

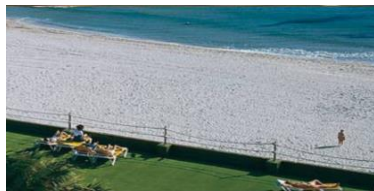


Decisions of the Trimester

June – August 2015

Christoph Bartos – Member of the Boards of Appeal
15 September 2015

Alicante



BEAUTIFUL, MEDITERRANEAN, UNIQUE



City of Business

4th province of Spain /

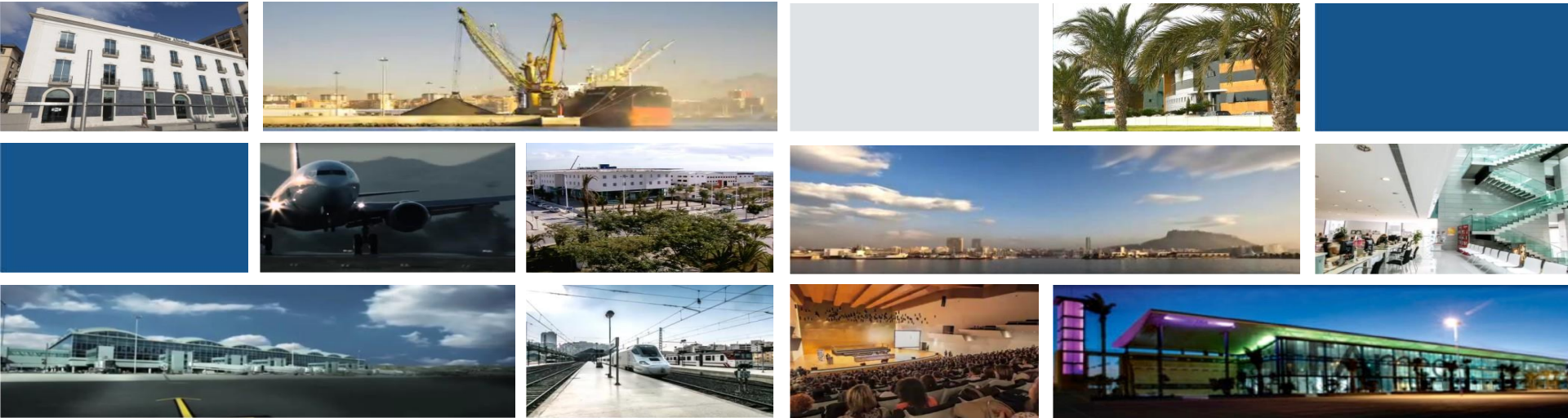
€35.000 Million in 2011 /

129.728 Companies

With the 4th largest GDP /

SMEs 96.1% /

Exports € 3.500 Million/year

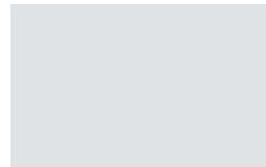
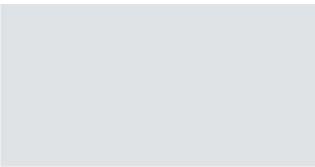
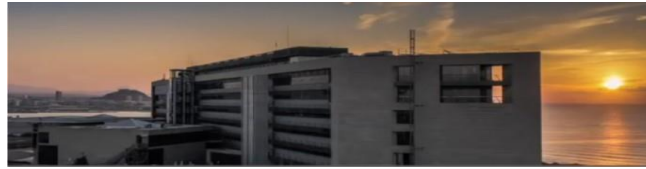
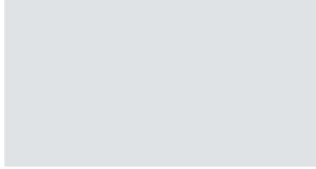




City of OHIM

OHIM – Agency of the EU / 100 000 CTMs and 80 000 RCDs/year / The EU Observatory on Infringements of IP rights
Employees from 28 EU Members States / 1000 IP Professionals working ...

For you



The Menu

Procedural Questions

- Unordered evidence

Absolute grounds of refusal

- Figurative trade mark
- Colour trade mark
- 3D trade mark
- Geographical denomination
- Open software
- Distinctive character acquired through use

The Menu

Relative Grounds of refusal

- Weak trade marks or weak elements
- Reputation helps
- My name, your name?



Just another figure

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Procedural Questions

R1840/2011-1 Galileo

Facts

- Proof of use submitted
 - Several hundreds of annexes with more than 1000 pages
 - Several annexes have the same number but different content
 - Evidence not ordered with respect to different goods and services

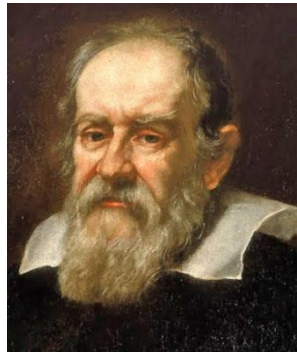
R1840/2011-1 Galileo

Board of Appeal

- Rule 22(3) CTMIR
 - Identify facts: support facts with evidence
 - If evidence is submitted without identifying which facts are to be supported, then the evidence cannot be taken into consideration

Result

- Evidence shall not be taken into consideration





Absolute grounds of refusal

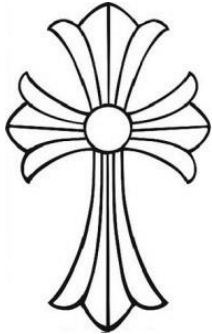


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R2432/2014-1 CROSS

CTM applied for



- Cl. 3, 9, 21, 30
 - E.g. Incense; DVDs; Chocolates

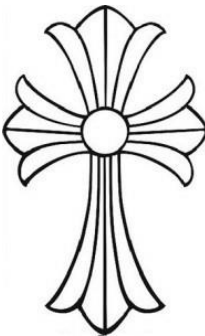
R2432/2014-1 CROSS

Board of Appeal

- cross embedded with various ornamental details
- Sign may be representation of the goods
 - Other shapes exist, but irrelevant

Result

- Contested decision confirmed
- CTM applied for **rejected**



R3101/2014-5 ORGAN

CTM applied for



- Cl. 9
 - Disks, CDs, DVDs and other digital data media

R3101/2014-5 ORGAN

Board of Appeal

- a large gold organ
 - No proof in file that the average consumers perceive the organ of the Grand Hall of the *Musikverein*
- reference to music or video recordings
 - organ music, church music or classical music

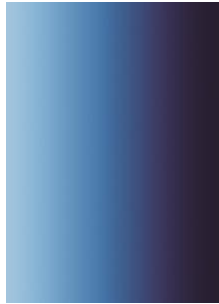
Result

- Contested decision confirmed
- CTM applied for **rejected**



R0518/2015-2 Shades of blue

CTM applied for



Description:

The mark consists of the colours depicted in the sample being a graduation from light blue (CMYK combinations C46 M9 Y2 K3), through mid-blue (CMYK combinations C*% M50 Y6 K2) to dark blue (C97 M97 Y45 K56)

- Cl. 9, 35 – 39, 41 – 45
 - Class heading + alphabetical list (?)

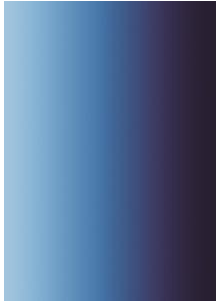
R0518/2015-2 Shades of blue

Board of Appeal

- Consumer does not see an indication of origin in colour *per se*
- Irrelevant whether the G&S may have naturally the colour

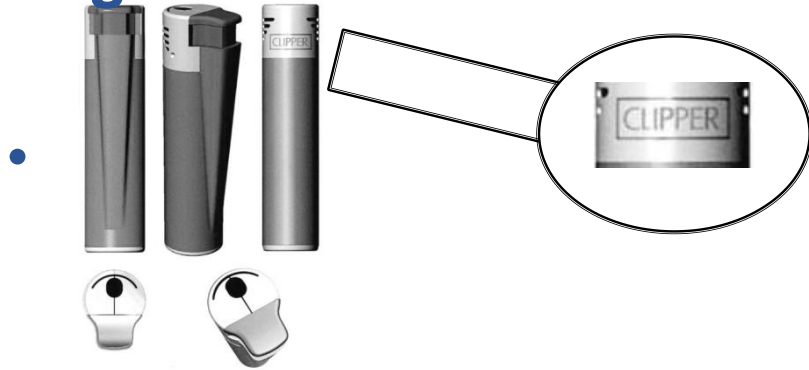
Result

- Contested decision confirmed
- CTM applied for **rejected**



R0924/2013-1 CLIPPER

Registered CTM



- Cl. 4, 34, 35

Cancellation Division

- Request to cancel the CTM **rejected**

R0924/2013-G CLIPPER

Board of Appeal

- The verbal element is not a major non-functional element of the trade mark, since the proprietor wished to register a 3D trade mark
 - No description filed which allows that more than the shape is sought
 - Verbal element is small
- Article 7(1)(e)(ii) CTMR for Cl. 4 and 34
- Article 7(1)(b) CTMR for all G&S



R0924/2013-G CLIPPER

Result

- Contested decision annulled
- CTM **cancelled**



R0297/2015-4 Tine 2.0

CTM applied for

- **Tine 2.0**
- **Cl. 9, 38 and 42**
 - all related to computer software or telecommunication

R0297/2015-4 Tine 2.0

Board of Appeal

- 2.0: a better version than the first one
- Tine: a specific software, based on Linux

Result

- Contested decision annulled
- CTM applied for **may proceed to publication**

R1458/2014-1 Ghostwriter.nu

CTM applied for

- **Ghostwriter.nu**
- **Cl. 42**
 - Services related to scientific work

R1458/2014-1 Ghostwriter.nu

Board of Appeal

- *Ghost writer* is a person who writes on behalf of a person who is then credited as author
- ‘.nu’: top level domain of Niue

Result

- Contested decision confirmed
- CTM applied for **rejected**



R1336/2014-2 THE DONKEY SANCTUARY

CTM applied for

- THE DONKEY SANCTUARY
- Cl. 43, 44 [& 6, 9, 16, 18, 25, 28, 35, 36, 41]
 - Boarding for animals; medical care



1336/2014-2 THE DONKEY SANCTUARY



Board of Appeal

- Article 7(3) CTMR
 - Relevant area: English speaking area of EU
 - Malta:
 - 0,6% of EN speaking population
 - 0,2% of donkey population in EN speaking area

Result

- Contested decision annulled
- CTM applied for **may proceed to publication**



Proof of use

use which does not alter the distinctive character



Just another figure

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Relative grounds of refusal



Just another figure

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R1653/2014-2 MATERNITY/MATERNITY

CTM applied for

-  maternity worldwide
- **Cl. 35, 36, 41, 42, 44**

Earlier trade mark (ES)

-  **MATERNITY**
una apuesta por la mujer y la maternidad
- **Cl. 41, 44, 45**

R1653/2014-2 MATERNITY/MATERNITY



Board of Appeal

- Services are at least similar
- ‘maternity’ understood by ES public
- Coincidence only in descriptive term



Result

- Contested decision annulled
- CTM applied for **may proceed to registration**

R2508/2014-5 DHP/HDP

CTM applied for

- DHP
- Cl. 7, 9

Earlier trade mark

- HDP
- Cl. 7, 11, 20

R2508/2014-5 DHP/HDP

Board of Appeal

- Even attentive consumers may remember only the letters, but not necessarily their order

Result

- Contested decision confirmed
- CTM applied for **rejected**

R0761/2014-1 pillow HOTELS/ibis

CTM applied for



- **Cl. 36, 43**

Earlier trade mark(IR_{EU})



- **Cl. 35, 43**

R0761/2014-1 pillow HOTELS/ibis

Board of Appeal

- dominant elements: ‘pillow’ and ‘ibis’
 - Other elements are only secondary or purely decorative
- Possible enhanced distinctiveness cannot change outcome
 - Has no impact on similarity of signs

Result

- Contested decision confirmed
- CTM applied for **rejected**

R2477/2014-2 mcVital/McDonald's

CTM applied for



- **Cl. 3, 5, 35**
 - Including dietetic supplements

Earlier trade mark (CTM)

McDONALD'S

- **Mc**
Mc[plus other elements]
- **Cl. 25, 28 – 31, 35, 41, 42**

R2477/2014-2 mcVital/McDonald's

Board of Appeal

- Goods and services are dissimilar
 - Article 8(1)(b) CTMR fails
- 'Mc' is the only common element
 - Known as part of Scottish or Irish names
 - Reputation is not part of the comparison of signs
 - 'Vital' vs 'food'
 - CTM applied for not part of family of trade marks



R2477/2014-2 mcVital/McDonald's

Result

- Contested decision partly annulled
- Opposition rejected in entirety
- CTM applied for **may proceed to registration**



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CTM applied for

- 

- **Cl. 9, 14, 18**
 - Class Heading

Earlier trade mark (CTM, ES)

- 

- **Cl. 9, 14, 18**
- **Reputation for sunglasses**

Board of Appeal

- Article 8(1)(b) CTMR
 - Signs are similar
- Article 8(5) CTMR
 - (Mental) link between signs exist
 - link between goods exists, since all in Class 9
 - Earlier trade marks enjoy reputation
 - Luxury goods, high standing

R1879/2014-1 & R1967/2014-1 Ret Bw/RayBan

Ret Bw Ray-Ban

Result

- Contested decision partly annulled
- Opposition allowed in entirety
- CTM applied for **rejected**

R0285/2014-2 MARIA CALLAS

CTM

- Maria Callas
- Cl. 14

Request for declaration of invalidity

- Article 53(2)(a) CTMR [right to a name] in conjunction with Article 57 Greek Civil Code
- Filed by the brother-in-law



R0285/2014-2 MARIA CALLAS

Board of Appeal

- IP rights, including moral rights and right on name, personality and artistic work can be inherited
- Brother-in-law is after chain of succession only heir
- Brother-in-law = brother

Result

- Contested decision annulled
- CTM declared **invalid**





Just another figure

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Maybe this helps

355 367 500 EUR Budget

1 555 Cases closed

Solution

Average costs of a proceedings before the ECJ

228 532 €





Thank You for your Attention

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Thank You