

Decisions of the Trimester General Court & European Court of Justice

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ICLAD



OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Statistics

Decisions from September 15 to December 1, 2015

COURT	TOTAL	(PARTIALLY) ANNULLED	DISMISSED
CJ	1	0	1
GC	97	24	73



OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Absolute Grounds



18/09/2015 T-710/13



TAFEL

CTM registered for Services in
Classes 39 and 45



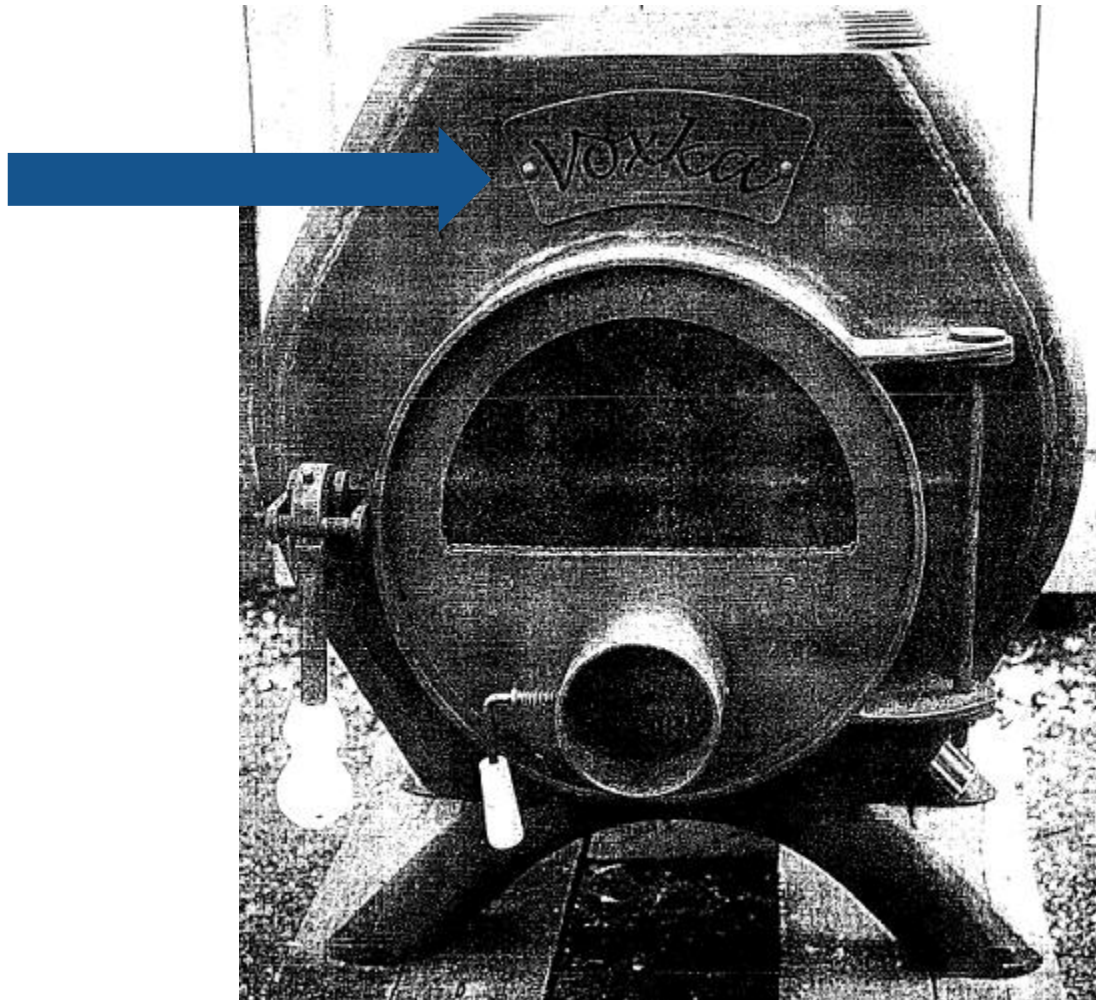
- The word “TAFEL” can have several meanings in the German language.
- BoA has based its decision on one meaning only, namely for “table” and not for “charity projects”.
- “TAFEL” understood in the sense of “table” is not descriptive for the services at hand.

24/09/2015 T-317/14



CTM registered for Goods in Class 11 “kitchen range oven”

24/09/2015 T-317/14



24/09/2015 T-317/14



CTM registered for Goods in Class 11 “kitchen range oven”

- Irrelevant whether mark might be functional or otherwise lacks distinctive character.
- Distinctive character of 3D marks has to be assessed the same way as for other marks.
- 3D marks might be perceived by average consumer differently than word marks.
- Unusual shape which enjoys high degree of distinctive character.
- Word element enjoys “only” normal degree of distinctive character.

25/09/2015 T-366/14

2good

CTM applied for Goods in Class 30

- Widespread use of “SMS language”.
- The number 2 is associated with the English words “two”, “too” or “to”.
- “2good” is neither an unusual nor rare combination and will be immediately understood as meaning “too good”.

25/09/2015 T-366/14



2good

CTM applied for Goods in Class 30

- Existence of identical marks irrelevant.
- BoA not bound by prior registrations made in a Member State.
- BoA not bound by prior registrations in other English-speaking countries.

25/09/2015 T-707/14



DetergentOptimiser

CTM applied for Goods in Class 7

- Relevant Public is the English-speaking public.
- Unitary character of CTM.
- Distinctive character required throughout the entire European Union.
- Principle of equal treatment / sound administration have to be consistent with respect to legality.

07/10/2015 T-187/14



FLEX

CTM applied for Goods in Class 10

- Sufficient that relevant public understands immediately and without intellectual effort the meaning of FLEX.
- BoA not obliged to prove that mark appears in dictionaries.
- Fact that term is cited in American dictionary is further evidence that term may be used in the same sense by an anglophone public, which includes the public in the UK, Ireland and Malta.
- Office guidelines cannot prevail over the provisions of the CTMR.

07/10/2015 T-642/14

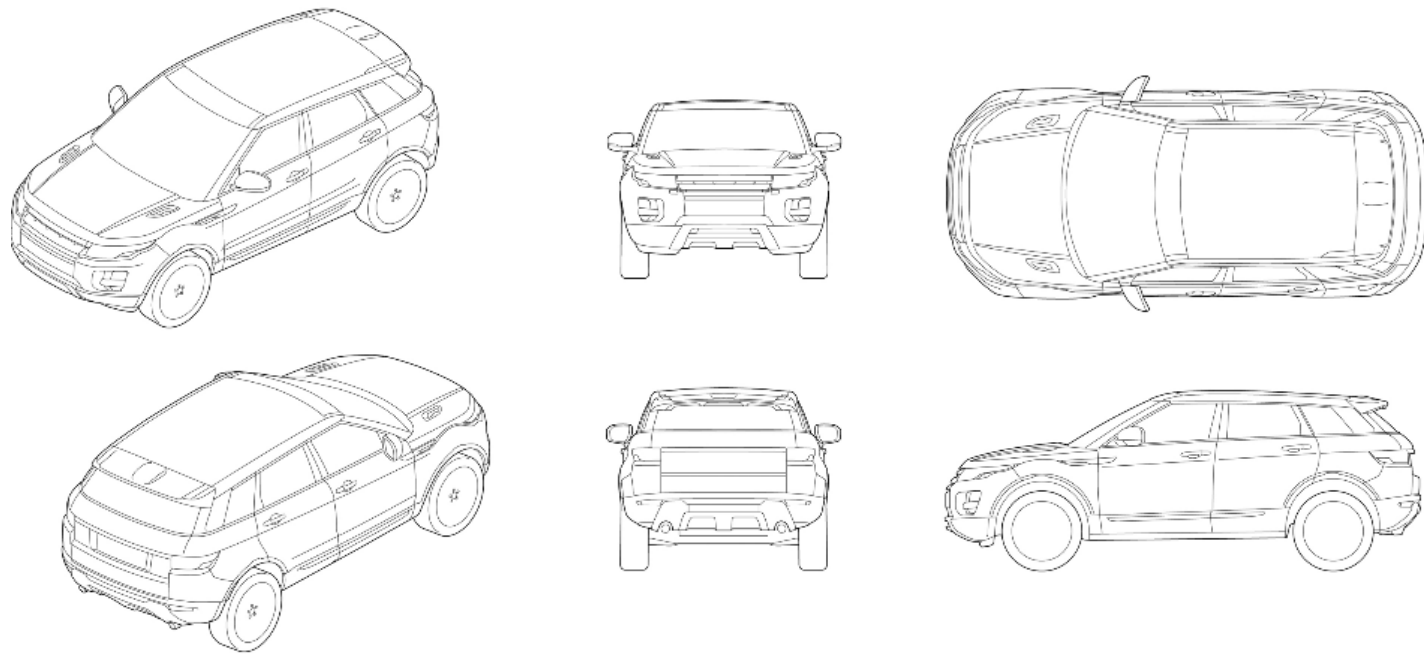


EQUIPMENT FOR LIFE

CTM applied for Goods and Services in
Classes 18, 25 and 35

- “Equipment” is immediately perceptible by the relevant public.
- “Equipment” not limited to technical background, but can be associated with clothing, too.
- Fact that consumers may replace their clothing for fashion reasons, does not affect the message about the durability of the goods in question.
- Applicant cannot deduct any right from prior registrations outside the EU.
- BoA is only bound by EU rules and neither by any national system nor prior Office practice.

25/11/2015 T-629/14



CTM applied for Goods in Classes 12, 14 and 28

25/11/2015 T-629/14

- Mark shows no features that distinguish the car significantly from others.
- Characteristics not set out in the application, do not have to be taken into account
- Account has to be taken “exclusively” to the representation of the mark as filed for.
- Photographs and third party reviews of the ready-made car are not relevant.

25/11/2015 T-629/14 (shape of a car)

ANNULLED





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Relative Grounds

24/09/2015 T-641/14

CTMA

LEXDELL

Earlier Mark

DELL



- Some visual and low degree of phonetic similarities.
- Word “lex” does not create a conceptual difference, capable of counteracting visual/phonetic similarities.
- Application does not exactly reproduce name of the applicant (Alexandra Dellmeier).

24/09/2015 T-195/14

ANNULLED

CTMA



Earlier Mark



- Word element of composite marks is usually more distinctive than figurative element.
- Element “PRIMA” cannot be disregarded in the comparison.
- “PRIMA” not perceived as laudatory in all languages.
- Marks are at least visually similar to a low degree.
- Minimum degree of distinctive character of earlier right can be presumed.

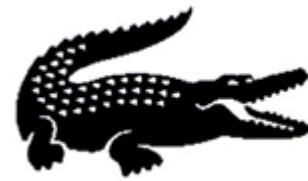
30/09/2015 T-364/13

CONFIRMED

CTMA



Earlier Mark



- Visual similarity is low. No phonetic comparison possible. Conceptually similar.
- Earlier right enjoys high degree of distinctive character.
- Claim of enhanced inherent distinctive character inadmissible as raised for the first time before the GC.

30/09/2015 T-720/13



CTMA
KARIS

Earlier Marks
CARYX
AKRIS

- Goods and Services are similar despite the fact that goods of the earlier right have been expressly excluded from the application.
- Applicant failed to demonstrate how the nature/purpose of relevant goods differ.
- TMclass/Nice classification only serve administrative purposes.
- No actual co-existence proven.

0710/2015 T-365/14

CONFIRMED

CTMA



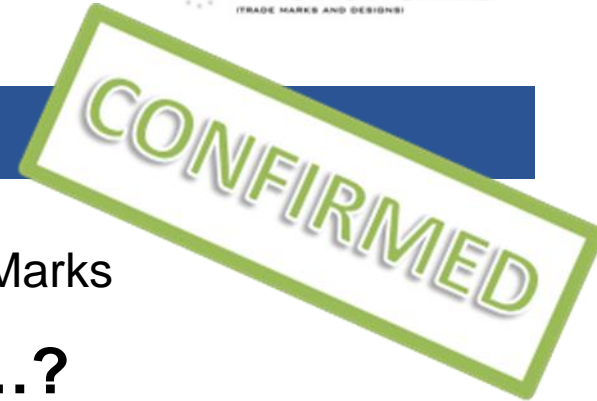
Earlier Marks

FRECCE TRICOLORI



- Attentiveness of consumers re: goods of classes 18 and 25 is above average.
- BoA erred in finding a low similarity between the goods in classes 9, 14, 18 and 25.
- BoA should have taken into account differences in the backgrounds.
- BoA right to conclude likelihood of confusion.

15/10/2015 C-270/14 P



CTMA
SÔ:UNIC

Earlier Marks
SO...?
SO...? ONE
SO...? CHIC
(etc.)

- Opposition was based on 24 earlier marks, all consisting of “so...?”
- Later mark needs to have characteristics, which suggest it belongs to the family of marks in question.
- GC erred in law by not taking into account that the goods covered were in part identical.
- Error irrelevant as GC ultimately found no likelihood of confusion irrespective of the goods covered.
- Identification of shared elements of the marks is question of fact and not subject to review by ECJ.

28/10/2015 T-736/14



CTMA
MoMo Monster

Earlier Mark
Monster

- “Confectionary” dissimilar to “milk and coffee based beverages”.
- Goods serve different purpose, are not in competition and not interchangeable.
- Doesn’t matter whether consumed together (only optional).
- Same outlet not particular significant.

18/11/2015 T-606/13

CTMA



Earlier Marks

MUSTANG



18/11/2015 T-606/13 (Mustang)



- Earlier word mark enjoys reputation (although not “exceptionally high”).
- No specific link between “tobacco” and “clothing”.
- Goods so dissimilar that application will not bring earlier mark to the mind of average consumer.
- From the mere fact that smoking negatively affects health, it cannot be automatically inferred that use for these products diminish the attractiveness of earlier mark for clothing.



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Thank You