



Decisions of the Trimester General Court / European Court of Justice

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Procedural/Preliminary issues

C-31/14



LIMITATION

Vaginal suppositories (class 5)

=>



*Non-prescription vaginal suppositories
against vaginal dryness and vaginal
infections (class 5)*

BoA: Limitation: REFUSED

- a) Non-prescription => irrelevant
- b) Confidential information, not suitable for Trademark Register

GC: ANNULLED the BoA

- a) No prescription => no criteria for valid subgroup of the goods
- b) Therapeutic indication => valid criteria for the scope of protection

=> Infringement of Art. 43 (1) CTMR: request as a whole: VALID!

CJ: Confirmed the GC

Para 43.: to the extent that limitation as to a therapeutic indication is refused

=> error of the BoA

Para 53.: GC stated => Boa should have accepted the limitation as filed

=> CONFIRMED: Infringement of Art. 43 (1) CTMR



T-655/13



CORRECTION of MISTAKES - Art. 43 (2)

- CTM applied for as a **colour mark**.
- After refusal (Absolute Grounds):

⇒ Request to correct to figurative mark
with colours



CTM applied for
(Class 7, i.a. wind
energy converters
and parts thereof)

T-655/13



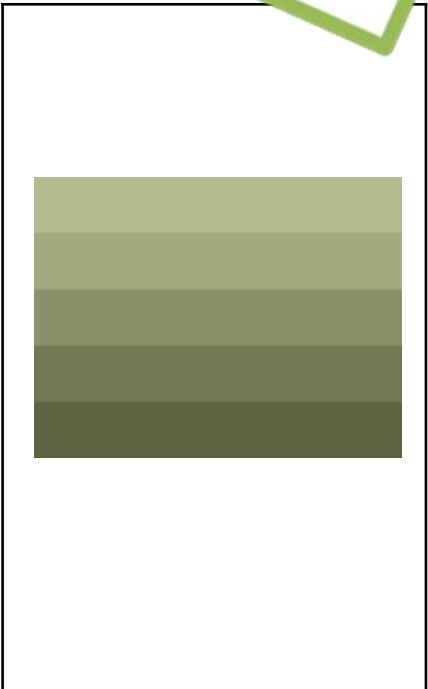
CORRECTION of MISTAKES - Art. 43 (2)

BoA => Confirmed by the GC:

Two Conditions of Art. 43 (2) CTMR not met:

1) Original Error

2) Substantial change of the mark



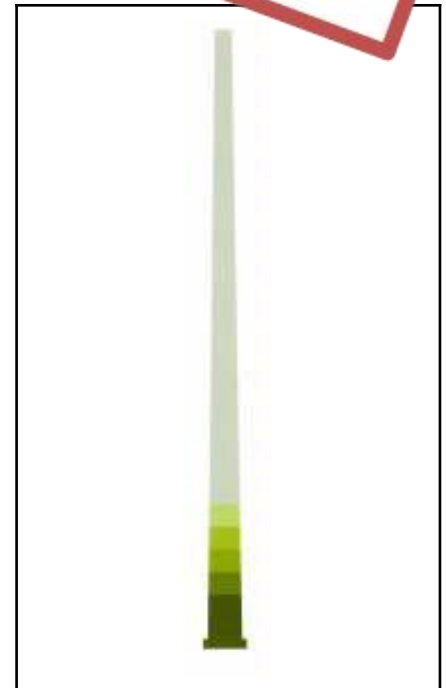
**CTM applied for
(Class 7, i.a. wind
energy converters
and parts thereof))**



T-245/12

ANNULLED

- CTM registered as a **colour mark**.
- BoA **re-categorised** the mark as a **two-dimensional figurative mark, made up of contours and colours.**



CTM applied for
(Class 7, i.a. wind
energy converters
and parts thereof)



T-106/14



IDENTICAL ACCEPTED CTMs

GREENWORLD
Cl: 4, 35 and 39

In line with case law:

- No binding effect
- Sound administration: in some cases: Office should assess on it
=> if not: could be seen as procedural mistake (see T- 492/11, p.: 33 and 34)
- Equal Treatment vs respect of legality



T-322/13



Art: 76 (2): DISCRETION WITH BELATED EVIDENCE

KENZO	KENZO

Time limits: Matter of public order

- *Proof of Use*: Additional belated evidence (C- 621/11 FISHBONE)

- *Substantiation of an opposition*:

⇒ C- 120/12 (Rintisch): BoA: Discretion for late evidence: Rule 50 (1), Art. 76(2)

- Rule 20 (1) is not a *lex specialis* => Rule 50 (1) prevails

T-322/13



Art: 76 (2): DISCRETION WITH BELATED EVIDENCE

KENZO	KENZO

Criteria for Discretion:

=> relevance, stage of proceedings, specific circumstances

- **BoA: assessed all the circumstances and found the late evidence relevant.**
- **Upheld by GC**

=> **Issues: PoU is a defence claim; consequences also for 1st Instance?**



T-287/13



HUSKY

**EXTENSION of
TIMELIMITS**

Time Limit for PoU in revocation case:

=> Interpretation of Rule 71 (2):

Version 1: ‘where there are two or more parties, [OHIM] may extend a period subject to the agreement of the other parties’

Version 2: ‘where there are two or more parties, [OHIM] may subject the extension of a period to the agreement of the other parties’

T-287/13



**EXTENSION of
TIMELIMITS**

HUSKY


GC:

- Need for uniform application => one language version must not be considered alone.
- Intention of Legislator
- Aim of the provision
- OHIM has discretion; it is not conditioned upon an agreement of parties



T-172/13



DUTY TO STATE REASONS

<p>AFRICAN SIMBA</p>	
<p>Cl. 9, 28</p>	<p>Cl: 28</p>

BoA examined the case correctly comparing the above marks, however in one paragraph it assessed visual comparison with:

	
<p>Cl. 9, 28</p>	<p>Cl: 28</p>

CONFIRMED

DUTY TO STATE REASONS

GC: recalled case law on duty to state reasons:

- Parties understand the decision
- Enable to review the legality

=> In spite of the error, the assessment of visual comparison is correct: error is NOT relevant

C-253/14



DUTY TO STATE REASONS

BigXtra
Cl: 16, 35, 39, 41, 42 and 43

Global reasoning applicable to all goods/services (G/S):

- If the goods/services are connected to each other
=> homogeneous category
- Connection in the case at hand:
all G/S => may offer advantages

Criteria for homogeneous category: not the G/S themselves

=> meaning of sign



Absolute grounds for refusal

T-59/14



**INVESTING FOR
A NEW WORLD**

Cl. 35 and 36

CONFIRMED

GC:

- Attention of the public vs Distinctiveness of a sign
- Different: attentiveness for a specific category of sign as a **Slogan**
- ⇒ If low, public will not see an origin function and not remember it
- Banal laudatory expression

T-59/14

**INVESTING FOR
A NEW WORLD**
Cl. 35 and 36



C-398/08: “Vorsprung durch Technik” not comparable:

- **Exceptional situation where reputation of a sign facilitates the consideration of it as an indicator of origin**
- **No play of words, imaginative, surprising or unexpected**



T-499/13



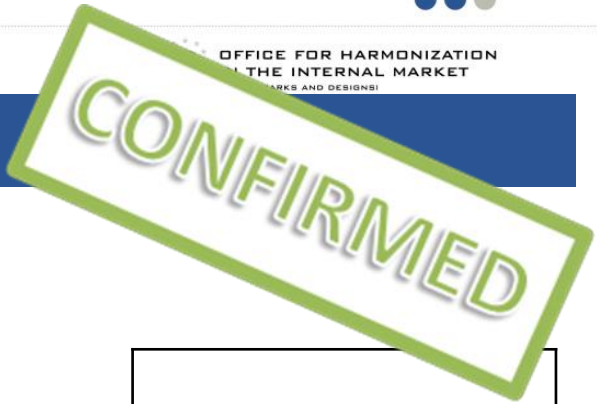
Smarter Scheduling
Cl. 9

GC:

- **Direct information for goods**
- **May be associated with other G/S => irrelevant**
- **Not imaginative, no conceptual tension => Not a condition for acceptance**



T-655/13



Art. 7 (1) (b) CTMR:

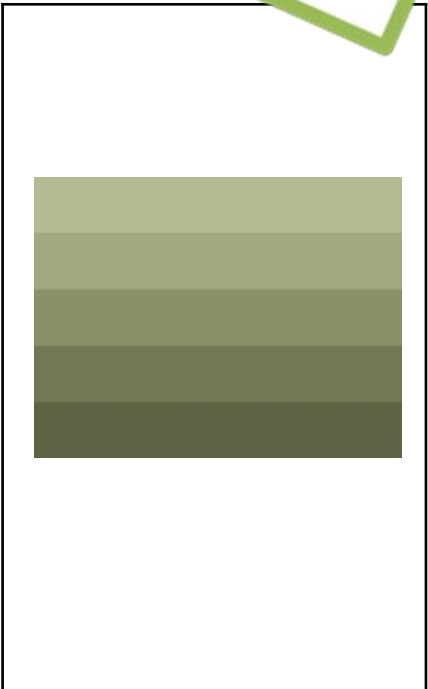
Colour Green:

- Ecological
- Degradation

=> integration in the landscape

-highly priced goods

=> not bought by reference to a colour



CTM applied for
(Class 7, i.a. wind
energy converters
and parts thereof)



Relative grounds for refusal



T-123/14



<p>AquaPerfect</p>	<p>waterPerfect</p>
<p>Cl: 7 (pumps, kitchen apparatus)</p>	<p>Earlier mark Cl: 7</p>

Goods: identical/similar: not disputed.

Signs:

Visually: longer component is identical, oval similar lengths => average similar

Aurally: same amount of syllables, two of them identical => average similar

Concept: all elements understood by EU consumer => similar

T-123/14



AquaPerfect	waterPerfect
Cl: 7 (pumps, kitchen apparatus)	Earlier mark Cl: 7

Distinctiveness of earlier mark: weak


Distinctiveness of common element: weak

⇒ **However: LoC**

Distinctiveness: only one factor

T-10/09 RENV 

ANNULLED

	<p>F1</p>
<p>Cl: 16, 38 and 41</p>	<p>Earlier mark Cl: 16, 38 and 41</p>


BoA: The element “F1” as such is descriptive for car racing. Earlier mark’s distinctiveness and reputation => specific figurative representation.

GC: upheld BoA (See T-10/09)

CJ: C-196/11: GC considered earlier mark as descriptive => Infringement of Art. 8 (1) (b) CTMR => referred back to GC.

T-10/09 RENV

ANNULLED

	F1
Cl: 16, 38 and 41	Earlier mark Cl: 16, 38 and 41

GC:

- Element “F1”: weak
- BUT: identity, high similarity of G/S, earlier mark identically reproduced in CTMA, imperfect collection

=> LoC

Weak/Descriptive elements

Comments:

Problem of Protection of weak/descriptive elements: (slight trend in case law)

- **Registered marks must have a distinctive character (F1/F1 C-196/11)**
- **Even descriptive elements may be dominant (see T-149/12 MICRO)**
- **The position of the common weak element might also play a role (see T-411/12 pharmastreet/pharmasee)**

⇒ R 1462/2012 G: Ultimate Greens/Ultimate Nutrition

⇒ See also Common Communication in the framework of CP5

T-46/13

CONFIRMED

PROOF OF USE

 <p><i>La Sabiduría del Sabor</i></p>	
<p>CTM as registered Cl: 29 and 30</p>	<p>Used in Spain (only)</p>

GC:

For assessment of alteration of distinctive character => only Spanish public is relevant, in spite of some (insufficient) use in Portugal, Germany (see case C-149/11 Leno Merken)

T-46/13

CONFIRMED

PROOF OF USE

 <p data-bbox="405 642 782 671"><i>La Sabiduría del Sabor</i></p>	
<p data-bbox="415 721 782 828">CTM as registered Cl: 29 and 30</p>	<p data-bbox="1159 749 1584 806">Used mainly in Spain</p>


For Spanish speaking public: “Wisdom of Flavour” => most distinctive element

=> **Omission** alters distinctive character (Art. 15 (1) (a) CTMR)



T-278/13

PROOF OF USE


Cl. 35, 41 and 42




Use for all services:

- Use for specific services => enough for all the services covered by the mark which forms homogeneous category
- The consumers would not see any subcategories, but consider the services globally

T-278/13

PROOF OF USE


Cl. 35, 41 and 42



Extent of Use :

Use refers mainly to LONDON

GC endorses reasoning of BoA:


PoU => YES!



T-172/13



PROOF OF USE

<p>AFRICAN SIMBA</p>	
<p>Cl. 9, 28</p>	<p>Cl: 28</p>

Affidavit of an employee

Check probability of the veracity

⇒ **the more detailed and conclusive information,
the more probative value; see: T- 86/07(DEITECH)**

⇒ corroborated by objective evidence

T-172/13

CONFIRMED

PROOF OF USE

Objective evidence:

- Catalogue with the wide range of games and playthings
- Invoices 14 out of 26 refer to period and place => only examples (numbering)

=> Affidavit corroborated: **YES!**

T-172/13

CONFIRMED

RELEVANT PUBLIC

Toys => General Public (children and adults)

Gaming machines => professional public

General Public => uses gaming machines

Specialised public => buys, uses toys

**⇒ Overlap with general public:
average degree of attentiveness**



T-78/13

ANNULLED**DISSIMILAR SIGNS**

BULLDOG	BULL
CTM Cl: 32	Earlier Mark: Cl: 32

BoA:**Signs visually and aurally similar in a LOW degree.****Concept: Clearly different => neutralises the similarities****=> Signs overall DIFFERENT => no LoC**



DISSIMILAR SIGNS?

BULLDOG	BULL
CTM CI: 32	Earlier Mark: CI: 32

GC:

Signs visually and aurally similar in an **AVERAGE** degree.

Concept: Both Bulls and Bulldogs are strong and aggressive

⇒ Low conceptual similarity



⇒ LoC: **YES!**



T-33/13



DISSIMILAR SIGNS?



	
<p>CTMa Cl: 35, 36, 38, 41 and 42</p>	<p>Earlier IR: Cl: 9, 35, 36, 38 and 42</p>

BoA:

- In spite on the common “bonus” => all other word, figurative and colour elements different + conceptual difference + “bonus” = weak for the services
- => overall dissimilar.



DISSIMILAR SIGNS?

	
<p style="text-align: center;">CTMa Cl: 35, 36, 38, 41 and 42</p>	<p style="text-align: center;">Earlier IR: Cl: 9, 35, 36, 38 and 42</p>

GC:



- “bonus” at beginning visual and aural similarity, also conceptual similarity
 - Main argument: “bonus” => autonomous role in both signs
- => Not as in case T-140/08: TiMi Kinderjoghurt

BoA: ANNULLED!!



T-570/10 RENV



	
<p>Contested CTMA (Class 7)</p>	<p>Earlier CTM (Class 7)</p>

- OD dismissed the opposition under 8(1)(b) and 8(5): the signs are not similar.
- BoA: 8(5) applies. Risk of dilution of the distinctive character of the earlier mark: ‘use by 3rd parties of a wolf’s (or canine’s) head in relation to similar goods could dilute the unique, one-off image of the earlier mark’.

T-570/10 RENV

GC confirmed BoA's decision:

'link' between the marks => similarity of G/S

Evidence that use of the later mark would be detrimental to the distinctive character of the earlier mark, but **neither** Art. 8(5) nor Intel (C-252/07) require change of **economic behaviour of the average consumer** of the G&S of earlier

Change in the economic behaviour = earlier mark's ability to identify the relevant G&S weakened.

Annulled by the Court of Justice

The GC => condition for dilution needs change in the economic behaviour

CJ: the requirement of proof of an economic change is autonomous. Dilution cannot be established without adducing evidence of such economic change (para. 36)

=> New condition for dilution

IMPLICATIONS of the 'WOLF' Judgment:

- Opponents (and invalidity applicants) relying on dilution ex Art. 8(5) must **substantiate** two things:
 - The **dispersion** of their mark
 - And the **change in the economic behaviour of the relevant public** (i.e., the consumers targeted by the earlier mark)


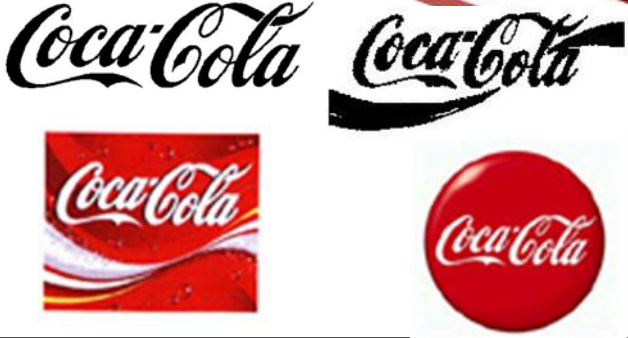
IMPLICATIONS of the ‘WOLF’ Judgment:

- Opponent: **evidence for likelihood of detriment** on the basis of **logical deductions made from an analysis of the probabilities (and not mere suppositions)**,
- => see also **normal practice** in the relevant commercial sector
=> **other circumstances** of the case (see judgment of 16/04/2008, T-181/05, ‘Citi’, para. 78 as cited in judgment of 22/05/2012, T-570/10, ‘Outils Wolf’, para. 52 and confirmed in the appeal by judgment of 14/11/2013, C-383/12P, paras. 42-43).



ART. 8 (5) CTMR: T-480/12



	
<p>Contested CTMA (CI 29, 30 and 32)</p>	<p>Earlier CTMs (CI 30, 32, 33 and 43))</p>

BoA: Signs dissimilar => Opposition rejected!

GC: - 'tail' flowing from the first letter as a signature


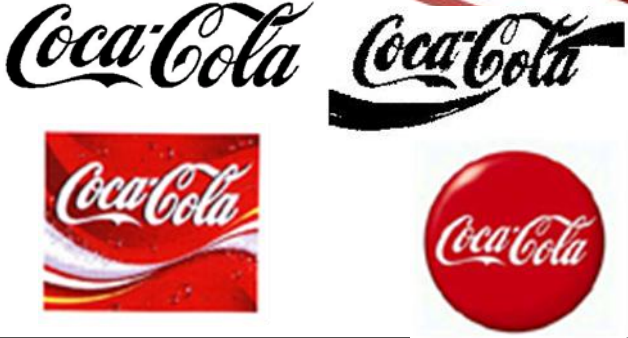
- Spenserian script (not commonly used)

- Food/Drinks: figurative elements are at least as visually important as the word elements

=> LOW DEGREE OF VISUAL SIMILARITY

Art. 8 (5) CTMR: T-480/12



	
<p>Contested CTMA (CI 29, 30 and 32)</p>	<p>Earlier CTMs (CI 30, 32, 33 and 43))</p>



Low visual similarity => consequences for Art. 8 (5) CTMR

⇒ **BoA: Examine other condition of Art. 8 (5)**

Free Riding: logical deductions, analysis of probabilities, usual practices and all other circumstances!

Art. 8 (5) CTMR: T-480/12

ANNULLED



 <p>ماسينا Master</p> <p>(CI 29, 30 and 32)</p>	 <p>Coca-Cola Coca-Cola</p> <p>earlier C'</p> <p>(CI 30, 32, 33 (٤٥٥ ٤٥٥))</p>
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One factor: Use by the CTM applicant of the applied for sign:



Art. 8 (5) CTMR: T-480/12



 <p>(CI 29, 30 and 32)</p>	 <p>earlier C[®] (CI 30, 32, 33 and 40)</p>
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Purpose of oppositions according to Art. 8:

=> ensure, for reasons of legal certainty and sound administration, that TM whose use could successfully be challenged downstream before the courts are not registered upstream.


=> BoA: **ANNULLED!!**



T-505/12

CONFIRMED

REPUTATION of Earlier Mark:

	LONGINES
Cl. 9	Cl: 9


Earlier mark => includes the word „LONGINES“

=> Question: reputation shown for the earlier mark as a whole or only for LONGINES

T-505/12



REPUTATION of Earlier Mark:

	<p>LONGINES</p>
<p>Cl. 14</p>	<p>Cl: 14</p>

Figurative elements:

- Ancillary
- Complicated
- Not easy to remember
- Not perceived as stylised hourglass



Thank you for your attention

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