



Decisions of the trimester

(1/4/2015 to 31/05/2015)

Presentation

- 1) Procedural issues
- 2) Classification issues
- 3) Absolute grounds
- 4) Relative grounds
- 5) Bad faith
- 6) Designs

Procedural issues



- [T-378/13](#) 25/3 Pink lady
- [C-622/13](#) 30/4 Castel
- [T-715/13](#) 5/5 Castello
- [C-445/13](#) 7/5 Voss

74 Thus, it is apparent from Title II of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995, L 303, p. 1), as amended, that the procedure for opposition to the registration of a mark comprises **two distinct phases**, a first phase concerning the admissibility of the opposition, and a second, *inter partes*, phase. That second phase commences, as Rule 18 of the regulation provides, when OHIM has found that the opposition is admissible and that none of the grounds listed in Rule 17 precludes that admissibility (see, to that effect, judgment of 18 October 2012 in *Jager & Polacek v OHIM*, C-402/11 P, ECR, EU:C:2012:649, paragraphs 48 and 49).

75 **The material relating to the existence, validity and scope of the protection of the earlier mark, in particular the renewal certificate for that mark**, falls, as Rule 19 of Regulation No 2868/95 provides, within the *inter partes* phase.

76 The material concerned, therefore, is **material that is required to be communicated** to the other party to the proceedings.

77 Even if the communication of the renewal certificate for the earlier mark were to fall within the first phase concerning the admissibility of the opposition that was referred to in paragraph 74 above or the phase laid down in Rule 18(1) of Regulation No 2868/95, the fact remains that, pursuant to Rule 16a of that regulation, any document submitted by the opposing party is to be sent to the other party. The renewal certificate for the earlier mark had therefore, **in any event, to be sent to the applicant.**

Lesson to be taken:

- All the documents in the file must be submitted to the other party
- Never too late to communicate to the other party

Abuse of rights: interpretation


Filing an application to register the word sign “CASTEL” as a trade mark at the German Patent and Trade Mark Office while the invalidity proceedings before OHIM were ongoing: **abuse of rights?**

*“the argument of abuse of rights plays **no** part as regards the admissibility of an action brought as part of invalidity proceedings against a decision of the BoA”*

Abuse of rights: interpretation

- The fact that the invalidity applicant may file an application with a view to subsequently affixing itself the sign in question to its own products cannot amount to an abuse of rights in any circumstances
- The intention of the invalidity applicant to use the mark in question after the declaration of invalidity is not prohibited by the law.
- However, the rejection of an application for a declaration of invalidity on the ground of an abuse of rights would preclude the effective attainment of the objectives pursued by Article 7(1)(b) and (c) CTMR. Such rejection would not permit an assessment of the mark in the light of the rules governing its registrability or of the existence of an absolute ground for refusal of registration

Duty to state reasons

CTMA	Earlier CTMs
<p data-bbox="879 392 1188 435">ENGLISH PINK</p>	<p data-bbox="1362 421 1593 464">PINK LADY</p> 

- **Nowhere** did the BoA refer to the TCB judgment, much less give **reasons** for its appraisal of the issue of taking that new fact into consideration
- **The Board did not comply with the requirement to state reasons**, either **explicitly** or **implicitly**
- Office: ‘in all likelihood...’ → belated attempt to state reasons for the contested decision. **INADMISSIBLE**
- Breach of Art. 75: annulment of BoA decision

Principles of legal certainty and sound administration

- The examination of any TM application must be stringent and full
- **Belgian judgment** is a **relevant factual element** for resolving the case at hand. Essential common points: same parties, same earlier mark, highly similar Blx tm and CTM
- **Infringement of principle of sound administration and of duty of diligence**: failing to assess with the required care the relevant factual aspects submitted to it → annulment.

Alteration of the decision to uphold the opposition?

- Applicant: res judicata of the TCB judgment binds on OHIM and the GC
- GC: **power to alter** → only when the BoA has already adopted a position on the issue
- **NO RES JUDICATA on OHIM**
- **In any case**, since the BoA failed to take account of the judgment and to assess its potential impact on the outcome of the dispute, the GC is not in a position to determine which decision the BoA was required to take and cannot exercise its power of alteration.

INTA's intervention to support Voss

Art. 40 Statute of the CJ:

... any person **establishing an interest** in the result of a case submitted to the Court, other than a case between Member States, between institutions of the European Union or between those States and such institutions, may intervene in that case.

INTA's interest (Order of the President of the Court):

- INTA's main object: "to **promote** the interests of its members in the uses of their trade marks"
- The questions raised are **questions of principle** concerning the assessment of the validity of 3D marks, and thus liable to affect the interests of INTA's members who are also TMO



Classification issues

- [T-717/13](#) 29/4 Shadow complex

CTMA	Earlier mark
SHADOW COMPLEX	BusinessShadow

BoA: identity of the goods because the products covered by the earlier mark included those covered by the mark applied for

Applicant:

- granting protection to the earlier mark and all the goods covered by the general indication used is contrary to the principles of the *IP Translator* judgement
- the Board of Appeal to examine the existence of an identity or similarity between the goods at issue by reference only to the literal meaning of the list of goods covered by the earlier mark

CJ:

- the heading of the class 9 goods covered by the earlier mark, namely, “computer software (recorded)” is sufficiently clear and precise
- in so far as the heading under Class 9 contains the term ‘software’, the goods covered by the earlier mark are **necessarily identical** to “computer game software for personal computers and home video games console”s covered by the mark applied for

This judgment **confirms** the Office practice regarding the application of the principles of the ***IP Translator*** judgment

“the use of all the general indications listed in the class heading of a particular class reflected the applicant’s intention to cover, by his demand, all the goods or services included in the alphabetical list relating to that class”

Absolute grounds

- [T-359/12](#) 21/4 chequerboard pattern
- [C-445/13](#) 7/5 Voss (3D mark)
- [T-203/14](#) 21/5 **SPLENDID**
- [T-222/14](#) 4/6 **DELUXE**

T-359/12 21/4 chequerboard pattern



‘Goods made of leather or imitations of leather not included in other classes in particular boxes of leather or of leatherboard, envelopes of leather for packaging; trunks, valises, travelling bags, travelling sets, garment bags for travel, vanity-cases, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, pouches, fine leather goods namely pocket wallets, purses, key-holders, card holders, checkbook holders; umbrellas, parasols, ombrelles, canes, walking-stick seats’ in Class 18

The Guidelines on patterns

- It follows from the above that, as a rule, in the assessment of the distinctive character of patterns the examiner should use the same criteria that are applicable to three dimensional marks that consist of the appearance of the product itself (see judgment of 19/09/2012, [T-329/10](#), ‘Black, grey, beige and dark red coloured checked pattern’).
- In principle, if a pattern is commonplace, traditional and/or typical it is devoid of distinctive character. In addition, patterns that consist of basic/simple designs usually lack distinctiveness. The reason for the refusal lies in the fact that such patterns do not convey any ‘message’ that could make the sign easily memorable for consumers.
- However, if a pattern is fanciful, unusual and/or arbitrary, departs from the norm or customs of the sector or is, more generally, capable of being easily memorised by the targeted consumers, it usually deserves protection as a CTM.

Issue of the inherent distinctiveness

- The GC dismissed the appeal and confirmed the BoA's findings. As to the issue of the inherent distinctive character of the contested mark, the GC recalled the established case-law relating to three-dimensional marks which consist of the appearance of the product itself and noted that it also applies to figurative marks consisting in the shape of the product concerned or a part of the shape of the product.
- The GC dismissed the CTM proprietor's argument that consumers are accustomed to perceiving a pattern as an indication of the commercial origin of goods as irrelevant, noting that the fact that such signs are recognised as marks by consumers does not necessarily mean that they have an inherent distinctive character, as a mark may acquire distinctive character through use over time.

Territorial extent of the proof of acquired distinctiveness

- The GC held that a mark can be registered only if it is established that it has acquired, through the use which had been made of it, distinctive character in the part of the European Union in which it did not, ab initio, have such character → in the present case, the European Union as a whole.
- Although noting the ECJ's statement to the effect that, in such cases, it would be unreasonable to require proof of such acquisition for each individual Member State, must have acquired distinctive character through use throughout the European Union, the GC pointed out that in the ECJ confirmed that it is correct in law to require proof of acquired distinctiveness (through use) throughout the European Union (see paras. 60-63 in [C-98/11 P](#)).

Findings of the GC on the evidence:

- ***The applicant failed to provide evidence of acquired distinctiveness in Denmark, Portugal, Finland and Sweden.***
- figures referring to the turnover: mere print-outs, without any other detail or certification → indicative only and need to be corroborated by other evidence
- presence of shops in different MS: no indication as to the perception of the contested mark by the public concerned
- catalogues, brochures, advertisements: no indication as to the perception of the contested mark by the public concerned
- no evidence that the catalogues are distributed amongst the relevant public.
The photos and advertisements prove only that the applicant has used the brown and beige chequerboard pattern.

Notion of 'substantial part of the EU' not applicable for the assessment under Article 7(3) CTMR

- The GC referred to several judgments clarifying that the case-law relating to Article 7(3) CTMR must not be confused with that defining the meaning of the phrase 'has a reputation' in a Member State or in the European Union within the meaning of Article 9(1)(c) CTMR.
- It therefore dismissed the applicant's argument invoking the extrapolation to the requirements of Article 7(3) of the case-law relating to the acquisition of a reputation, which must be shown in a substantial part of the European Union and not in every Member State.

3D marks:

the definition of the 'norms or customs of the relevant sector'



INTA's argument: error in law by contrasting 'mere variant' with 'significant departure' in relation to the applicable norms and customs, instead of examining whether the contested trade mark deviates from the shapes that are customarily or normally used in the relevant sector to such an extent that consumers will be able to attach significance to it

3D marks:

the definition of the 'norms or customs of the relevant sector'

CJ: Only a mark which departs significantly from the norm or customs of the sector is not devoid of distinctive character.

The Voss bottle's shape **did not significantly depart** from other drinks bottle shapes on the market and was simply a mere variant of well-known shapes. This was found to be the case both when looking at the overall impression of the **bottle as a whole** and when assessing the mark's **components** (*i.e.* the bottle's see-through tubular body and matte lid).

3D marks:

the definition of the 'norms or customs of the relevant sector'

The test for assessing the distinctive character of 3D trade marks consisting of the shape of the product itself is identical to the test for other categories of trade mark (See *Mag Instrument* Judgement).

Is this ruling bad news for those seeking to register 3D trade marks consisting of the shape of a product?

Imperfect recollection for Art. 7 CTMR assessment

Splendid*

- an ordinary word in English which means, inter alia, ‘grand’, ‘spectacular’, ‘superb’ or ‘gorgeous’;
- the products covered by the mark applied for are clearly among those the appearance of which could be described as ‘splendid’;
- refers to “goods the appearance of which presents such qualities”
→ “**laudatory**” word – “**promotional formula**”

Imperfect recollection for Art. 7 CTMR assessment

What about the *grafic style of the typeface*?

- the typeface used, although stylised, cannot divert the consumer's attention from the clear message conveyed by the term 'splendid'
- cursive script is an ordinary and traditional style which is used by both children and adults, in daily life or in a professional context, and which remains largely unremarkable from the perspective of any consumer and, in the present case, of the relevant public

What about the * put on the *i*?

- replaces the usual dot over the 'i' and thus will be attributed that function within that mark. It plays a minor role in the mark considered as a whole.

... the average consumer must place his trust in the
imperfect picture of the mark that he has kept in his
mind

T-222/14 4/6 DELUXE

- CTM applied for goods in classes 9 and services in classes 35, 37, 39 to 42 and 45
- Examiner refuses on the basis of 7(1)(b)
- BoA confirms refusal
- **GC annulled**
- Lack of motivation; must be done in relation with every single type of product/service (point 16) except « homogeneous categories »
- Motivation too general so action upheld (points 22, 23 and 24)
- More than 90 categories of products and services



Relative grounds

- [T-581/13](#) 26/3 POLO CLUB
- [T-423/12](#), [T-183/13](#), [T-184/13](#) 5/5 SKY
- [T-599/13](#) 7/5 GELENKGOLD
- [T-608/13](#) 13/5 easyAir-tours
- [T-102/14](#) 13/5 TPG POST
- [T-420/14](#) 21/5 Wine in Black / NOVAL BLACK

Relevant public & degree of attention



- T-581/13 26/3 POLO CLUB

- The level of attention of the relevant public is **normal in the absence of further details** concerning their possible status as luxury goods
- **the evidence** the applicant has to submit to prove that the goods are **luxury goods**

- T-608/13 13/5 easyAir-tours

The GC confirmed that both the general public and professionals in the travel industry in Germany will tend to display a **higher than average** level of attention when purchasing **G&S related to travel arrangements**.

- T-102/14 13/5 TPG POST

The relevant public is used to encounter various postal service providers which are using the word “POST” as part of their company signs



Earlier TM

Cl. 9, 14, 18, 25

Contested sign

Cl. 9, 14, 18, 25

OD: No LOC

BoA: LOC with respect to some goods

Inherent distinctiveness

BoA:

- The **image of the polo player** and the words **‘POLO CLUB’** are **distinctive**
- **Distinctiveness** is, in relation to the **Class 25 and 18** goods, **intrinsically enhanced because, in relation to those goods**, the representation of a polo player (and the use of the words ‘POLO CLUB’) has an **imaginative content**
- **Same reasoning** applied to the goods of **Classes 9 and 14**
- **At least average inherent distinctiveness** of the earlier marks

Inherent distinctiveness

GC: did not uphold the BoA's finding

The GC held that that the image has

- (i) **weak inherent distinctiveness** in relation to ‘whips, harness and saddlery’ in Class 18, given their close connection to the playing of polo;
- (ii) **normal inherent distinctiveness** in relation to ‘articles of clothing, footwear and headgear’ in Class 25, given that they can be used for polo playing, although there is nothing in their description to the effect that they relate to goods specifically designed for that purpose;
- (iii) **inherent distinctiveness which is more enhanced, and at the very least normal**, in relation to the other goods, given that they have no connection with the playing of polo.

Inherent distinctiveness

Conclusions & Guidelines

- The device of a polo player and the words ‘POLO CLUB’ may **have weak, normal or enhanced inherent distinctiveness** and it relates to the **connection to the goods and services**
- When the **earlier mark (or the component)** is not descriptive (or is not otherwise non-distinctive), it is deemed to have a **normal degree** of inherent distinctiveness. (...) this degree of distinctiveness can be **further enhanced** if appropriate evidence is adduced showing that a higher degree of distinctiveness of the earlier mark has been **acquired through use** **or** because it is **highly original, unusual or unique**

POST

Earlier German TM

Cl. 9, 14, 18, 25

TPG POST

Contested sign

Cl. 9, 14, 18, 25

OD: no LOC (opposition dismissed)

BoA: no LOC (OD's decision confirmed)

GC: no LOC (dismissed the appeal)

Similarity of the signs: weak elements

BoA:

- Within the CTMA, following the company initials “TPG”, the term “POST” will be perceived as a purely descriptive word referring to the postal services originating from the company “TPG”.
- “Therefore, the visual, aural and conceptual similarity arising from the mere addition of the term “Post”, which clearly has a descriptive role in the mark applied for, is largely counterbalanced by the differentiating initials “TPG”, which is the more distinctive and dominant element of the mark applied for”.
- Due to purely descriptive function of “POST” within CTMA, there is NO LOC.
- *Thomson Life* Judgement is not applicable due to descriptiveness of “POST”.

Similarity of the signs: weak elements

GC:

- The fact that „POST“ must be considered to have some degree of distinctive character does not mean that it enjoys such a high degree thereof that it gives an unlimited right to prevent all subsequent registrations of signs containing it. OHIM must evaluate the distinctive character of a sign (→ See [C-196/11](#) P, 24/05/2012 – “F1”, para. 42)

Similarity of the signs: weak elements

C-196/11 P, 24/05/2012 – “F1”:

- OHIM must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the CTMA and evaluate the degree of distinctiveness of that sign.
- However, this evaluation may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark.

T-102/14, 13/5/2015 – “TPG POST”:

- A word forming part of a composite sign may be perceived differently than when used on its own or in a different context. This applies even more so when the word is preceded by the indication of a different commercial origin (“TPG”). In these circumstances, the element „POST“ is considerably less distinctive than the element „TPG“. In addition, it is common practice in the postal market to use company initials composed of three capital letters.

Similarity of the signs: weak elements

Final considerations:

- GC did not strictly follow wording of F1 approach by CJ
- However, justified by underlying reasons in F1 (“coexistence”)
- Holistic approach
- Still, GC refrained from expressly stating that “POST” is descriptive within the CTMA



CTMA

Earlier CTM

Figurative TM

Figurative TM

OD: LOC

BoA: LOC (appeal dismissed)

Similarity of the signs:
the assessment of aural similarity

BoA: No comparison can be made since the earlier TM does not include word elements

GC: Aural comparison is possible

- CTMA pronounced as ‘Gelenkgold’

Arg.: complex signs composed of figurative and word elements are generally referred to by pronouncing the latter

- Earlier mark pronounced as ‘Tiger’

Arg.: ‘where a purely figurative mark represents a form which is easily recognized and associated to a precise and concrete term, the public will use that term to name the mark’

CTMA	Earlier marks
	

OD: LOC with respect to some goods and services

BoA: LOC (appeal dismissed)

Similarity of the signs: the assessment of dominant element

“Air-tours”?

- Weak distinctive character
- **Allusive element**: it alludes to package holidays (“tours”) involving air transport (“air”) → **Not intrinsically dominant**

“Easy”?

- Weak distinctive character
- Its position at the beginning of the sign makes it **slightly dominant**



- **Clearly** perceived and memorised by the relevant public
- Not be dominated by the word elements

Similarity of the signs: Conceptual similarity

CTMA	Earlier Mark
Wine in Black	NOVAL BLACK

... the signs had to be **considered as a whole**

Wine in Black

- 'wine': weakly distinctive (not descriptive) in respect of the goods covered;
- However 'Wine in black' had an imaginative and evocative character → it is capable of surprising the public and conveying to it the idea of a wine of elegance and distinction, like a person dressed in black

Noval Black

- 'black' accompanied by 'noval' perceived as a company name

→ the marks had **no conceptual similarity**, despite their common element 'black'.

Similarity of the signs



/ SKYPE

SKY

Figurative/word CTMA

Earlier Word CTM

GC: SKYPE is similar to SKY

- Visually

- 'sky': basic English word
- the element 'pe' has no specific meaning
- the word 'sky' clearly identifiable in the word 'skype'
- the figurative element highlights the word element and is, therefore, perceived as a mere border

Similarity of the signs

- Aurally

- the pronunciation of the vowel ‘y’ is no shorter in the word ‘skype’ than it is in the word ‘sky’
- the figurative element in the shape of a border cannot produce any phonetic impression, this latter remaining determined solely by the word element

- Conceptually

- the figurative element conveys no concept, except perhaps that of a cloud, which would further increase the likelihood of the element ‘sky’ being recognised within the word element ‘skype’, for clouds are to be found ‘in the sky’ and thus may readily be associated with the word ‘sky’.



Designs

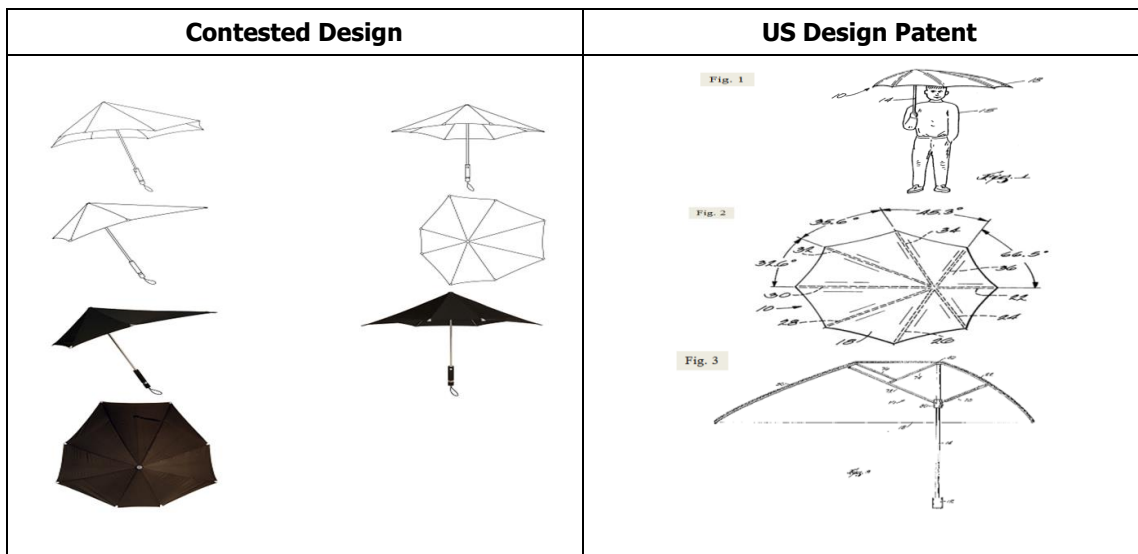
- T-22/13 and T-23/13 21/5 Umbrella

T-22/13 and T-23/13 21/5 Umbrella



A US patent could amount to a relevant prior disclosure of a similar design which “could reasonably have become known to the persons forming part of the circles specialised in the sector concerned” within the EU ...

... despite the fact that no umbrellas had ever been made to the design shown in the **US patent**, because umbrella designers would have been expected to have searched the US patent register, particularly where as in this case the umbrella design in question was designed to be wind-resistant.





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