



Decisions of the Quarter

Christoph Bartos – Member of the Boards of Appeal
17 March 2015

The Menu (I)



PROCEDURAL QUESTIONS

- **Multitasking – left side and right side work independent**
R1202/2014-1 COP
- **My address is a secret**
R2075/2014-4 Sole
- **What happens if I apply for everything or too much ...**
R1534/2014-5 M
- **The postman always rings twice**
R2808/2014-5 Fortune/Fortune-Hotels

The Menu (II)



ABSOLUTE GROUNDS FOR REFUSAL

- **My trade mark is too simple ...**
 - R1147/2014-2 SIMPLY MANGO
 - R1277/2014-2 ShampooExpert
 - R2288/2014-4 REALLY USEFUL BOX
- **... or not**
 - R2015/2013-1 SCIENCE FOR BRANDS
- **Geography, never heard about that**
 - R0574/2013-G SUEDTIROL
 - R0028/2014-5 NEUSCHWANSTEIN
 - R1426/2014-5 TERRA DALMATIA

The Menu (III)



RELATIVE GROUNDS FOR REFUSAL

- **I am soooo strong ...**

R0542/2014-2 HORSE FRIENDS/HORSE

R0614/2013-4 INTERNATIONAL GOURMET/GOURMET

R0541/2014-5 CHATEAU NEOS/NEO

R0392/2013-4 GOLDEN EAGLE/CUP OF COFFEE

REVOCACTION

- **To be or not to be, that's the question**

R2257/2013-1 AVARDO

R2353/2013-2 DEVICE OF A DOG

R2041/2013-4 MYPHOTOBOOK

R1506/2014-4 SHAPE

- **Am I A Color?**

R0483/2014-1 GRANDE LAMB



AS ALWAYS ...

... Another figure



365



PROCEDURAL QUESTIONS



Facts

- 12/12/2013: CTMA filed
- 18/12/2013: Objection concerning Art. 7(1)(b) & (c)
- 09/01/2014: 1st Objection concerning list of g&s
- 11/02/2014: 2nd Objection concerning list of g&s
- 07/03/2014: reclassification rejected by party
- 07/04/2014: CTMA rejected pursuant Art. 7(1)(b) & (c)

Boards of Appeal

- Assessment Art. 7(1)(b) & (c) must be based on valid list of g&s
- Decision without valid list of g&s is substantial procedural violation

Result

- Contested decision **annulled**
- CTMA remitted for further proceedings
- Appeal fee reimbursed

Facts

- Representative of appellant files an appeal
 - Official form is NOT used
 - No indication concerning the address of the appellant
- Appellant is informed that address is an important indication and consequences if lacking
 - Rule 48s CTMIR
- Appellant refuses to remedy the deficiency
 - Office has the address
 - Norm lacks any logic

Board of Appeal

- Board must apply CTMIR
- CTMIR indicates the consequences if address is lacking

Result

- Appeal **inadmissible**

CTM applied for



- Cl. 6, 8, 9, 11, 12, 14, 16, 18, 20, 21, 22, 24, 25, 27, 28, 35
 - Class Heading and alphabetical list (approx. 45 pages)

Examiner

- Global rejection without addressing the list of g&s

Board of Appeal

- Art. 7(1)(b) & (c) must be based on list of g&s
- Global assessment only possible if homogeneous
- Examiner must proof existence of absolute grounds

Result

- Contested decision **annulled**
- CTMA remitted for further proceedings
- Appeal fee reimbursed

Fortune/Fortune-Hotels

Facts

- 19/12/2013: OD rejects CTMA for some g&s
 - Notified by registered mail
- 22/09/2014: OD rejects CTMA in parallel proceedings for other g&s

Applicant

- 08/10/2014: Notice of Appeal against decision of 19/12/2013 & *Restitutio in Integrum*
 - Decision of 19/12/2013 never received

Fortune/Fortune-Hotels

Board of Appeal

- Signature on acknowledgement of receipt differs from representatives signature and signature in parallel proceedings
- Contested decision never received

Result

- *Restitutio in Integrum* granted
- Appeal admissible



ABSOLUTE GROUNDS FOR REFUSAL

Any idea?



365

R1147/2014-2

SIMPLY MANGO



CTM applied for

- **SIMPLY MANGO**
- Cl. 34
 - Tabacco, cigars, cigaretts, herbs for smoking

R1147/2014-2

SIMPLY MANGO



Board of Appeal

- Wide variety of different fruit flavors
- Not more than mere sum of elements

Result

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



CTM applied for

-
- Cl. 3, 44
 - Shampoo and other products used in connection with hair;
Coiffeur, services of beauty salon

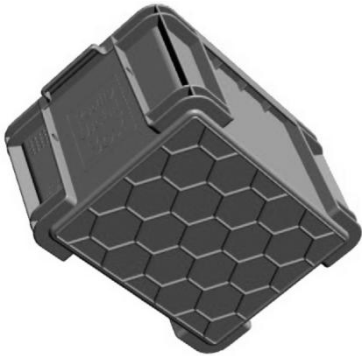
Board of Appeal

- Word element is descriptive
- Figurative elements
 - Standard script
 - Colors commonly used
 - Structure commonly used

Result

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

CTM applied for



-
- Cl. 6, 16, 20
 - Containers of different material

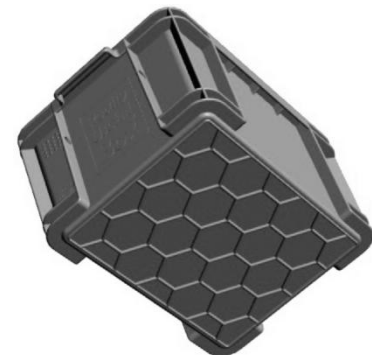
REALLY USEFUL BOX

CTM applied for

- No '*3D trade mark with word elements*' exist
- Typical storage box
 - Whether differs or not irrelevant
- Word elements are invisible

Result

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



R2015/2013-1

SCIENCE FOR BRANDS




CTM applied for



SCIENCE FOR BRANDS

- Cl.35
 - Marketing

Board of Appeal

- Word element is descriptive
-  is distinctive
- Combination is not descriptive and distinctive

Result

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

Registered CTM

- **SUEDTIROL**
- **Cl. 35, 39, 42**

Cancellation Division

- CTM is not descriptive
- CTM **may remain in register**

Board of Appeal

- SUEDTIROL = Südtirol
 - South Tyrol; Alto Adige
- The bigger an area the more likely to be known
- Knowledge of the area not sufficient
 - Link between g&s and the sign needed
- All services may be rendered in the area

Result

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

Registered CTM

- **NEUSCHWANSTEIN**
- Cl. 3, 8, 14, 15, 16, 18, 21, 25, 28, 30, 32, 33, 34, 35, 36, 38, 44
 - Partly typical merchandising articles
 - Advertising; insurance and financial services; real estate services; telecommunication; health and beauty services

Cancellation Division

- Request for declaration of invalidity **rejected**

Board of Appeal

- ‘Neuschwanstein’ not a geographical place
- Neuschwanstein not known for origin of g&s
- No link between the g&s and any geographical place
 - Normally not marketed with reference to origin
- Any vague association not sufficient

Result

- Contested decision **confirmed**
- CTM **remains** in register



R1426/2014-5

TERRA DALMATIA



CTM applied for

- **TERRA DALMATIA**
- Cl. 29, 30, 31, 33, 44

- Disclaimer on ‘Terra’ and ‘Dalmatia’

Board of Appeal

- Clear meaning in EN and IT
- Reference to the Dalmatian coast
- Dalmatian coast lives from tourism, agriculture and viniculture
- Link between all g&s and the geographic indication

Result

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





RELATIVE GROUNDS FOR REFUSAL

Still wondering?



365

CTM applied for



- Cl. 18, 25, 35

Earlier TM (UK, PT, CTM)



- Cl. 18, 25, 35

Opposition Division

- Horse is distinctive for all goods and services
 - Horse lacks any meaning in PT
- Likelihood of confusion **exists**

R0542/2014-2

Horse FRIENDS/HORSE



Board of Appeal

- Analysis of elements
 - ‘Friends’: distinctive
 - ‘Horse’ and image: distinctive, unless goods relate to horses
 - terms are understood, in PT and entire EU
- Comparison of signs
 - Visual: dissimilar
 - Aural: similar
 - Conceptual: distinct concepts



R0542/2014-2

Horse FRIENDS/HORSE



Board of Appeal

- Global assessment
 - Coincidences in 'Horse'
 - Horse running in different directions, different numbers
 - No protection for all depictions of horses

Result

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



INTERNATIONAL GOURMET/GOURMET

CTM applied for



- Cl. 29, 30, 32

Earlier TMs (UK, PT, CTM)



- Cl. i.a. 29, 30, 32

Opposition Division

- Likelihood of confusion **does not exist**

Board of Appeal

- ‘Gourmet’ descriptive in ES
- Comparison of signs
 - Visual: remote degree of similarity
 - Aural: low degree of similarity
 - Conceptual: similar
- Low level of distinctive character *per se* of earlier tm

Result

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

CTM applied for

- CHATEAU NEOS
- Cl. 33, 35, 39

Earlier TM (CTM)

- *Neo*
- Cl. 32, 33, 39

Opposition Division

- Likelihood of confusion **does not exist**

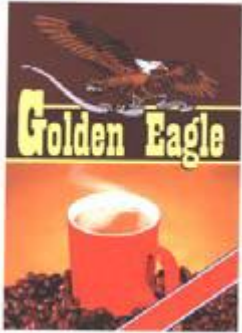
Board of Appeal

- 'Neo' non-distinctive in entire EU
- 'neo' has no independent role in 'CHATEAU NEOS'
- Existence of same letters is irrelevant

Result

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

CTM applied for



- Cl. 30
 - Coffee and coffee beverages

Earlier TMs (CTM *et al.*)



- Cl. 30 *et al.*
 - Coffee and coffee related goods

Facts:

- 1st OD Decision: no likelihood of confusion
 - Signs are dissimilar to a high degree
- 1st BoA Decision: no likelihood of confusion
 - Signs are dissimilar
- GC (T-5/08-7/08): No ruling on likelihood of confusion
 - signs are slightly similar
- 2nd BoA Decision: remitted to OD for new assessment
 - Proof of use must be assessed
 - Reputation must be assessed
- 2nd OD Decision: no likelihood of confusion

R0392/2013-4

GOLDEN EAGLE/CUP OF COFFEE

OFFICE FOR
IN THE IN
(TRADE MARKS A)

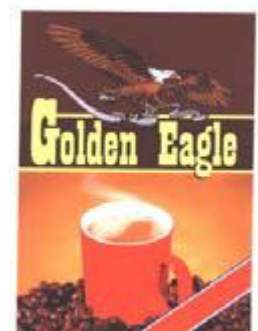


Board of Appeal:

- Bound by analysis of the GC
 - signs are slightly similar
 - elements not very distinctive
- No enhanced distinctive character through use
 - Use always together with other elements

Result

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





REVOCATION

No clue at all?



365

Registered CTM

- AVARDO
- Cl. 9, 35, 42

Cancellation Division

- no use within relevant 5 years period
- CTM **revoked**

Board of Appeal

- Extend:
 - Evidence for yearly sale of specific software (controlling) between EUR 4000 to EUR 29000
 - General market of software irrelevant
- Nature:
 - Not only controlling software in Cl. 9 but also design and development in Cl. 42
 - No evidence for Cl. 35

Result

- CTM partly used (Cl. 9 and 42) and partly no use (Cl. 9 and 35)
- CTM may remain partly in register, partly revoked

R2353/2013-2

DEVICE OF A DOG



Registered CTM



- Cl. 3, 14, 18, 21, 25, 28

Cancellation Division

- **use** within relevant 5 years period
- CTM **remains in the register**

R2353/2013-2

DEVICE OF A DOG



Board of Appeal

- Use in a form which differs




- Image of the dog always independent from text

Result

- Contested decision **confirmed**
- CTM **remains in the register**



Registered CTM

- 
- Cl. 9, 24, 25, 42

Cancellation Division

- **use** within relevant 5 years period for these goods
- CTM **remains in the register**



SHAPE

Board of Appeal

- Use in a form which differs



- Figurative elements are seen as an ‘ensemble’
 - ‘bone’ and circle not considered as two independent signs

Result

- Contested decision **annulled**
- CTM **removed** from register

Registered CTM

-  myphotobook
- Cl. 9, 16, 21, 24, 28, 35, 40, 41, 42

Cancellation Division

- CTM **partly revoked**

Board of Appeal

- Use must be as registered
 - Color may alter the distinctive character
 - ‘my photobook’ is very weak
 - Color adds to the distinctive character
 - Red and green are different



myphotobook



myphotobook



Result

- Contested decision **confirmed**
- CTM **partly revoked**

R0483/2014-1

GRANDE LAMB



CTM applied for



-

- Colour claim
 - Black, white
- Colour claim published
 - Black, white, grey

R0483/2014-1

GRANDE LAMB



Board of Appeal

- Colors must be indicated
- Figurative elements contain color grey
- If black & white is claimed, than the representation shall not contain grey
- Black & white is not identical to any color
 - Black & white does not cover all color combinations

Result

- Appeal **dismissed**
- Color claim remains 'black, white, grey'



AND THE FIGURE...

Still not the days of a year!



365

Cl. 29 – edible bird nests



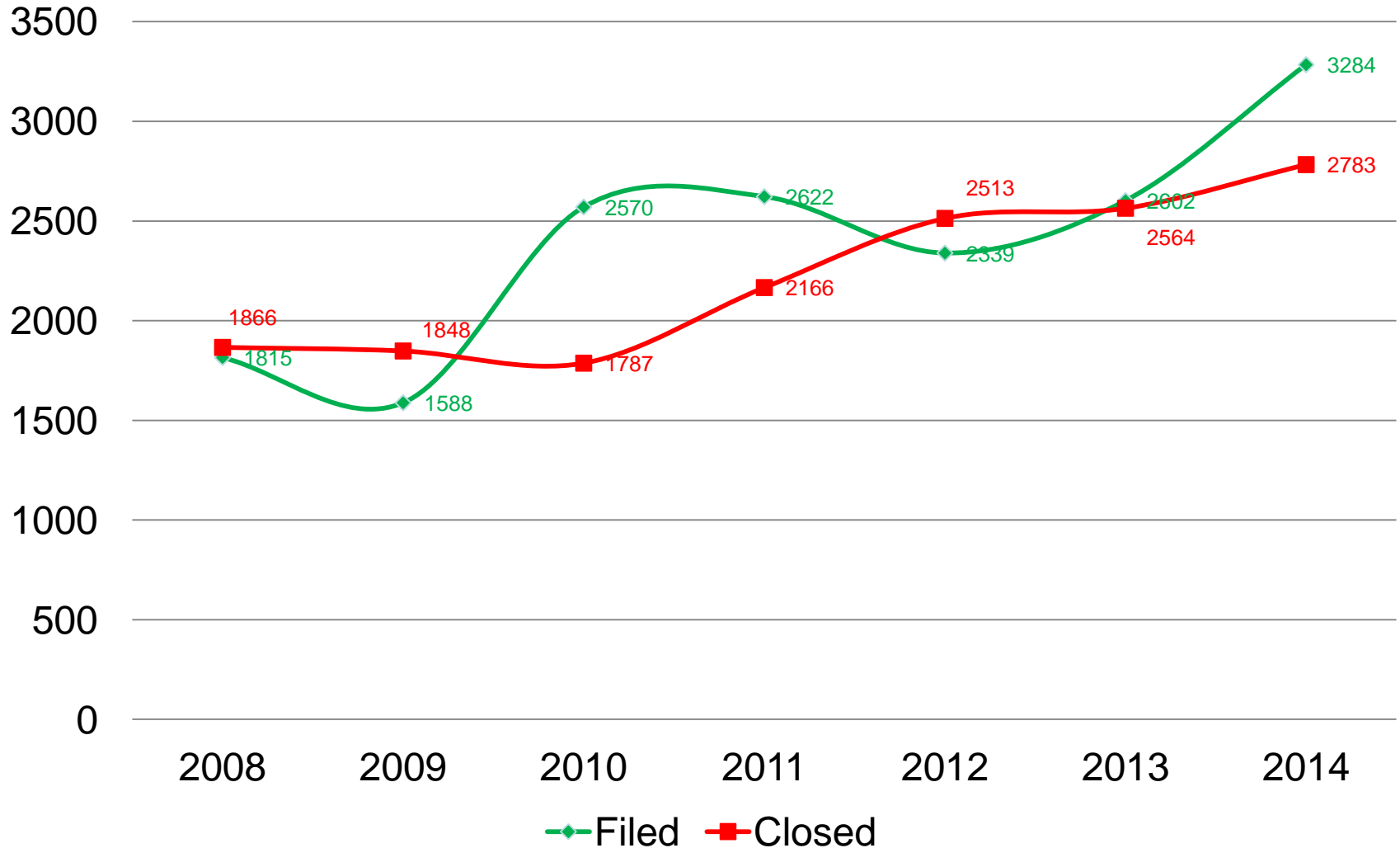


OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

STATISTICS

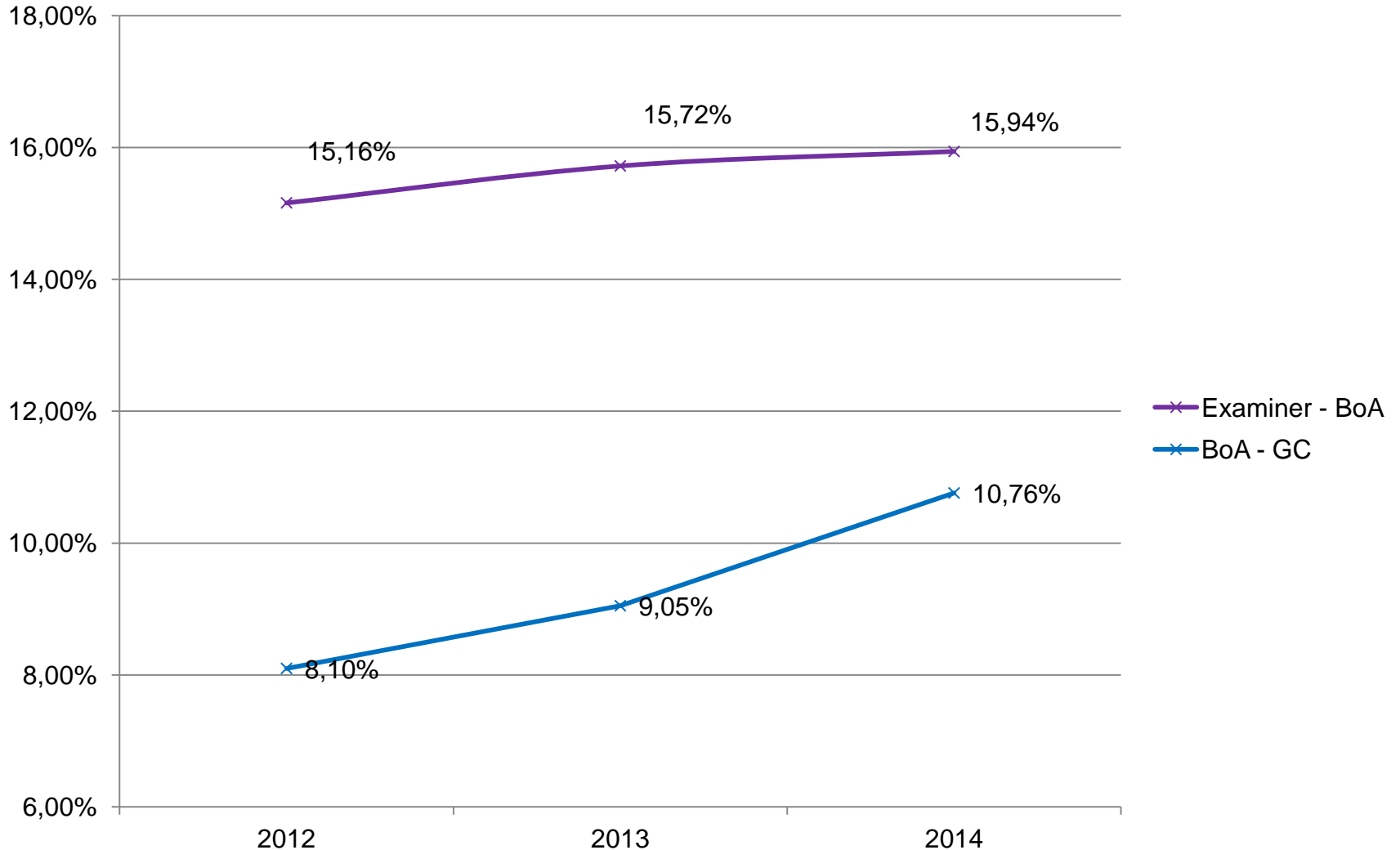
Boards of Appeal

appeals filed – appeal closed



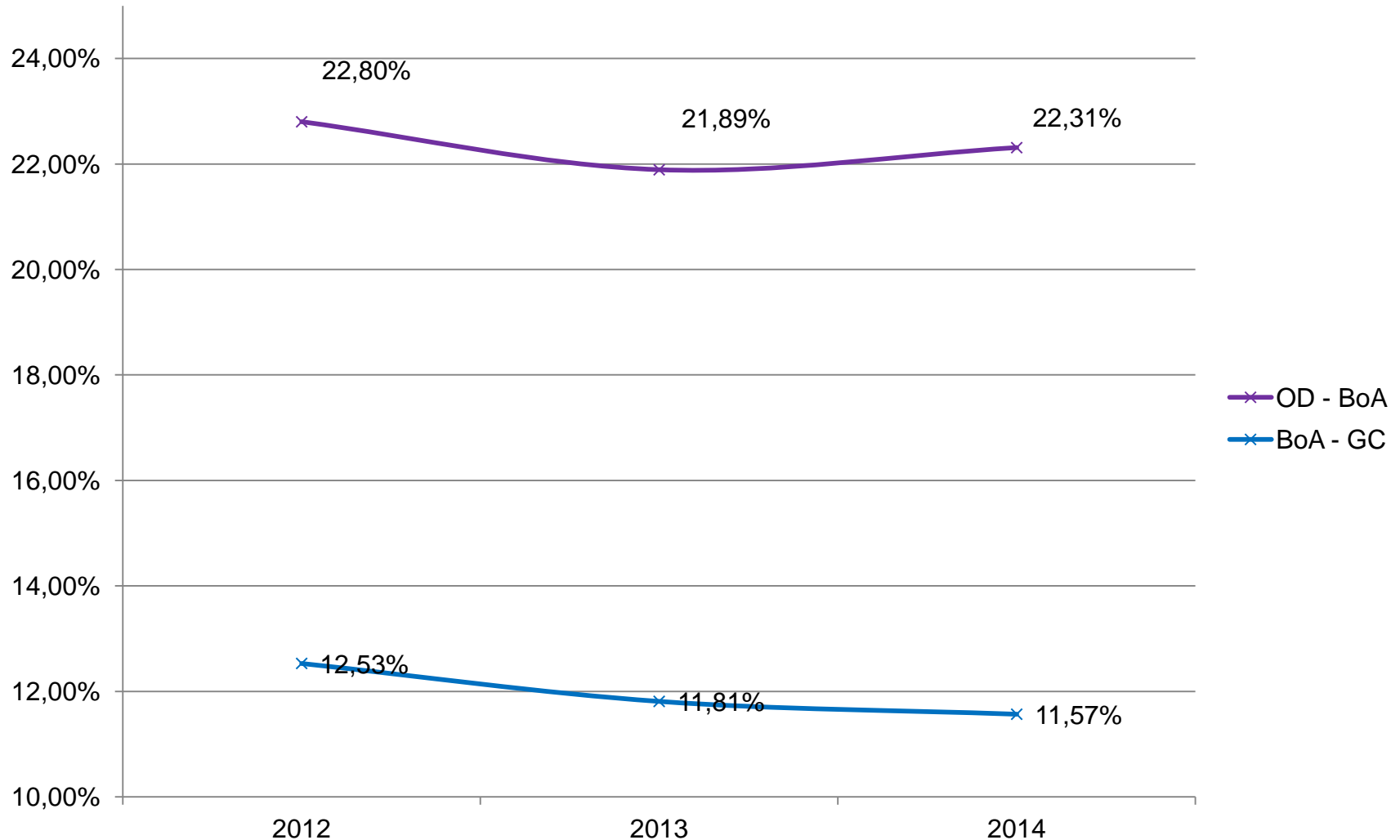
Appeal ration

Examination of absolute Grounds of Refusal



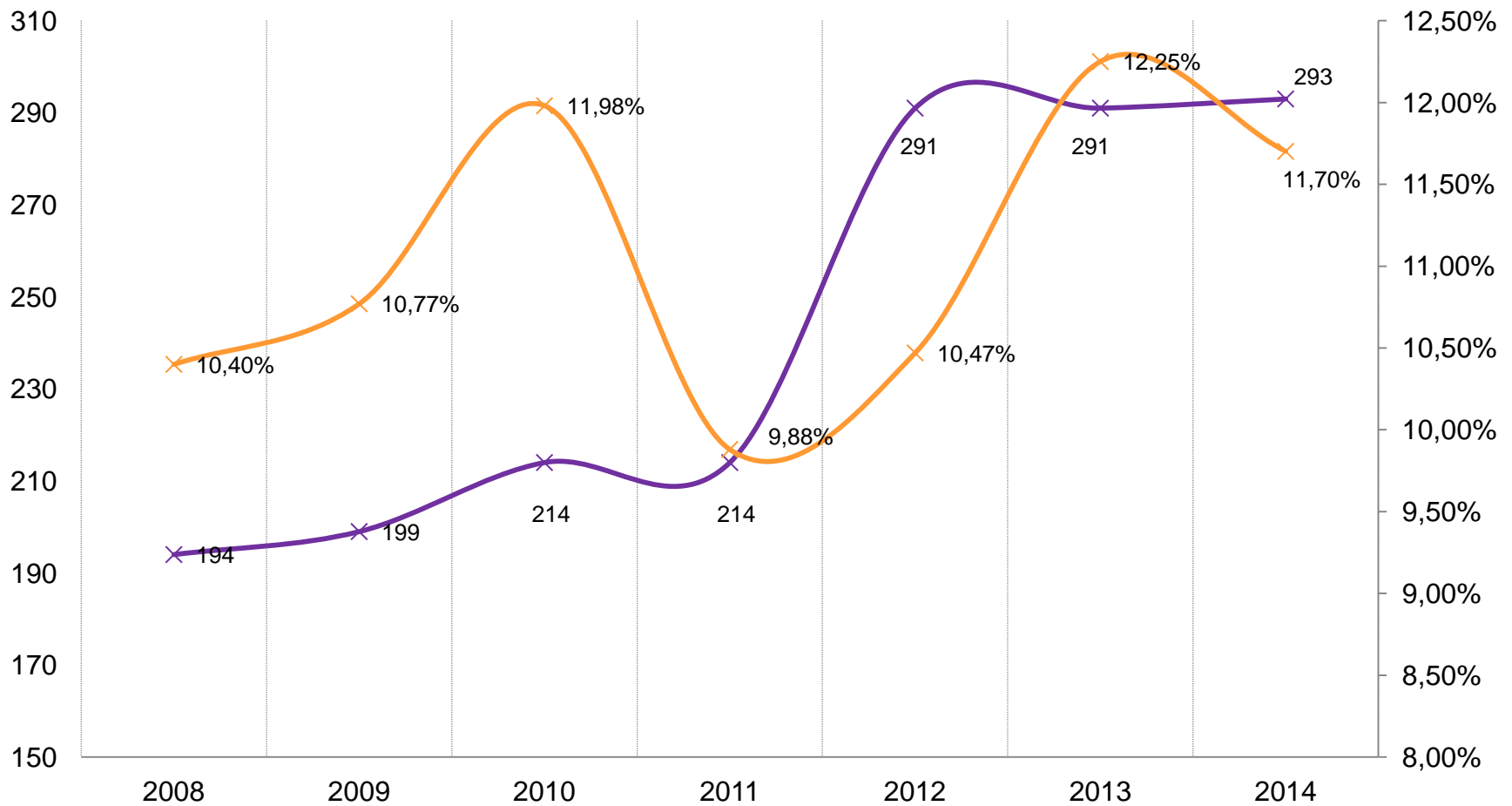
Appeal ration

Examination of relative Grounds of Refusal



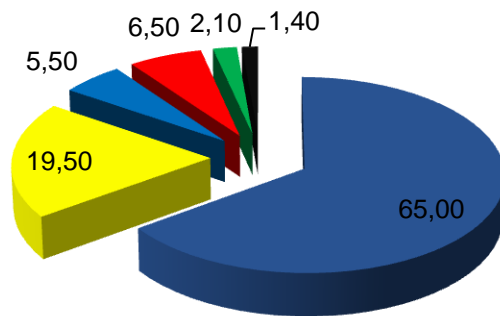
Boards of Appeal

Appeals filed before the GC



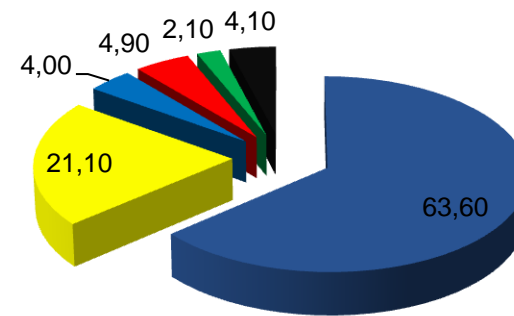
Language of appeal proceedings

1997-2013



■ EN
■ DE
■ FR
■ ES
■ IT
■ Other

2014



■ EN
■ DE
■ FR
■ ES
■ IT
■ Other



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)

www.oami.europa.eu

Thank You