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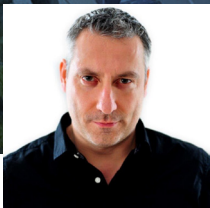
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EU trade mark legislation published



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EU trade mark legislation published

The legislation which introduces a new EU Trade Mark Directive and amends the existing EU Trade Mark Regulation was published in the Official Journal of the European Union on December 24. The amendments to the EU Trade Mark Regulation will enter into force on March 23, 2016.

The legislative package culminates the work that has been carried out during the last seven years on the reform of the EU trade mark system. It acknowledges the success of the existing EU trade mark system, confirming that its main principles have stood the test of time and continue meeting business needs and expectations, but seeks to build on this success by making it more effective, efficient and consistent as a whole and adapting it to the Internet era.

The amending Regulation, in particular, seeks to streamline proceedings and increase legal certainty, as well as to clearly define all the tasks of the Office including the framework for cooperation and convergence of practices between the Office and the industrial property offices of the Member States. The most important terminology changes brought in by the amending Regulation affect the name of the Office (previously "Office for Harmonisation in the Internal Market (trade marks and designs)") and the name of the Community trade mark, which will now become the European Union Intellectual

Property Office and the European Union trade mark, respectively.

The amending Regulation also entails a revision of the fees payable to the Office, including an overall reduction in their amounts, particularly significant in the case of renewals, and the adoption of a one-class-per-fee system.

Applicants will pay a lower fee if they only apply for one class per application, the same fee if they apply for two, and a higher fee if they apply for three or more. Renewal fees are substantially reduced in all instances, and set to the same level as application fees.

On March 23, 2016, all the Office's online application forms and fee calculator will be fully updated to reflect the new system. For more detail, users are invited to view the [section dedicated to the amending Regulation](#) on the Office's website.

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The James Nurton Interview



Andrew Bradshaw, Vice Chairman, Asian Coalition Against Counterfeiting and Piracy (ACACAP)

What is your background?

I started out at Brent and Harrow Trading Standards in 1991, working with some fantastic investigators. I later joined the Metropolitan Police Service for five very enjoyable years. I subsequently returned to Trading Standards where I specialised in anti-counterfeiting legislation. During this time I successfully prosecuted a retailer of counterfeit garments, where assets totalling £1.1 million were confiscated. This led to an approach by Pentland Brands Plc where I spent a number of years as a brand protection manager looking after brands such as Speedo, Berghaus and Kickers.



Andrew Bradshaw

Three years ago I joined SuperGroup Plc, owners of the Superdry brand. As a young company, they hadn't yet felt the impact of global counterfeiting which had recently exploded with the popularity of the brand. I established their first brand protection strategy, focusing on a proactive zero tolerance approach. We formed coalitions with competitors and joined some well-known associations to maximise our efficiency. Using excellent advisors, we soon found a modicum of control in manufacturing countries.

What have you achieved at Superdry?

We've been quite successful in a short period of time and there's a lot less counterfeit product in the market than there was two years ago. This achievement is the result of a zero tolerance approach to online infringements and an aggressive approach to offline counterfeiting. When the team was established there were in excess of 200,000 infringing listings online in Asia alone. Our online strategy saw infringements reduce substantially, enabling our legitimate online business to flourish. Offline we have used many approaches including criminal enforcement, private criminal proceedings and creating financial disincentives through civil proceedings.

SuperGroup knows that it can't rest on its laurels and past achievements. They know that growth will lead to increased threats and it is essential that the

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The James Nurton Interview



business invests in its legal functions and continues to support brand protection.

What are you going to do next?

I leave Superdry in January to manage the Asian Coalition Against Counterfeiting and Piracy. It was founded at INTA in May 2014, by a number of brands who were tired of the merry-go-round of constant seizures and escalating costs. It was agreed that the coalition should be a voice for change and a platform to share ideas and best practice. Whilst there are many great coalitions, we decided to focus on a proactive aggressive approach to deal with counterfeiting in Asia.

ACACAP is a coalition, not an association. Each brand member brand has an equal say, and we encourage brands to engage and to be creative with new initiatives. We have about 30 brands at the moment from across the globe and hope to increase this number in 2016.

The Coalition also consists of lawyers, investigators service provider members. Recent negative publicity against investigators in Asia has affected the confidence of brands. Our advisors commit to following best practice and buy into what we are trying to achieve. They are carefully vetted and we have checks and balances in place to ensure they continue to provide value to brand members.

ACACAP strives to promote efficient strategies through its advisors and insists they focus on full counterfeit supply chains and cost sharing opportunities, particularly when numerous brands are found in one location.

ACACAP's cost sharing initiative has already seen substantial cost savings and a return on investment for brands. Fee sharing is a key performance indicator of the coalition.

We want to be at the forefront of new initiatives including the way in which we communicate with our members. We are in the process of incorporating an easy-to-use case management system named LANACA which will add efficiency to the way we manage and report enforcement actions and ROI. The system enables the coalition to use analytics so that our members' resources can be targeted more effectively.

The coalition also offers a regional training programme to law enforcement around the region. An emphasis is placed on visual impactful sessions with the use of media applications which is very popular with enforcement officers. Whilst our training is focused on front line officers, we also engage with decision makers, lobbying support for anti-counterfeiting. We have met with senior High Court judges, heads of Customs and police and Government Ministers, focussing our message on the losses in taxable revenue and serious criminality.

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How do you differ from other coalitions and associations?

There are lots of great coalitions out there, such as the QBPC, the IACC, UNIFAB and React - each with different approaches. I believe we need many tools in the toolbox, so that we can hit counterfeiting from all angles. Just as brands work together, so should coalitions and associations. We have a duty to assist our members and to drive positive change to the detriment of the counterfeiting world. As for ACACAP, we believe our strength lies in our fluidity of strategy, our receptiveness to new ideas and the openness of our brands.

One of our goals is to set up an intelligence hub, to record information on counterfeiters. We are delighted that Strategic IP Information (SIPI), headquartered in Singapore, has agreed to partner us on this project. SIPI is a fast growing fully managed online brand protection service with their own propriety software. Their recent acquisition of Veri-Site Global should be a game-changer for brands universally. Through a comprehensive database, Veri-Site are uniquely placed to disrupt on and offline counterfeiting by focusing on the connecting linkages.

Veri-Site is able to collect data and enhance it with open source information and proprietary research. This intelligence will be collated and shared with public authorities and enables IP holders to alert ad

networks, banks, payment processors, and other commercial enterprises to such infringements offering alternative measures to deal with the threat of counterfeiting. The long-term goal is to build up an Asia-centric intelligence hub which will be beneficial to all brands and enforcement.

Do different industries share the same problems?

All industries are impacted by counterfeiting or piracy. However, it's clear that some industries receive more protection from law enforcement than others. Where consumer safety issues are concerned there is more traction with law enforcement and rightly so. However, we should never forget that counterfeiting of all products is seen by organised criminal groups as a safer crime and extremely profitable. It is vital that brands, supported by law enforcement, use intelligence to target the money behind the production and importation of illicit goods so that we can target assets to create financial disincentives.

Are the laws sufficient or do they need to be improved?

In most countries, the law is sufficient, but in others such as Laos, Cambodia and Indonesia they need to be strengthened. Corruption is common in Asia and it is important that we as a coalition are able to trust our partners to protect our members from bribery and corruption offences.

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Surprisingly, it's a lot easier to get anti-counterfeiting actions done in Asia if you use the right advisors. It is certainly easier than in the UK at this time. This is in no way a criticism of UK enforcement who strive to do their best on limited budgets and man-power following the austerity measures of the past years. We believe that governments should use current legislation to drive confiscation orders from those that profit from counterfeiting and tax avoidance.

Are there any changes you would like to see?

All governments must review their approach to counterfeiting. Vast revenues are lost through unpaid taxes which could be ploughed into health and public services. Counterfeit sales fund the activities of organised criminal groups and serious crime such as drugs, human trafficking and terrorism.

There is great work being done by Regional Assets Recovery Teams, the City of London Police Service (PIPCU) and brands through private criminal prosecutions and civil actions. However, frontline enforcement must be supported with sensible legislation, financial resources and the technology to execute their duties. Governments need to encourage the use of confiscation legislation to support further enforcement action.

I would also like the judiciary to take a harder line on IP infringements with appropriate penalties. The connections to organised crime are well documented and it is with regret that counterfeiting makes millions for those treated with a light touch by the authorities.

Do you welcome the development in the EU regarding goods in transit?

The subject of 'goods in transit' has been a huge problem to brands. The changes are welcomed but the shortage of enforcement officers and resources must be addressed by government.

What's been the most challenging thing to deal with?

The complexity of the counterfeiters' operations – their organisation, finances and ability to cross international borders at will. Chasing the money men is incredibly difficult and extremely difficult in Asian countries.

What has been your biggest success?

I would say the development of Superdry's brand protection strategy and the rapid growth of awareness amongst enforcement authorities has been a huge challenge and a success. As a team we've worked hard to send a signal to the market by disrupting counterfeiting and creating financial disincentives.

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The James Nurton Interview



The Asian Coalition has also been a huge success, not only for me but to all those involved. I'm very proud to have contributed to its growth and early achievements. I'm certain that the Coalition will go from strength to strength with the hard work of its members, advisors and friends.

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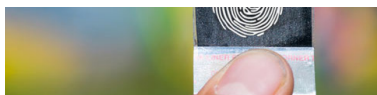
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OHIM's New Guidelines: CTM

OHIM's practices are reflected in the [Guidelines on Trade Mark Practice](#) and the [Guidelines on Designs practice](#). The Guidelines are revised annually in an open and cyclical process, split into two separate "work packages" (WP1 and WP2).

The WP1/2016 review process has now been completed. All of the Parts, Sections and Chapters of the Guidelines contained in WP1 have been reviewed by the Knowledge Circles, approved by internal and external stakeholders and adopted by the President in Decision EX-15-7. They will enter into force on 01/02/2016.

Parts of the Guidelines contained in WP1/2016

COMMUNITY TRADE MARK:

Editor's note and general introduction
WP1

Part A: General Rules

- Section 3, Payment of fees, costs and charges
- Section 5, Professional representation

Part B: Examination

- Section 2, Formalities
- Section 4, Absolute Grounds for Refusal 7(1)(a), (b), (c),(d), (e) and 7(3)

Part C: Opposition

- Section 0, Introduction
- Section 1, Procedural Matters
- Section 2, Double identity and Likelihood of confusion
- Chapter 1, General Principles
- Chapter 2, Comparison of Goods and Services
- Chapter 3, Relevant public and degree of attention
- Chapter 4, Comparison of signs
- Chapter 5, Distinctiveness of the earlier mark
- Chapter 6, Other factors
- Chapter 7, Global assessment
- Section 6, Proof of Use

Part D: Cancellation

- Section 1, Cancellation proceedings

Part E: Register Operations

- Section 2, Conversion
- Section 4, Renewal
- Section 5, Inspection of files
- Section 6, Other entries in the Register
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WP1

- Examination of Design Invalidity Applications

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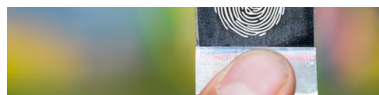
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Part A: Examination, Section 3: Payment of fees, costs and charges

References to the types of credit/debit cards have been deleted in the Guidelines, since this information may vary in time and will be available on the web and when the users execute the payment online.

It has been clarified that in order to benefit from the fee reduction of an electronic filing of a CTM, the Goods and Services must be inserted in the tool itself, and may not be annexed in a PDF or alike. In such case, it is not considered as an electronic filing in the sense of Art. 2 (1b) CTMFR and will therefore not benefit from the reduction.

Part A: Examination, Section 5: Professional representation

The Annex containing the professional representatives has been updated thanks to the input from the stakeholders.

Part B: Examination, Section 2: Formalities

Goods and services

A specific formality deficiency for e-filing is introduced in a new paragraph. The deficiency applies when goods and services are filed as an attachment to e-filing applications. This change was introduced as a Fast-Track change on 06/07/2015 and is reflected in the new Guidelines

Filing Date

The entire paragraph has been restructured to provide details of the exact filing date requirements and to separate out the information relating to formalities. This has been done specifically to introduce the change in practice for goods and services attached as an annex to an e-filing and to emphasise that it is a formality deficiency instead of a filing date deficiency (see above).

First and second language

It has been clarified which language prevails in the case of discrepancies.

Smell/olfactory marks

This paragraph has been re-worked to clarify current Office practice as regards graphical representations.

Position marks

The part of this paragraph in relation to specific goods of position marks has been removed since the examination of the these goods takes place during the examination of absolute grounds for refusal and all the relevant information is available in the Guidelines, Part B, Examination, Section 4, Absolute grounds.

Indication of colour

This paragraph has been reworded to clarify the Office's practice regarding black and white. The rewording concerned the following: (i) 'Black, grey and white may be claimed as 'colours' and (ii)

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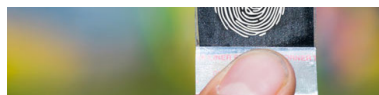
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the reference to 'black and white trade mark' as equivalent to a mark that has not been represented in colour has been deleted.

Furthermore, superfluous sentences, namely regarding applications by fax and indications like 'transparent', have been deleted, as well as the sentence 'and inform the applicant' regarding those cases where the colour indication includes information that is not relevant to this field, since it does not reflect the current practice.

(Convention) Priority

Following comments by a Users' Association, the specification of 'first regular filing' has been added. Cape Verde (CV) has been deleted from the list of independent states that are not WTO members. The condition of the previous application being a first filing is now expressly mentioned as a requirement.

Seniority

Following a proposal submitted by a Users' Association, the established list with the required format for seniorities has been added as 'Annex 1'.

Examples

All examples given in this part of the Guidelines have been checked and deleted or updated where appropriate. Furthermore, due to feedback from users, it has been clarified that the examples are only meant for 'formalities purposes'.

Part B: Examination, Section 4: Absolute grounds for refusal

Changes to the sections of the Guidelines dealing with graphical representation, distinctiveness, descriptiveness, customary signs, shapes and distinctiveness acquired through use (Articles 7(1)(a) to 7(1)(e) CTMR and Article 7(3) CTMR) include some substantial changes (such as the implementation of the results of the Convergence Programme 3. Nevertheless, the vast majority refer to clarifications, inclusion of new Case-Law and addition of examples or restructuring.

More in particular, the section on graphical representation (Article 7(1)(a) CTMR) has been revisited to restructure the sections on smell marks and sound marks. As regards movement marks, the practice of the Office has been nuanced: it is not compulsory for a movement mark to contain a description in order to pass the Article 7(1)(a) test. However, such description will normally be necessary for the representation to be clear, precise, intelligible and objective. Moreover, in light of the preliminary ruling in C-421/13 "layout of a flagship store" a new section has been drafted to indicate that the requirements of graphic representation of the layout of a retail store are satisfied by a design alone, combining lines, curves and shapes, without any indication of the size or the proportions.

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The section on distinctiveness (Article 7(1)(b) CTMR) has been reviewed in light of the recent Case-Law and decisions of the Office on slogans and shapes (including toys and dolls). In addition, a new section on the distinctiveness of sound marks has been drafted as the current Guidelines missed this part. The general principles given by the Court for other types of trade marks are applied by analogy.

As regards descriptiveness (Article 7(1)(c) CTMR), one of the most visible changes relates to the addition of the conclusions of 'Convergence Programme 3 - Distinctiveness - Figurative marks containing descriptive/non-distinctive words' (CP3) into the Guidelines. In the framework of this programme, IP offices of the European Trade Mark and Design Network have agreed on a Common Practice in relation to when a figurative mark containing purely descriptive/non-distinctive words, passes the absolute grounds examination because the figurative element renders sufficient distinctive character. More information on CP3 is available at <https://www.tmdn.org/network/web/10181/59>. The addition of the Common Practice in the Guidelines has only minimal impact on the Office's practice, as it is already aligned with the results of the project.

Other modifications in the Article 7(1)(c) CTMR section regard the update of the section on geographical terms in light of the judgment T-197/13 'Monaco' and the addition of a new section on the assessment of the international non-proprietary names (INN codes).

Only minor modifications have been introduced regarding customary signs.

Finally, the section on distinctiveness acquired through use (Article 7(3) CTMR) has been improved to include recent Case-Law dealing with various aspects of this issue (for instance, T-273/12 'Ab in den Urlaub', T-474/12 'Shape of goblets', T-520/12 'Gifflar', C-217/13 and C-218/13 'Oberbank & Banco Santander' and T-553/12 'Bateaux-Mouches'). Substantial changes have been introduced regarding the "standard of proof", although there is no change of practice. In particular, it has been clarified that the test is not the same as the one for proof of genuine use under Article 42(2) CTMR. As regards the assessment of the evidence, the section has been restructured to give more practical information on the means of evidence that could be adduced, stressing the fact that an overall assessment has to be performed.

Part C: Opposition, Section 1, Procedural matters

Introduction

The wording and structure of the introduction has been improved.

Admissibility check

The order of the means of filing a Notice of opposition has been updated to reflect that the electronic filing of oppositions is the first choice followed by fax and post/courier service.

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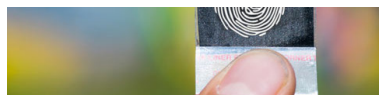
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Furthermore, the paragraph on the time of payment has been revised and new sub-paragraphs have been added for payment by bank transfer and by current account in order to present the information in a user-friendly way.

The paragraph on fee refund has been substituted by a cross reference to the specific paragraph '5.4. Fee refund' of this part of the Guidelines which provides the same information.

As to languages and translation of the Notice of Opposition, paragraph 2.3 was redrafted in order to improve its language and structure. New sub-paragraphs that describe the current practice on the language of proceedings and the translations of the Notice of Opposition have been introduced and new examples have been added.

Finally, the order of the different means of communication (notification of the Notice of opposition) has been changed so that e-communication is the first choice, followed by fax and post/courier service.

Adversarial part

The whole paragraph has been revised and amended where clarifications in wording and structure were needed.

Furthermore, clarifications as to the current practice on scanned documents, renewal certificates (registrations that expire before a decision is

taken), translation requirements and references to evidence filed in other proceedings have been added.

Termination of proceedings

The Guidelines have been updated to clarify the practice on restrictions following judgment C-31/14P and the wording of the whole paragraph has been improved.

Moreover, a new paragraph on national post-registration proceedings has been included under '5.3.2 Ceasing of existence of earlier right'.

Procedural issues

The wording regarding the first request for an extension has been modified. This does not imply a change of practice from a procedural point of view. However, users should be aware that the granting of a first request for an extension can no longer be justified on the basis of it being automatically granted.

A clarification has been added regarding the handling of decisions of multiple oppositions against the overlapping goods and services.

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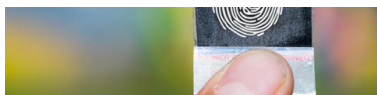
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Part C: Opposition, Section 2: Double identity and Likelihood of confusion

The section 2 'Double Identity and Likelihood of Confusion' was substantially re-structured. The trade mark comparison shall now encompass the analysis of the distinctive and dominant elements of the mark and their impact of the overall impression. Until now, the dominance and distinctive character were analysed in a separate point of the decision, as indicated in the respective Chapters of the Guidelines. Under the new approach, the analysis of the dominant and distinctive elements will be integrated in the trade mark comparison, however, as its prominent and separate part - following the objective description of the signs and followed by the assessment of the degree of similarity. The global assessment of the likelihood of confusion will be concentrated on the application of the inter-dependence theory, based on the previously established degree of the similarity of the signs and goods or services, the degree of the distinctiveness of the earlier mark and balanced against the level of attention of the public.

The main change is the new Chapter 4: Comparison of the signs, which now includes considerations regarding the dominant character and distinctiveness of their elements and further factors. These were previously dealt with in separate chapters. Chapter 5 is now related only to the "distinctiveness of the earlier mark". Parts from

Chapter 7 "Global assessment" were taken to the new Chapter 4. Previous "Chapter 0" and the references to the methodology in Chapter 1 were deleted. New paragraph was prepared on the basis of the previous general Chapter on Distinctiveness regarding now only that of an element of the mark. Dominant elements of the marks were previously dealt with in a separate Chapter, but there are no substantial changes.

A new paragraph was introduced summarizing the previous ones and aiming at providing the examiners with practical advice as to their importance and correlation.

Within the Chapter on the comparison of the signs, their dissimilarity is now analysed in the last part. Since according to current practise the marks can be found dissimilar if they "coincide in irrelevant aspects", paragraphs 4.2.1-4.2.4 try to explain the term "irrelevant" and give examples of element in common (pages 79), overlap in a negligible element (pages 79 et seq.), overlap in a verbal element not noticeable due to high stylisation (page 80) and overlap in other irrelevant aspects (page 81). Paragraph 4.2.5 on "overlap in a non-distinctive elements" contains the change of practise. It was intended to keep a finding of dissimilarity limited to cases, where not only the overlap is non-distinctive, but other elements differentiate the signs.

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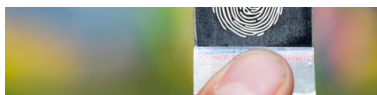
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Part C: Opposition, Section 2: Double identity and Likelihood of confusion Chapter 2: Comparison of Goods and Services

Sections extensively elaborated:

Annex 2 - Provision of food and drink versus food and drink

The practice on the comparison of goods and services relating to the Provision of food and drinks versus food and drinks was updated in the last review of the Guidelines and became practice on 01/02/2015. This update changed Office practice from systematically finding dissimilarity between services for the provision of food and drink and the specific goods in classes 29, 30, 32 and 33 to assessing similarity on a case by case basis.

In response to examiners' requests for further guidance, the Knowledge Circle Goods & Services (KCG&S) carried out an in-depth analysis of decisions and case law from the Boards of Appeal (BoA) and the General Court (GC). It identified certain goods that both the BoA and the Court tend to find to be similar to the services for the provision of food and drink. As a result of this analysis, Annex 2 on the 'Provision of food and drink versus food and drink' has been elaborated to explain the change in practice that came into effect in February 2015.

Reflecting the BoA and GC, the starting point set out in the Guidelines is that 'the mere fact that

food and drinks are consumed in a restaurant is not enough reason to find similarity'. However, 'in certain situations these goods and services can be complementary'. Where market reality can be shown to support the proposition that the same undertaking produces the good and provides the service, a key criterion for similarity is present. Where such a market reality does not exist, as a rule, there will not be similarity. This is KCG&S' interpretation of the copious case law examined.

KC G&S has also updated the pairs in the [Similarity Tool](#) to reflect these trends. The pairs concerned can be found, along with a link to the relevant case-law, by searching for 'provision of food and drink'.

Annex 2 - Services to support other businesses

This section has been substantially developed to identify differences between the services and to provide further examples. In particular, the difference between Business Management services, as services that are intended to help companies manage their business by setting out the strategy and/or direction of the company, Business Administration services, as services that are intended to help companies with the performance of business operations and, therefore, the interpretation and implementation of the policy set by an organisation's board of directors and Office functions, as being the internal day-to-day operations of an organisation including the administration and the support services in the 'back office', are explained in greater detail in order to assist examiners when making such comparisons.

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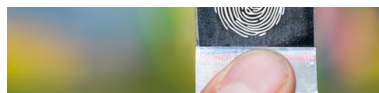
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Part C: Opposition, Section 6: Proof of Use

The recent amendments aim to clarify or emphasize Office's practise but no substantial changes in the practise itself were suggested. New case-law was introduced and the examples coming from the decisions of the Opposition Division or Boards of Appeal replaced, where suitable, by examples from the recent case law.

The need to clarification or better explanation of the Office's practise required the re-drafting of the paragraph 2.3.2. "use as a trade mark" in relation to company names and Internet domains. Also paragraph 3.7.2 "Need for assessing proof of use" was redrafted. The new case law was especially introduced in the paragraph 2.7 "use in forms different than the one registered" where several developments of the jurisprudence were observed.

Part D: Cancellation, Section 1: Procedural matters

Admissibility check

Some clarifications of absolute admissibility deficiencies have been introduced. These clarifications concern (i) *res judicata* (this terminology has been replaced by the literal wording of Article 56(3) CTMR and a cross reference to Part D, Section 2 is included), and (ii) previous application/counterclaims on the basis of a different earlier right also belonging to the applicant (a cross reference to Part D, Section 2 is included).

A paragraph concerning the possibility of limiting the scope of the cancellation application by excluding sub-categories of the goods and/or services for which the contested mark is registered, has been added in line with judgment T-307/13.

Furthermore, examples to illustrate the difference between admissibility and substantiation concerning earlier rights under paragraph '4.1.3 Grounds of the application for cancellation and facts, evidence and arguments presented in support of those grounds' were added.

Notification of the application to the CTM Proprietor and further exchanges between the parties

The practice as regards renewals has been clarified in order to highlight the difference between opposition and invalidity proceedings on the date of substantiation. In cases of invalidity, the date of substantiation is the date of the closure of the adversarial part (although in principle all of the evidence should be submitted with the cancellation application).

A further clarification has been introduced concerning revocation of decisions on admissibility, namely that no revocation will take place when the cause of inadmissibility arises after the initial admissibility check. In this case the Office will check again the admissibility and issue the corresponding deficiency letter because the previous admissibility decision did not contain any error at the time it was adopted.

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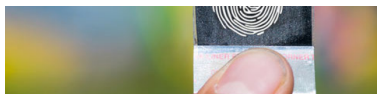
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Language used in cancellation proceedings

The wording of the paragraphs on the language of the cancellation proceedings and on translations of the cancellation application has been improved.

Part E: Register Operations

The only substantial change has been introduced in Section 5, Inspection of files. Guidelines were stricter than the law and required that the request for confidentiality shall be submitted at the same time of submission of the document. Rule 88 (c) CTMIR: excludes confidentiality only during Inspection of File. Consequently, a request for confidentiality may be filed at a later stage. However, as long as an Inspection of File proceeding is pending, the request is inadmissible.

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Examination of Design Invalidation Applications

In a quest for adopting a more design specific terminology, references to “professionals” have been replaced by those to “specialised circles”. In addition, rather than referring to “prior art” preference has been given to the term of “prior designs” which underlines the comparison to be made in relation to individual designs and their features instead of combined features taken from the entire prior art.

Furthermore, for the purpose of interpreting a design, relevant for various parts of the Guidelines, the formulation that the design itself is considered “where necessary” has been deleted. In addition to the product indication, the design representation should rather be taken note of in all cases.

3.3 Language of proceedings

The users’ attention is drawn to the fact that the language regime in design invalidity proceedings differs in some points to that governing CTM proceedings.

3.15 Participation of an alleged infringer

When alleged infringers fulfil certain legal conditions they are entitled, in principle, to join invalidity proceedings as third parties. The former expression that they “may join”, therefore, has been replaced by “can join”.

4.1.1 Observations by the holder

In accordance with CTM cancellation proceedings, the procedure has been clarified in case the holder of the contested RCD is no longer represented despite this being mandatory. The holder is required to appoint a representative in that case, failing which procedural statements made are disregarded by the Invalidation Division.

4.1.8 Oral proceedings

Given that oral proceedings are not conducted automatically upon request by a party but only when the Office considers them to be expedient, as laid down in Art. 64 CDR, the formulation “[o]ral proceedings will be held [...]” has been substituted by “[o]ral proceedings may be held [...]”.

4.2.2 Examination of the grounds for invalidity

In case the invalidity request is based on a lack of individual character only according to Art. 6 CDR, the Invalidation Division is given the discretion to examine the novelty of the contested RCD under Art. 5 CDR as well. In suitable cases, in particular when there are no apparent differences between the conflicting designs, this shall facilitate the decision practice. However, the Invalidation Division shall not engage in an additional examination of Art. 5 CDR when not expressly claimed.

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5.1.1. Living Organisms

It has been clarified that Community designs will not be declared invalid if it is apparent from the representation that the product does not show a living organism.

5.5.1.4 Disclosures derived from the internet

The wording of the guidelines with respect to disclosures derived from the internet has been approximated to the wording of Art. 7 CDR.

5.5.1.9 Grace period

It has been clarified that the grace period under Art. 7(2) CDR, allowing designers and others under certain conditions to disclose their designs for test purposes without destroying the novelty/individual character of a subsequent design registration thereof, is also available when the previously disclosed design does not produce a different overall impression.

5.5.2.1 Common principles

Concerning the visibility requirement, the former part addressing the impact of less visible parts on the overall impression has been deleted since this issue, strictly speaking, is not subject matter of the visibility requirement under Art. 4(2) CDR.

5.5.2.3 Individual character

The reference to the “d  ja vu” right at the outset of the explanations given in respect of what defines “individual character” has been eliminated. This shall

prevent the wrong impression that a “d  ja vu” is the central and established test in assessing individual character which has not sufficient support in case-law. Moreover, the overall impression of conflicting designs, in principle, is to be assessed based on a side-by-side comparison rather than the “imperfect recollection” as relevant in trade mark law.

Furthermore, it has been clarified that the informed user constitutes a fictitious rather than a real person.

In relation to the overall impression of conflicting designs, the concept of the saturation of the state of the art, as acknowledged in case-law, has been introduced into the guidelines, pointing out, however, that an actual impact for the assessment will depend on sufficient evidence of the existing design corpus and its density to be presented by the holder of the contested RCD.

7.2 Interlocutory revision

It has been clarified that revision can only be granted if the application for a declaration of invalidity is rejected as inadmissible. A revision in the subsequent inter-part part of the proceedings is excluded by Art. 58(1) CDR.

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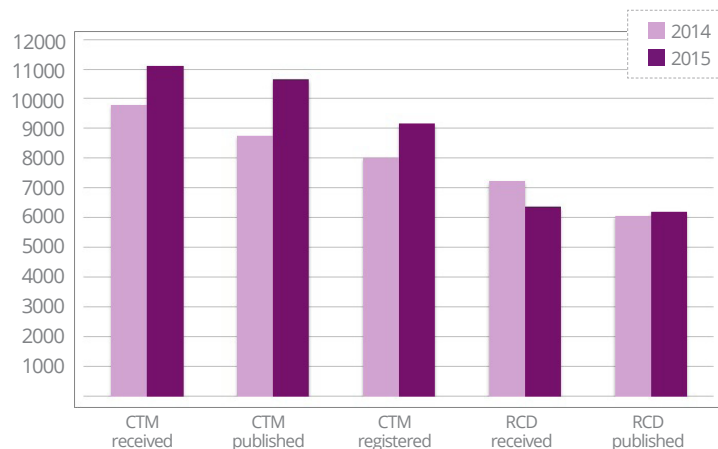


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Monthly statistical highlights November*	2014	2015
Community Trade Mark applications received	9 804	11 113
Community Trade Mark applications published	8 767	10 647
Community Trade Marks registered (certificates issued)	8 035	9 171
Registered Community Designs received	7 240	6 366
Registered Community Designs published	6 078	6 220

* Statistical data for the month in course is not definitive. Figures may vary slightly thereafter.



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Finland joins DesignView

As of 30 November, the Finnish Patent and Registration Office (PRH) has made its design data available to the DesignView search tool.

The incorporation of PRH took place under the Cooperation Fund programme managed by OHIM in association with its partners from the European Union.

With PRH on-board, DesignView now contains data from 47 participating offices, including those accessible through the ASEAN DesignView. With the addition of more 44 448 designs from Finland, DesignView now provides information and access to almost 9 million industrial designs in total.

Since the introduction of DesignView on 19 November 2012, the tool has served more than 1,34 million searches from 141 different countries, with the most frequent users from Germany, Spain and UK.

You can find out more at <https://www.tmdn.org/tmdsview-web/welcome>.

Lithuania implements Back Office

The State Patent Bureau of the Republic of Lithuania (SPB) went live with the Back Office system developed by the Cooperation Fund by switching off their legacy system launched 18 years ago.

To ensure a smooth transition to new system the SPB had been using the two systems in parallel since June this year.

The parallel phase successfully finished on 12th October and now the office operates only the Back Office system.

The original Back Office, which was created by the Cooperation Fund and handed over to SPB, was expanded by creating additional modules such as Official Gazette, Correspondence, Statistics and Analytics modules.

The tool helps the SPB manage the entire trademarks and designs lifecycles, including Registration, Opposition/Cancellation/Invalidity, Records, Appeals, International Registration and International Application for trademarks and designs.

The new system has been named "LINRA", which should be encoded as L - Lithuanian, IN - Industrial property, R - Registers, A - Administration.

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As of today eight EU IP offices have implemented the Back Office system developed by the Cooperation Fund.

DesignClass goes live

A new design classification tool, [DesignClass](#), has been launched by OHIM.

The tool, built on the same lines as TMClass, includes a harmonised database of product indications (HDBPI).

The HDBPI contains approximately 13,000 concepts including Locarno Classification terms and other terms pre-approved and pre-validated by 24 participating EU offices, in 23 EU languages.

[DesignClass](#) is the most extensive free, online resource of pre-accepted product indications available to users.

[DesignClass](#) is live and may be consulted for classification questions related to designs as of today. However, users should note that it is not yet the definitive guide to OHIM's practice on the matter.

OHIM will undertake a series of actions to adjust practice and systems, and our intention is to make [DesignClass](#) fully available for our users during the course of 2016.



EU IP offices can also implement the tool into their own e-filing systems, on a voluntary basis and according to their own established procedures.

[DesignClass](#) was developed by the Convergence Programme at OHIM as part of the CP7 - Harmonisation of Product Indications project.

Hellenic Industrial Property Organisation implements e-Services

As of 17 December 2015, the Hellenic Industrial Property Organisation (OBI) has implemented e-Services, developed by the Cooperation Fund under the Software Package project.

The e-Services system complements the Design eFiling implementation that took place in January 2014.

OBI offers a Front Office suite that allows the receipt of online applications relating to the creation of and major changes to of the designs lifecycle. OBI also integrated Designs eFiling and eServices applications in their electronic mailbox implementation. Following these implementations, OBI now offers a complete and secure online solution for document exchange and electronic filings to the public.

The e-Services project is now implemented in 14 National Offices. The project aims to develop a set

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of web-based tools for national and regional EU IP Offices to facilitate the electronic filing of trade mark oppositions, trade mark and design registrations and renewals, trade mark cancellations and design invalidities.

Ireland implements e-filing for designs

As of 11 December 2015, the Irish Patents Office implemented e-filing for designs, developed by the Cooperation Fund under the Software Package project.

The new system which is similar to the trademark e-filing introduced in the Irish Office in 2014, represents a big step forward in the way designs are processed and registered, making applications easier, quicker and more accessible to users of the Irish design system.

Estonia implements Back Office

On 10 December 2015, the Estonian Patent Office announced the implementation of the Back Office. The tool is part of the Software Package developed under the framework of the Cooperation Fund.

Of the 12 European IP offices who showed their interest in implementing the Back Office Software



Package, a total of ten offices are already using the Back Office.

The Back Office tool helps the Estonian Patent Office manage the entire trademarks and designs lifecycles, including Registrations, Oppositions/Cancellations/Invalidity, Recordals, Appeals, International Registrations and International Applications for trademarks and designs.

A beneficial and user-friendly feature in the Back Office is the integration with the electronic services of the Estonian state: the payment module, the business register, the population register, the address register and the digital signature system.

The Correspondence module of the Back Office allows communication to be carried out with applicants or their representatives directly from the Back Office by sending digitally signed official letters via emails.

The main benefit of the Back Office for the Estonian Patent Office is that it allows transition to electronic proceedings. All the files gathered during the examination can be saved electronically, which is an especially useful feature for examiners, and in the long run, for the registry and the archive.

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India joins TMclass

As of 07 December 2015, The Indian Office of the Controller General of Patents, Designs & Trade Marks (CGPDTM) has joined TMclass.

With CGPDTM on-board, TMclass now contains data from 57 participating offices.

TMclass now offers users the opportunity to search and translate terms to and from any of the 40 languages available.

This successful integration is the result of the EU-INDIA Intellectual Property Cooperation (IPC-EUI) project co-funded by the European Union and the Office for Harmonization in the Internal Market within the framework of the International Cooperation Programme and in close collaboration with CGPDTM.

You can find out more at www.tmdn.org and <http://oami.europa.eu/ec2>

ARIPO and Bosnia and Herzegovina join TMview

As of 07 December 2015, the African Regional Intellectual Property Organization (ARIPO) and the Institute for Intellectual Property of Bosnia and Herzegovina (IIP-BIH) have made their trade mark data available to the TMview search tool.

ARIPO's member states are Botswana, Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Liberia, Rwanda, São Tomé and Príncipe, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe (a total of 19 member states).

With ARIPO and IIP-BIH on-board, TMview now contains data from 53 participating offices. With the addition of about 25.000 trade marks in total from ARIPO and IIP-BIH, TMview now provide information and access to more than 34,6 million trade marks in total.

Since the introduction of TMview on 13 April 2010, the tool has served more than 16,9 million searches from 151 different countries, with Spain, Germany and Italy among the most frequent users.

You can find out more at www.tmview.org

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OHIM performance update

OHIM has published the 2015 Q3 results for timeliness, quality and accessibility.

All timeliness indicators continue to improve, despite a sustained upward curve of 9.8% in filings compared to 2014. The result of CTM examinations quality checks remains stable, while opposition proceedings and decisions quality dipped into Compliance and Actions Needed ranges, respectively.

International Registrations now join the list of indicators to continue an upward volume trend of 25% (compared to 2014), while achieving Excellence status in timeliness.

Regarding Appeals, the trend is stable. Ex-parte and Inter-parte decisions timeliness keep the Excellence level achieved in the previous quarters.

Accessibility achieved high levels of effectiveness during the third quarter. The performance remains stable as almost all of the indicators are in the Excellence range.

For any comment or suggestions, please contact CGS@oami.europa.eu.

For more information visit our Quality page – [OHIM Service Charter section](#)

OHIM launches DesignEuropa awards

To celebrate the importance of design in the EU, OHIM has announced the first edition of the DesignEuropa Awards.

The Awards are open to firms and/or individuals who hold a valid Registered Community Design (RCD). The RCD is a unitary intellectual property right administered by OHIM and valid throughout the EU-28.

The DesignEuropa awards will have three categories: Industry (firms with more than 50 employees and over €10 million turnover); Small and Emerging companies (firms with fewer than 50 employees and less than €10 million turnover, or companies established after January 1, 2013); and a special Lifetime Achievement Award.

Applications for entry will open through OHIM's website on February 1, 2016. Terms and conditions and a guide for entrants will also be published on that date.

The award ceremony will be held in Milan, Italy, in December 2016.

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The economic cost of IPR infringement in the toys and games sector in the EU

A new report published by OHIM reveals that toys and games manufacturers across the European Union lose approximately €1.4 billion each year due to the presence of counterfeit products.

The [report](#) shows that 12.3% of sales in the EU toys and games sector is lost due to counterfeiting. Those lost sales translate into 6,150 jobs, as legitimate manufacturers employ fewer people than they would have done in the absence of counterfeiting. The report also shows that, when the direct and indirect effects of counterfeiting in the toys and games manufacturing sector are taken into account, €370 million in government revenue is lost across the EU, in terms of lost VAT, income tax, social security contributions and tax on company profits. The toys and games manufacturing sector in the EU is largely made up of small and medium enterprises (SMEs), employing, on average, around 10 workers per firm.

The report, released by OHIM acting through the Observatory, covers the manufacture of products like dolls, action figures, stuffed animals, board games, toy musical instruments, model trains and puzzles. It does not include video games consoles, software for video games or bicycles.

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B: General Court: Orders and Judgments on appeals against decisions of the OHIM

Case T-633/14; Monster Energy Company v OHIM; Order of 9 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Notification, Admissibility, Force majeure, Fax, Representative, Figurative trade mark

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods within Classes 5, 30 and 32. The examiner refused to register the word as a CTM on the ground that it is devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA notified its decision by fax although the applicant had opted for e-communication. Six months later, the applicant informed the Office that he had not been notified of the BoA decision and requested a new period for bringing an action before the General Court (GC). The Office confirmed the notification of the BoA's decision by fax. The applicant filed an action before the GC, which was found to be manifestly inadmissible.



SUBSTANCE: DATE OF NOTIFICATION OF CONTESTED DECISION / PERIOD FROM BRINGING AN ACTION: The GC observes that the Office's fax machine's transmission report bears the word "OK" and concludes that the Office had proved to the requisite legal standard that the fax which it sent to the applicant on 20 December 2013 reached the latter on that date and that, therefore, the contested decision, which was reproduced in that fax, was notified to and received by the applicant on 20 December 2013. Thus, even if the Office had not complied with the method of communication by electronic means chosen by the applicant, the contested decision must be deemed to have been notified on that date pursuant to Rule 68 CTMIR (Paras. 22-24). The GC reminds that to determine the date of receipt of a notification, account should be taken only of the external aspect of the notification, irrespective of whether that entity effectively received and took cognisance of the notification (Para. 26). Thus, the appeal before GC lodged on

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18 August 2014 is out of time. UNFORSEEABLE CIRCUMSTANCES OR FORCE MAJEURE: The applicant alleged an accident which gave rise to the malfunction of the representative's fax machine, namely a fire and a flood which resulted in a power cut. The GC reminds the concept of force majeure does not apply to a situation in which, objectively, a diligent and prudent person would have been able to take the necessary steps before the expiry of the period prescribed for instituting proceedings (Para. 35). The GC notices that a period of almost six months elapsed between the occurrence of the accident and the date on which the representative became aware of the contested decision. In order to guard against the consequences of the accident, the representative should have checked whether, during the period in which its fax machine was malfunctioning, there had been a failure in the reception of faxes and, to that purpose, should, without making unreasonable sacrifices, have ensured that the progress of that case was followed diligently by establishing as soon as possible after that malfunction had occurred, directly with the Office, whether the latter had notified a decision to him (Paras. 38-40). Since the representative did not take all reasonable steps to meet the deadline for bringing an action and ensure that the progress of the case was followed diligently in this instance, the concepts of force majeure and unforeseeable circumstances do not apply (Paras. 41-42).

Case T-666/14; Monster Energy Company v OHIM; Order of 9 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Notification, Admissibility, Force majeure, Fax, Representative

FACTS: The applicant sought to register the mark represented below as a CTM for goods within Classes 5, 30 and 32. The examiner refused to register the word as a CTM on the ground that it is devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal. The BoA notified its decision by fax although the applicant had opted for e-communication. Six months later, the applicant informed the Office that he had not been notified of the BoA decision and requested a new period for bringing an action before General Court (GC). The Office confirmed the notification of the BoA's decision by fax. The applicant filed an action before the GC, which was found to be manifestly inadmissible.

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SUBSTANCE: DATE OF NOTIFICATION OF CONTESTED DECISION / PERIOD FROM BRINGING AN ACTION: The GC observes that the Office's fax machine's transmission report bears the word "OK" and concludes that the Office had proved to the requisite legal standard that the fax which it sent to the applicant on 20 December 2013 reached the latter on that date and that, therefore, the contested decision, which was reproduced in that fax, was notified to and received by the applicant on 20 December 2013. Thus, even if the Office had not complied with the method of communication by electronic means chosen by the applicant, the contested decision must be deemed to have been notified on that date pursuant to Rule 68 CTMIR (Paras. 24-26). The GC reminds that to determine the date of receipt of a notification, account should be taken only of the external aspect of the notification, irrespective of whether that entity effectively received and took cognisance of the notification (Para. 28). Thus, the appeal before GC lodged on 16 September 2014 is out of time (Para. 34). UNFORSEEABLE CIRCUMSTANCES OR FORCE MAJEURE: The applicant alleged an accident which gave rise to the malfunction of the representative's fax machine, namely a fire and a flood which resulted in a power cut. The GC reminds the concept of force majeure does not apply to a situation in which, objectively, a diligent and prudent person would have been able to take the necessary steps before the expiry of the period prescribed for instituting proceedings (Para. 37). The GC notices

that a period of almost seven months elapsed between the occurrence of the accident and the date on which the representative became aware of the contested decision. In order to guard against the consequences of the accident, the representative should have checked whether, during the period in which its fax machine was malfunctioning, there had been a failure in the reception of faxes and, to that purpose, should, without making unreasonable sacrifices, have ensured that the progress of that case was followed diligently by establishing as soon as possible after that malfunction had occurred, directly with the Office, whether the latter had notified a decision to him (Paras. 40-42). Since the representative did not take all reasonable steps to meet the deadline for bringing an action and ensure that the progress of the case was followed diligently in this instance, the concepts of force majeure and unforeseeable circumstances do not apply (Paras. 43-44).

Case T-530/14; Verein Sterbehilfe Deutschland v OHIM; Judgment of 9 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctiveness element, Nature of the goods and services, Figurative trade mark

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FACTS: The applicant sought to register the figurative sign displayed underneath as a CTM for services in Classes 35, 41, 44 and 45 (press services; advertising, publicity/information with regard to death/assisted suicide medical services, etc.). The examiner partially refused the application based on Article 7 (1) (b) CTMR. The Board of Appeal confirmed the examiner's decision. It held that ribbons such as the present one are frequently used in different colours to indicate affiliation and solidarity with certain groups (e.g.: red: AIDS, pink: breast cancer, etc.). Even though the public can differentiate between the different colours, it will not regard such ribbons as denoting a particular commercial origin. Black is known as a typical colour for death and for expressing grief. The black ribbon merely expresses solidarity with deceased or their relatives. Furthermore, the ribbon does not depart significantly from ribbons commonly used. The applicant filed an action before the General Court (GC), claiming a violation of Article 7 (1) (b) CTMR.

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SUBSTANCE: The GC confirmed that the appearance of the ribbon at issue was common and did not depart noticeable from other types of ribbons used in the market. It considered it a well-known fact that ribbons in different colours are commonly used to express solidarity with certain groups of persons (AIDS, breast cancer, etc) (Para. 21). The ribbon at issue will be understood as a symbol of grief and solidarity with the deceased or with persons who have lost a family member/loved one, not as a source of origin (Paras. 22-23). The services, which all (can) deal with the subject of death in a broader sense, are sufficiently homogeneous to conclude that the ribbon lacks distinctiveness for all the services at issue. In this regard it would have been for the applicant to point out, for which specific services the mark is allegedly distinctive or which services do allegedly not form part of a homogenous group (Paras. 24-25). As far as the applicant claims that the ribbon possesses distinctiveness on account of the (black) colour, which differs from other colours, it needs to be noted that colours – despite their ability to evoke feelings and mental connections - are hardly capable of conveying clear-cut information. This is all the more true in light of the fact that colours are widely used in marketing and advertising of goods and services without a clear content (Para. 32). All in all, neither the form nor the colour of the ribbon makes it possible to attribute a specific commercial origin to the mark (Para. 34). Based on the foregoing, the action was dismissed.

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Case T-550/14; Volkswagen AG v OHIM; Judgment of 17 September 2015; Language of the case: DE

RESULT: Action dismissed

KEYWORDS: Distinctive element, Specialised public, Quality of the goods and services, Laudatory mark, Nature of the goods and services, Descriptive element, Principle of legality

FACTS: The applicant sought to register the word mark COMPETITION as a CTM for goods and services in Classes 12, 28, 35 and 37. The examiner refused the application in its entirety based on Article 7 (1) (b) CTMR. The Board of Appeal (BoA) confirmed the examiner's decision. It held that the trade mark denotes a certain category of goods, namely those, which can cope with the high demands of a competition as well as services, which prepare vehicles for competitions ("tuning"). Therefore, "COMPETITION" was deemed non-distinctive for the goods and services at issue. The applicant filed an action before the General Court (GC), claiming a violation of Article 7 (1) (b) CTMR.

CTMA

COMPETITION

SUBSTANCE: At the outset, the GC confirmed that the relevant public consists of specialists (taking part in motor races) as well as the general public interested in vehicles/parts for automotive competitions. "Competition" is a commonly known, banal English word, which will also be understood in its meaning by the French public (Paras. 19-20, 24). It denotes obviously goods and services, which are suitable for competitions and therefore are of superior quality. It is a laudatory term to underline and emphasize the positive characteristics of the goods and services and their advantages in comparison with other goods and services (Para. 24). In connection with the goods in Class 12, "Competition" merely points out that the vehicles, etc. are apt for competitions, more durable or faster than other vehicles. The meaning of the term is not ambiguous and does not have a semantic depth that would prevent the public from immediately connecting it to the goods and services (Paras. 25-30). An analogous reasoning applies for the claimed services in Class 37 and 35, which are all directly linked to the goods in Class 12. In this context, "Competition" directly describes the suitability of the services to prepare vehicles for competitions or the retailing of vehicles apt for competitions. Finally, with regard to "toys", etc. in Class 28, these goods can either be apt for competitions or serve for re-enacting competitions (Paras. 34-36). The correct findings of the BoA with regard to the non-distinctiveness of the term "Competition" cannot be put into question by the applicant's argument that

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the public is used to more or less laudatory trade marks in the automobile sector. This argument is in direct contraction to the applicants claim that "Competition" would not have a laudatory character (Para. 39). Finally, the applicant cannot deduct any rights from prior registrations or alleged Office practice, as the BoA is only bound by the law and not by prior Office practice. Besides, each case has to be judged upon its own merits (Paras. 41-47). Based on the foregoing, the action was dismissed.

Case T-195/14; Compagnie des gaz de Pétrole Primagaz SA v OHIM; Judgment of 24 September 2015; Language of the case: DE

RESULT: Action partly upheld (BoA decision partially annulled)

KEYWORDS: Figurative trade mark, Likelihood of confusion, Specialised public, Common element, Visual similarity, Phonetic similarity, Conceptual similarity, Distinctive element, Descriptive element, Dominant element, Figurative element, Identity of the goods and services, Dissimilarity of the goods and services, Laudatory mark, Weak element, Minimum degree of distinctiveness

FACTS: The CTM applicant sought to register the figurative trade mark PRIMA KLIMA, displayed underneath, for goods and services in Classes 11 and 42 (e.g. lighting, heating drying apparatus; R&D

in the field of lighting, heating, drying). The opponent (applicant before the GC) filed an opposition based, inter alia, on the earlier figurative CTM PRIMAGAZ as displayed underneath, registered, inter alia, for identical goods in Class 11. The opposition was based on Article 8 (1) (b) CTMR and directed against all the goods and services in Classes 11 and 42. The Opposition Division found no likelihood of confusion (no LOC) and rejected the opposition in its entirety. The Board of Appeal (BoA) dismissed the appeal. It found that the R&D-services are directed at a professional public with an enhanced degree of attentiveness, whereas the goods are directed at the public at large, which will nevertheless - due to the relatively expensive goods with a long life span - be attentive above average as well. With regard to the contested services in Class 42, the opposition already fails, because these services are dissimilar to the goods in Class 11 of the earlier mark. With regard to the goods in Class 11, which are identical/highly similar, the opposition fails, because the marks are not sufficiently similar to conclude a LOC (visually dissimilar, aurally lowly similar, conceptually dissimilar for those consumers who perceive the meaning of "KLIMA" and "GAZ"). Taking into account that the marks only coincide in a non-dominant, descriptive and non-distinctive element ("PRIMA") and considering that all word elements are descriptive and non-distinctive, the consumers will rather focus on the marks' figurative elements. The opponent filed an application to the General Court (GC), based on a claimed violation of Article 8

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(1) (b) CTMR, requesting the annulment of the BoA's decision.

CTMA



Earlier mark



SUBSTANCE: With regard to the comparison of the goods in Class 11 with the services in Class 42, the GC confirmed the BoA's finding of dissimilarity. It pointed out that they are directed at a different public and not complementary either, as the goods are not indispensable or important for rendering the (R&D) services (Paras. 31-37). With regard to the distinctiveness and dominant character of the individual elements of the signs, the BoA erred in several aspects. First: When composite marks are compared, the word elements are usually considered more distinctive than the figurative elements, in particular if the figurative elements - as in the present case - are rather banal (Paras. 46-47). Second: Even though it is true that "KLIMA" and "GAZ" are of low distinctive character (as they

refer to "Climate" and "Gas", Para. 51), the same cannot be said about the word "PRIMA", which has only a clearly laudatory meaning in German and Dutch, but not in other relevant languages (e.g. French or Italian (Para. 48)). Third: Even if "PRIMA" was considered to be laudatory/weak, this would not automatically mean that this element can be disregarded in the comparison, particularly due to its size and positioning within the signs (Para. 49).

With regard to the possible meaning of "PRIMA" the BoA has basically stated that it will be perceived as laudatory in all languages, as it derives from the Latin word "Primus" (the first) and has similar equivalents in most languages (French: "Premiere"; Engl.: "primary"; Ital.: "prima"). The GC does not share this view. "Primus" (female form: "prima") is primarily an ordinal number, which does not convey an immediate image of high quality. Furthermore, e.g. in Italian, "GAZ" and "CLIMA" are masculine words, and the public will note the wrong declination and grammatical inconsistency in combination with the "feminine" adjective "PRIMA" (instead of "Primo"). Similar considerations apply with regard to French consumers. In light of the above said, the marks do not merely raise the concept of an "extraordinary gas/climate". Therefore, the conceptual comparison as performed by the BoA was incomplete and erroneous, as the signs display a certain degree of conceptual similarity at least for the Italian and French consumers (Paras. 61-71).

With regard to the visual comparison, the BoA has erroneously stripped the element "prima" completely

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of its importance in the overall appearance of the signs, which is not to be neglected at least for the Italian and French public. As the marks share at least a low degree of visual similarity, the BoA's finding of visual dissimilarity was wrong (Paras. 72-78).

As the regards the overall assessment, the BoA erroneously referred to the "earlier trade mark's non-distinctive character". A minimum degree of distinctiveness of the earlier mark is to be assumed in opposition proceedings and can only be challenged in cancellation proceedings. Even assuming that the BoA wanted to refer (merely) to a weak distinctive character of the earlier mark, it is to be noted that the distinctive character of the earlier mark is only one factor in the overall assessment (Paras. 95-97). Finally, due to the fact that the element "PRIMA" is of normal distinctiveness for the Italian/French part of the public, which perceives the combination of "PRIMA" with "GAZ"/"PRIMA" as unusual, the earlier mark enjoys a normal degree of distinctiveness for this part of the public.

In light of the above said, the identity of the goods and the high degree of consumer attention, the contested decision of no LOC is annulled for the goods found to be identical/highly similar (Para. 100).

Case T-77/14; EE Ltd v OHIM; Judgement of 10 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Colour mark, Figurative trade mark, Admissibility, Function of trade mark, Distinctive element

FACTS: The applicant sought to register figurative sign represented below as a CTM for the goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The examiner rejected the application in respect of all goods and services on the grounds of 7 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the appeal finding that the sign was inherently devoid of any distinctive character. The CTM applicant filed an appeal before the General Court (GC).

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SUBSTANCE: The CTM applicant claimed infringement of Article 7 (1) (b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the (BoA). The applicant maintained that the distinctive character of the sign has been proved before the BoA.

The action was dismissed in its entirety by the GC. The GC concluded that in case each one of the individual features of the mark applied for is devoid of any distinctive character the combination of those features, taken as a whole is a priori not distinctive in itself. However, the GC ruled that the provision of description of the figurative mark before the GC cannot be considered new argument and the BoA erred when dismissed it as inadmissible providing the description of such mark is not a mandatory requirement (Para. 51). According to the judgement, there is no need for each of the goods and services to be assessed and they may be grouped for the purpose of the examination and general reasoning may be applied where they form a category or groups sufficiently homogenous to permit such general reasoning (Para. 59). The sign described by the applicant will not be perceived by the relevant consumer as indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the service of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (Paras. 63-64). The GC concluded that high degree of attentiveness with regard to some of the goods

and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (Para. 70).

Case T-323/14; Bankia, SA v OHIM; Judgment of 17 September 2015; Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)

KEYWORDS: Likelihood of confusion, Common element, Conceptual similarity, Descriptive element, Similarity of the goods and services, Similarity of the signs, Specialised public, Visual similarity, Phonetic similarity

FACTS: The applicant sought to register figurative sign BANKIA represented below as a CTM for the goods and services in Classes 9, 16, 35, 36, 38, 41 and 45.

An opposition was filed based on the basis of the earlier national word mark BANKY, which covers services in Class 36 against the registration of the sign for the in respect of the services in Class 36. The Opposition Division partially upheld the opposition for most of the services in Class 36. Both the applicant and the opponent filed an appeal before the Board of Appeal (BoA). The BoA dismissed the applicant's appeal and upheld the opposition in respect of "real estate services" in Class 36. The applicant filed an application for annulment before

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the General Court (GC) on the basis of infringement of article 8 (1) (b) CTMR.

CTMA

Earlier mark

SUBSTANCE: The contested decision was annulled to the extent that it upheld the appeal of the opponent concerning the “real estate services” covered by the Community trade mark application in Class 36. The GC concluded that the relevant public is made up of the general public and professionals with high level of attention. According to the GC the mark possesses certain degree of visual and conceptual similarity and high degree of phonetic similarity. Despite of the fact that the two signs in question are not purely descriptive of the services at issue, the relevant public will associate them with the same concept. The GC upheld the applicant’s plea in law to the extent that the BoA wrongly found that there was LOC for the part of services in Class 36, “real estate services” and therefore wrongfully upheld the appeal of the opponent. The GC dismissed the remainder of the action.

Case T-707/14; Grundig Multimedia AG vs OHIM; Judgment of 25 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Relevant territory

FACTS: The applicant sought to register the word sign below as a CTM for goods and services in Class 7. The Opposition Division rejected application on the basis of Article 7 (1) (b) and (c) and (2) CTMR. The Board of Appeal dismissed the applicant’s appeal on the ground of Article 7 (1) (c). The applicant filed an application for annulment before the General Court (GC) on the basis of infringement of Article 7 (1) (c) and 7 (1) (b) CTMR.

CTMA

SUBSTANCE: The GC dismissed the action. According to the judgement the relevant public is the English-speaking public. The sign must have distinctive character throughout the European Union (EU) in order to be registered as CTM following its unitary character, a mark is not to be registered if it lacks

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distinctive character in a part of the EU. The sign is incompatible with the CTMR and it is descriptive for the goods concerned. The application could be dismissed without ruling on existence of an absolute ground of refusal under Article 7(1)(b) providing the sign is descriptive.

Case T-143/14; EE Ltd. v OHIM; Judgment of 10 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Admissibility, Colour mark, Distinctive element, Figurative trade mark, Function of trade mark.

FACTS: The applicant sought to register the figurative mark for goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The Examiner's decision, rejecting the application for registration in its entirety based on Article 7(1)(b) CTMR, was confirmed by the Second Board of Appeal (BoA). The applicant filed an action before the General GC (GC).

SUBSTANCE: The CTM applicant claimed infringement of Article 7(1)(b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the (BoA). The applicant maintained that the distinctive character of the sign has been proven before the BoA.

CTM



The action was dismissed in its entirety by the GC. The GC pointed out that where a sign is composed of a number of features, each one of which is devoid of distinctive character, the distinctive character of the sign as a whole depends on whether the overall impression is greater than the mere sum of its parts (para. 34). The BoA was correct in finding that the contested sign does not denote a connection with a specific undertaking since it is a mere banal combination of two non-distinctive and barely memorable or noticeable features (Para. 46). However, the GC ruled that the provision of description of the figurative mark before the GC cannot be considered a new argument. The description of such mark is not a mandatory requirement and the BoA erred when it dismissed it as inadmissible (Paras. 52 and 53). According to the judgement, there is no need for each of the

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goods and services to be assessed and they may be grouped for the purpose of the examination and general reasoning may be applied where they form a category or groups sufficiently homogenous to permit such general reasoning (Para. 60). The sign described by the applicant will not be perceived by the relevant consumer as an indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the service of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (Para. 64). The GC concluded that high degree of attentiveness with regard to some of the goods and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (Para. 72).

Case T-641/14; Alexandra Dellmeier v. OHIM; Judgment of 24 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Common element

FACTS: The applicant sought to register the sign LEXDELL as a CTM for the goods and services in Classes 16, 25, 41 and 45. The Opposition Division

upheld the opposition in respect of some of the goods and services, partly on the basis of Article 8 (5) CTMR and partly on the basis of Article 8 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the partial annulment of the decision of the BoA.

CTMA

LEXDELL

Earlier mark

DELL

SUBSTANCE: The GC finds a certain degree of visual similarity between the marks at issue, notwithstanding the fact that the mark applied for differs from the earlier mark in its first syllable, and irrespective of whether the relevant public attributes a meaning to the word “lex” (Paras. 16-17).

There is a low degree of phonetic similarity between the marks (Para. 18).

The presence of the word “LEX” within the mark applied for does not create a conceptual difference capable of counteracting the visual and phonetic similarities. Moreover, partial conceptual similarity

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results from the fact that the marks at issue have in common the word “del”, meaning “small, wooded hollow” in English (Para. 19).

The mark applied for does not reproduce the applicant’s name word for word, but only a part of that name. Therefore, this does not amount to a due cause for the use of that mark (Para. 27).

The plea alleging infringement of Article (8) (1) (b) CTMR and regarding the absence of similarity between the goods and services concerned is not sufficiently precise and intelligible, as it refers to the services for which registration was refused pursuant to Article (8) (5) CTMR (Para. 30).

The applicant’s pleas are rejected and the action dismissed.

Case T-366/14; August Storck KG v OHIM; Judgment of 25 September 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Abbreviation, Descriptive element, Distinctive element, Laudatory mark, Slogan mark, Principle of legality

FACTS: The applicant sought to register the word mark 2GOOD as a CTM for goods within Class 30. The examiner refused to register the word as a CTM on the ground that the mark would be perceived as a laudatory promotional message. The Board

of Appeal dismissed the applicant’s appeal. The applicant filed an action before the General Court.

CTMA

2GOOD

SUBSTANCE: The relevant public is deemed to be the average consumer who is reasonably well informed and reasonably observant and circumspect whose level of attention is somewhat reduced (Para. 20). It may reasonably be presumed, having regard, in particular, to the very widespread use of the language known as “SMS language” that the number 2, if it is associated with an English word, will itself generally be read in English and understood as referring to the English words “two”, “too” or “to” depending on which English word follows it or precedes it (Para. 28). The number 2, combined with the word “good”, will be easily and immediately understood by the relevant public as meaning “too” as that public will think of the meaning of the expression “too good” in relation to the goods covered (see Paras. 24-26). Combining the word “too”, symbolised by the number 2, with another word such as “good” is not unusual or even rare in current linguistic usage (Para. 27). It follows that the mark sought does not have any particular originality or salience; nor does it require a minimum interpretative effort or

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trigger any particular cognitive process on the part of the relevant public; rather, it is merely an ordinary advertising slogan making the point that the goods covered by the mark sought are excellent (too good) (Para. 30). Even if the mark sought is not regarded as an advertising slogan, it merely describes an essential feature of the goods in question: their gustatory qualities (Para. 34). The relevant public in the present case will not be confronted with a slogan which can have a number of meanings, or constitute a play on words, or be perceived as imaginative, surprising and unexpected, but simply a statement relating to an allegedly highly positive gustatory quality of the goods covered by the mark sought (Para. 35). Since the examination of the trade mark at issue in the light of Article 7 (1) (b) could not, in itself, lead to a different conclusion, the applicant's claims of a failure to take into consideration the registration of identical marks cannot succeed (Para. 41). The BoA is not bound by registrations already made in a Member State of the European Union. The same holds true for previous registrations in other English-speaking countries which are not Member States of the European Union (Para. 42).

Case T-736/14; Monster Energy Company v OHIM; Judgment of 28 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Complementary goods and services, Nature of goods and services, Purpose of the goods and services, Dissimilarity of the goods and services

FACTS: The applicant sought to register the word mark MoMo Monsters as a CTM for goods and services within Classes 14, 16, 25, 28, 30 and 41.

An opposition based on, inter alia, the earlier word mark MONSTER, registered for goods in Classes 5, 29, 30, 32, and 33, was filed on the grounds of Article 8 (1) (b) CTMR.

The Opposition Division partially upheld the opposition in so far as there would be a likelihood of confusion with respect to all the goods and services applied for except the goods in Class 30 (among others, confectionary, biscuits, cakes, pastries). It considered that the earlier goods, and in particular the goods in Class 29 (milk-based products) and Class 30 (coffee-based products) were dissimilar to the contested products.

The Board of Appeal dismissed opponent's appeal. The opponent filed an action before the General Court (GC).

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CTMA

MoMo Monsters

Earlier mark

MONSTER



sold at the same outlets such as coffee chains. The GC considered this fact not particularly significant since different kind of goods can be found in these outlets without the consumers considering that they have the same commercial origin (Para. 30).

Case T-584/14; Industria de Diseño Textil, S.A. (Inditex) v OHIM; Judgment of 9 September 2015;
Language of the case: ES

RESULT: Action dismissed

KEYWORDS: Evidence of use, Function of trade mark, Proof of use, Use by another undertaking, Used in the course of trade, Revocation grounds

FACTS: The applicant sought to register word sign ZARA represented below as a CTM for the goods and services in Classes 3, 9, 14, 16, 24, 25, 28, 37, 39, 40 and 42 and the mark was registered on 3 of January de 2001.

On 24 of October 2011 an application for revocation of the CTM for the goods and services in Classes 39 and 42 was filed.

The Cancellation Division issued a decision upholding the application for revocation which was confirmed by the Board of Appeal (BoA) regarding only the goods and services in Class 39. The applicant filed an application for annulment before the General Court (GC).

SUBSTANCE: The GC dismissed all of the opponent's arguments regarding the similarity of the goods in conflict. In particular, it considered that the goods share different nature and that this is not called into question by the possibility that milk-based or coffee-based products also contain sugar (Para. 24). Moreover, they do not serve the same purpose: confectionary, biscuits, cakes or pastries serve to satiate hunger or address a desire to eat sugary goods whilst the earlier goods serve to quench thirst or satisfy a need for calcium or caffeine (Para. 25). The GC emphasized that confectionary and milk-based and coffee-based products are not in competition as they are not interchangeable in so far they have different purposes (Para. 27). It further indicated that they are not complementary as one is not absolutely indispensable for the other. Whether they are consumed together is just optional (Para. 29). Finally, the GC dismissed the argument that similarity results from the fact that the goods are

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CTMA

ZARA

SUBSTANCE: The contested decision was upheld by the GC.

The GC confirmed the BoA's finding that there was no publicly and outwardly use of the mark for the goods and services in Class 39. The Judgement refers to the Case-Law establishing that it is not sufficient for genuine use to appear probable or credible; actual proof of that use must be given (Para. 38).

According to the GC, for the franchisee companies to be considered independent entities in general they shall not be fully integrated in the entity of the franchisor, but instead they shall be associated with it. In the current case the GC found that, although in the franchisees are independent entities, they in fact form part of the internal organization of the trade mark owner. The main characteristic of Zara's franchise model is the full integration of the franchisees with Zara's shops, as well as integrated logistics and a high degree of vertical integration (Para. 33).

The GC found that the evidence provided does not prove an external and public use of the CTM (Para. 34). In particular, it is not possible to identify the transportation costs in the invoices. Furthermore, the total cost of transport is included in the resale price.

On the basis of those considerations, the GC concluded that there was no sufficient evidence provided in order to proof genuine use of the mark for the goods and services in Class 39.

Case T-61/14; Monster Energy Company v OHIM, Judgment of 6 October 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Common element, Conceptual similarity, Distinctive element, Identity of goods and services, Likelihood of confusion, Phonetic similarity, Similarity of signs, Visual similarity, Weak element, Complex mark, Figurative element, Descriptive element, Dominant element

FACTS: The applicant sought to register the figurative mark icexpresso+energy coffee as a Community trade mark (CTM) for goods and services in Classes, 9, 30, 32 and 35. An opposition based on the earlier CTMs X-PRESSO MONSTER, HAMMER M X-PRESSO MONSTER ESPRESSO + ENERGY and MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY registered for goods in Classes 5 and 32, was filed on the grounds of Article 8 (1) (b) CTMR. With regard to the examination of the likelihood of confusion, the goods in question were presumed to be identical (not disputed). The Opposition Division rejected the opposition and the Board of Appeal (BoA) dismissed the appeal.

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CTMA



Earlier marks

1. **X-PRESSO MONSTER**
2. **HAMMER MONSTER ENERGY** **M X-PRESSO ESPRESSO +**
3. **MIDNIGHT MONSTER ENERGY** **M X-PRESSO ESPRESSO +**

SUBSTANCE: The General Court (GC) confirmed no likelihood of confusion.

The figurative element of the contested mark is constituted in a specific and original way and will attract the attention of the relevant public (Para. 38). Considering that “expresso” and “energy coffee” are descriptive of the goods and services in question, BoA rightly relied on the overall impression given by the marks (Para. 39). BoA did not err in

its assessment of the dominant and distinctive elements of the mark applied for (Para. 40).

In view of clear differences at the beginning of marks and the coincidence in elements which do not stand out, the overall similarity between the marks is low. The GC referred to the Case-Law pointing out that where some elements of a trade mark are descriptive of the goods and services in respect of which that mark is registered or the goods and services covered by the application for registration, those elements are recognised as having only a weak, or even very weak, distinctive character (Para. 76).

BoA was entitled to find that the word elements common to the signs at issue will not attract the attention of the relevant public and, therefore, to conclude that, even if the goods and services at issue are identical, there was no likelihood of confusion (Para. 78).

Case T-137/14; I Castellani Srl v OHIM, Judgment of 23 October 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Catalogue, Extent of use, Evidence of use, Functional continuity, Graphical representation, Packaging, Proof of use, Revocation grounds, Right of defence, Sales figures, Used in the course of trade, Nature of use, Database printout

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FACTS: The applicant sought to cancel the the Community trade mark (CTM) as represented below for goods in Class 19. The Cancellation Division revoked the CTM for all contested goods because the nature of the use was not proven. The appeal before the Second Board of Appeal (BoA) was dismissed, however not because the mark was not used in its registered form but because the extent of the use was not sufficiently proven.

CTMA



SUBSTANCE: The General Court (GC) dismissed both pleas on which the action was based, the alleged infringement of Article 75 CTMR and of Articles 15 (1) (a) and 51 (1) (a) CTMR.

ARTICLE 75 CTMR: The applicant's right of defence was not breached by BoA since the applicant had the opportunity to present its observations relating to all aspects of the application for revocation, including the extent of use (Para. 22). It follows from the continuity in terms of functions between the various departments of the Office that, when

BoA conducts the review of decisions taken by the departments of the Office at first instance, it must base its decision on all the matters of fact and of law which the parties concerned introduced either in the proceedings before the department which heard the application at first instance or in the appeal (Para. 23). The extent of the examination which BoA must conduct in relation to the contested decision before it is not, in principle, determined solely by the grounds relied on by the party, or parties, to the proceedings before it (Para. 24).

ARTICLE 15 (1) (a) and Article 51 (1) (a): The applicant's argument concerning the nature of use is ineffective since BoA itself found that there is no precept in the CTM system that obliges the proprietor of the CTM to prove the use of its mark on its own, independently of any other mark (Paras. 40-42). Contrary to BoA's assessment, the extracts from the website as a whole establish a connection between the website references, the invoices and the photographs of the packaging despite the fact that the contested mark did not feature on the website (Para. 47). However, having regard to the market price of the goods concerned in Class 19, the value of the marketed goods was very low (Para. 50). The additional documents, including the catalogues, do not compensate for the low sales of the goods concerned and are, therefore, not sufficient to demonstrate the genuine use of the contested mark (Paras. 53 and 54).

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Case T-642/14; JP Divver Holding Company Ltd, v OHIM, Judgment of 7 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Distinctive element, Laudatory mark, Descriptive element, Purpose of the goods and services, Quality of the goods and services, Principle of legality

FACTS: The applicant sought the registration of the international word mark EQUIPMENT FOR LIFE designating the European Community for goods and services in Classes 18, 25 and 35. The examiner's decision, rejecting the application for registration in its entirety based on Articles 7 (1) (b) and 7 (2) CTMR, was confirmed by the Second Board of Appeal (BoA). The applicant filed an action before the General Court (GC) alleging an infringement of Articles 7 (1) (c) and 7 (2) CTMR.

CTMA

EQUIPMENT FOR LIFE

SUBSTANCE: The GC confirmed the BoA's decision and dismissed the appeal. The GC pointed out that the word "equipment", irrespective of the specific intended purpose of each of the goods or services

covered by the mark applied for, is, because of its meaning, immediately perceptible by the relevant public as relating to all of the elements required for the exercise of an activity (para. 30). The GC found that the word "equipment" is also associated with clothing in Class 25 and is not limited to designating only goods with a technical background or function (Para. 32). The meaning of the word "equipment" is broader than the definition given by the applicant and that that word is often used in very varied market sectors in order to designate a group or a set of things necessary to achieve a certain aim. It should be observed, in that regard, that the Office gave examples of those sectors, including travel (travel equipment) and sport (fitness equipment, scuba diving equipment). The same is true of the goods concerned in Class 18: by way of example, the expression "travel equipment", is commonly used to describe backpacks, travel bags and luggage (Para. 33).

The GC confirmed that the expression "equipment for life" will be understood, in relation to the relevant goods, as meaning that those goods will last for the lifetime of the purchaser. Thus, that expression suggests, when applied to the goods concerned, that these are very robust, long-lasting, and that they can be made to last a long time. It will thus be perceived as an unambiguous laudatory message suggesting positive characteristics of the goods and services. Moreover, the applicant's argument that that reasoning does not make sense because the goods concerned are regularly replaced by newer, more

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fashionable items cannot be accepted. The fact that consumers may replace their clothing in order to follow fashion trends does not affect the message about the durability of the goods concerned clearly conveyed by the sign in question (Paras. 37-39).

The GC recalled the Case-Law according to which, the applicant cannot deduct any rights from prior registrations in the U.S.A, Australia and New Zealand and that earlier decisions taken by the Office allowed the registration of marks containing the elements “equipment” or “life”, as the BoA is only bound by the relevant EU rules and not by any national system and neither by prior Office practice (Paras. 40-43).

Case T-187/14; Sonova Holding AG v OHIM, Judgment of 7 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Descriptive element, Abbreviation, Quality of the goods and services

FACTS: The applicant sought the registration of the word mark FLEX for “hearing aids and hearing aids components; hearing aids accessories; parts and fittings for the aforesaid” in Class 10. The examiner’s decision, rejecting the application for registration in its entirety based on Articles 7 (1) (c) and 7 (2) CTMR, was confirmed by the Second Board of Appeal (BoA).

The applicant filed an action before the General Court (GC) alleging an infringement of Articles 7 (1) (c) and 7 (2) CTMR.

CTMA

FLEX

SUBSTANCE: The GC confirmed the BoA’s decision and dismissed the appeal. In reply to the applicant’s argument that the BoA has not shown that the term “flex” was the short form of an adjective meaning “flexible”, the GC held that the question whether the term “flex” is cited in dictionaries, as a short form or affix of the words “flexible” or “flexibility”, is not relevant since it is not usual for abbreviations to be defined in dictionaries (Para. 17). Neither is necessary for the sign to be caught by the prohibition to be used correctly as regards its grammatical form or its spelling, it is sufficient that the relevant public understand, immediately and without the need of any particular intellectual effort, the word “flex” as an abbreviation of the words “flexible” or “flexibility”, even if such usage is unusual or, grammatically or orthographically, incorrect (Para. 20). The GC found that the word “flex” must be regarded as the root or fundamental part of the word “flexible” and can also exist as a short form of the latter. As the BoA therefore rightly held, “flex” will be perceived by the relevant Anglophone public as meaning “flexible” or invoking or making reference to the concept of

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“flexibility”. The consumer, presented with hearing aids, will attribute to the word “flex” the meaning of “flexible” or “flexibility” and will understand it as a reference to the physical comfort and adjustable character, both as regards the physical shape and the volume, of those aids or of their accessories (Paras. 21-23).

In relation to the applicant’s argument that the refusal to register the mark applied for was wrongly based on evidence drawn from American rather than English sources, the GC held that, first, the BoA is not obliged to prove that the mark applied for appears in the dictionary. The finding that the consumer, faced with the goods concerned, would logically associate that word with the terms “flexible” or “flexibility” was logical, is relevant and consistent and suffices, in itself, to demonstrate the concrete possibility that the mark sought could be understood as a description of the goods that it designates. Second, as the Office correctly observes, the fact that the term “flex” is referred to as an abbreviation of the word “flexible” in an American dictionary, is further evidence that it is possible that the word may be used in that sense by an Anglophone public, including that made up of consumers from the United Kingdom, Ireland and Malta (Paras. 25-27).

The GC refused then the applicant’s complaint that the decision was in breach of the principles laid down in the guidelines relating to procedures before the Office (Part B, Section 7, paragraph 7.3.1), according to which, in order to refuse abbreviations, “it is not only necessary for the

examiner to show that the abbreviation actually is a composition of terms which on their own are purely descriptive, but in addition it must be shown that this abbreviation is commonly used or at least understood by the relevant specialists in the field, as an abbreviation identifying the goods as to their characteristics”. The GC held that according to the guidelines it is not necessary to show common use of an abbreviation, but suffices that an abbreviation be understood by a not insignificant number of persons amongst the relevant public. Moreover, the Office guidelines cannot prevail over the provisions of the Regulation and, finally, the question whether the Office guidelines refer or do not refer to relevant GC judgments is irrelevant for the outcome of the present proceedings (Paras. 31-34).

Case T-227/14; CBM Creative Brands Marken GmbH v OHIM; Judgment of 7 October 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Distinctive element, Dominant element, Visual similarity, Phonetic similarity, Conceptual similarity

FACTS: The CTM applicant sought to register the sign Trecolore as a CTM for goods and services in Classes 18, 25 and 35. The Opposition Division (OD) rejected the opposition. The First Board of Appeal

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(BoA) annulled the OD's decision in so far as it had rejected the opposition with regard to the goods in Classes 18 and 25 covered by the mark applied for, and thus upheld the opposition to that extent. The CTM applicant filed an application before the General Court (GC) for the partial annulment of the decision of the BoA and the full rejection of the opposition.

CTMA

Trecolore

Earlier marks

1. FRECCE TRICOLORI



2.

SUBSTANCE: The degree of attentiveness of consumers when purchasing goods in Classes 18 and 25 is no more than average (Para. 27-28). The fact that the word "frecce" has distinctive character in view of its meaning for the Italian public (arrows) and that the word 'tricolori' is merely an

adjective supplementing the description of the main element is not a sufficient basis for holding that the first of those terms is the dominant element of the earlier trade mark and that the second is negligible (Para. 36).

There is a certain degree of visual similarity between the signs in question, since the single word which constitutes the mark applied for comprises seven of the nine letters of the second word of that earlier trade mark, including, in particular, the first two letters. Furthermore, there is a significant similarity between the terms "trecolore" and "tricolori" which is not undermined by the visual difference between the vowels (Paras. 41-42).

Concerning phonetic similarities, the absence of the word "frecce" in the mark applied for has no impact on the assessment of the degree of phonetic similarity, given the similarity between the phonetic impression resulting from the pronunciation of the mark applied for and that resulting from the pronunciation of the second element of the earlier trade mark. Therefore, there is an average level of phonetic similarity between the signs in question (Paras. 46-47).

According to the applicant, the expression "frecce tricolori" refers to the acrobatic demonstration team of the Italian Air Force and, accordingly, the earlier trade mark will certainly be associated — at least by the Italian public — with that group. Such a finding permits the assumption that — at least for that public — the earlier trade mark will be associated with the Italian flag which is also (in a stylised form)

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an element thereof. As regards the mark applied for Trecolore the applicant does not challenge the Board of Appeal's assessment that the Italian public may perceive that mark as the result of a misspelling of the Italian expression "tre colori" and thus as indirectly referring to a flag, more specifically that of Italy. Therefore there is a conceptual similarity between the signs in question (Paras. 51-52).

The BoA was right to conclude that there was a likelihood of confusion between the marks at issue and, accordingly, the action must be dismissed in its entirety as unfounded (Paras. 60-61).

Case T-228/14 CBM Creative Brands Marken GmbH v. OHIM; Judgment of 7 October 2015; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Distinctive element, Dominant element, Visual similarity, Phonetic similarity, Conceptual similarity, Figurative trade mark

FACTS: The CTM applicant sought to register the sign figurative trade mark below as a CTM for goods and services in Classes 18, 25 and 35.

The Opposition Division (OD) upheld the opposition in part for the goods in Classes 18 and 25 and for certain services in Class 35. The First Board of Appeal (BoA) dismissed the appeal.

The CTM applicant filed an application before the General Court (GC) for the partial annulment of the decision of the BoA and the full rejection of the opposition.

CTMA



Earlier marks

1. FRECCIE TRICOLORI



2.

SUBSTANCE: The degree of attentiveness of consumers when purchasing goods in Classes 18 and 25 is no more than average (Paras. 28-29).

The BoA erred in its assessment of the similarity

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between the goods and services by holding that the services in Class 35 covered by the mark applied for were similar to a low degree to the goods in Classes 9, 14, 18 and 25 covered by the earlier trade mark, when they are in fact similar (Para. 34).

As the applicant has not shown that the word elements of the earlier figurative trade mark would be read as forming a single expression or that that expression would be likely to dominate the overall impression conveyed to the relevant public by that mark, it does not appear to be possible to apply, the Case-Law according to which the element situated at the beginning of a sign will be immediately perceived and thus more likely to attract the consumer's attention (Paras. 38-39).

There is a certain degree of visual similarity between the signs in question, since the single word element which the mark applied for contains comprises seven of the nine letters of the second word of that earlier trade mark, including, in particular, the first two letters. Furthermore, there is a significant similarity between the terms "trecolore" and "tricolori" which is not undermined by the visual difference between the vowels (Para. 46). Moreover, notwithstanding the differences between the three stylised shapes appearing in the mark applied for and those present in the earlier trade mark, the impression which emerges therefrom is one of similarity, since they are all three-pronged shapes laid out in the same precise sequence of colours against a dark background (Para. 48).

Concerning phonetic similarities, the absence of

the word "frecce" in the mark applied for has no impact on the assessment of the degree of phonetic similarity, given the similarity between the phonetic impression resulting from the pronunciation of the mark applied for and that resulting from the pronunciation of the second element of the earlier trade mark. Therefore, there is an average level of phonetic similarity between the signs in question (Paras. 54-55).

The three stylised geometric shapes included in the earlier trade mark are green, white and red in colour, appearing in that order, and the word element "tricolori", a reference to the Italian expression "il tricolore" designating the Italian flag, also appears in the earlier figurative mark. The fact that the mark applied for does not refer to the acrobatic demonstration team of the Italian Air Force named "Frecce Tricolori" has no effect, since the contested decision bases the conceptual similarity of the signs in question, on the reference to the Italian flag and, more broadly, Italy. Hence there is a conceptual similarity between the signs in question (Paras. 58-64).

The BoA was right to conclude that there was a likelihood of confusion between the marks at issue and, accordingly, the action must be dismissed in its entirety as unfounded (Paras. 68-69).

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Case T-365/14 CBM Creative Brands Marken GmbH v. OHIM; Judgment of 7 October 2015; language of the case: EN

RESULT: Action dismissed

KEYWORDS: Likelihood of confusion, Distinctive element, Dominant element, Visual similarity, Phonetic similarity, Conceptual similarity, Figurative trade mark

FACTS: The CTM applicant sought to register the sign figurative trade mark below as a CTM for goods and services in Classes 18, 25 and 35.

The Opposition Division (OD) rejected the opposition. The First Board of Appeal (BoA) annulled the Opposition Division's decision in so far as it had rejected the opposition with regard to the goods in Classes 18 and 25 covered by the mark applied for, and thus upheld the opposition to that extent.

The CTM applicant filed an application before the General Court (GC) for the partial annulment of the decision of the BoA and the full rejection of the opposition.

SUBSTANCE: The degree of attentiveness of consumers when purchasing goods in Classes 18 and 25 is no more than average (Para. 28-29).

The BoA erred in its assessment of the similarity between the goods and services by holding that the services in Class 35 covered by the mark applied for were similar to a low degree to the goods in Classes

CTMA



Earlier marks

1. FRECCIE TRICOLORI



2.

9, 14, 18 and 25 covered by the earlier trade mark, when they are in fact similar (Para. 34).

As the applicant has not shown that the word elements of the earlier figurative trade mark would be read as forming a single expression or that that expression would be likely to dominate the overall impression conveyed to the relevant public by that mark, it does not appear to be possible to apply, the

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Case-Law according to which the element situated at the beginning of a sign will be immediately perceived and thus more likely to attract the consumer's attention (Paras. 39-40).

There is a certain degree of visual similarity between the signs in question, since the single word element which the mark applied for contains comprises seven of the nine letters of the second word of that earlier trade mark, including, in particular, the first two letters. Furthermore, there is a significant similarity between the terms "trecolore" and "tricolori" which is not undermined by the visual difference between the vowels (para. 48). However, the BoA should have taken into account not only the near-total identity of the second word element of the earlier trade mark and the single word element of the mark applied for, the absence in the mark applied for of the representation of a bow and arrow and the first word element of the earlier trade mark, and the presence in the signs in question of three similar geometric shapes, but also the differences between the backgrounds of the signs in question in terms of their colour. There is, at best, a certain degree of visual similarity between the signs in question (Para. 52).

Despite the absence of the word "frecce" in the mark applied for, the signs in question produce a similar phonetic impression, having regard to the near-identical pronunciation of the mark applied for and the second word element of the earlier trade mark (Para. 59).

The three stylised geometric shapes included in the

earlier trade mark are green, white and red in colour, appearing in that order, and the word element "tricolori", a reference to the Italian expression "il tricolore" designating the Italian flag, also appears in the earlier figurative mark. The fact that the mark applied for does not refer to the acrobatic demonstration team of the Italian Air Force named "Frecce Tricolori" has no effect, since the contested decision bases the conceptual similarity of the signs in question, on the reference to the Italian flag and, more broadly, Italy. Hence there is a conceptual similarity between the signs in question (Paras. 63-69).

The BoA was right to conclude that there was a likelihood of confusion between the marks at issue and, accordingly, the action must be dismissed in its entirety as unfounded (Paras. 75-76).

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Please note that the full number including slash has to be entered in our database under 'Appeal N°', without the letter 'R'. e.g. Case R 219/2004-1 has to be entered under 'Appeal N°' as: 0219/2004-1

Decision of 8 September 2015 – R 223/2014-2 – OMTV OPEN MARKET: TELEVISION (FIG.) / MTV ET AL.; Language of the case: EN

RESULT: Decision annulled.

FACTS: The applicant sought to register the figurative mark represented below for services in Classes 35, 38 and 41. The opponent filed an opposition against the mark and raised doubts about the applicant's existence. The Opposition Division rejected the opposition, accepted the contested trade mark in its entirety. The opponent appealed the contested decision.

SUBSTANCE: The Board sent a letter to the applicant stating that taking into account the evidence submitted by the opponent of the German company name register, the Board had serious doubts as to

the existence of the company 'open market TV AG' as the applicant of the CTM application.

CTMA



In particular, these serious doubts were further strengthened after a telephone conversation with an employee at the 'Trade Register' in Offenbach am Main, who confirmed that the applicant had never been registered in the Register. The applicant did not submit any comments within the set time-limit. In assessing the applicant's silence within the context of the facts on file, the Board considered that the circumstances of the case at hand justified the same result as in R 575/2010-4. On the basis of the evidence on file, the Board considered that the applicant no longer existed. Given that the applicant no longer existed and no successor-in-title had claimed any rights to the application since then, the application for the CTM had to be deemed to have ceased to exist or to have been abandoned. Therefore, all proceedings related to that application had to be discontinued. Since no object for an opposition existed under Article 8 CTMR, the contested decision had to be annulled.

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Decision of 20 October 2015 – R 1073/2015-2 – SEE THE UNSEEN; Language of the case: EN

RESULT: Decision annulled.

KEYWORDS: *Slogan mark, Descriptive element, Distinctive element, Minimum degree of distinctiveness, Nature of the goods and services, Purpose of the goods and services.*

FACTS: The applicant sought to register international registration 'SEE THE UNSEEN' within the European Union for various goods and services in Classes 9 and 35. The examiner rejected, under Article 7(1)(b) and 7(1)(c) CTMR, the mark in the field of, inter alia, infrared detectors, knowing that the Office had previously registered the identical mark (CTM No 3 254 349), for, inter alia, 'infra-red thermal imaging systems' in Class 9. The IR holder filed a notice of appeal.

SUBSTANCE: In the Board's view, the existence of the prior identical registration, even though it had since lapsed, should have been afforded more weight in the examiner's deliberations. With regard to the objection under Article 7(1)(b) CTMR, the mark could not be labelled 'laudatory' or 'promotional', since it did not praise or extol the goods or the good value or quality of the services. With regard to the objection under Article 7(1)(c) CTMR, the Board found that the mark did not describe any characteristics or purpose of the goods or services, since one could

not, by definition, 'see' what is 'unseen'. The goods in question measured standard physical quantities such as 'force', 'pressure', 'temperature' or 'infra-red radiation'. None of these quantities are visible to the human eye and none could be made directly visible by the goods. Nor would the specialist consumer refer to these quantities as 'unseen'. Therefore, the mark did not describe, in a direct and straightforward way, the characteristics or intended purpose of the goods. Overall, the mark possessed a certain poetic quality, given the paradox and alliteration of 'seen/unseen', and the fact that it was a play on words. Therefore, the Board found it ultimately distinctive and capable of acting as a badge of origin. The appeal was upheld.

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Decision of 23 October 2015 – R 3079/2014-5 – Arsenal VICTORIA CONCORDIA CRESCIT (fig.); Language of the case: EN

RESULT: Decision confirmed.

KEYWORDS: *Complex mark, Descriptive element, Distinctive element, Evidence of use, Figurative trade mark, Function of trade mark, Nature of the goods and services, Purpose of the goods and services, Quality of the goods and services.*

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FACTS: A figurative mark, as represented below, was registered for goods and services in Classes 3, 9, 14, 16, 18, 24, 25, 28, 41 and 42. The cancellation applicant filed an application for a declaration of invalidity of the contested CTM for all goods specified with the registration, on the basis that the mark had been registered contrary to Article 52(1) (a) in conjunction with Article 7(1)(c) CTMR in that the contested CTM designated a quality in the goods and services at issue. The Cancellation Division took a decision rejecting the application in total. The CTM proprietor filed an appeal.

significant level of maturity. The contested mark was therefore not just a badge of allegiance but was

wrapped up in the CTM proprietor's brand. Article 7(1)(c) CTMR did not apply because the sign was not immediately descriptive. In relation to Article 7(1)(b) CTMR, the Board noted that no amount of evidence as regards the contested mark (sales, etc.) would show that it had ceased to become a badge of allegiance.

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CTMA



SUBSTANCE: The Board found that the reality of the marketplace at the time of application of the contested sign was such that the evolution of football club names as monopolised signs, merchandised and exploited by their owners, had reached a very

Decision of 23 October 2015 – R 1947/2014-1 – DEVICE OF A VERTICAL PATTERN OF WAVES (fig.) / DEVICE OF A HORIZONTAL PATTERN OF WAVES (fig.); Language of the case: EN

RESULT: Decision confirmed.

KEYWORDS: *Figurative trade mark, Substantiation of earlier right, International registration, Database printout.*

FACTS: The applicant sought to register the figurative mark represented below for goods in Classes 14, 18 and 25. The opponent filed an opposition against all the goods of the application on the basis of its international registration, as represented below, designating the European Union for goods in Classes 9, 14, 18, 25, 26 and 28.

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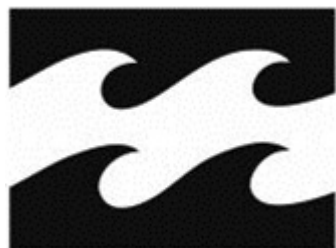


The grounds of the opposition were those laid down in Article 8(1)(b) and 8(5) CTMR. The Opposition Division rejected the opposition in its entirety due to the lack of substantiation. The opponent filed a notice of appeal.

CTMA



Earlier CTM



SUBSTANCE: The Board found that the earlier right was an international registration designating the EU, which the opponent considered unnecessary to substantiate alleging that such an IR had to be assimilated into a Community registration within the meaning of Rule 19(2)(a) CTMIR. However, pursuant to Rule 19(2) CTMIR, the requirement to substantiate applied to any earlier right 'which is not

a Community trade mark'. As in the present case the earlier mark was an IR designating the European Union and not a CTM, the opponent was required to substantiate its earlier right and to submit a copy of the international registration certificate or an 'equivalent document emanating from the administration by which the trade mark was registered' - this administration being, in the present case, WIPO. This finding was also in accordance with case T-240/13. The Board did not accept the belated substantiation documents sent by the opponent at the appeal stage, since the wording of the law was clear about how to substantiate the earlier right (Rule 19 CTMIR). A lack of awareness or misinterpretation of the law could not be criteria for exercising discretionary power within the meaning of Article 76(2) CTMR.

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Decision of 16 November 2015 – R 1649/2011-G – SHAPE OF A BOTTLE (3D); Language of the case: EN

RESULT: Appeal inadmissible.

KEYWORDS: *Admissibility, Competence of the Boards, Identity of the signs, Identity of the goods and services, Legal certainty, Res iudicata, Three dimensional mark.*

FACTS: The applicant sought to register the three-dimensional mark, as represented below, for 'goods in Classes 32 and 33'. The same mark protecting the same goods was filed and registered as Community trade mark No 3 156 163 ('the earlier CTM') in the applicant's name on 3 December 2004. An application for invalidity lodged against this CTM and an appeal in the cancellation proceedings in question were pending before the Boards (case R 785/2010-1) when the mark applied for was filed. The First Board of Appeal invalidated the applicant's earlier CTM because of its lack of distinctiveness.

In the present case the examiner rejected the mark applied for pursuant to Article 7(1)(b) CTMR ('the contested decision'). The examiner referred to the reasoning made by the First Board in its decision in which it declared the applicant's earlier CTM invalid. The applicant appealed the contested decision. The

First Board of Appeal referred the case to the Grand Board, in accordance with Article 1(b)(1) RoP-BoA.

The appeal proceedings were suspended pending the outcome of the applicant's appeal (T-178/11, C-445/13 P), against the First Board's decision in case R 785/2010-1 declaring the earlier CTM invalid. The General Court dismissed the applicant's action for annulment of the Board's decision, and the Court of Justice dismissed the applicant's appeal against the General Court's judgment as unfounded.

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Earlier CTM



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SUBSTANCE: The Grand Board found that a decision that was purely confirmatory of an earlier decision was not a measure open to legal challenge, since such a decision did not give those concerned the opportunity of reopening the question as regards the legality of the measure which was confirmed. An applicant, who re-files an application for the same trade mark has the onus of establishing why a re-examination is justified by new factors and new circumstances.

Where, an applicant files an application for the same trade mark and the same goods or services, and the Office replies when examining the second application that invokes arguments already put forward by the applicant in the case of the earlier CTM, that circumstance does not in itself demonstrate that the second application has been the subject of a fresh examination by the Office. To hold otherwise would amount to accepting that an applicant might reopen the appeal and Court proceedings against a definitive decision of the Office.

If the Grand Board were to hold that an appeal against a confirmatory act, taken by the Office was admissible despite the fact that the appeal and the annulment action against the original act had been dismissed, this would make it possible to circumvent the irrevocable character of a Board decision confirmed by a definitive judgment of the General Court and the Court of Justice. An applicant would

then be able to reactivate the possibility of bringing appeal and Court proceedings by provoking the adoption of a confirmatory act, thereby jeopardizing legal certainty.

In the present case, the applicant has filed a re-application of the same trade mark for the same goods. The contested decision amply refers to and relies fully on the reasoning of the Board in case R 785/2010-1 based on the lack of distinctiveness of the applicant's earlier mark which is identical to the mark applied for. No new relevant facts had been put forward by the applicant that could have altered the assessment in the first decision. There are no new issues introduced in the present case and it has not been claimed that the mark applied for has become distinctive in relation to the goods applied for in consequence of the use that has been made of it. There is identity of the parties, purpose and the submissions in the present case and the one settled by the final judgment of the General Court in Case T-178/11. The contested decision amounts to a mere confirmatory decision. Consequently, the appeal is inadmissible.

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