



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

Decisions of the Trimester

April – June 2015

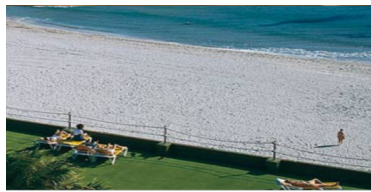
Christoph Bartos – Member of the Boards of Appeal

30 June 2015

Alicante



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



BEAUTIFUL, MEDITERRANEAN, UNIQUE



City of Business

4th province of Spain /

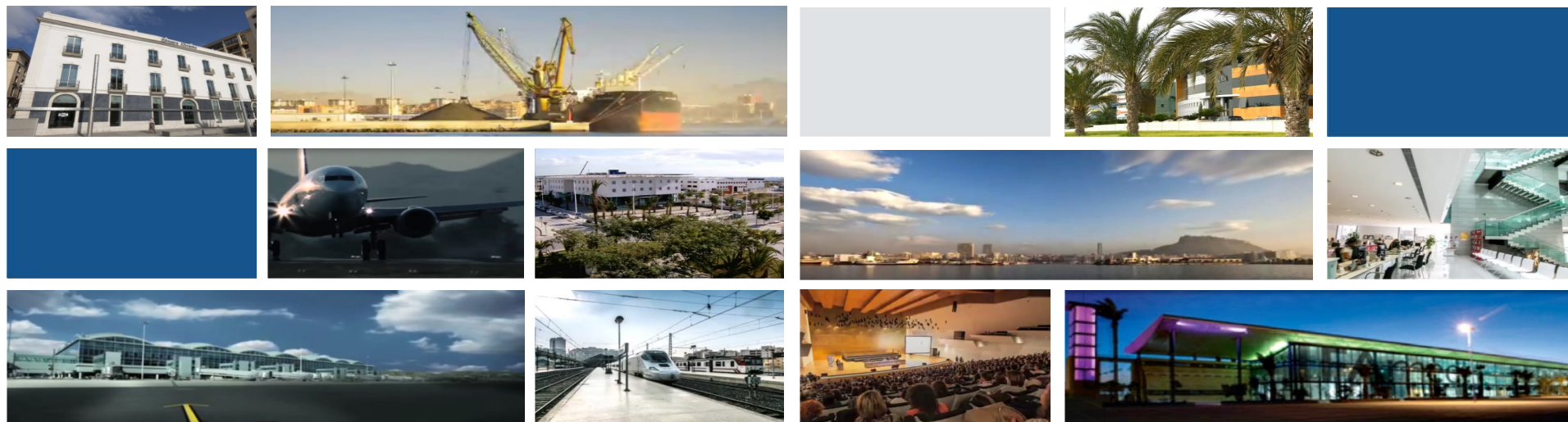
€35.000 Million in 2011 /

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

- Request for exclusion
- Claim of priority

Absolute grounds of refusal

- Clear and precise
- Non-distinctive word elements and figurative elements
- Public order

Proof of use

- Use which alters the distinctive character

Relative Grounds of refusal

- Weak and non distinctive elements
- Family of trade marks

Just another figure

1518



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

Procedural Questions

R0117/2014-4 request for exclusion

Facts

- Board cancels a trade mark of the opponent (not relevant for the current proceedings) due to bad faith
- Opponent files an action against before GC against that decision
- Several months later, Opponent files in current appeal proceedings a request for exclusion of members who decided on the bad faith case
 - for all future cases of opponent and/or its representative

R0117/2014-4 request for exclusion

Board of Appeal

- Request inadmissible since presented too late
 - No further procedural steps are allowed as soon as party gets aware of possible reasons for exclusion
- Request not substantiated
- Request not well founded
 - Members are not to be excluded just because they cancelled a specific trade mark, not even if the GC would annul the case

Result

- Request for exclusion rejected



R1536/2014-2 claim of priority

CTM applied for

trade mark on which priority is based





R1536/2014-2 claim of priority



Board of Appeal

- The term 'identity' means the same in the entire CTMR
 - Strict interpretation
 - Only insignificant differences which go unnoticed

Result

- Contested decision annulled
- **Priority claim accepted**



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

Absolute grounds of refusal

Just another figure

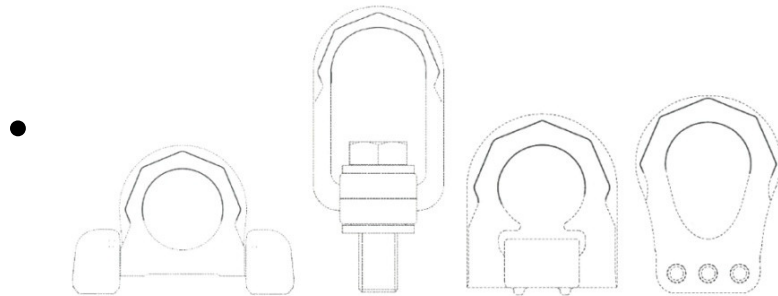


1518

R1793/2014-4

Achteck mit mindestens 5 Ecken (I)

CTM applied for

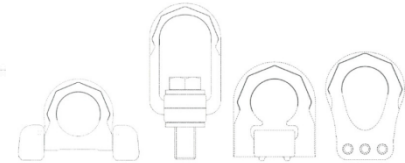


Position mark with the following description:

Exclusive rights are only directed at the arrangement of the relief of an octagon or octagonal arc with at least 5 corners, which relief is depicted in a solid line and preferably positioned enclosing an opening on the product. All parts of the product depicted in dotted lines are not part of the trade mark and merely serve to represent the position of the trade mark on the product.

R1793/2014-4

Achteck mit mindestens 5 Ecken (I)



Board of Appeal

- New objection under Article 7(1)(a)
- Description can only clarify the subject of application
- graphical representation of the trade mark is reduced to a non-binding example

Result

- Appeal dismissed
- **CTM applied for rejected**

R2931/2014-5 Economy Car Rentals

CTM applied for

- 
ECONOMY CAR RENTALS
RENTAL-HIRE-RENT A CAR-
AUTOVERMIETUNG-MIETWAGEN

- Cl. 39

R2931/2014-5 Economy Car Rentals



Board of Appeal

- sign must be assessed in its entirety
- verbal elements have no capacity to distinguish the services *per se*
- Animated money box on wheels


Result

- Appeal allowed
- **CTM remains on register**



R0672/2014-2 IP

CTM applied for

- 
- Cl. 9, 16, 41, 45
– i.a. legal advise



R0672/2014-2 IP

Board of Appeal

- 'IP' ... Intellectual Property
- Violet rectangle


Result

- Appeal dismissed
- **CTM applied for rejected**



R3176/2014-4 PHARMACY CONNECT

CTM applied for

-  PHARMACY CONNECT
- Cl. 35, 38, 42, 44

R3176/2014-4 PHARMACY CONNECT



Board of Appeal

- Verbal elements are descriptive
- Green cross often used for pharmacies in EU
- Computer mouse indicates availability over the net

Result

- Appeal dismissed
- **CTM applied for rejected**

Figurative elements and non-distinctive word elements - Examples (I)

T-494/13

- **watt** REJECTED
- Cl. 35, 39, 42

T-504/12

- **NOTFALL
CREME** REJECTED
- Cl. 3, 5

T-344/14

-  REJECTED
- Cl. 5, 29, 30, 31, 32, 33

T-520/12

-  REJECTED
- Cl. 30

Figurative elements and non-distinctive word elements - Examples (II)

T-366/12

- 

REJECTED

- Cl. 30

T-535/12

- 

REJECTED

- Cl. 3, 5

T-203/14

- 

REJECTED

- Cl. 18, 25

(CP 3) Figurative elements and non-distinctive word elements - Criteria to be taken into consideration

Normally not sufficient to render distinctive character

- standard typeface, lettering or handwritten style typefaces
- punctuation marks or other symbols commonly used in trade
- addition of colors to the word element
- arrangement of word elements
 - vertical, upside-down etc.
- simple geometric shapes or signs commonly used in trade
 - such as labels, pictograms, representation of the goods and services
- non distinctive (or banal) figurative element

and also

- misspellings, grammatical errors
- use of different languages
- combination of descriptive words
- combination of any of these elements

R02804/2014-5

MECHANICAL APARTHEID

CTM applied for

- **MECHANICAL APARTHEID**
- Cl. 9, 16, 41
 - *i.a.* computer games, books, entertainment services

R02804/2014-5

MECHANICAL APARTHEID

Board of Appeal

- Terms are understood in the entire EU
 - apartheid is a crime
- contradicts the indivisible, universal values on human dignity, freedom, physical integrity, the principles of democracy and the rule of law

Result

- Appeal dismissed
- **CTM applied for rejected**



R02822/2014-5 CONTRA-BANDO

CTM applied for

- **CONTRA
-BANDO**
- Cl. 33

R02822/2014-5 CONTRA-BANDO

**CONTRA
-BANDO**

Board of Appeal

- ‘contrabando’: ‘contraband’, ‘smuggling’
- Provocative and transgressive

Result

- Appeal allowed
- **CTM applied for may proceed to publication**

Proof of use

use which does not alter the distinctive character

Just another figure



1518





R1971/2014-4

Sign as registered

- **BAG PAX**

Sign as used

- **BAGPAX**

R1971/2014-4

Board of Appeal

- Overall impression whether sign used alters the distinctive character
 - Not the degree of distinctive character
- Not the added (or omitted) element must assessed

Result

- Distinctive character of the CTM not altered



R1125/2014-5 KIKO/CHICCO

Sign as registered



Sign as used



R1125/2014-5 KIKO/CHICCO

Board of Appeal

- Distinctive character lies in the verbal element, not in the colour or label

Result

- Distinctive character of the CTM not altered



Relative grounds of refusal

Just another figure



1518



R0909/2014-5

BARISTA PRIMA COFFEEHOUSE/PRIMA

CTM applied for

- **BARISTA PRIMA COFFEEHOUSE**
- Cl.30, 35

Earlier trade mark (PL)

- **PRIMA**
- Cl. 30

R0909/2014-5

BARISTA PRIMA COFFEEHOUSE/PRIMA

PRIMA



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

Board of Appeal

- ‘prima’ will be understood as ‘the best’
 - ‘barista’ will not be understood
- Overall impression is different
 - Same non-distinctive term not enough

Result


- Appeal dismissed
- CTM applied for may proceed to registration

R1125/2014-5 KIKO/CHICCO

CTM applied for

- 
- Cl. 3, 10, 12, 21, 25, 28

Earlier trade mark

- 
- Cl. 3, 10, 12, 21, 25, 28

R1125/2014-5 KIKO/CHICCO

Board of Appeal

- Comparison of signs
 - Visually: dissimilar
 - Aurally: highly similar, especially in IT
 - Conceptually: dissimilar
- No reputation proven


Result

- Appeal dismissed
- **CTM applied for may proceed to registration**

R2539/2013-2

Tu viaje empieza aquí/aquí empieza tu viaje

Registered CTM

- Tu viaje empieza aquí 
- Cl. 16, 35, 38, 39, 43

Earlier trade mark (ES)

- 

GERISO
- "AQUI EMPIEZA TU VIAJE"
- Cl. 39

R2539/2013-2

Tu viaje empieza aquí/aquí empieza tu viaje



Board of Appeal

- Slogans are descriptive
 - Descriptive elements are not dominant
- Comparison of signs
 - Visually: certain degree
 - Aurally: dissimilar
 - Conceptually: dissimilar (dominant elements)

Result

- Appeal dismissed
- **CTM remains in register**

30 June 2015

Decisions of the Trimester



Weak and non-distinctive elements – likelihood of confusion – Examples (I)

T-102/14

- TPG POST v. POST

No LoC

T-608/13

-  v. 

No LoC

T-566/13

-  HostelTouristWorld.com v. HOSTELWORD.COM

LoC

(CP 5) - Weak and non-distinctive elements – likelihood of confusion – Criteria to be taken into consideration

Comparison of the signs

- All components of both signs must be assessed
 - Prioritizing on the common elements
- Same criteria as in absolute grounds is used for assessment of distinctive character of the earlier trade mark
 - various degrees of distinctive character exist
 - Sign may even lack any distinctive character (? , question currently pending before GC , T-777/14)

Low or non distinctive character in global assessment

- Weak trade mark enjoys low scope of protection;
- Coincidence in weak elements normally not sufficient, unless
 - other elements that are lower (or equally low) or have insignificant impact AND the overall impression is similar , or
 - overall impression is highly similar or identical;
- Coincidence in non-distinctive elements not sufficient, unless
 - Other similar or identical elements exist, and
 - overall impression is highly similar or identical.

 **Likelihood of confusion is not excluded but difficult to establish**



R0654/2014-2 McGym/McDONALD'S

CTM applied for

- **McGym**
- Cl. 25, 28, 32, 41

Earlier trade mark

- **McDONALD'S**
- Cl. 25, 28, 29, 30, 31, 35, 41, 42

- Various trade marks with 'Mc'



R0654/2014-2 McGym/McDONALD'S

Board of Appeal

- No one can seriously dispute reputation
 - 'Mc' is part of a family of trade marks
 - Reputation does not extend to the goods and services applied for
- Signs are dissimilar
 - 'McGym' does not fit into family of trade marks

Result

- Appeal allowed
- Case remitted to Opposition Division for further examination

Just another figure



1518



What do these trade marks, and 1500 others, have in common?

O2 ARENA



pegasholidays

the vacation strategist

MERCADONA



Elbphilharmonie



MyMathLab



ORGOGGIO
ITALIA
EXPO MILANO 2015



IBERIA BUSINESS PLUS



ALICANTE PORT



KRAKÓW 2022
APPLICANT CITY



Spanish Council of Civil Engineers (Master of Engineering)



CajaSur

Decisions of the Trimester



TelekomSlovenije

PAUL & SHARK
yachting





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

Thank You for your Attention

CONTACT:

Christoph Bartos
(+ 34) 965 139 743

christoph.bartos@oami.europa.eu
mediator-bartos@oami.europa.eu



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

CONTACT US:

(+ 34) 965 139 100 (switchboard)

(+ 34) 965 139 400 (e-business technical incidents)

(+ 34) 965 131 344 (main fax)

information@oami.europa.eu

e-businesshelp@oami.europa.eu



[twitter/oamitweets](https://twitter.com/oamitweets)



[youtube/oamitubes](https://youtube.com/oamitubes)

Thank You