article 8(5) CTMR; criteria (must such a mark be registered?) – Opposition: likelihood of confusion (LOC): comparison of goods.

The action had been directed against a decision of the 1st Board of 18.2.2004 in R0949/2001-1 relating to opposition proceedings between Mühlens GmbH & Co. KG, Cologne/Germany, and Minoronzoni Srl, Italy. The CTM application concerned is Tosca Blu (as shown below). It had been applied for in Classes 18 and 25, namely: Class 18: Bags; handbags; travelling bags; rucksacks; wallets; purses; briefcases; document holders made of leather and imitation leather; gents' handbags; trunks; animal skins, hides; leatherware; leather and goods made of leather; imitations of skins and leather and goods made of these materials; parasols, beach umbrellas, umbrellas, walking-sticks; harness and saddlery; Class 25: Clothing for men, women and children in general, including clothing of leather; shirts; blouses; skirts; suits; jackets; trousers; shorts; sports jerseys; T-shirts; pyjamas; stockings; singlets; corsets (underclothing); suspenders; underpants; brassières; underwear; hats; headscarves; neckties; waterproof clothing; overcoats; topcoats; swimsuits; tracksuits; windcheaters; ski pants; belts; furs; scarves; gloves; dressing gowns; footwear in general, including slippers, shoes, footwear for sports, boots and sandals.

CTM application	
TOSCA BLU	Tosca



It had been opposed on the basis of the earlier non-registered mark Tosca (word) allegedly well known in Germany for cosmetics, in particular for the following products: perfume, eau de toilette, eau de Cologne, body lotions, toilet soaps, shower gel, etc. The opposition had been rejected. The Board had held that Article 8(1)(b) CTMR required proof that the marks are identical or similar and that the goods or services covered are identical or similar. Although it was held that the marks at issue were undeniably similar, it was nevertheless held that the goods in issue were very different. The Board also held that the reputation of a mark did not allow it to be assumed that a likelihood of confusion existed from the simple fact of a likelihood of association in the strict sense. As regards Article 8(5) CTMR, the Board had held that the opposition could not be upheld under this provision since it required the earlier mark to have been registered.

(a) Comparison of goods: cosmetics and fashion goods etc.

“(29) In assessing the similarity of the goods in question, all the relevant factors relating to the way in which those goods are connected should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (LINDENHOF, paragraph 49; see also, by analogy, Canon, paragraph 23).

(30) In the current proceedings, it is clear from the contested decision that the goods covered by the earlier mark have the following description ‘perfumery products: eau de Cologne, perfumes’. This point was not contested. The products covered by the trade mark applied for consist of the products in Classes 18 and 25 of the Nice Agreement listed at paragraph 3 of this judgment.

(31) Clearly perfumery products and leather goods within Class 18, as of themselves, cannot be considered similar. Perfumery products and leather goods are plainly different as regards their nature, their purpose, and their method of use. Moreover, there is nothing that enables them to be regarded as in competition with each other or functionally complementary.

(32) The same conclusion must be drawn concerning a comparison between perfumery products and clothing in Class 25. Those goods, as of themselves, also differ as regards their nature, their purpose and their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary.

(33) Nevertheless, the applicant claims that the goods covered by the marks at issue share a certain degree of similarity, in so far as the public is accustomed to fashion items being marketed under perfume trade marks and associate these goods with the same undertaking, by reason of trade mark licences which are granted by undertakings in the fashion sector for the marketing of perfumery articles.

(34) In this regard, it is clear from Article 8(1)(b) CTMR that a likelihood of confusion between two identical or similar marks can exist only within the limits of the principle of speciality, that is to say, where, as has been pointed out at paragraph 27, regardless of the distinctive character which the earlier mark enjoys as a result of the awareness which the relevant

public may have of it, the goods or services at issue are identical or similar in the eyes of that relevant public.

(35) Nevertheless, it cannot be ruled out, particularly in the fashion and body and facial care sectors, that goods whose nature, purpose and method of use are different, quite apart from being functionally complementary, may be aesthetically complementary in the eyes of the relevant public.

(36) In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) CTMR, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraphs 60 and 62).

(37) However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (SISSI ROSSI, paragraph 63).

(38) In the current proceedings, the applicant claims only that the public is accustomed to fashion industry products being marketed under perfume trade marks owing to the practice of granting licences. Yet, if proved, that point alone would not be sufficient to compensate for the absence of similarity between the goods at issue. Such a point does not, in particular, establish the existence of an aesthetically complementary connection between perfumery goods on the one hand and the leather goods and clothing, referred to at paragraph 3 above, on the other hand, so as to mean that one is indispensable or important for the use of the other and that consumers consider it ordinary and natural to use those goods together.

(39) The applicant nevertheless claims that the goods at issue have in common their importance for a person’s image and appear together in fashion magazines. In this respect, it should be pointed out that, apart from the fact that this argument, which was not pleaded in the hearings before OHIM, has been submitted out of time, the point does not suffice, in any event, to establish the existence of an aesthetically complementary nature, such as that referred to above in paragraph 36.

(40) In relation to the applicant’s argument based on the decision of the Oberlandesgericht Köln of 28 March 2003 (see paragraph 20 above), it should be pointed out that this decision was annulled by judgment of the Bundesgerichtshof (German Federal Court of Justice) of 30 March 2006 (Case I ZR 96/03) and that, in any event, a decision of a national court cannot bind the OHIM authorities or the Community Courts. The Community trade mark regime is an autonomous system which applies independently of any national system (Case T-32/00 Messe München v OHIM (Electronica) [2000] ECR II-3829 paragraph 47). (41) It follows from the foregoing that the Board of Appeal was correct to find a lack of similarity



between the goods at issue. Accordingly this plea must be rejected.”

(b) Scope of Article 8(5) CTMR

Plea:

“(42) The applicant claims that the opposition should also be successful on the basis of Article 8(5) CTMR. According to the applicant, the Board erred in law in holding that Article 8(5) could be relied upon only as regards registered trade marks.

(43) According to the applicant, the approach adopted by the Board of Appeal goes against the wording and the purpose of Article 8(5) CTMR, in so far as this provision relates back to earlier marks within the meaning of paragraph 2 of that article and therefore, in particular, to the well-known marks referred to in Article 8(2)(c) CTMR. According to the applicant, if Article 8(5) related only to registered trade marks then only paragraphs 2(a) and 2(b) would have been mentioned in paragraph 5 of that article.

(44) The applicant also claims that the phrase ‘for which the earlier mark is registered’ in Article 8(5) CTMR, is the result of a drafting error. This phrase should have stated, ‘for which the earlier mark is protected’, in order to cover also those marks which are well known within the meaning of Article 6bis of the Paris Convention.

(45) In support of the argument that Article 8(5) CTMR be interpreted broadly and contrary to its wording, the applicant refers to Case C-292/00 Davidoff [2003] ECR I-389, paragraph 24, in which the Court of Justice interpreted Article 5(2) of First Council Directive 89/104/EEC of 21 December 1988 (OJ 1989 L 40, p. 1) not solely on the basis of its wording, but also in the light of the overall scheme and objectives of the system of which it is a part. The applicant maintains that if the objective of Article 8(5) CTMR, like that of Article 5(2) of Directive 89/104, the increased protection of well-known marks, it would follow that not only registered trade marks but also earlier marks, protected due to their reputation, should be able to enjoy this increased protection.

(46) In reply to the questions of the Court the applicant also submits that German legislation ensures extended protection for well-known marks within the meaning of Article 6 bis of the Paris Convention.”

Court:

“(53) It should be pointed out, in this regard, that Article 8(1) and (5) CTMR lay down the relative grounds for refusal for the registration of a particular CTM. On the one hand, Article 8(1)(b) CTMR protects the earlier mark against the risk of confusion. The protection is confined by the limits of the principle of speciality, that is, when the goods or services of the marks at issue are identical or similar. Moreover, Article 8(1) CTMR does not specify whether the earlier mark must have been registered.

(54) On the other hand, Article 8(5) CTMR protects an earlier well-known mark against marks likely either to, take unfair

advantage of its reputation or of its distinctive character, or to be detrimental to that reputation or to that distinctive character. While this protection can apply when the products or services covered by the marks at issue are identical or similar, it is intended, primarily, to be applied in the case of goods and services which are not similar (see, to that effect, and by analogy Case C-408/01 Adidas-Salomon and Adidas Benelux [2003] ECR I-12537, paragraph 22).

(55) It follows from Article 8(5) CTMR which uses the expression ‘for which the earlier trade mark is registered’, that this provision only applies to earlier marks within the meaning of Article 8(2) of that regulation in so far as they have been registered (see, to that effect, and by analogy, Case C-375/97 General Motors [1999] ECR I-5421, paragraph 23; Davidoff, paragraph 20; and Adidas-Salomon and Adidas Benelux, paragraph 22).

(56) Consequently, in contrast to Article 8(1)(b) CTMR which allows, as regards identical or similar goods or services, opposition based on marks for which no proof of registration has been provided, but which are well known within the meaning of Article 6bis of the Paris Convention, Article 8(5) CTMR protects, in relation to goods or services which are not similar, only those well-known marks within the meaning of Article 6bis of the Paris Convention for which proof of registration has been provided.

(57) In this regard, it should be noted that the exclusion of well-known marks for which registration has not been proved, from the scope of Article 8(5) CTMR is in keeping with Article 6bis of the Paris Convention, which, since it is only applicable within the limits of the principle of speciality, provides no protection for different goods.

(58) In the light of the foregoing, the applicant’s argument alleging that the wording of Article 8(5) CTMR resulted from a drafting error must be rejected.

(59) Nor can the applicant further claim that an interpretation of Article 8(5) CTMR having regard to its overall scheme should lead to that article also applying to unregistered well-known marks. Indeed, it is clear from the scheme of Article 8 CTMR that a well-known mark within the meaning of Article 6bis of the Paris Convention, for which no proof of registration is provided, enjoys protection only against a risk of confusion in regard to identical or similar goods or services, in the same way as Article 6bis of the Paris Convention provides protection in relation to goods.

(60) In addition, Regulation No 40/94 is consistent, on this point, with Article 16(3) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (*TRIPS*) of 15 April 1994 (Annex 1 C to the Agreement establishing the World Trade Organisation) (OJ 1994 L 336, p. 214), which extends the application of Article 6bis of the Paris Convention to situations where the goods or services at issue are not similar, on the condition, however, that the earlier mark has been registered. (61) The fact that, as the applicant mentions, that German legislation provides broader protection to unregistered marks which are well known within the meaning of Article 6bis of the Paris Convention does not change the finding that Article 8(5) CTMR does not apply to well-known marks where they have not been registered. As has been



pointed out at paragraph 40 above, the Community trade mark regime is an autonomous system which applies independently of any national system (Electronica, paragraph 47)."

Toska Leather/Tosca : T-28/04 - Judgment of 11 July 2007 (only in Fr and IT; action dismissed; Office practice confirmed)

Keywords: Opposition: earlier mark notorious within Article 6bis PC – Earlier rights: mark with reputation within Article 8(5) CTMR; criteria (must such a mark be registered?) – Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 20.11.2003 in R0010/2003-1 relating to the CTM application for the figurative mark "Toska Leather" (as shown below) which had been applied for in a range of goods in Classes 16, 18 and 25.



It had been opposed on the basis of Tosca (word mark), a non-registered mark for a range of cosmetics products, and the opposition had been rejected. The pleas in law were the same as in T-263/03 (Toska; below). The 2nd Chamber of the CFI, in the same composition as in Tosca, took an identical decision (action dismissed; see also above Tosca Blu, T-150/04).

Toska/Tosca : T-263/03 - Judgment of 11 July 2007 (only in FR and IT; action dismissed; Office practice confirmed).

Keywords: Opposition: earlier mark notorious within Article 6bis PC – Earlier rights: mark with reputation within Article 8(5) CTMR: criteria (must such a mark be registered?) – Opposition: likelihood of confusion (LOC): similarity of goods.

The action had been directed against a decision of the 2nd Board of 13.5.2003 in R0369/2002-2 in opposition proceedings between Mühlens GmbH & Co KG (Cologne/Germany) and Conceria Tosca Srl. It had concerned CTM application Toska (word mark), applied for a range of products in Class 18. It had been opposed on the basis of Tosca (word), a non-registered mark for a range of cosmetics products. The opposition had been rejected on the grounds that there is no classic conflict because the goods at issue are dissimilar, and as regards invocation of Article 8(5) CTMR (earlier mark with reputation) that that article is not applicable because the mark at issue is not registered. Before the CFI, the plaintiff had pleaded, *inter alia*, that Article 8(5) CTMR requires a corrective interpretation so that the

provision also includes non-registered well-known marks (= non-registered "notorious marks") within the meaning of Article 6bis of the Paris Convention. The 2nd Chamber of the CFI (Pirrung; Meij; Pelikánová) held that, in order to qualify for protection of identical or similar marks within Article 6bis of the Paris Convention, the products and services concerned must at least be similar because it is stated (in paragraph 46 of the Judgment) that that provision provides protection against a risk of confusion. Further, the CFI held that, in contrast to Article 6bis PC, protection within Article 8(5) CTMR requires registration of the mark at issue, i.e. that there is no room for assuming a drafting error or the like.

Webmulti/Web : T-395/05 - Case closed; Order of 13 June 2007 (DE).

Keywords: Opposition: likelihood of confusion (LOC).

The action had been directed against a decision of the 1st Board of 20.6.2005 in R0895/2004-1. The case was closed following settlement out of court further to which the plaintiff withdrew the action.

Panrico or Krispy Kreme Doughnuts: T-317/06 - Case closed; Order of 7 June 2007 (only in FR and ES).

Keywords: Opposition: Likelihood of confusion (LOC).

The case was closed following withdrawal of the action by plaintiffs.

Europig : T-207/06 - Judgment of 14 June 2007 (only in FR, ES; action dismissed; Office practice confirmed).

Keywords: Absolute grounds for refusal: descriptiveness – Distinctiveness: acquired in the course of trade, Article 7(3) CTMR.

The action had been directed against a decision of the 4th Board of 31.5.2006 in R1425/2005-4 relating to CTM application Europig (word mark), applied for meat and a range of meat products in Classes 29 and 30. It had been rejected on the grounds that Europig merely describes the products at issue. As regards alleged acquired distinctiveness on the market, the Board had found that the documents provided were not sufficient to show that the sign had become a trade mark in the minds of the relevant consumers. The 4th Chamber of the CFI (Legal; Vadapalas; Wahl) confirmed these findings.

Letter "I" : T-441/05; Judgment of 13 June 2007 (action allowed; decision will have a certain impact on the broadness of reasoning provided in decisions relating to this specific area of signs).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness: a coloured single letter for services.

The action had been directed against a decision of the 4th Board of 1.9.2005 in R0559/2004-4 concerning a coloured single letter for registration as a CTM. The sign at issue is the letter "I" in royal blue.

I

The services in respect of which registration had been sought are in Classes 35, 36, 37, 39, 42 and 43, and correspond, for each of those classes, to the following description: Class 35: Cost price analysis; business management and commercial advice, inter alia company management and administration advice; valuation in commercial matters. Class 36: Financial analysis; banking affairs; debt recovery; secured loans; consultation on financial matters; financial development; guarantees; recovery of rent and farm rent; property management; land and property management; property valuations; property rental; investment of capital; rental of agricultural premises; brokering services, asset placing, asset management. Class 37: Building demolition; asphaltting; information on construction matters; construction work management; construction; drilling; irrigation installations; factory construction; port construction, jetty construction. Class 39: Delivery of goods; chartering; warehousing of goods; rental of garages; rental of warehousing containers; transport. Class 42: Services of an architect, advice on construction, and Class 43: Rental of temporary buildings.

The application had been rejected on the grounds that the sign at issue solely means “number one” in Roman numerals, in Times New Roman character font, which is an ordinary font type. The fact that the sign is in blue does not significantly change the finding of lack of distinctive character. The 4th Chamber of the CFI (Legal; Wisniewska-Bialecka; Moavero Milanesi) did not share this view:

“(38) While Article 4 of Regulation No 40/94 expressly refers to letters and numerals, the fact that a category of signs is, in general, capable of constituting a trade mark for the purposes of that provision does not, however, mean that those signs necessarily have distinctive character for the purposes of Article 7(1)(b) in relation to a particular product or service (Case T-173/00 KWS Saat v OHIM (Shade of orange) [2002] ECR II-3843, paragraph 26).

(39) Signs that are incapable of identifying specifically the origin of the goods or services designated and 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 are devoid of any distinctive character (Shade of orange, paragraph 38 above, paragraph 27).

(40) Moreover, such greater difficulty as might be encountered in the specific assessment of the distinctive character of certain trade marks cannot justify the assumption that they are a priori devoid of any distinctive character or that they can acquire such character only through use, pursuant to Article 7(3) of Regulation No 40/94 (see, with regard to Article 3(3) of Directive 89/104, the normative content of which is essentially identical to that of Article 7(3) of Regulation No 40/94, Nichols, paragraph 37 above, paragraph 29).

(41) The distinctive character of a trade mark required by Article 7(1)(b) of Regulation No 40/94 must be assessed by reference, first, to the goods or services in respect of which registration is sought and, second, to the perception of the relevant persons, namely the consumers of the goods or services (see, with regard to Article 3(1)(b) of Directive 89/104, the normative content of which is essentially identical to that of Article 7(1)(b) of Regulation No 40/94, Case C-218/01 Henkel [2004] ECR I-1725, paragraph 50).

(42) It was therefore appropriate in the present case to examine, in the context of a specific examination of the potential capacity of the sign proposed for registration, whether there appeared to be no possibility that that sign may be capable of distinguishing, in the eyes of the public to which it is addressed, the goods or services referred to from those of a different origin (EASYBANK, paragraph 17 above, paragraph 40), since a minimum degree of distinctiveness is sufficient to prevent application of the absolute ground for refusal provided for in Article 7(1)(b) of Regulation No 40/94 (Torch shape, paragraph 17 above, paragraph 34).

(43) In order to carry out such an assessment, OHIM or, where a challenge is brought, the Court of First Instance, must have regard to all the relevant facts and circumstances (Case C-136/02 P Mag Instrument v OHIM [2004] ECR I-9165, paragraph 48). (44) It must be stated that the Board of Appeal did not carry out such an assessment in the present case.

(45) The Court finds, first, that, in paragraph 10 of the contested decision, the Board of Appeal merely took the view that the claimed mark was not capable of indicating the commercial origin of the services designated in that the two transversal strokes of the symbol submitted for registration and its royal blue colour, to which a primarily decorative purpose was attributed, were not sufficient to attract the attention of the normally attentive observer.

(46) In order to reach such a conclusion, the Board of Appeal took as its basis the fact that the claimed mark lacked notable specific graphic features in comparison to the standard Times New Roman character font. That conclusion is confirmed by the finding of the ordinariness of the sign under examination which the Board of Appeal made in paragraph 11 of the contested decision.

(47) By thus focussing the assessment of the distinctive character of the claimed mark from the outset on the configuration of its colour and on the importance of the graphic differences which it allegedly showed in relation to the equivalent symbols of the standard Times New Roman character font, the Board of Appeal implicitly but necessarily took the view, in breach of Article 4 of Regulation No 40/94, that a printing symbol forming part of a standardised character font did not of itself have the minimum degree of distinctiveness required by Article 7(1)(b) to be eligible for registration as a Community trade mark.

(48) To that extent, moreover, the Board of Appeal deprived of all practical application the principle that Article 7(1)(b) of Regulation No 40/94 makes no distinction between different types of signs with regard to the requirement for



distinctiveness, despite the fact that that principle was recalled in paragraph 9 of the contested decision.

(49) Furthermore, it is settled case-law that a sign's lack of distinctive character, within the meaning of Article 7(1)(b) of Regulation No 40/94, cannot arise merely from the finding that it does not look unusual or striking (EASYBANK, paragraph 17 above, paragraph 39).


(50) Registration of a sign as a Community trade mark is not subject to a finding of a specific level of creativity or imaginativeness on the part of the proprietor of the trade mark (Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317, paragraph 41), but to the ability of the sign to distinguish the goods or services of the applicant for the trade mark from goods or services offered by competitors (Case T-79/00 Rewe-Zentral v OHIM (LITE) [2002] ECR II-705, paragraph 30).

(51) A sign lacking stylised graphic elements can even be more easily and instantly memorised by the relevant public and can enable it to repeat a positive purchasing experience inasmuch as the sign is not already commonly used, as such, for the goods and services in question (Case T-360/00 Dart Industries v OHIM (UltraPlus) [2002] ECR II-3867, paragraph 48). (52) By deducing, from the absence of notable specific graphic features in comparison to a standard character font, that the claimed mark lacked distinctiveness the Board of Appeal thus incorrectly applied Article 4 and Article 7(1)(b) of Regulation No 40/94."

Fennel/Fenjal : T-167/05 - Judgment of 13 June 2007 (action dismissed; Office practice confirmed).

Keywords: Opposition proceedings: points of law not raised by parties (may be ruled on by Office) – Opposition proceedings: scope of Article 73 CTMR – Opposition proceedings: scope of Article 74(1) CTMR – Opposition: likelihood of confusion (LOC) – LOC: comparison of signs – LOC: earlier mark with enhanced recognition.

The action had been directed against a decision of the 4th Board of 14.10.2004 in R0250/2002-4, relating to an opposition which had been lodged against CTM application FJ Fennel (figurative mark; as shown below; it should be noted that the "NN" in the middle of the word are in different graphics).

CTM application 	fenjal
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The said sign had been applied for a range of cosmetics products in Class 3, and it had been opposed on the basis of the word mark "Fenjal" for identical or very similar products. Further, the opponent had invoked enhanced recognition in the market place (Germany). The appeal had been dismissed on the grounds that the marks at issue are dissimilar. The 4th Chamber of the CFI (Legal; Vadapalas, Wahl) confirmed these findings.

(a) *Enhanced recognition of the earlier mark: criteria of invocation*

"(77) In the present case, it is clear from the documents before the Court that the Board of Appeal did not rule on whether or not the earlier mark is distinctive. However, it must be noted that whether or not the sign FENJAL is well known in Germany would not call into question the Board of Appeal's conclusion.

(78) Whilst it is settled case-law that, the more distinctive the earlier mark, the greater will be the likelihood of confusion (SABEL, paragraph 24, and Case T-85/02 Díaz v OHIM – Granjas Castelló (CASTILLO) [2003] ECR II-4835, paragraph 44), it should be noted that a likelihood of confusion presupposes that the signs are identical or similar. Thus, the fact that a trade mark is well known is a factor which, far from giving rise of itself to a likelihood of confusion, must be taken into account when determining whether the similarity between the signs or between the goods and services is sufficient to give rise to a likelihood of confusion (see, to that effect, Canon, paragraph 19, and Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraph 65.

(79) In the light of the above, it must be held that the Board of Appeal correctly found that there was no likelihood of confusion between the signs at issue."

(b) *Article 73 and Article 74(1) CTMR*

"(102) While the right to be heard, as laid down in the second sentence of Article 73 of Regulation No 40/94, covers all matters of law or of fact and the items of evidence which form the basis of the decision-making act, it does not, however, apply to the final position which the administration intends to adopt (Case T-16/02 Audi v OHIM (TDI) [2003] ECR II-5167, paragraphs 71 and 75; see also, to that effect and by analogy, Joined Cases T-129/95, T-2/96 and T-97/96 Neue Maxhütte Stahlwerke and Lech-Stahlwerke v Commission [1999] ECR II-17, paragraph 231.

(103) Moreover, it is apparent from Article 74(1) of Regulation No 40/94 that, in proceedings relating to relative grounds for refusal of registration, such as those in the present case, the examination of the facts carried out by OHIM of its own motion is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought.

(104) The criteria for applying a relative ground for refusal of registration, as with any other provision relied on in support of the claims made by the parties, are naturally part of the matters of law submitted for examination by OHIM. It should be borne in mind in this regard that a matter of law may have to be ruled on by OHIM even when it has not been raised by the parties if it is necessary to resolve that matter in order to ensure a correct application of Regulation No 40/94 in the light of the facts, evidence and arguments provided by the parties and the relief sought. Thus, the matters of law put forward before the Board of Appeal also include any question of law which must necessarily be examined for the purpose of assessing the facts, evidence and arguments provided by the parties and for the purpose of allowing or dismissing the claims, even if the parties have not put forward a view on

those matters and even if OHIM has omitted to rule on that aspect (Case T-57/03 Spag v OHIM – Dann and Backer (HOOLIGAN) [2005] ECR II-287, paragraph 21).

(105) In the present case, the applicant cannot criticise the Board of Appeal for having taken into consideration in the contested decision the presumed perception of the relevant public – in particular with regard to the consumer's degree of attention, the manner in which the goods are bought or the meaning of the signs in question – as it appears from the facts and evidence put forward before it by the applicant.

(106) Moreover, the Board of Appeal also based its analysis, essentially, on facts derived from generally acquired practical experience of the marketing of cosmetics, namely compact powder, lipstick, eye-shadow, eye-liner, blusher, nail polish and mascara, since those facts are likely to be known by consumers of those products.

(107) It follows that the Board of Appeal did not, contrary to what the applicant maintains, base its decision on new facts and arguments. Moreover, the appraisal of the evidence conducted by that Board could, in any event, be challenged before the Court of First Instance (Case C-214/05 P Rossi v OHIM [2006] ECR I-7057, paragraph 53).

(108) With regard to the claims relating to the failure to take into consideration the evidence demonstrating the distinctiveness of the earlier mark in Germany, it must be noted that a procedural irregularity will entail the annulment of a decision in whole or in part only if it is shown that, had it not been for the irregularity, the contested decision might have been substantively different (see Case T-315/03 Wilfer v OHIM (ROCKBASS) [2005] ECR II-1981, paragraph 33 and the case-law cited).

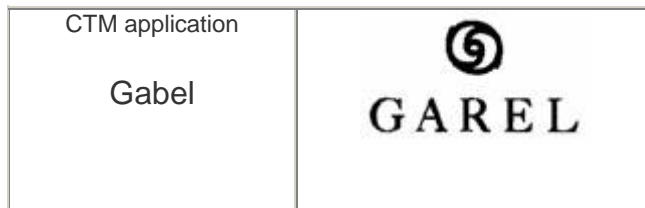
(109) In the present case, it was held at paragraphs 73 to 80 above that the difference between the signs at issue made it impossible to find a likelihood of confusion, however well known the earlier sign may be. It must therefore be held that recognition of the fact that the earlier sign was well known in Germany could not have altered the operative part of the contested decision."

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

Gabel/Garel : T-85/07 - Office response filed (IT).

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

The action is directed against a decision of the 2nd Board of 25.1.2007 in R0960/2006-2, relating to CTM application 3754777, Gabel (word mark), which had been applied for in Classes 24 and 25.



It had been opposed on the basis of Garel (figurative mark), protected by various trade marks and by a CTM registered in Classes 24, 25 and 26. The opposition had only partially been allowed.

Spa Therapy : T-109/07 - Office response filed (FR).

Keywords: Opposition proceedings: filing of proof of use at the appeal stage - Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 4th Board of 24.1.2007 in R0468/2005-4, relating to CTM application 1975283, Spa Therapy (word mark), applied for a range of goods in Class 3. It had been opposed on the basis of "Spa" (word mark), a Benelux trade mark with a priority of 1981, registered in Class 3. The opposition had been allowed.

Tosca de Fedeoiliva : T-63/07 - Office response filed.

Keywords: Opposition: earlier right with reputation – Earlier right with reputation: risk of dilution – Risk of dilution: assessment (ex officio or task of the party?).

The action is directed against a decision of the 2nd Board of 18.12.2006 in R0761/2006-2, relating to CTM application 3467651, Tosca de Fedeoiliva (figurative mark), applied for in Classes 16, 29, 35 and 39. It had been opposed on the basis of Tosca, allegedly a famous brand for cosmetics in Germany. The opposition had been rejected.



Polaris : T-79/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 8.1.2007 in R0658/2006-1, relating to CTM application 3267713, Polaris (figurative mark), which had been applied


for a range of goods in Class 9. It had been opposed on the basis of "Polar" (word mark) also registered in Class 9. The opposition had been successful.

CTM application	
	POLAR

Dada : T-101/07 - Office response filed (IT).

Keywords: Opposition: earlier right within Article 8(4) CTMR – Article 8(4) CTMR: Italian denominazione sociale – Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 1st Board of 12.1 2007 in R1342/2005-1, relating to CTM application 1903111 Dada (figurative mark), applied for in Classes 9, 16, 18, 25, 28, 35, 38, 39, 41 and 42.

CTM application	
	DADA

It had been opposed on the basis of an earlier Italian right in the trade mark DADA, registered in Classes 35, 37, 38 and 42, and the Italian "denominazione sociale" DADA for a range of services similar to those contained in the trade mark. The opposition had been successful.

Vitro : T-412/06 - Office response filed (ES).

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 13.10.2006 in R1364/2005-2, relating to CTM application 2669521, Vitro (word mark), which had been applied for a range of goods and services in Classes 1, 7, 8, 9, 11, 12, 16, 17, 19, 20, 21, 22, 27, 30, 35, 39, 40, 41, 42 and 43. The Class 19 products had been opposed on the basis of Vitral (word mark), registered both as a CTM and as national marks in Class 19. The opposition had been allowed, based on the invoked CTM.

CTM application	
	Vitral



Zoomerang/Boomerang : T-105/07 - Office response filed.

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

The action is directed against a decision of the 2nd Board of 25.1.2007 in R0253/2006-2, relating to CTM application 1603950, Zoomerang (word mark). It had been opposed on the basis of various Boomerang brands (figurative marks). The opposition had been allowed.

CTM application	
Zoomerang	

The CTM application (Zoomerang) had been applied for the following range of goods and services:

Class 9: Computer software; computer software for use in administration, distribution, collection, reporting and analysis of information via computer communication networks, computer software for use in designing and conducting surveys, research, and training via computer and communication networks; user manuals for computer software in electronic format. *Class 35*: Advertising; business administration; business management and consulting services; providing information in the field of survey research methods, results, and related topics; acquisition of potential survey respondents and their data for others; business consultation in the field of online research; building and facilitating of market research communities. *Class 42*: Online and web-based services for designing and conducting surveys, polls and other feedback and data collection activities via computer and communication networks; online and web-based services facilitating the administration, distribution, collection, reporting, analysis and representation of information gathered via computer and communication networks; hosting web-based surveys, polls and other feedback and data collection instruments for others; computer bulletin boards; providing information and technical consultation in the field of survey research methods, real-time feedback, results, and related topics; provision of portal websites for the purpose of conducting market research; designing surveys for others; hosting websites for others; management of potential survey respondents for others; provision of online facilities for use in the collection, reporting, and analysis of website user activity and feedback; providing end-to-end (design sample strategy, data collection, reporting, and analysis) survey solutions; design and programming of computer software for others; online research portal services; technical consultation, including technical consultation in the field of online research; design, development, installation, deployment, and maintenance of online information collection, analysis, and reporting applications for others; hosting web-based applications; updating of computer software; rental of



computer software; restoration of computer data; maintenance of computer software; analysis of computer systems; rental of access time to databases; providing access via computer and communication networks to the use of computer software for use in administration, distribution, collection, reporting and analysis of information via computer and communication networks; providing access via computer and communication networks to the use of computer software for use in conducting surveys, research and training via computer and communication networks.

The opponent had based its opposition only on part of the goods and services covered by both of its earlier signs:

Mobile telephones and cards for use in mobile telephones, telecommunications equipment, apparatus for communication, transmission and terminals for the broadcasting, transmission and reception of information (namely telephone exchanges, telephone and radio apparatus), computers, including magnetic data carriers, parts and accessories for all these products (Class 9); advertising, commercial businesses and office services in the field of telecommunications (Class 35); services relating to the study and activity of engineers, research and development in the field of telecommunications; design and realisation of computer programmes for telecommunications (Class 42).

DSBW/DSB or Goncharov/Danish Railway: T-34/07 - Office response filed (DE).

Keywords: Opposition: likelihood of confusion (LOC) – LOC: comparison of marks – Comparison of marks: earlier right with enhanced recognition.

The action is directed against a decision of the 2nd Board of 4.12.2006 in R1330/2005-2 relating to CTM 2852143, DSBW (word mark), for a range of services in Classes 39, 41 and 43. It had been opposed by Danish Railway on the basis of their Community trade mark DSB (word mark), registered in Classes 39, 41 and 42 (should read 43). Whereas the Opposition Division found no LOC on the grounds that the marks were dissimilar enough to exclude LOC, because of the “W” in the CTM application, the Board held to the contrary. It took into account that DSB is the logo of Danish railways and that the sign, for that reason alone, enjoys particularly enhanced recognition on the market.

Number “150” : T-66/07 - Office response filed (PL)

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

The action is directed against a decision of the 4th Board of 21.12.2006 in R1035/2006-4 by which it had rejected CTM application “350” (numeral) for periodicals, word puzzle books and pamphlets in Class 16. The reasoning was the same as in T-64/07 below.

Number “250” : T-65/07 - Office response filed (PL)

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

The action is directed against a decision of the 4th Board of 21.12.2006 in R1034/2006-4 by which it had rejected CTM application “350” (numeral) for periodicals, word puzzle books and pamphlets in Class 16. The reasoning was the same as in Case T-64/07 below.

Number “350” : T-64/07 - Office response filed (PL)

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

The action is directed against a decision of the 4th Board of 21.12.2006 in R1033/2006-4 by which it had rejected CTM application “350” (numeral) for periodicals, word puzzle books and pamphlets in Class 16. It had been rejected on the grounds of Article 7(1)(b) and (c) CTMR:

“(20) In relation to the goods ‘periodicals; word puzzle books and pamphlets’ the numeral ‘350’ may serve as a designation of the quantity of the information contained or as a designation of content. The goods covered by the application also include publications containing a specific number of various works (such as, for example, the lyrics of songs, proverbs or recipes). Published works of this kind do not appear in isolation but in the form of collections. Such practice is characteristic of the market concerned also in relation to publications containing brainteasers, as the examiner pointed out in particular in the decision refusing registration. These publications normally contain round quantities of brainteasers. At present the following publications, for example, are available on the market: ‘A Plethora of Crosswords – 500 Challenging puzzles’, ‘100 code crackers’ and ‘100 word searches’. The numeral ‘350’ also appears in this capacity, as examples of Internet searches indicate (cf. ‘Over 350 crosswords especially designed to be completed during your coffee break’).”

And further:

“(26) Furthermore, the refusal to grant registration is justified under Article 7(1)(b) CTMR since the sign applied for is not capable of distinguishing the goods claimed as originating from a particular undertaking. A word mark which is descriptive of characteristics of the goods or services concerned in a directly discernible manner is, on that account, necessarily devoid of any distinctive character (cf. judgment of the Court of Justice of 12 February 2004 in Case C-363/99, ‘Postkantoor’, paragraph 86), because in that case the designation will be perceived merely as factual information and not as an indication of their origin from a particular undertaking.”

Note : Cases T-64/07, T-65/07 and T-66/07 have been joined.

Fun : T-67/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: distinctiveness – Distinctiveness/assessment: impact of national registrations.

The action is directed against a decision of the 2nd Board of 20.12.2006 in R1135/2006-2 concerning an application by Ford Motor Company for registration of the word “Fun” for



motor vehicles and parts thereof in Class 12. The said application had been rejected under Article 7(1) (b) and (c) CTMR, inter alia on the grounds that the sign would merely indicate that the vehicle at issue would be particularly enjoyable to drive. The plaintiff had invoked registrations in Austria, Denmark, France, Portugal, Sweden, the Benelux and in Switzerland.

Ixi : T-78/07 - Office response filed.

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

The action is directed against a decision of the 2nd Board of 11.1.2007 in R0796/2006-2, relating to CTM application 3066412, word IXI, applied for a range of goods in Class 9, inter alia for electronic devices for mobile computing and communication. It had been opposed on the basis of the earlier word mark “ixi”, registered in Class 9 for computer programs (except for children). The CTM application had been rejected on standard criteria.

Zipcar : T-36/07 - Office response filed.

Keywords: Opposition: likelihood of confusion (LOC).

The action is directed against a decision of the 2nd Board of 30.11.2006 in R0122/2006-2, relating to CTM application 3139375, Zipcar (word mark), applied for a range of goods and services in Classes 9, 39 and 42. It had been opposed on the basis of the earlier right Cicar, word, registered in Class 39. The opposition had been allowed in full.

BioGeneriX-I : T-47/07 - Office response filed (DE).

Keywords: Absolute grounds for refusal: observations of a third party, Article 41 CTMR – Absolute grounds for refusal: descriptiveness.

The action is directed against a decision of the 4th Board of 20.12.2006 in R1047/2004-4 relating to CTM application 1701762, BioGeneriX (word mark), which had been applied for in Classes 5, 35, 40 and 42. It had been published but then refused on the basis of observations which had been filed by a third party. That party had filed evidence that the term “biogenerics” is in generic use within the trade concerned.

BioGeneriX-II : T-48/07 - Office response filed (DE); as in T-47/07 above. The sign had been applied for in Classes 1 and 5. The challenged decision of the 4th Board is R1048/2004-4.

Built to resist : T-80/07 - Office response filed.

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

The action is directed against a decision of the 2nd Board of 12.1.2007 in R1090/2006-2, relating to CTM application 2937522, slogan “Built to resist” (word mark). It had been applied for the following goods:

Class 16: Paper, cardboard and goods made from these materials, not included in other Classes; printed matter; bookbinding material; advertisement boards of paper or cardboard, albums, announcement cards, bags of paper or plastic, for packaging, bags of conical paper, bibs of paper, books, calendars, cardboard labels, catalogues, charts, embroidery designs (patterns), engravings, envelopes, folders, forms, greeting cards, books, magazines, newspapers, pamphlets, newsletters and other printed publications, photographs, pictures, portraits, postcards, stationery, address plates, address stamps, adhesive tapes for stationery or household purposes, announcement cards book markers, writing pads, plastic film for wrapping, paper, cardboard and goods made from these materials; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other Classes); printers' type; printing blocks pencil cases, pens, writing paper, envelopes, posters, paper banners, personal organizers, notebooks and paper binders; mouse pads - Class 18: Leather and imitations of leather, and goods made of these materials and not included in other Classes; animal skins, hides; trunks and travelling bags; all purpose bags and sporting bags, soft luggage, luggage cases, backpacks, day packs, fanny packs, frame packs, knapsacks, ski packs, book bags, tote bags, duffle bags, bicycle bags, handbags, garment bags, fanny packs, clothing bags, suitcases, Pullman cases, briefcases, wallets, umbrellas and parasols, business card cases and holders, billfolds and money clips, straps, pads and belts and all related goods to the before mentioned as far as included in Class 18 - Class 25: Clothing, headgear and footwear.

Whereas the examiner had rejected the application in full, relying on Article 7(1)(b) and (c) CTMR, arguing that the sign is a slogan that merely indicates in ordinary English that the goods were resistant, the Board had allowed the appeal in respect of some of the goods in Class 16, namely writing paper, postcards, magazines, newspapers, pamphlets, newsletters, forms, greeting cards, catalogues, charts, calendars and announcement cards since the mark appeared fanciful in relation to them given that the property of durability was not required or even was senseless. For this reason is the Board doubted whether consumers would make any pertinent connection between the mark and said goods. For the remainder of the goods, the Board had dismissed the appeal.



NEW DECISIONS FROM THE BOARDS OF APPEAL

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

Procedural Questions – Article 74(2) CTMR

Facts and evidence filed late – proof of genuine use

Decision of the Second Board of Appeal of 27 June 2007 in Case R 574/2006-2 (English)

R 0574/2006-2 PROTIDIET/PROTI et al. – the Board held that the additional evidence aiming to prove genuine use of the earlier trade mark, as submitted with the statement of grounds, was complementary evidence and, consequently, could be taken into consideration in accordance with the judgment in Case C-29/05(P), 'Arcol', since the opponent had made a serious attempt to prove genuine use before the Opposition Division. The complementary evidence enabled the opponent to show normal commercial use designed to obtain a share of the market of goods at stake. The case was remitted to the Opposition Division for the assessment of likelihood of confusion.

Facts and evidence filed late – substantiation of the earlier right

Decision of the Second Board of Appeal of 29 June 2007 in Case R 1468/2006-2 (English)

R 1468/2006-2 BUZZ! (Fig. Mark)/BUZZ! – the Board held that the evidence aiming to prove the substantiation of the earlier mark submitted in the appeal proceedings was inadmissible since neither the stage of the proceedings at which the late submission took place nor the surrounding circumstances supported such matters being taken into consideration. Such evidence was not complementary since no evidence had been submitted beforehand. The copy of an excerpt of a private data base cannot be accepted as valid evidence. The opposition was dismissed.

Opposition Proceedings – Article 8(1)(b) CTMR

Comparison of goods and services – pharmaceuticals – nature of goods – likelihood of confusion

Decision of the First Board of Appeal of 28 June 2007 in Case R 565/2006-1 (French)

R 565/2006-1 ISDIN 14-8.000/ISTIN – when comparing pharmaceuticals, it is important to take the specific market of the pharmaceuticals into consideration. Products intended to

treat skin disorders do not have any similarities with cardiovascular products, apart from their pharmaceutical nature. The goods are intended to relieve different health problems; consequently there is only a slight similarity. The similarities of the signs and the similarities of the goods were not sufficient to produce a likelihood of confusion.

Cancellation proceedings – Article 51(1)(b) CTMR

Absolute grounds for invalidity – opposition based on an unregistered well known trade mark – sign used in trade – bad faith

Decision of the First Board of Appeal of 23 May 2007 in joined cases R 1246/2005-1, R 1247/2005-1, R 1248/2005-1, R 1249/2005-1 (all in Spanish)

R 1246/2005-1, R 1247/2006-1, R 1248/2006-1, R 1249/2006-1, TRAXDATA et al./TRAXDATA et al. – when basing its application for cancellation on an unregistered trade mark with reputation (Art. 6 bis PCU) or on a sign used in trade, the applicant for cancellation has to show that the public attributes such trade mark or sign to the applicant and not to the owner of the registered CTM.

The concept of bad faith may apply to any person aware that what he or she is doing is not correct, because such behaviour is in conflict, for example, with ethical standards or standards of commercial equity. Additionally, such behaviour must result in unjust prejudice to others. The bad faith of the person performing the action should not be measured subjectively, but objectively, on the basis of the information available to the person when the act took place. Bad faith must be proven to have existed at the moment of filing a trade mark. A person convinced of being the creator of a trade mark cannot act in bad faith at the moment of filing said trade mark. The request for cancellation was rejected.

Procedural Questions – Article 62 CDR

Design proceedings – right to be heard

Decision of the Third Board of Appeal of 5 July 2007 in case R 1421/2006-3 (English)

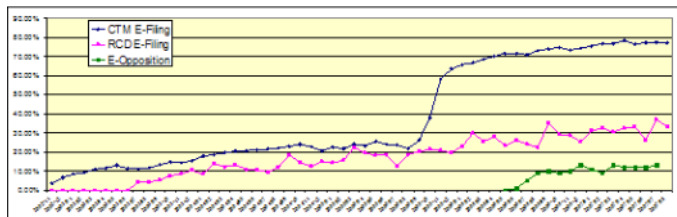
R 1421/2006-3 CASH REGISTERS – the indication of the product (a mandatory requirement of any design application - Article 36(2) CDR) may produce legal consequences. Consequently, the Board held that the Designs Department is not entitled to change the indication of the product without offering the applicant the right to comment on such a proposed modification.

E-Business at OHIM

The OHIM E-Business Roundup (2007)

Statistical summary

- The use of the CTM e-filing web form is maintained at around 75%.
- The use of RCD e-filing has decreased to around 30%
- 14% of oppositions against CTM applications are received electronically.



State of play of future projects

B2B e-filing CTM:

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

Status - The OHIM has set up its system. CPA Software Solutions (Inprotech) has completed the tests.

Service - New version of e-Communication:

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

Status - The OHIM has started the testing phase

Service - New version of CTM E-filing:

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

Status - The OHIM has completed the requirements.

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 OHIM has completed the requirements.

Service-E-renewal RCD:

The objective is to provide an electronic tool for renewing registered Community designs. s.

Status - This new facility will be available as from 01/11/2007

Service - E-Caveat:

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

Status - The OHIM has completed the requirements.

Service - Online handling of opposition procedures:

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

Status - The OHIM has completed the requirements.

More News

OHIM Annual Prize gets Bigger and Better

The OHIM Annual Prize, aimed at graduates or post-graduates in courses related to Community industrial property (IP), has been launched for 2007/2008 with a larger prize fund and a wider remit.

The competition, for the best original and unpublished dissertation on a subject related to Community trade marks and designs, offers €15,000 to the winner and €7,500 to the runner-up – plus the opportunity for both to take part in a coveted five-month-long paid internship in an OHIM department.

The main aims of the annual prize are:

- to promote better understanding at university level of Community trade marks and designs
- to reinforce links with IP training and research institutions in Europe
- to encourage more expertise and experience in Community trade marks and designs.

Director of the general affairs and external relations department João Miranda de Sousa says the prize fund has been made even more attractive and the competition is no longer restricted to those studying courses.

“We realise that many talented post-graduates now on the jobs market might also be interested in taking part and could have a lot to contribute”, he adds.

The competition is open to those who have studied or are in the process of studying a post-graduate course related to Community IP in the 27 member states of the EU, with a deadline for applications of 15 December, 2007.

The dissertations, which must be submitted in English, will be examined by a special Jury composed of experts drawn from the Office or from outside. The winners will be announced on 15 March, 2007 with an official award ceremony the following month.



Further information on the OHIM Annual Prize, including the detailed rules of the competition and the application form, can be obtained from our website at:

<http://oami.europa.eu/en/office/award/default.htm>

E-Business workshops

The OHIM is organising workshops throughout 2007 to provide practical information on the electronic tools which are available to clients, in particular CTM and RCD e-filing, e-opposition, MYPAGE and search systems.

The first two workshops were held on 23 March in Alicante and 28 March in Brussels.

The next ones will be organised on 22 October from 09:30 to 13:30 in Alicante (in Spanish) and on 15 November from 14:00 to 18:00 in Brussels (in English). Participation is free of charge and is limited to 50 people on a 'first come, first served' basis.

The content of the workshops is mainly targeted at paralegals.

If you are interested in participating, please send an e-mail to e-business@oami.europa.eu indicating the name and job title of the participant(s) you wish to send, and the date and place of the workshop. The OHIM will then send you practical details together with the confirmation of participation.

Monthly Statistical Highlights July-August 2007

Monthly Statistical Highlights* - July 2007

Community trade mark applications received	7,768
Community trade mark applications published	9,859
Community trade marks registered (certificates issued)	6,425
Community trade mark renewal applications	1,117
Registered Community designs received	6,326
Registered Community designs published	6,446

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

Monthly Statistical Highlights* - August 2007

Community trade mark applications received	7,310
Community trade mark applications published	7,754
Community trade marks registered (certificates issued)	6,331
Community trade mark renewal applications	911
Registered Community designs received	4,782
Registered Community designs published	5,487

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