

# Alicante News

Up to date information on IP and OHIM-related matters

Quick Links 

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



September 2015

The new  
**online form  
for designs**



Tobias Cohen Jehoram talks to James Nurton

## First Page

### New online design application form

On September 28 OHIM released an improved version of the online design application form. The new form is aligned with the structure and features of the current trade mark application process.

The new design application form allows applicants to use a 3D image upload function to present a design from different camera angles. Applicants can move their 3D images, zoom in and out and take snapshots of different views. By enabling the possibility of adding three additional, non-protected views of the design in question, the new online application will help to create a more complete snapshot that can be used to claim priority in other countries.

Once registered, the 3D image of your design will be visible on OHIM's search engine, eSearch plus, which provides comprehensive information about trade marks, designs, owners, representatives and bulletins enhancing quick and efficient searches within OHIM databases.



The drag and drop feature in the new tool enables users to upload one or more images into any given application, by selecting the required image with a pointer and dragging it into the image box on the screen.

The form has been structured for Fast Track applications. This means it guides applicants every step of the way, with autocomplete options and a fee calculator. It is also linked to DesignView to enable applicants to search the registries of 35 IP offices around the world.

By enabling the possibility of adding three additional, non-protected views of your design, the new online application will help to create a more complete snapshot that can be used to claim priority in other countries.

For all information on how to submit an application successfully, please [read OHIM's help files](#).

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## The James Nurton Interview



### Tobias Cohen Jehoram, De Brauw Blackstone Westbroek, Amsterdam

#### What is your background?

I tried to fight off my interest in IP for a long time. My father was a professor of IP law and I was determined not to follow him so I started by studying archaeology. But then I turned into history and law, and law got the upper hand quite quickly. Within that field I was interested in civil law generally. Eventually two dear friends said to me: "If you know so much about it, and enjoy it, why not just do IP?"



Tobias Cohen Jehoram

My father specialised in copyright and there was a lot changing in the Dutch media landscape during my childhood so that was an interesting time. I didn't want to take any courses with him but fortunately one of his former students became a professor at Leiden University and I took a course with him.

#### And you have combined legal practice with teaching since then?

I suppressed my academic interest when I came into contact with the law practice in 1991 when I did an internship at De Brauw Blackstone Westbroek. I loved the practice and the people I worked with and I applied for a job with the firm, where I have stayed ever since. But at the back of my mind I still retained the academic interest. There was a Dutch treatise written by one of the firm's founders and I was asked to update the trade mark part and that ended up extending into a PhD thesis, and on the basis of that I became a part-time professor.

I love that I can combine both the practical and the more theoretical angles on IP. I also like to keep in touch with the younger generation through my teaching. I sometimes say that I work five days as a lawyer and one as a professor, with one left for my family!

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## The James Nurton Interview



### What are your main areas of practice?

Trade marks and copyright are about 75% of my practice. The rest is more focused on know-how protection in the broad sense, including trade secrets and database protection. I work in a full-service firm and we are the largest litigation firm in the Netherlands so over 85% of my work is contentious or litigation-related. We also advise on regulatory issues, M&A work and so on.

### What trends have you seen in enforcement and in the courts?

Cases are getting more complex, and the law is also becoming more and more complex unfortunately. The last edition of my book was in May 2009 and now I have to completely re-do it and it will be a lot of work!

The internationalisation of IP is definitely relevant and one of the more practical focuses of my practice today is litigation strategies. Most of our clients are part of international businesses so there are options and you have to make the right business decisions based on the information you have, and your knowledge of both substantive and procedural law.

For example, my firm did an enormous project on behalf of Douwe Egberts, which broke the monopoly of Nestlé on the Nespresso cups. It was an unfair competition and patent case. We guided this project from beginning to end: it was interesting

in that we launched the litigation in France, primarily on the basis of legal concerns, not commercial ones. Handling cases such as that is like playing games of chess. That kind of thing is now my daily practice. In fact, I've just had a conference call on exactly this kind of issue.

### Why has the Netherlands been a popular jurisdiction for IP cases?

Our Dutch courts have been extremely liberal in granting cross-border injunctions in patent cases but also in trade mark and copyright cases. For example, I handled a design case between a Danish and German company and we ended up litigating in the Benelux, leading to a decision for the whole of Europe.

### What notable recent cases have you been involved in?

Part of my practice is Supreme Court litigation and a few years ago I did a case with Charles Gielen defending Lancôme against Kecofa, who make smellalikes. We litigated that on the copyright protection of smells. Later on we had the CJEU Bellure decision on referential use of trade marks in such cases, which was very helpful, but the Lancôme case focused just on copyright.

The latest case on this issue that I am involved in is between Levola and Royal Smilde and concerns the copyright protection of tastes. I was arguing against

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal





## The James Nurton Interview



protection and we won at first instance in June but without the court ruling on whether tastes can in principle be protected. I'm sure there will be further litigation on this question.

When it comes to trade marks, I'm quite confident that under the new Regulation taste will be protectable as a trade mark but there should be means to reproduce taste in a sufficiently precise manner for people who check the register to know what the scope of the monopoly is. That's where there's a technical hiccup. Until such time as we are licking our computer screens, it may prove difficult to have taste marks registered in practice. We used to have the graphical representation requirement, which will now go, but it will still be difficult to get tastes protected.

I don't mind expanding the scope of trade marks as long as they fulfil the function of a trade mark. I handled the Für Elise case at the Court of Justice, which was a fabricated test case concerning the protection of sounds. As long as there is a trade mark function, why not expand?

Equally, for patents, I would say you should be able to get a patent if it is inventive and merits protection. I am more of the liberal school than some people.

Unfortunately, the CJEU is going in a different direction. You saw what they did with the Stokke v Hauck case concerning the shape mark exclusions,

though we might still win that in the national court. The CJEU is reining in and they have a very strong sense of freedom of competition.

### What do you think of the CJEU case law?

It's very unfortunate there are no IP lawyers in the Court so they have little regard for the structure of the legislation, which has been thought through quite well. The function theory is something they have thought up, and they can do anything they like with that, and I think they are overstepping their competence there.

### Will the changes to the Directive and Regulation make things better or worse?

Hopefully better, as some of the case law has been incorporated into the system. The thoroughly reviewed new rules should be an indication to the CJEU that they should not mess around any further. Hopefully they will take note. The changes are the result of a lot of work and thought, including the research by Max Planck. I don't agree with all of it, but overall I think it is balanced and fair.

In the Benelux we will have to adopt administrative procedures, and include bad faith as a relative ground of refusal. There are some reservations because it's sometimes complicated and subtle especially with bad faith trade mark applications, especially if we get unclear guidance from the Court of Justice. If you put issues like this into the hands

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## The James Nurton Interview



of national courts, you risk inconsistency. My clients' main concern is to have consistency. That is an even bigger problem than getting unfavourable decisions because you can't predict the outcome.

### Next year will be 20 years of the CTM. How do you think it is doing?

I think OHIM has done a great job, and should be given credit. They have put a very good system in place, after the initial problems resulting from the scale of applications. They have a large surplus, but overall are spending it wisely with harmonisation projects and improving consistency with national offices. Generally speaking the quality of the Boards is really good.

The problem with these huge organisations is you can get caught up in red tape. We've seen that a bit in complicating procedures: it's becoming a specialism to "litigate" at OHIM as they have their own procedural rules and policies which are ever changing, and you have to keep track of them.

### What will be the challenges for trade mark practitioners in the future?

IT will play a much bigger role: that is developing as we speak. As practitioners we have to show we can add value. Just finding a trade mark and opposing it is insufficient. It gives us more room to work in a more strategic field, including enforcement and brand protection. There is still a lot to be gained there.

### Wearing your teaching hat, what issues are students interested in?

They have quite a good feel for trade marks. Copyright is more of a challenge!

It's interesting as I teach a general IP course and a trade marks course for those that score higher. They're interested in what decides these cases and where a practising lawyer can make a difference: the outcome can differ significantly depending on who is arguing it.

I use examples and cases that they don't know about yet. You confront them with the dilemma in that case and see them struggle, and realise it is not as easy as they first thought. Sometimes I adopt an extreme position to make them think, and see if they will follow me! I want to open their eyes to the nuances.

Many of my students are from abroad, including the newer EU member states, and some of them are now in senior positions in the IP field. It's nice to meet them now!

### Are there any other interesting cases pending?

There are some interesting cases on copyright, including one referred to the CJEU on linking – the Playboy case – about a blog where they put a link to pictures that were leaked, having been sent it by an anonymous individual. This follows on

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## The James Nurton Interview



from the Svensson and Bestwater cases, which also addressed linking, but left some important questions unanswered.

Generally speaking, there is a lot happening in copyright and we are all adjusting to the online environment, which creates jurisdiction in so many countries at the same time. It provides so many options in enforcement, as there are still national traditions and cultures.

### Do you think copyright reform is needed?

There is no doubt copyright needs to be harmonised in the EU. It's only been partially harmonised. I did a case for a museum that exhibited letters by an actor, and a foundation inherited the copyright of the sender of the letter. It's not an online communication to the public so that is not harmonised.

We also lack harmonisation on the limitations of copyright. But it is extremely difficult, because there are many interest groups, so it will be much harder than updating the trade mark law. Even the Copyright Directive, which was drafted relatively recently with the internet in mind, needs revision.

## First Page

- New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015
- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

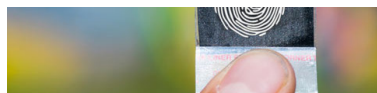
## Community Trade Mark

### Data carriers and recorded content

In the framework of the comparison of goods and services, KC G&S Issues has analysed whether 'magnetic data carriers, recording discs' in particular, and 'data carriers' in general, should be considered to contain data and, as such, whether they should be found to be similar to the recorded content they could contain.

In its deliberations, the KC G&S Issues defined:

- **'Magnetic data carriers, recording discs'** as carriers that use magnetic technology to operate, e.g. floppy discs, magnetic tapes, hard drives, etc. It follows, that not all data carriers are covered by this general indication, in particular many of the more popular data carriers, such as CDs, solid-state memory devices, USB sticks, do not use magnetic technology and are, therefore, not covered by this general indication;
- **'Data carrier'** as all kinds of memory devices, whether removable, detachable or transportable. In particular, the term can cover diskettes as well as hard drives, which can be computer consumables, computer peripherals or parts of computers.



No clear trend has been identified in case-law, with both first and second instances considering 'magnetic data carriers' in some cases to be blank or to contain content or to cover both possibilities.

However, having reviewed the relevant practice and authorities, KC G&S Issues considered that, from a classification perspective 'magnetic data carriers' must be considered to be blank media.

Factors that supported this interpretation include:

- Although the Nice Classification does not state explicitly that 'magnetic data carriers' should be interpreted as being blank, it does include the following in the explanatory note: *This Class includes, in particular: all computer programs and software regardless of recording media or means of dissemination, that is, software recorded on magnetic media or downloaded from a remote computer network.* This effectively distinguishes between 'content' and 'blank' media and in the case of content emphasises the lesser relevance of the media or means of dissemination by using 'regardless'.
- This comports with the reality of the marketplace where blank recording media and media that contain recorded data are very distinct products. The difference between the market for blank recordable CDs and that for CDs pre-recorded with music is vast. In the

## First Page

- New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015
- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

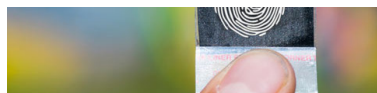
## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal





## Community Trade Mark



latter the subject matter recorded on the CD determines the fundamental characteristic of the product. The consumer is, in essence, purchasing the recorded data. Consumers looking for a CD of their favourite band would not buy a blank CD instead or another music CD. The recorded data characterises the product and the maker of the medium (CD) is irrelevant. It would be wrong to ignore this and to have a situation where a term covers both blank and recorded media; the difference between the two is too significant.

- Taxonomy makes a clear distinction between such group titles as **'recorded content'** (e.g. pre-recorded discs, recorded tapes, recorded data [magnetic], etc.) and **'data storage devices'** (e.g. data storage discs, data storage media, blank tapes for computer data, etc.). This allows the conclusion that 'data storage devices' (without the specification that they are recorded) refer to blank media only.
- Within [TMclass](#), goods and services are grouped according to shared characteristics from a market perspective, starting from the more general and ending with the more specific. Therefore, the fact that a distinction has been made between 'recorded content' and 'data storage devices' (which cover 'magnetic data carriers'), supports this position.

- The use of a semi-colon to separate 'magnetic data carriers, recording discs' from the remaining goods in the class heading of Class 9 of the Nice Classification suggests that this pair of goods form an expression or a pair sharing the same characteristics. Since the term 'recording discs', according to its natural and usual meaning, clearly refers to blank discs, 'magnetic data carriers' should be interpreted as having the same characteristics.

By analogy, the same applies to any other data carriers listed as general indications in the class heading of Class 9: 'Compact discs, DVDs and other digital recording media'. These have to be considered as blank, unless specified as recorded.

Applicant's seeking to protect their trade mark for the recorded content should indicate the nature of the goods they are seeking to protect, rather than their carriers, using indications such as 'audio books', 'music recordings', 'video films', etc., either alone or together with an indication of the data carrier, such as 'pre-recorded DVDs featuring music', 'CD-ROMs containing electronic telephone directories'.

Therefore, for the purposes of the comparison of goods and services, if magnetic data carriers and data carriers have to be considered to be blank, they cannot be found to be similar to the recorded content they could contain. There is no similarity between blank data carriers (of any kind) and other

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

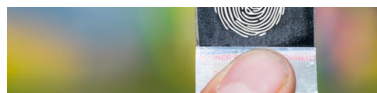
- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Community Trade Mark



goods merely on the basis that the latter goods can be stored or saved onto data carriers, as the latter are merely ancillary goods in this situation (see [Guidelines](#)).

In particular, as regards goods in Class 16, these are printed on paper (printed matter, teaching materials, printed publications, magazines). They do not include electronic publications/books. No relevant Canon criteria apply to printed matter and blank data carriers. Consequently, 'magnetic data carriers' and goods in Class 16, should be dissimilar.

Likewise all kinds of recorded content such as audio visual recordings, digital music, electronic books or audio books in Class 9 must also be found to be dissimilar to 'magnetic data carriers'.

However, an exception can be made for 'software'. There is a close correlation between software and the recording device and very often recording devices, such as pen drives, come with their own integrated software. The reality in the market is that consumers are likely to believe that these goods could coincide in origin or producer. For that reason, and exceptionally in relation to recorded content, 'magnetic data carriers' are considered to be similar to a low degree to 'software'.

The [Similarity Tool](#) has been updated to reflect this.

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Registered Community Design



### 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

In May, the General Court gave its judgment in the above case. It ruled on an appeal against OHIM's Third Board of Appeal decision R 2004/2010-3 on invalidity proceedings ICD 7024 for registered Community design No 000107834-0025 (the RCD).

The RCD, filed in 2003, published in 2004 and renewed in 2009 and 2014, was registered in respect of a 'shower drain' (see its representations below). In 2010 it was challenged in invalidity proceedings brought on the grounds of Article 25(1)(b) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR) for non-compliance with the requirements of novelty and individual character. The invalidity applicant relied on a prior design disclosed by its publication in a catalogue (see image below).

The invalidity applicant essentially claimed that the RCD was embodied in a component part of a complex product, of which visibility in 'normal use' was limited to the top of a non-perforated cover plate and to this extent it was not new and did not have individual character pursuant to Article 4(1) and (2) CDR with respect to the prior design, namely the non-perforated grating shown in the centre of the image submitted in the evidence.

The RCD holder contested that the RCD itself was a complex product within the meaning of Article 3(c) CDR, consisting of several parts but it did not qualify in itself as a component part of another product. Therefore, it should have been assessed as registered, and if so it was new and had individual character with respect to the prior design. With reference to recital 14 of the preamble of the CDR, the holder further submitted that the prior design could not be invoked as an obstacle to the novelty and individual character of the RCD, because it concerned a product of a different nature used in a different industrial sector. The RCD was incorporated in a shower drain consisting of an elongated cover plate with two parallel slots on each long side through which the water flows into a water collector and a siphon mounted on the reverse side, and the product was intended to be used in household or sanitary facility showers, whereas the prior design related to a grating for gutters that had to be inserted in the floor; the drainage slots were built in the floor and the prior design was pertinent to the meat processing and other industrial sectors, but not the housing or sanitary sectors.

The Invalidity Division upheld the application for a declaration of invalidity, finding that the RCD was a component part of a complex product within the meaning of Article 4(2) CDR; in normal use the shower drain was integrated in the floor, whereby the water collector and the siphon were not visible, and the only discernible part — the top plate — was

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Registered Community Design



identical to the prior design. The RCD was declared invalid due to lack of novelty. The holder's argument as to the use of the prior design in a different environment was rejected as irrelevant because the use of the product was not a visual feature and therefore this did not have any impact on the design assessment.

The RCD holder appealed the decision unsuccessfully. In its decision, the Third Board of Appeal stated that the assessment of novelty and individual character of the RCD should be limited only to features visible during normal use, namely the rectangular cover plate, its edges and parallel slots, and it concentrated on resolving the issue relating to whether differences from the prior design of a 'shower drain' found within these features should be considered as immaterial. In the Board of Appeal's opinion, the compared designs were not identical within the meaning of Article 4 CDR. It annulled the contested decision and remitted the case to the Invalidity Division to undertake a comparison of both designs on the requirement of individual character.

The invalidity applicant lodged an appeal with the General Court, requesting that the contested decision be annulled and the decision of the Invalidity Division confirmed. The RCD holder requested an annulment of the decision based on the reasons submitted before the first instance. The General Court allowed both claims and annulled the

contested decision.

According to the Court, with respect to the RCD holder's claim, the Board of Appeal erred when it referred to the prior design as a 'shower drain', when it concerned, as correctly noted by the RCD holder, a grating. The Board of Appeal rejected the RCD holder's arguments that the prior design did not constitute an obstacle to the novelty and individual character of the RCD because it pertained to a different product and a different sector. In this sense the contested decision was detrimental to the RCD holder.

With respect to the invalidity applicant's claim, the Court held that the Board of Appeal erred in its identification of the prior design. The Court agreed with the Board of Appeal that the RCD consisted of the cover plate, collector and siphon and that during its normal use only the features of the solid top of the cover plate, slots on the sides and edges were visible. The Board of Appeal, however, made the comparison and reassessment of the RCD with only a part of the prior design, namely the grating visible in the centre of the image submitted in the evidence, despite the fact that the invalidity applicant claimed (and the catalogue submitted demonstrated) that the prior design concerned a drainage system, of which the grating formed a part. In other words, the whole contested design was compared with only a single element of the prior design. The Court rejected OHIM's objection that there was no drainage

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal





## Registered Community Design



system with side slots and a solid elongated grating depicted as such in the evidence. According to the Court, it was sufficient that all the parts of which the prior design was composed were disclosed and that it was clearly indicated in the evidence that those parts were intended to be connected to form the complex product. This sufficed to allow the shape and other features of the prior design to be determined.

The Court thus held that novelty should be denied to designs that should subsist only in a combination of designs, which would be disclosed together and it would be clear that they were to be used together.

The Board of Appeal was to assess differences between the RCD and the whole prior design but not limit its assessment solely to the grating forming only a part of the drainage system. Stating this and identifying the prior design, the Court further expressed its opinion on the RCD holder's argument that the prior design did not constitute an obstacle to the novelty and individual character of the RCD because it concerned a different product used in a different industrial sector.

The Court accepted the RCD holder's argument, which was that the drainage system according to the prior design was intended for industrial use but not in showers in the housing or sanitary sectors. As for the question whether the nature of a product may determine assessment of novelty and

individual character, with reference to Article 3 CDR defining the design as the appearance of a product, Article 19 CDR concerning the rights conferred on the holder by a Community design registration, Article 10 CDR determining the scope of protection, and Article 36(2) and (6) CDR about the obligation to indicate in the application for registration the product in which the design is intended to be used, although this does not affect the scope of protection of the design as such, the Court concluded that the legislation did not limit the exclusive rights of the holder conferred by a Community design registration to a product indicated in the application for the registration and therefore any design made available to the public in compliance with Article 7 CDR may form an obstacle to the novelty of the contested RCD.

However, according to the Court, the sector to which a prior design relates may play a role in the assessment of individual character of a contested RCD. The Court mainly referred to recital 14 of the preamble of the CDR, stating that in the assessment of the individual character of an RCD, account should be taken of the nature of the product related to the design and, in particular, the industrial sector to which it belongs. The Court stated that it could not be excluded that the knowledge of the informed user extends to designs of different products, but that such knowledge cannot be expected automatically. The identification of the prior design is therefore important to determine the awareness

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Registered Community Design

of the informed user. It follows from the Court's reasoning that a prior design of a different nature and from a different sector cannot be taken into account in the assessment of individual character, unless it is established by the evidence that the informed user is familiar with the design.

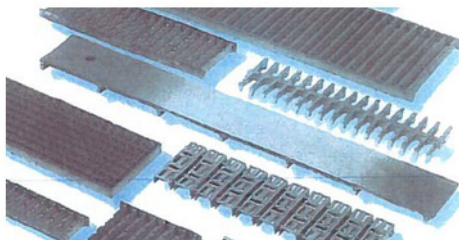
The judgment has been appealed to the Court of Justice.

To see the General Court judgment click [T-15/13](#)

Contested [RCD 000107834-0025](#)



Prior design:



25.1



25.1



25.1

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015
- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

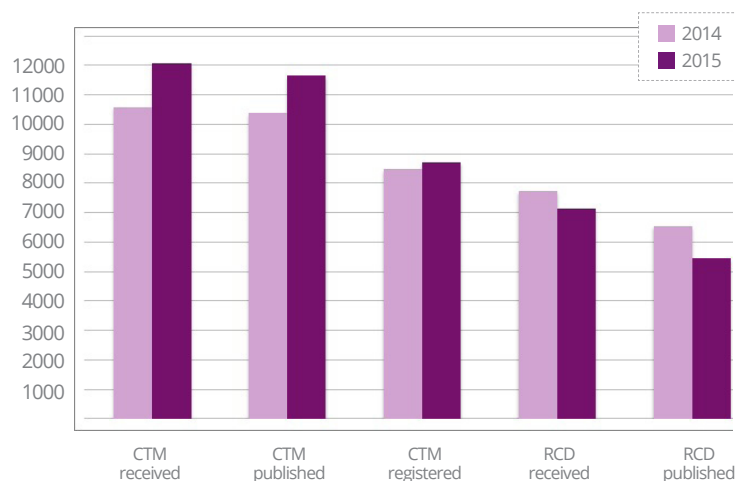


## Statistical Highlights



Monthly statistical highlights July*	2014	2015
Community Trade Mark applications received	10 583	12 058
Community Trade Mark applications published	10 376	11 659
Community Trade Marks registered (certificates issued)	8 471	8 718
Registered Community Designs received	7 735	7 114
Registered Community Designs published	6 549	5 456

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



## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

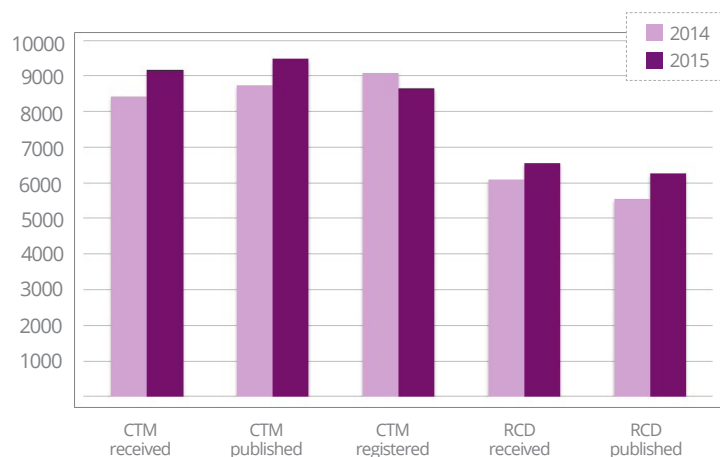


## Statistical Highlights



Monthly statistical highlights August*	2014	2015
Community Trade Mark applications received	8 420	9 177
Community Trade Mark applications published	8 735	9 471
Community Trade Marks registered (certificates issued)	9 087	8 657
Registered Community Designs received	6 087	6 554
Registered Community Designs published	6 260	6 260

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



## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal





## Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

Under the Office's current Strategic Plan the integration of non-EU countries into the so-called 'flagship tools', such as TMview, Designview and TMclass, is a key priority. As of 15 September 2015, 13 non-EU countries (out of 41) have joined TMview (Iceland, the Former Yugoslav Republic of Macedonia, Morocco, Mexico, Norway, the Philippines, Serbia, South Korea, Russia, Tunisia, Turkey, the US and very recently Canada) by enabling access to their trade mark data through this application. This represents almost 15 million trade marks, or 55 % of the current set of trade mark data available through TMview. By the end of 2015, trade mark data from countries such as Japan, Switzerland and Africa (ARIPO) is expected to be made available. Progress is being made in relation to the integration of trade mark data from China (SAIC) and Brazil.

TMview is currently available in 31 languages, and the Graphic User Interface is also already available in Arabic. The implementation of TMview into these non-EU countries has made it a valuable tool, not only for European users but also globally, with a trade mark volume currently standing at over 27.4 million. Since 2010, the number of free searches has grown too, from a yearly average of 37,000 then to 600,000 today, representing a total of 15.2 million searches in just five years.



In terms of Designview, 11 non-EU countries (out of 35) have joined the tool so far (Iceland, Morocco, Mexico, Norway, Russia, South Korea, Tunisia, Turkey, and very recently Canada, China (SIPO) and the US), bringing with them a total volume of over 5.7 million designs, which equates to 66 % of the total volume. By the end of 2015 data from the Former Yugoslav Republic of Macedonia and from Serbia will also become available through Designview, which is currently available in 30 languages.

With the recent integrations of these non-EU countries, the total number of designs in Designview has almost doubled to 8.6 million designs. The number of free searches has grown from a yearly average of 20 000 in 2013 to 60 000 in 2015, representing a total of over 1 million searches in two years.

TMclass has also taken an increasingly important place in activities with non-EU countries. Trade mark classification data (e.g. lists of goods and services) from Africa (OAPI) Bosnia & Herzegovina, Canada, China (SAIC), the Former Yugoslav Republic of Macedonia, Iceland, Japan, South Korea, Morocco, Montenegro, Mexico, Norway, Serbia, Russia, Tunisia, Turkey and the US has become searchable through this tool, with data from Switzerland already integrated in 2010.

Other integrations, including Brazil, are expected before the end of the year. The tool is available in

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## ETMDN Updates

34 languages and, like TMview, the Graphic User Interface (but not the terms) is already available in Arabic. The number of free searches has doubled from almost 300 000 in 2013 to almost 600 000 in 2015, representing a total of more than 12 million searches.

Flagship tools integration is not the only international cooperation activity engaged in by OHIM. Non-EU offices are invited to training sessions arranged by the OHIM Academy, and in the last 21 months a total of almost 200 participants from non-EU offices have been trained. Awareness-raising seminars (for the CTM and RCD system and information tools) have also been arranged, along with high level meetings, expert visits and traineeships (with colleagues from China), as well as exchanges of expertise (through the deployment of experts from non-EU countries to OHIM). International cooperation activities have also supported the work of the EU Observatory on Infringements of Intellectual Property Rights by disseminating its activities and outputs in Turkey, Morocco, Mexico, Russia and China.



## BOIP implements Back Office

The Benelux Office for Intellectual Property (BOIP) has gone live with the Software Package Back Office for Designs tool, developed by the Cooperation Fund.

The first application has already been received and processed by the new system.

This implementation is the result of substantial effort and close collaboration between OHIM and BOIP. With this implementation, 12 tools have now been implemented by BOIP office within the CF framework.

The new system will support the complete lifecycle of designs and facilitates application examination, the records lifecycle as well as renewal and expiration automations, and will speed up the processing of design registrations.

With the inclusion of the Hellenic Industrial Property Organisation (GR OBI) recently in the tool, seven IP offices across the EU now use the Back Office, including the Finnish Patent and Registration Office (PRH) and the Polish Patent Office, both of which were pilot offices for the Back Office system and which have defined its core functionalities.

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Hungary implements trade mark e-filing

The Hungarian Intellectual Property Office (HIPO) has implemented trade mark e-filing.

The trade mark e-filing system, part of the Software Package of services developed under the Cooperation Fund, allows Hungarian users to file their trade mark applications electronically.

With this latest integration, the total number of tools and services implemented by EU national and regional IP offices has reached 352.

## First Page

- New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## More News

### €500 million lost every year throughout the EU due to fake sports equipment

On September 10, OHIM, acting through the EU Observatory on Infringements of Intellectual Property Rights, released a study showing that sales lost due to counterfeiting of sports equipment correspond to 6.5% of all sales in this sector across the 28 EU Member States – a loss of €500 million every year for EU manufacturers.

The study also shows that approximately 2,800 jobs are lost in this sector throughout the EU, as manufacturers sell less than they would have done in the absence of counterfeiting, and therefore employ fewer people.

Every year, an additional €360 million is lost across the EU due to the indirect effects of counterfeiting of sports equipment – as manufacturers buy fewer goods and services from suppliers, causing knock-on effects in other areas.

The report also shows that up to €150 million is lost annually in government revenue throughout the EU due to this type of counterfeiting. This includes tax, social contributions and VAT which are not paid by producers and distributors of fakes.

The [report](#) is the third in a series of studies undertaken by OHIM into the economic impact



of counterfeiting in industrial sectors in the EU, in terms of job and revenue losses. In July, a report into the economic impact of fake clothes, shoes and accessories (including fake sportswear) was released, while in March, OHIM published the first study in this series, into the economic impact of fake cosmetics and personal care items. Each report centres on a sector known to be vulnerable to counterfeiting.

### Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

The overall timeliness of operations appears to be maintained despite the increase in number of applications compared to the previous quarter. During the first quarter, the trend presented a much slower growth in applications than initially forecasted for this year, while the second quarter shows an impressive increase in application filings. The performance achieved in the second quarter nevertheless maintains the trend of the first one, and there are no remarkable overall deviations.

The timeliness for CTM is maintained although the volume of applications is higher. The result of quality checks in CTM examination presented a slightly lower result, but is still in compliance, while opposition proceedings and decisions are stable.

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal





## More News

IRs examination presents a slight decrease in timeliness of operations due to the increase in number of files.

Regarding Appeals, the trend keeps improving achieving a very high performance for Appeals Reception with 3 days maximum time and 1 day average time for 90% of the cases.

Accessibility also has very high levels of effectiveness during the second quarter maintaining the global performance reached last year.

For any comment or suggestions, please contact [CGS@oami.europa.eu](mailto:CGS@oami.europa.eu).

## Online IP Management: OHIM's European Workshop Roadshow

OHIM's European workshop roadshow began in London on 10 September. It was the first in a series of workshops to be held across the EU, aimed at offering participants a quick overview of the Office's online services.

### Upcoming destinations and live streaming details:

**Denmark**, 01/10/2015 (from 09:00 to 12:30 CET). Organised in collaboration with [DKPTO](#)  
**Italy**, 06/10/15 (from 13:30-17:00 CET) Organised in collaboration with [UIBM](#) and [Consortio Camerale](#)



**Germany**, 4/11/2015. Organised in collaboration with [GRUR](#)

**Spain**, 18/11/2015. Organised in collaboration with [OEPM](#)

**France** (dates to be confirmed)

## National Case-Law Collection meeting

Representatives from a number of national IP offices from across the EU Member States met at OHIM on September 15 to discuss the implementation of the national enforcement-related case-law collection and analysis project that is being implemented by the EU Observatory.

The purpose of the project is the collection of key jurisprudence related to enforcement of IP rights rendered at national level and preparation of analysis of the selected judgments, enabling identification and description of the most relevant jurisprudential trends concerning enforcement. The collected jurisprudence will be made available to the public in OHIM's eSearch case-law database.

The project is being implemented in cooperation with the National IP Offices. It started as a pilot with eight national IP Offices: Denmark, France, Lithuania, Slovenia, Spain, Sweden, Romania and United Kingdom and more national IP offices will be joining during 2015.

## First Page

■ New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

### Luxembourg trade mark and design news

**A: Court of Justice: Orders, Judgments and Preliminary Rulings**

**Case C-494/13 P; GRE Grand River Enterprises Deutschland GmbH v OHIM; Order of 22 January 2015; Language of the case: DE**

**RESULT:** Action dismissed

**Keywords:** Distortion of facts or evidence, Likelihood of confusion, Admissibility

**FACTS:** The Opposition Division uphold the opposition and the Board of Appeal confirmed it, due to the likelihood of confusion in case of the CTM application and the earlier mark represented for goods in Class 34 "tobacco and tobacco products". The CTM applicant filed an action before the General Court (GC) claiming an infringement of Article 8 (1) (b) CTMR. The GC dismissed the action. The applicant filed an appeal to the European Court of Justice (CJ) claiming an infringement of Article 8 (1) (b) CTMR.



#### CTMA



#### Earlier marks



**SUBSTANCE:** The CJ dismissed the action by an order pursuant to Article 181 of its Rules of Procedure, as manifestly inadmissible. It recalled its Case-Law related to Article 256 (1) TFEU and the first subparagraph of Article 58 of the Statute of the CJ, an appeal lies on a point of law only. The GC has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

evidence thus does not, save where they distort the evidence, constitute a point of law which is subject, as such, to review by the CJ on appeal (Para. 35). All arguments of the applicant concern the comparison of good or of the marks and are of factual character (Paras. 37-38).

**Case C-495/13 P; GRE Grand River Enterprises Deutschland GmbH v OHIM; Order of 22 January 2015; Language of the case: DE**

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### Earlier marks

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## First Page

■ New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

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**RESULT:** Action dismissed

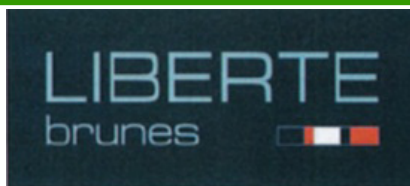
**KEYWORDS:** Distortion of facts and evidence, Likelihood of confusion, Admissibility, Burden of proof

**FACTS:** The Opposition Division uphold the opposition and the Board of Appeal confirmed it, due to the likelihood of confusion in case of the CTM application and the earlier mark represented for goods in Classes 14 and 34. The CTM applicant filed an action before the General Court (GC) claiming an infringement of Article 8 (1) (b) CTMR. The GC dismissed the action. The applicant filed an appeal to the European Court of Justice (CJ) claiming an infringement of Article 8 (1) (b) CTMR.

**SUBSTANCE:** The CJ dismissed the appeal by an order pursuant to Article 181 of its Rules of Procedure, as manifestly inadmissible and manifestly unfounded. It recalled its Case-Law related to Article 256 (1) TFEU and the first subparagraph of Article 58 of the Statute of the CJ, an appeal lies on a point of law only. The GC has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus does not, save where they distort the evidence, constitute a point of law which is subject, as such, to review by the CJ



### CTMA



### Earlier marks



on appeal (Para. 33). The arguments of the applicant that concern the comparison the marks are of factual character (Paras. 35 and 36). The arguments related to the alleged infringement of the rules of the burden of proof are directed against grounds included in the judgment purely for the sake of completeness. Complaints directed against grounds included in a judgment of the GC purely for the sake of completeness must, however, be rejected from the outset as they cannot lead to that judgment being set aside (Para. 38 with a reference to further Case-Law).

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## Case law

**Case C-622/13 P; Castel Frères SAS v Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell and OHIM; Order of 30 April 2015; Language of the case: EN**

**RESULT:** Appeal dismissed

**KEYWORDS:** Admissibility, Descriptive element, Geographical origin, Lack of reasoning, Conceptual dissimilarity

**FACTS:** The applicant registered the word mark **castel** as a CTM for goods and services within Class 33.

An application for invalidity was filed based on indication of geographical origin **Castell**, protected for wines in Germany, France, Greece, Italy and Spain. The Cancellation Division dismissed the application for invalidity.

The Board of Appeal (BoA) dismissed invalidity applicant's appeal after finding that **Castell** was an indication of geographical origin relating to wines produced in Germany and was perceived as such by the relevant public. The spelling difference was likely to create some distance and a conceptual difference between the terms at hand. The invalidity applicant filed an action before the General Court (GC) based on 6 pleas in law. The GC rejected the BoA's finding that the spelling difference would be sufficient, from the relevant public's point of view, to outweigh the resemblance of the disputed mark to the earlier geographical indication (GI). The GC held



that the relevant public, which is aware of the earlier (GI) and, therefore, of the existence of the wine-producing municipality of "Castell" in Germany, will, when confronted with goods bearing the disputed mark, namely, **castel**, think immediately, without further thought, that what they have in front of them is a wine which comes from that wine-producing municipality. The applicant lodged and appeal before the European Court of Justice (CJ).

### CTMA

**castel**

### Earlier geographical indication

**Castell**

**SUBSTANCE:** Regarding the admissibility of the appeal the CJ stated the single period of extension on account of distance is not to be considered to be distinct from the period for bringing an appeal referred to in Article 56 of the Statute of the CJ, but rather as an integral part of that period which it extends by a fixed period of time. Thus, the period within which an appeal must be brought is two months and ten days after notification of the decision appealed against (Para. 28).

**FIRST GROUND OF APPEAL:** The CJ stated that with regards to a supposed absence of a statement of reasons in the judgment under appeal and an

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



allegedly incorrect interpretation by the GC of the concept of abuse of rights within the meaning of EU law, it is clear from Article 56 (1) (a) CTMR that an application for a declaration of invalidity based on an absolute ground for invalidity does not require the applicant to show an interest in bringing proceedings (Para. 41). Further, recalling the principles set in Donaldson Filtration Deutschland v ultra air, case C-450/13, the CJ highlighted that, because it is necessary to protect the public interest underlying Article 7 (1) (b) and (c) and Article 56 (1) (a) CTMR, the Office's task is to assess whether the mark under examination is descriptive and/or devoid of distinctive character in the light of the rules governing the registrability of that mark. The motives and earlier conduct of the applicant for a declaration of invalidity cannot affect the scope of that task. Accordingly, there can be no question of an abuse of rights on the part of the applicant for a declaration of invalidity (Paras. 43-44).

**SECOND GROUNDS OF APPEAL:** The applicant has failed to demonstrate, in law, that the relevant criteria when assessing descriptiveness, established by the Case-Law in the context of marks resulting from a combination of elements established in Procter & Gamble v OHIM, case C-383/99 P, and in Koninklijke KPN Nederland, case C-363/99, do not apply when the mark for which registration is sought is composed of a single word (Paras. 67-72). It follows from the contested judgment that the GC properly examined the perception by the relevant consumer of the sign in question and ruled explicitly

on the way that consumer actually interprets that sign (Para. 77). As regards the inapplicability of the bilateral treaties referred to by the GC in the judgment, the GC was correct finding that the inapplicability of those treaties might be relevant for the purpose of establishing the scope of the legal protection relating to the earlier GI, but is not relevant when what is at issue is establishing that the relevant public is familiar with the wine-producing municipality of "Castell" and the degree of that familiarity (Para. 81). Finally, in regards of the relationship of Article 7 (1) (c) and 7 (1) (j), since the term "castel", by itself, does not designate the origin or GI of a wine, the GC cannot be criticised for failing to apply the specific provisions of Article 7 (1) (j) CTMR (Paras. 83-85).

**Case C-400/14P; Basic AG Lebensmittelhandel v. OHIM + Repsol YPF SA; Order 16 July 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Figurative trade mark, Retail services, Identity of the signs, Similarity of the goods and services

**FACTS:** The CTM applicant sought to register the figurative sign indicated below. An opposition was filed based on Article 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition for part of

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

the contested services in Classes 35 and 39. The opponent based its opposition in Classes 35, 37 and 39 filed an appeal against the OD's decision. The Board of Appeal (BoA) partially upheld the appeal. The CTM applicant filed an application for annulment before the General Court (GC) which dismissed the action as unfounded. The CTM applicant filed an action before the European Court of Justice (CJ). The ground of appeal is the infringement of article 8 (1) (b) CTMR.



**SUBSTANCE:** The CJ, pursuant to Article 181 RPCJ, dismissed the appeal, stating that none of the arguments put forward by the CTM applicant can succeed.

First of all, the CJ found that the CTM applicant misunderstood the judgement of the GC and that there was no need to define the scope of distribution services restrictively: the GC correctly defined the scope of "distribution services" before assessing the similarity of the services (Paras. 49-51).

Secondly, the CJ rejected as manifestly inadmissible



the reference of the CTM applicant to the definition of retail services given by the CJ in the "Praktiker" case: the CTM applicant confined itself to repeating arguments which had already been submitted before the GC and did not take a position on the reasoning of the CJ (Paras. 54-56).

Furthermore, the CJ rejected the argument that the GC did not take into account the explanatory note to Class 39 of the Nice Agreement, highlighting that it was based on a manifestly incorrect reading of the judgement of the GC.

**Case C-147/14; Loutfi Management Propriété intellectuelle SARL v AMJ Meatproducts NV and Halalsupply NV; Preliminary ruling of 25 June 2015; Language of the case: NL**

**KEYWORDS:** Conceptual dissimilarity, Distinctive element, Dominant element, Identity of the goods and services, Likelihood of confusion, Phonetic dissimilarity, Similarity of the goods and services, Visual similarity

**FACTS:** This request for a preliminary ruling has been made in proceedings between Loutfi Management Propriété intellectuelle SARL ('Loutfi'), on the one hand, and AMJ Meatproducts NV ('Meatproducts') and Halalsupply NV ('Halalsupply'), on the other hand, concerning an alleged infringement of two figurative Community trademarks (CTM) registered by Loutfi. Loutfi owns two earlier CTMs. First, EL

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

BENNA, was registered for goods in Classes 29, 30 and 32, second, EL BNINA, was registered for goods in Classes 29 and 30, both CTMs combining the colours red, white and green. Meatproducts registered figurative Benelux trademark EL BAINA for goods in Class 29 and 30 without any colour combination. Halalsupply has taken over the business of Meatproducts, including the latter's trade mark portfolio.

### Registered Benelux Trade Mark



### Earlier CTMs



According to the national court, the sign considered refers to the same goods, or at least to similar goods to those identified in the two CTMs (Para. 12). Further, the relevant public must be defined as being the public composed of Muslim consumers of Arab origin who consume "halal" food products in the EU and who have at least a basic knowledge of written Arabic (Para. 14). The word elements in Latin script are dominant in all signs as well as those in Arabic, although the latter elements are less dominant than the former (Para. 15). Even though the national court finds a certain visual similarity between the signs, it remains the case that the pronunciation of those words in that language differs substantially; as does the significance which each holds (Para. 16).

### QUESTION REFERRED TO THE EUROPEAN COURT OF JUSTICE (CJ):

The Court of Appeal in Brussels referred the following question to the European Court of Justice (CJ) (Para. 18):

"Having regard, in particular, to Articles 21 and 22 of the Charter of Fundamental Rights of the European Union, must Article 9 (1) (b) CMTR be interpreted as meaning that, in the assessment of the likelihood of confusion between a CTM in which an Arabic word is dominant and a sign in which a different, but visually similar, Arabic word is dominant, the difference in pronunciation and meaning between those words may, or even must, be examined and taken into account by the competent courts of the Member States, even though Arabic is not an official

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law

language of the European Union or of the Member States?"

### ANSWER OF THE CJ:

First the CJ underlined that CTMR, and in particular Article 9 (1) (b) thereof, do not make reference to the use of any particular language or alphabet which should or should not be taken into account in assessing the likelihood of confusion (Para. 20). The CJ referred to its Case-Law, namely to judgment in Henkel v OHIM, C-456/01 P and C-457/01 P in regards of the relevant public (Para. 21), and judgments in Aceites del Sur-Coosur v Koipe, C-498/07 P, EU: C: 2009:503, and XXXLutz Marken v OHIM, C-306/11 P in regards of the global appreciation of the existence of likelihood of confusion (Para. 23). Based on that, the CJ found that the phonetic and conceptual differences should be taken into account because, if they are not, the assessment of the likelihood of confusion could be made only partially and, as a result, without taking into account the overall impression made by the CTMs and the sign considered on the relevant public (Para. 25).

THE CJ THUS RULED: Article 9 (1) (b) CTMR must be interpreted as meaning that, in order to assess the likelihood of confusion that may exist between a CTM and a sign which cover identical or similar goods and which both contain a dominant Arabic word in Latin and Arabic script, those words being visually similar, in circumstances where the relevant public for the CTM and for the sign at issue has a basic knowledge of written Arabic, the meaning and



pronunciation of those words must be taken into account.

**Case C-379/14; TOP Logistics BV, Van Caem International BV v Bacardi & Company Ltd, Bacardi International Ltd and Bacardi & Company Ltd, Bacardi International Ltd v TOP Logistics BV, Van Caem International BV; Preliminary ruling of 16 July 2015; Language of the case: NL**

**KEYWORDS:** Sign used in the course of trade, Use by another undertaking, Used in the course of trade, Proprietor consent, Relevant territory, Function of trade mark, Adversely affected

**FACTS:** This request for a preliminary ruling has been made in the context of two sets of proceedings between, on the one hand, TOP Logistics BV ("TOP Logistics") and Van Caem International BV ("Van Caem") against Bacardi & Company Ltd and Bacardi International Ltd ("Bacardi") and, on the other hand, Bacardi against TOP Logistics and Van Caem, concerning goods originating from Bacardi. The goods at issue have been produced in a third state. They have been brought into the customs territory of the EU without the consent of the proprietor of the trade mark and placed under a suspensive customs arrangement. They were then released for free circulation, which brought an end to that customs arrangement and gave rise to payment of

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



import duties, without the consent of the proprietor.

### QUESTION REFERRED TO THE EUROPEAN COURT OF JUSTICE (CJ):

The Gerechtshof te Amsterdam referred the following question to the European Court of Justice (CJ) (Para. 29): Concerning goods originating outside the European Economic Area (EEA) which, after having been brought into the territory of the EEA (neither by the trade mark proprietor nor with its consent), are placed in a Member State of the European Union (EU) under the external transit procedure or under the customs warehousing procedure ...

(1) Where such goods are subsequently placed under a duty suspension arrangement, as in the present case, must those goods then be regarded as having been imported within the meaning of Article 5 (3) (c) TMD with the result that there is “use (of the sign) in the course of trade” that can be prohibited by the trade mark proprietor pursuant to Article 5 (1) TMD?

(2) If Question 1 is answered in the affirmative, must it then be accepted that in circumstances such as those in the case at issue, the mere presence in a Member State of such goods (which have been placed under a duty suspension arrangement in that Member State) does not prejudice, or cannot prejudice, the functions of the trade mark, with the result that the trade mark proprietor which invokes national trade mark rights in that Member State cannot oppose that presence?

### ANSWER OF THE CJ:

Since the import duties having been paid for the goods at issue in the main proceedings and those having been released for free circulation, those goods have been imported within the meaning of Article 5 (3) (c) (Para. 35). The proprietor of the trademark is not in any way obliged to wait for the release for consumption of the goods covered by its trade mark to exercise its exclusive right. It can also oppose certain acts committed without its consent, before that release for consumption, such as the import of the goods concerned and their storage for the purpose of putting them on the market (Para. 38). The terms “using” and “in the course of trade” do not refer only to immediate relationships between a trader and a consumer (Para. 40). There is use of a sign identical to the trade mark, within the meaning of Article 5 TMD, where the economic operator concerned uses the sign in its own commercial communications (Para. 41). The use is made in the course of trade where it occurs in the context of commercial activity with a view to economic advantage and not as a private matter (Para. 43). That is the case where an economic operator active in the parallel trade of trade-marked goods, imports and stores such goods. By contrast, provision of a warehouse service for goods bearing another’s trade mark does not constitute use of a sign identical to that trade mark for goods or services identical or similar to those in respect of which the mark is registered (Paras. 44-45). Any act by a third

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal





## Case law

party preventing the proprietor of a registered trade mark in one or more Member States from exercising his right to control the first placing of the goods bearing that mark on the market in the EEA, by its very nature undermines the essential function of the trade mark. The importation of products without the consent of the proprietor of the trade mark concerned and the holding of those products in a tax warehouse before their release for consumption in the EU has such effect. Such acts also adversely affect the function of the trade mark of identifying the undertaking from which the products originate and under whose control the initial placing on the market is organised. That is not invalidated by the fact that goods imported and placed under the duty suspension arrangement can subsequently be exported to a third State and thus never be released for consumption in a Member State (Paras. 48-49).

### THE CJ THUS RULED:

Article 5 TMD must be interpreted as meaning that the proprietor of a trade mark registered in one or more Member States may oppose a third party placing goods bearing that trade mark under the duty suspension arrangement after they have been introduced into the EEA and released for free circulation without the consent of that proprietor.



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

**Case T-366/11RENV; Bial-Portela & Ca SA v OHIM, Isdin, SA (intervener); Judgement of 3 March 2015; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Admissibility, Likelihood of confusion, Visual similarity, Identity of the goods and services, Phonetic similarity, Similarity of the signs, Specialised public, Ending of mark, Common element

**FACTS:** The applicant sought to register a CTM for the word mark ZEBEXIR for goods in Classes 3 and 5. The opponent challenged the application on grounds of likelihood of confusion with previously registered word CTM ZEBINIX covering inter alia goods in Classes 3 and 5. The Opposition Division found no likelihood of confusion and rejected the opposition. Subsequently, the Board of Appeal (BoA) dismissed the appeal, holding that the dissimilarity of the signs is sufficient to exclude a likelihood of confusion, even for identical goods. The General Court (GC) annulled the decision of the BoA, finding average degree of visual similarity being, however, of particular importance as regards all goods in Class 3 and most of the goods in Class 5 because they are marketed in a way that requires visual examination by the consumer. In its appeal the applicant raised

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



several pleas in law before the European Court of Justice (CJ).

The opponent lodged an appeal. The CJ found a failure to state reasons in the GC's judgment with regard to the finding of a likelihood of confusion relating to certain goods designated by the marks at issue. The contested judgment was set aside and the case referred back to the GC.

### CTMA

**ZEBEXIR**

### Earlier marks

**ZEBINIX**

**SUBSTANCE:** The relevant public is composed of the average consumer in the EU. The disputed goods are mostly directed at a general public, partially at a professional public. As the general public is considered to be less informed and observant than the professional public, it is the level of attention of the former that must be taken into account (Para. 30). The disputed goods are identical (Para. 31). Contrary to the BoA's finding, the visual differences created by the central and end parts of the signs at issue, namely, the groups of letters "inix" in the earlier mark and "exir" in the mark applied for, are not sufficient to cancel out the impression of visual

similarity created by the common first part "zeb" of the signs at issue. The two groups of letters contain the letters "l" and "x". Furthermore, it must be stated that the common letter "x", which is visually striking, reinforces the similarity created by the common first part of the two signs, notwithstanding the fact that it is not situated in the same position in each of the signs at issue (Para. 38). Phonetically, first the marks are each composed of three syllables. Second, the first syllable is identical. Third, the second syllables "be" and "bi" of the marks at issue are close in their sound. Fourth, the third syllables "xir" and "nix" of the marks at issue are distinct but contain the common letters "l" and "x", the second of which has a clearly recognisable sound. Fifth, the sounds "eks" in the middle of the mark applied for and "iks" at the end of the earlier mark are capable of attracting consumers' attention (Para. 44). The signs at issue have an average degree of visual similarity and a certain level of phonetic similarity. In those circumstances, the slight differences between the marks at issue are not sufficient to offset, in the mind of the relevant public, the fact that the goods covered by those marks are identical. On the contrary, the relevant public, when confronted with the signs at issue, of which it may perhaps have an imperfect recollection, could well believe that the goods designated by the marks at issue come from the same undertaking or economically linked undertakings and there is a likelihood of confusion (Para. 52).

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**Case T-323/12; Knauf Insulation Technology v OHIM; Judgment of 15 July 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Abbreviation, Complementary goods and services, Conceptual similarity, Descriptive element, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Nature of goods and services, Similarity of the goods and services, Similarity of the signs, Specialised public, Visual similarity, Ending of mark, Principle of legality

**FACTS:** The applicant sought to register the word mark ECOSE as a CTM for goods and services within Classes 1, 2, 3, 16, 17, 19, 20 and 40. An opposition based on the earlier Spanish word mark ECOSEC FACHADAS registered for goods in Classes 17 and 19 was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division partly rejected the opposition in respect of the goods and services in Classes 1, 2, 3, 16, 20 and 40, and partly upheld in respect of the goods in Classes 17 and 19. The Board of Appeal (BoA) partly upheld the appeal of the applicant and annulled the decision of the Opposition Division in so far as it had rejected the application for registration in respect of “rubber, gutta-percha, gum, asbestos and mica” in Class 17. Given the similarity between the conflicting signs and the identical nature or similarity between the goods at issue, the BoA found a likelihood of



confusion between the marks at issue with respect to the identical or similar goods. The applicant filed an action before the General Court (GC).

CTMA

ECOSE

Earlier marks

ECOSEC FACHADAS

**SUBSTANCE:** The GC confirms that the relevant public is made up of professionals in the building sector in Spain, as well as of do-it-yourself enthusiasts (part of general public), and that that public has a high level of attention (Paras. 21-22). Also, BoA's assessment that the goods at issue are partly identical and partly similar is upheld (Paras. 25-32). Regarding the visual similarity, the GC endorses BoA's observations that the sign sought is entirely contained in the first word of the earlier mark, the only two differences being the additional letter “c” at the end of the first word of the earlier mark and the additional word ‘fachadas’ contained in the earlier mark. Consumers would attach greater visual importance to the first part of the earlier mark, namely the word “ecosec”, and would consider the second word “fachadas” as being of secondary importance, inter alia due to its descriptive character. The signs are thus, as a whole,

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



visually similar (Paras. 35-40). On the phonetic level, since the words “ecose” and “ecosec” are not part of the Spanish vocabulary, it is not possible to determine their rhythm or intonation with absolute certainty (Para. 42). The first two syllables “e” and “co” of the marks at issue would both tend to be construed as an abbreviation of the Spanish words as “ecológico” (ecological) or “económico” (economical). It would thus be logical to stress the words “ecose” and “ecosec” in an identical manner (Para. 44). The word “fachadas” was relegated to a secondary position due to its descriptive nature (Para. 45). There exists a vague conceptual similarity between the conflicting signs in that they could be linked to the rather allusive concepts of “ecological” or “economical” (Para. 49). Even though when perceiving a word sign, the consumer will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him, in the present case, given that the applicant itself puts forward two possible interpretations of the element “eco”, that element does not suggest a concrete meaning and does not resemble words known to the average consumer. It is accordingly highly unlikely that the relevant public will examine the earlier mark by breaking it down into two parts. The earlier mark has thus normal distinctiveness (Paras. 58-59). Based on the foregoing, likelihood of confusion exists between the marks at issue (Para. 60). As to the national decisions relied on by the parties, registrations already made in the Member States are merely a factor which, without being given

decisive weight, may be taken into consideration for the purposes of registering a CTM (Para. 61). OHIM’s earlier decision-making practice can neither bind the Courts of the EU (Para. 62). A CTM applicant cannot rely to his advantage on a possibly unlawful act committed to the benefit of someone else (Para. 63).

**Case T-324/12; Knauf Insulation Technology v OHIM; Judgment of 15 July 2015; Language of the case: EN**

**RESULT:** (Action upheld) BoA decision annulled

**KEYWORDS:** Abbreviation, Complementary goods and services, Conceptual similarity, Descriptive element, Identity of the goods and services, Likelihood of confusion, Nature of the goods and services, Phonetic similarity, Purpose of goods and services, Similarity of the goods and services, Similarity of the signs, Specialised public, Visual similarity, Figurative trade mark, Figurative element

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 1, 2, 3, 16, 17, 19, 20 and 40. An opposition based on the earlier Spanish word mark ECOSEC FACHADAS registered for goods in Classes 17 and 19 was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) partly upheld the opposition in respect of “paints” in Class

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM’s European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



2 and the goods in Class 17 (apart from “rubber, gutta-percha, gum, mica; flexible pipes, not of metal; pipe muffers (not of metal)”) and Class 19. The applicant as well as the opponent lodged appeals. The Board of Appeal (BoA) dismissed the applicant’s appeal and upheld, whilst dismissing it as to the remainder, the opponent’s appeal in so far as it sought annulment of the OD’s decision dismissing the opposition in respect of “flexible pipes, not of metal; pipe muffers (not of metal)” in Class 17. Given the similarity between the conflicting signs and between the goods at issue, the BoA found a likelihood of confusion between the marks at issue. The applicant filed an action before the General Court (GC).

### CTMA



### Earlier mark

**ECOSEC FACHADAS**

**SUBSTANCE:** The GC confirms that the relevant public is made up of professionals in the building sector in Spain, as well as of do-it-yourself enthusiasts

(part of general public), and that that public has a high level of attention (Paras. 21-22). As regards the comparison of the goods, the contested decision contains a reasoned explanation only for part of the goods. Yet it is clear from a reading of the contested decision that the BoA endorsed the OD’s decision also in respect of the other goods concerned. Therefore, as the OD’s decision is part of the context in which the contested decision was adopted, it contains a sufficient statement of reasons and must be taken into account in the review of the merits of the BoA’s findings on the comparison of the goods (Para. 29). After a brief analysis, GC upholds BoA’s assessment that the goods at issue are partly identical and partly similar (Paras. 31-40). Regarding the visual similarity, it is true that the word elements “ecose” and “ecosec” do bear a certain similarity. Nevertheless, that similarity is not decisive for the overall visual impression that the relevant public will retain from those marks, including the mark sought (Para. 45). The figurative elements contained in the mark sought must be regarded as being fairly original and more than simply decorative. The earlier mark as a word mark does not contain any element resembling the figurative elements of the mark sought. Thus the marks are clearly distinguishable from each other (Paras. 47-48). Given that, first, the conflicting signs are similar in terms of the word elements “ecose” and “ecosec”; secondly, they differ with respect to the figurative elements, including the green colour and the slight inclination towards the right of the mark sought; and thirdly, the word

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM’s European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law

elements “technology” and “fachadas” are different but of secondary importance due to, inter alia, their descriptive character, the conclusion must be that there is only a low degree of visual similarity between the conflicting signs (Para. 50). On the phonetic level, since the words “ecose” and “ecosec” are not part of the Spanish vocabulary, it is not possible to determine their rhythm or intonation with absolute certainty (Para. 52). The first two syllables “e” and “co” of the marks at issue would both tend to be construed as an abbreviation of the Spanish words as “ecológico” (ecological) or “económico” (economical). It would thus be logical to stress the words “ecose” and “ecosec” in an identical manner (Para. 54). The words “technology” and “fachadas” were relegated to a secondary position due to their descriptive nature (Para. 55). There exists a vague conceptual similarity between the conflicting signs in that they could be linked to the rather allusive concepts of “ecological” or “economical” (Para. 58). Even though when perceiving a word sign, the consumer will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him, in the present case, given that the applicant itself puts forward two possible interpretations of the element “eco”, that element does not suggest a concrete meaning and does not resemble words known to the average consumer. It is accordingly highly unlikely that the relevant public will examine the earlier mark by breaking it down into two parts. The earlier mark has thus normal distinctiveness (Paras. 70-71). The



GC concludes that there is only a very low degree of visual similarity between the conflicting signs, they are phonetically similar, although that similarity is limited to the word elements, there is no direct conceptual similarity and, therefore, the relevant public, having a high level of attention, will perceive the conflicting signs as having only a low degree of similarity. Thus, despite the fact that the goods concerned are partly identical and partly similar, there will not be a likelihood of confusion (Paras. 73-74). As to the national decisions relied on by the parties, registrations already made in the Member States are merely a factor which, without being given decisive weight, may be taken into consideration for the purposes of registering a CTM (Para. 75). The Office’s earlier decision-making practice can neither bind the Courts of the EU (Para. 76). A CTM applicant cannot rely to his advantage on a possibly unlawful act committed to the benefit of someone else (Para. 77).

**Cases T-544/12 and T-546/12; Pensa Pharma, SA v OHIM; Judgment of 3 June 2015; Language of the case: EN**

**RESULT:** Actions dismissed

**KEYWORDS:** Admissibility, Coexistence of trade marks, Complementary goods and services, Descriptive element, Distinctive element, Dominant element, Ending of mark, Figurative trade mark,

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM’s European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

Figurative element, Identity of goods and services, Likelihood of confusion, Nature of goods and services, Obvious mistakes, Phonetic similarity, Proprietor consent, Relevant territory, Similarity of the goods and services, Similarity of signs, Visual similarity, Specialised public

**FACTS:** The applicant registered the word mark Pensa PHARMA and the figurative mark represented bellow as a CTM for goods and services within Classes 3, 5 and 44.

The invalidity applicants filed first oppositions which were afterwards withdrawn. After registration of the contested marks, applications for of invalidity based on the earlier word mark PENTASA registered for goods in Class 5, namely "Pharmaceutical preparations", in several Member States, was filed on the grounds of Article 8 (1) (b) CTMR. The list of contested goods was restricted to Class 5 and Class 44. The Cancellation Division upheld the applications for invalidity.

The Board of Appeal (BoA) dismissed the applicant's appeals finding that the goods and services at issue were identical or similar and that the marks were also similar. The visual differences between the marks were not sufficient to rule out a likelihood of confusion (LOC), in view, inter alia, of the highly distinctive character acquired through use of the earlier rights. Neither the applicant's arguments relating to the invalidity applicants' consent to the registration of the contested marks may be taken into consideration for the purposes of assessing



whether there is a LOC. The applicant filed an action before the General Court (GC).



**SUBSTANCE:** The GC first decided on inadmissibility of documents submitted for the first time before the General Court (Para. 25) and of arguments put forward for the first time at the hearing (Para. 31) referring to settled Case-Law.

**FIRST PLEA IN LAW – ARTICLE 53 (3) CTMR:** The consent of the proprietor of the right must be express for the registration of a sign which may result in a LOC to be permitted (Para. 37). The peaceful coexistence of the marks at issue cannot take the place of the "express consent" of the right holder (for the purposes of Article 53 (3) CTMR) to the registration (Para. 40). Also, despite the argument of the peaceful coexistence in Italy and Spain, a LOC established in one or more Member States is sufficient to refuse registration of TM

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



applied for without it being necessary to rule on the LOC in other States relevant to the dispute (Para. 42). Regarding the withdrawal of the oppositions, the GC stresses out that the principle of procedural economy cannot preclude a party's right to protect its earlier rights by withdrawing its opposition with a view to filing an application for a declaration of invalidity. In the absence of any provision to the contrary in the legislation, a party is free to choose the legal remedy which it intends to use to assert its rights (Para. 45). The coexistence agreement cannot be interpreted in such a way as to the extent beyond its scope without the express consent of the parties; there is no consent on the part of the invalidity applicants (Paras. 50-51). A clerical error made by the BoA in the contested decision is not capable of invalidating its findings as to the inapplicability of the coexistence agreement to the marks at issue, since it draws no formal inferences as to the lawfulness of the decision (Para. 52-54). The first plea was thus rejected as unfounded.

### SECOND GROUNDS PLEA IN LAW – ARTICLE 8

**(1) (b) and 53 (1) (a) CTMR:** The relevant public consists of consumers from the Benelux countries and French consumers respectively and, having regard to the nature of the goods and services, the level of attention of that public, which consists of the general public and of health professionals, was higher than average (Paras. 69-70).

In regards of the visual comparison of the word marks PENTASA and PENZA PHARMA the GC stated that the relevant public will not be able to

disregard the element “pharma” in PENZA PHARMA. Furthermore, the weak distinctive character of one element of a mark does not necessarily mean that that element will not be taken into consideration by the relevant public. The addition of the word “pharma” to the word “pensa” in the contested mark necessarily gives rise to a visual difference between it and the word “pentasa”. That is a fortiori the case because the element “pharma” has a greater number of letters than the element “pensa” (Paras. 75-78). On the other hand, it is important to bear in mind the distinctive and dominant elements of the marks at issue in the overall impression created by them. The dominant element visually in the mark PENZA PHARMA is the element “pensa” (Para. 81). The sequence of letters “ta” in the middle of the earlier mark does not make it possible to disregard any visual similarity between the marks at issue. On the one hand, the word “pensa” and the word “pentasa” have the same letters occupying a similar position at the beginning and the end of the words and, on the other hand, they have the same first part which is likely to catch the consumer's attention more than the parts that follow (Para. 83). Thus there is a certain degree of similarity between the marks at issue (Para. 84). As to the applicant's arguments, the protection which results from the registration of a word mark relates to the word mentioned in the application for registration and not to any specific graphic or stylistic elements that that mark might have (Para. 88). Regarding the figurative mark pensa, the positioning and the shape of the

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law



figurative element cannot differentiate it sufficiently from the earlier mark, inasmuch as that element consists only of a circular shape surrounding the first letter and a font in a different colour (Para. 95). Regarding the phonetic comparison, the consumer generally pays more attention to the beginning of a sign (Para. 102). The public will focus its attention on the element "pensa" in the contested mark and presumably will not be the word "pharma", inasmuch as that word is superfluous because of the nature of the goods and services covered by the contested mark (Para. 107). On conceptual level, the GC rejected the argument of the applicant that "pentasa" will be understood by the relevant public as derived from Greek word "penta", since suffix "asa" has no conceptual meaning which might be clearly linked to a concept connected with the number 5 (Paras. 114-117). While providing a summary chart of Case-Law, the applicant failed to explain to what extent each of the judgments would be capable of showing that there is no likelihood of confusion in the present case (Paras. 123-125).

The comparison of the goods must relate to the description of the goods covered by the earlier mark and not to the goods for which the trade mark is actually used unless, following a request for proof of genuine use of the earlier mark, such proof is furnished only in respect of some of the goods or services for which the earlier mark is registered (Para. 128). Also, the Office may only take account of the list of goods applied for as it appears in the trade mark application concerned, subject to any

amendments thereto (Para. 130). The medical services and consultancy in the field of pharmacy in Class 44 are complementary to the pharmaceutical preparations in Class 5 (Para. 136). The goods and services at issue are identical or similar (Para. 137). Under the global assessment, the GC finds that the low degree of visual similarity between the signs at issue is offset by the identity or similarity of the goods or services which they cover and the highly distinctive character of the earlier trade mark (Para. 148). Further, even if the relevant public consists of persons whose level of attention may be considered to be high, in the present case that is not sufficient, given the similarity between the goods and the signs at issue, to exclude the possibility that that public might believe that those goods come from the same undertaking or, as the case may be, from economically-linked undertakings. That is particularly so if the earlier mark is highly distinctive (Para. 152). Based on the foregoing, the second plea was rejected.

**Case T-193/12; MIP Metrov OHIM; Judgment of 22 January 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Letter mark, Visual similarity, Phonetic identity, Conceptual similarity, Identity of the goods and services, Admissibility, Figurative trade mark, Likelihood of confusion, Right to be heard

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM among others for goods within Class 32. The opposition based on the earlier mark represented below and registered for good in Class 32 was uphold and confirmed by the Board of Appeal (BoA). The CTM applicant filed an action to the General Court (GC) claiming the infringements of Article 8 (1) (b) and Article 75 CTMR.

### CTMA



### Earlier mark



**SUBSTANCE:** The GC dismissed both pleas in law. The documents filed for the first time in the proceedings before the GC are inadmissible (Para. 17). With regard to Article 8 (1) (b) CTMR, the identity



of the goods “beers” is not under dispute (Para 24). The marks are visually similar. The CTM application takes over the part of the earlier mark that contains a word element (Paras. 29, 39). For the public that pronounce only the word element in the marks those are phonetically identical (Para. 44). The marks are conceptually similar, due to their heraldic connotations (Para. 45). There exists a likelihood of confusion (Para. 58). The claimed infringement of Article 75 CTMR shall be rejected. The BoA listed all factual and legal arguments for its decision (Para. 63).

**Case T-186/12; Copernicus-Trademarks Ltd v. OHIM + Maquet SAS; Judgement of 25 June 2015;**  
**Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Filing date, Priority, Right to be heard, Substantiation of earlier right, Admissibility, Fee, Competence of the Boards

**FACTS:** The CTM applicant filed an application for the word mark LUCEA LED for goods in Class 10. The Opponent relied on the earlier CTM LUCEO and claimed priority for the mark LUCEO filed with the Austrian Patent Office for the same goods. The Opposition Division (OD) upheld the opposition. The CTM applicant filed an appeal against the OD's decision. The Board of Appeal (BoA) upheld the

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

appeal, annulled the OD's decision and rejected the opposition. It found that the mark on which the opposition was based was not earlier than the mark applied for, considering the filing date and the fact that the right of priority for the mark on which the opposition was based had not been validly claimed. The Opponent brought an action before the General Court (GC).

### CTMA

**LUCEA LED**

### Earlier mark

**LUCEO**

#### SUBSTANCE:

##### A ON THE ADMISSIBILITY OF THE ACTION

The CTM Applicant claimed the inadmissibility of the appeal since the mark on which the opposition was based no longer belongs to the Opponent. The GC preferred considering the merits without first ruling on the admissibility of the action since the action is unfounded (Para. 29).

##### B ON THE MERITS OF THE ACTION

**FIRST PLEA IN LAW: infringement of Article 76 (2) CTMR**



The GC rejected the argument. It considered that the CTM applicant disputed the priority claim for the mark on which the opposition was based and its precedence as pre-dating the mark applied for by arguing that (i) the priority claim was vitiated by a number of errors, (ii) that only the date of the application for registration of that mark could therefore be taken into account, (iii) that the claim was based on the application for an Austrian mark and (iv) that the opponent had paid the filing fee for that mark only after it had lodged its application for registration of a Community trade mark (Paras. 36-41).

#### **SECOND PLEA IN LAW: infringement of Article 75 (right to be heard)**

The GC rejected the argument, considering that the BoA was not obliged to inform the opponent on the final position which the BoA intends to adopt and that, in any case, the opponent was authorized to submit observations during the proceeding before the BoA (Paras. 90-91 and 98).

#### **THIRD PLEA IN LAW: infringement of Articles 1 and 2 of Decision No EX-05-5 (Substitution of priority certificates by information from Internet sites and procedure)**

The GC rejected the plea in law: the BoA did not err in concluding that the conditions laid down in Decision No EX 05 5 had not been satisfied, without it being necessary to rule on the question whether the search engine offered by the private

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

undertaking controlled by the Austrian IPO could be considered to be part of that IPO's Internet site within the meaning of the Decision (Paras. 69-75). Furthermore, the BoA did not have the competence to ask the Austrian IPO for submitting the priority documents required (Para. 82).

### FOURTH PLEA IN LAW: infringement of Articles 41 and 42 CTMR

The GC stated that the BoA did not err in examining whether the conditions for the priority claim were satisfied: the BoA is entitled to examine the validity of the priority claim in the context of opposition proceedings and call into question the validity of information entered in the register (namely the priority date) (Paras. 54-58). In particular the GC highlighted that the case law according to which the validity of a CTM cannot be challenged in the context of opposition proceeding cannot be transposed to a claim for priority in respect of such mark (Paras. 48-54).

### FIFTH PLEA IN LAW: bad faith

The GC rejected the fifth plea in law alleging that the BoA took account of opponent's bad faith, even though such a matter cannot be taken into consideration in opposition proceedings: since the contested decision is based on the finding that the mark applied for was earlier than the mark on which the opposition was based, the priority claim for the latter mark had to be rejected.



**Case T-548/12; Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM; Judgment of 08 July 2015; Language of the case: CS**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Similarity of the signs, Common element, Weak element, Distinctive element, Visual similarity, Phonetic similarity, Conceptual similarity, Descriptive element, Laudatory mark

**FACTS:** The applicant registered the figurative mark represented below as a CTM for goods and services within Classes 1, 2, 17, 19 and 37. An application for invalidity was filed on the grounds of Article 53 (1) (a) CTMR in connection with Article 8 (1) (b) CTMR. It was based on the earlier word marks represented below, registered for goods and services in Classes 1, 6, 7, 8, 17, 19, 37 and 42. The Cancellation Division dismissed the application for invalidity. The Board of Appeal dismissed the invalidity applicant's appeal. The invalidity applicant filed an action before the General Court.

**SUBSTANCE:** According to the previous final judgment T-146/08, there is no likelihood of confusion between REDROCK and ROCK (Para. 16). The degree of attention of the relevant public will be high (Para. 24). Concerning the signs REDROCK vs. KEPROCK, the common element "ROCK" has a low degree of distinctiveness (Para 49). Despite a low

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



### CTMA

**REDROCK**

### Earlier marks

**ROCK, KEPROCK, FLEXIROCK, FORMROCK, FLOOR-ROCK, TERMAROCK, KLIMAROCK, SPEEDROCK, DUROCK, SPLITROCK, PLANAROCK, TOPROCK, KLEMMROCK, FIXROCK, SONOROCK PLUS, VARIROCK, SONOROCK, MASTERROCK**

degree of visual similarity and an average degree of aural similarity, there is no likelihood of confusion (Para. 80). Regarding the remaining earlier trade marks, there is at most a low degree of visual, aural and conceptual similarity. The differences between the marks are sufficient to avoid likelihood of confusion (Para. 88). FAMILY OF MARKS: The element "ROCK" is broadly descriptive and laudatory and, therefore, cannot represent a common element on which a family of trade marks could be based (Paras. 93-98). In addition, the invalidity applicant failed to prove use of the family of marks (Paras. 99-103).

**Case T-184/13 Skype Ultd. v OHIM; Judgment of 5 May 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Relative grounds, Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Conceptual similarity, Beginning of mark, Identity of the goods and services, Allusive trademark, Enhanced distinctiveness, Coexistence of trademarks, Dilution of distinctiveness, Weak element, Distinctive element, Relevant territory

**FACTS:** An application was filed for the word mark 'SKYPE' for a range of goods and services in Classes 9, 38 and 42. An opposition was filed pursuant to Articles 8 (1) (b), 8 (4) and 8 (5) CTMR based on, inter alia, the earlier CTM SKY for a range of goods and services in Classes 9, 38, 41 and 42. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the appeal.

### CTMA

**SKYPE**

### Earlier marks

**SKY**

## First Page

■ New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



**SUBSTANCE:** The General Court (GC) dismissed the appeal. It found that the relevant public consists of the public at large and professionals (Para. 22). The average consumer of the contested peer-to-peer communication services, although choosing those services with care, will have an average degree of attention (Paras. 23-24). The services are identical (Paras. 26-27). The signs are visually and phonetically similar to a medium degree (Paras. 34-38). They are also similar on a conceptual level, since the possibility cannot be ruled out that the relevant public will recognise the term 'sky' in the mark applied for (Para. 39). The earlier mark SKY has an enhanced distinctiveness in the United Kingdom for "apparatus for recording, transmission or reproduction of sound and images" in Class 9, "telecommunications" in Class 38 and 'entertainment' in Class 41 (Paras. 45-46). The alleged "secondary meaning" of the contested mark SKYPE (i.e. a link that would be established by consumers between that sign and the namesake applicant's provision of the services) does not translate into a conceptual content that could offset the existing similarities. On the other hand, in the event that the term 'SKYPE' had actually acquired a meaning of its own for identifying the services covered by the mark applied for, it would be a generic term, and therefore a descriptive one, for that type of service (Para. 49). The GC recalled the established Case-Law to the effect that the (possible) recognition of the mark applied for cannot be taken into account when determining whether there is a likelihood

of confusion between two marks (Para. 50). With regard to the alleged "dilution" of the earlier SKY mark, the GC noted that the applicant limited itself to general and unsubstantiated allegations and that it referred merely in an abstract way to the "evidence" it provided. The GC stressed that it is not for the GC to research and identify which documents within the case file could serve as the basis of the applicant's arguments (Para. 54). Even if it were accepted that the earlier mark SKY is inherently weakly distinctive for television broadcasting services and for goods in Class 9 directly related to those services, this limited distinctiveness would be overridden by its acquired enhanced distinctiveness for those same goods and products, on account of its recognition by the relevant public (Para. 55). The applicant's argument based on a supposed peaceful coexistence between the marks was rejected (Paras. 57-64). The GC confirmed the existence of a likelihood of confusion for the relevant public in the United Kingdom, even taking into account a higher level of attention on the part of the relevant public (Paras. 65-66).

**Case T-78/13; Red Bull GmbH, v OHIM; Judgment of 5 February 2015; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Conceptual similarity, Identity of goods and services, Likelihood of confusion; Similarity of the signs, International registration, Visual similarity, Phonetic similarity, Common element

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**FACTS:** An opposition has been filed against the CTMA BULLDOG (word mark) for goods in Classes 32 and 33 based inter alia on earlier International Registration BULL (word mark) having effect in the EU and covering goods in Class 32. The opposition was based on Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division upheld the opposition based on Article 8 (1) (b) CTMR. The Board of Appeal (BoA) reversed the First Instance decision. It considered in particular that the conceptual differences would neutralize the visual and aural similarities rendering the signs overall dissimilar. Consequently, it dismissed the opposition. The opponent (applicant before the General Court (GC)) filed an appeal, arguing an infringement of Article 8 (1) (b) CTMR.

CTMA
<b>BULLDOG</b>
Earlier International Registration
<b>BULL</b>



**SUBSTANCE:** The goods were found identical (undisputed) (Para. 25). The consumers are held to be the general public with an average degree of attention (Para. 24).

Comparison of the signs:

With regard to the visual comparison the GC found that the earlier mark is fully included in the beginning of the contested mark. The four letters "BULL" constitute also the majority of the seven letters of the contested application. Since the beginnings of the marks are in principle more important than the endings of the signs, there is a medium degree of visual similarity and not a low degree as stated in the contested decision (Paras. 31-32).

Similarly, the GC considered that the fact that the earlier mark is fully contained in the pronunciation of the first syllable of the contested sign is sufficient to rule out the assessment of the BoA which held the marks to be aurally similar in a low degree. However, the second syllable of the application may not be neglected, as claimed by the applicant. The goods are not only sold in noisy ambiances as bars but also in supermarkets and retail stores. Consequently, there is an average degree of phonetic similarity (Paras. 37-39).

The most important aspect in this case refers to the conceptual comparison of the signs. The BoA found that for the public who will understand at least the meaning of the term, "BULLDOG" this meaning will neutralize the visual and aural similarities and avoid any likelihood of confusion.

The GC had a very different approach. First of all, it

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal





## Case law

distinguished - as the BoA did - between the English speaking public which will understand the meaning of both signs, BULL and BULLDOG and the non-English speaking public which will only understand the meaning of "BULLDOG" (Para. 47).

For the latter group of consumers there cannot be made any conceptual comparison of the marks because one of the signs has no meaning (Para. 48). For those consumers that understand the meaning of both marks and in spite the fact that they denote two different animals, the GC held that they convey the image of animals with a concentrated force, a great muscular force expressing itself often aggressively towards others. Therefore it concluded that for those consumers there would be a low degree of conceptual similarity (Para. 50).

Overall assessment on likelihood of confusion

The different approach taken by the GC in the conceptual comparison had a direct impact on the overall assessment of LOC. Since for one part of the public the conceptual comparison has no impact and for another relevant part the signs are conceptually even similar in a low degree, the conceptual comparison cannot neutralize the visual and aural similarities anymore as found by the BoA. Since the marks are similar and the goods identical, the GC found that there is likelihood of confusion (Para. 60).



**Case T-654/13; Gako Konietzko GmbH v OHIM; Judgement of 16 June 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Three dimensional mark, Distinctive element, Shape of the product, Specialised public, Packaging, Principle of legality

**FACTS:** The applicant sought to register the three-dimensional mark displayed underneath as a CTM for goods in Classes 3, 5 and 10. The examiner refused the application in its entirety based on Article 7 (1) (b) CTMR. The Board of Appeal (BoA) confirmed the decision. It found that neither the individual features of the sign applied for, nor their combination constituted a significant deviation from the norms common in the sector. Furthermore, the colours red-white were deemed common in the relevant (medical) sector. Therefore, neither the arrangement nor the individual features convey an overall impression that could lead to the acceptance of the sign as a distinctive trade mark. The fact that the sign has been accepted for registration in Poland and Germany does not alter this finding, as the CTM system is autonomous and independent from national jurisdictions.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7 (1) (b) CTMR and of the principle of equal treatment.

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

### CTMA



**SUBSTANCE:** The GC emphasised at the outset that the criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks (Para. 20). However, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products in Classes 3 or 5 on the basis of their shape or the shape of their packaging in the absence of any graphic or word element (Paras. 23-25).

Cylindrical shapes with a lid are common for



products of beauty care. The fluting around the lid is merely a common technical feature to facilitate its opening (Para. 28). The only feature of the sign which departs from the usual form is the additional smaller lid on top of the main lid. Even if this feature was to be considered uncommon, it would not be sufficient in itself to convey an overall impression significantly departing from the norm in the sector. The “double lid” is merely a variant of a common feature of containers for creams and liquids prepared in pharmacies (Para. 30). It is immaterial in this regard whether the “double lid” conveys a new, innovative concept. What matters is whether the mark as applied for is distinctive or not (para. 32). Further, the colour combination red/white is not uncommon in the medical/cosmetic sector, where white symbolizes hygiene and red symbolizes warnings (Para. 31). From the fact that the relevant public, which partly consists of highly attentive specialists with regard to goods from the medical sector (pharmacies), it cannot be inferred that this high attentiveness also expands to the packaging of the goods at stake. The public - even the highly attentive one - will generally focus rather on the label rather than on the form/packaging, when confronted in particular with liquids, which cannot be sold without packaging (Para. 34). Finally, it has not been proved by the applicant that the public in the medical sector (like in the sector of washing/cleaning preparations or drinks) has become accustomed to recognising the form of the goods as an indicator of origin (Para. 37).

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## Case law



With regard to the prior national (Polish and German) registrations of the same mark and the claimed violation of the principle of equal treatment, the GC notes that the BoA is not bound by national decisions, as the CTM system is autonomous and independent from national jurisdictions (Para. 46). Based on the foregoing, the action was dismissed.

**Case T-137/13; Saferoad RRS v OHIM; Judgement of 28 April 2015; Language of the case: DE**

**RESULT:** Action dismissed

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

**FACTS:** The applicant sought to register the word mark MEGARAIL as a CTM for goods and services in Classes 6, 19 and 37. The examiner refused the application in its entirety based on Article 7(1)(b) and (c) CTMR. The Board of Appeal (BoA) partly annulled the examiner's decision, but upheld the decision for the majority of goods and services, namely all those related to "crash barriers and guardrails". For these goods and related services the CTMA was found to be descriptive and non-distinctive. The relevant consumers are undisputedly English speaking professionals in the public sector, concerned with the acquisition of road security. "MEGA" will be

understood either as a particular size (of Greek origin) or in a meaning of "big in importance or size", "RAIL" refers to a track or fence. The composition MEGARAIL in the context of the particular goods and services of road safety will be understood as denoting their size or high quality. It is descriptive and, thus, also devoid of distinctive character for the relevant goods and services.

The applicant filed an action before the General Court (GC), claiming a violation of Article 7(1)(c) and (b) CTMR.

CTMA

**MEGARAIL**

**SUBSTANCE:** With regard to the BoA's finding that "MEGA" can be understood as "particularly good", the GC confirmed that this meaning - despite belonging to informal "slang" language - has become customary in trade and therefore will be understood by the relevant public with this meaning. This understanding is not in contradiction with the technical nature of the goods and the conservative language expectations the public might generally have when safety products are at stake. Those expectations can become only relevant when specific technical features (e.g. the size) are concerned, but not, if the element refers to the nature of the goods in a general way (Para. 44).

For Article 7(1)(c) CTMR to apply it is not necessary

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

that a specific technical feature of the goods is described, it is sufficient that the mark can serve to describe the nature of the goods (Para. 48). The public will understand MEGARAIL as a reference to particularly good crash barriers or guardrails (Para. 51).

As far as the applicant claims that the Office has previously accepted very similar marks such as MEGARAILER, MAXIRAIL, EASYRAIL or SUPERRAIL, the GC notes that the principle of equal treatment must be consistent with the principle of legality. For reasons of legal certainty and sound administration the examination of any trade mark application must be stringent and full in each individual case (Paras. 57-61). That being said, the mentioned cases display a number of differences to the case at issue: MEGARAILER contained further letters ("-ER"), which might have had an impact on the distinctiveness on the mark; furthermore the specification was different. The remaining cited signs were figurative marks and not word marks. Therefore, these cases are not comparable to the case at hand (Paras. 61-66).

As one ground for refusal [Article 7 (1) (c) CTMR] is sufficient for the refusal of the mark, it is not necessary to examine the second ground invoked by the applicant, namely Art. 7(1) (b) CTMR (Para. 68).

Based on the foregoing, the action was dismissed.



**Case T-227/13; Bayer Intellectual Property GmbH v OHIM; Judgment of 27 February 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Identity of the goods and services, Visual similarity, Phonetic similarity, Conceptual dissimilarity, Likelihood of confusion, Relevant territory, Similarity of the signs

**FACTS:** The applicant sought to register the word mark INTERFACE as a CTM for goods within Class 5. An opposition based on the earlier word mark Interfog, registered for goods in Class 5, was filed on the grounds of Article 8 (1) (a) and (b) and (5) CTMR. The Opposition Division upheld the opposition affirming the likelihood of confusion. The Board of Appeal (BoA) dismissed applicant's appeal. The CTM applicant filed an action to the General Court (GC) claiming an infringement of Article 8 (1) (b) CTMR.

**CTMA**

**INTERFACE**

**Earlier mark**

**Interfog**

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**SUBSTANCE:** The GC dismissed the action confirming the likelihood of confusion. The relevant public is that of the European Union (EU) (Para. 20) that level of attention is high, as the goods concerned may contain toxic substances (Para. 22). The goods covered by the marks at issue are identical. The “fungicides” and “herbicides” covered by the earlier mark fall into the broader category of “preparations for destroying plants” covered by the mark applied for (Para. 27). The marks have an average degree of visual and phonetic similarity. The earlier mark does not have any clear and determinate meaning (Para. 41), the mark applied for is composed of the English word “interface”, which is a technical term used particularly in the field of information technology and has a semantic content not only in English but also in other EU languages (Para. 42). The BoA ought to have concluded that there is a certain conceptual difference between the marks at issue (Para. 43). The overall comparison of the marks at issue reveals certain similarities between them which cannot be ignored and cannot be invalidated by the error vitiating the BoA’s reasoning with regard to the conceptual comparison of the marks at issue. The conceptual difference which exists between the marks at issue is liable to escape the attention of the relevant public. Consequently, it must be held that the conceptual content of the mark applied for is not such as to neutralise the visual and phonetic similarities which exist between the marks at issue (Paras. 47 and 48).



### **Case T-657/13; BH Stores BV v OHIM; Judgment of 2 July 2015; Language of the Case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Lack of reasoning, Legitimate expectations, Principle of legality, Likelihood of confusion, Dissimilarity of the goods and services, Nature of the goods and services, Purpose of the goods and services, Complementary goods and services, Evidence of use

**FACTS:** The applicant sought to register the word mark ALEX as a CTM for goods in Classes 16, 20 and 28. An opposition based, among others, on the earlier word mark ALEX, registered in Germany for goods in Class 28 was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) confirmed the OD’s decision and dismissed the appeal. The BoA found, in particular, that the contested “children’s bath toys and children’s educational and developmental activity toys”, covered by the mark applied for, are not similar to “sporting articles”, covered by the earlier marks. The BoA relied upon that finding of dissimilarity of the above goods on the judgment of 4 June 2013, in case T-514/11, (BETWIN). As a consequence, the BoA found that there was no likelihood of confusion between the signs at issue. The opponent filed an action before the General Court (GC), alleging two pleas in law: the infringement of the obligation to

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM’s European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



state reasons, provided for in Article 75 CTMR and the infringement of Article 8 (1) (b) CTMR. The GC dismissed the appeal.

ADMISSIBILITY: 1) ADMISSIBILITY OF THE APPEAL: The applicant (intervener before the GC) claims that the appeal was inadmissible since the opponent filed the grounds of its appeal on 7 February 2013, after expiry of the period prescribed by Article 60 CTMR, a period which, according to the applicant, expired on 4 February 2013. The GC confirmed that reference must be made to Article 7 (4) of Decision No EX-I 1-3 of the President of the Office of 18 April 2011 concerning electronic communication with and by the Office which was applicable at the time the decision of the OD was given. According to that Article, "without prejudice to accurate establishing the date of notification, notification shall be deemed to have taken place on the fifth calendar day following the day on which the document was created by the Office's systems". The GC confirmed that the date of the OD's decision is 3 October 2012, as argued by the Office, and therefore the creation of the document by the Office's systems under Article 7 (4) of Decision No EX-11-3 could not have taken place before then. Therefore, under Article 70 (1) and (2) of CTMR, read in conjunction with the last sentence of Article 60 CTMR, in the present case the time-limit for lodging a statement of grounds of appeal accordingly expired on 8 February 2013 at the earliest. As a consequence, the BoA was right to declare the appeal admissible and the applicant's plea alleging the inadmissibility was rejected (Paras. 19-22).

2) ADMISSIBILITY OF EVIDENCE SUBMITTED FOR THE FIRST TIME BEFORE THE GC: In relation to the applicant's argument that the evidence filed by the opponent for the first time before the GC has to be disregarded, the GC recalled the Case-Law according to which the purpose of actions before the GC is to secure review of the legality of decisions of the BoAs for the purposes of Article 65 CTMR and, accordingly, the role of the GC is not to re-evaluate the factual circumstances in the light of evidence which has been produced for the first time before it. For this reason a part of the evidence was not taken into consideration. The GC found, however, that Annexes 13 and 19 to the application, although produced for the first time before the GC, are not strictly evidence but relate to the Office's usual practice in reaching decisions and to the Case-Law of the EU judicature to which a party has the right to refer, even after the procedure before the Office is complete. Therefore, the GC found that evidence as admissible according to the relevant Case-Law (Paras. 24-26).

CTMA
<b>ALEX</b>
Earlier mark
<b>ALEX</b>

## First Page

- New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015
- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law



**SUBSTANCE:** By its first plea in law, the applicant claims that the BoA infringed its obligation to state reasons as provided by Article 75 CTMR in that it merely referred to the cited judgment of the GC in case T-514/11, (BETWIN), by partly copying (Paras. 36 to 38) of that judgment, and concluded that the goods at issue were dissimilar, without examining whether the facts and the reasoning underlying that judgment were also applicable to the present case. The GC reminded the Case-Law that the question whether the statement of reasons for a decision satisfies the requirements provided by Article 75 CTMR and Article 296 TFEU must be assessed with reference not only to its wording but also to its context and the whole body of legal rules governing the matter in question. According to the same Case-Law, the BoAs are not required to provide an account which follows exhaustively and point by point all the arguments put forward by the parties before them. The reasoning may therefore be implicit, on condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent GC with sufficient material for it to exercise its power of review (Paras. 29-31). The GC found, that in the present case, the BoA clearly set the relevant facts and the legal considerations having decisive importance in the context of the contested decision and that they inform the applicant of the justification for the contested decision so that it can protect its rights and enable the EU judicature to exercise its power to review the legality of the decision.

Moreover, there is nothing in principle to prevent the BoA from following the reasoning of a judgment of the EU judicature, if it considers that it applies to the case in question. Therefore, although it is true that the BoA drew heavily on (Paras. 36 to 38) of the judgment in the (BETWIN) case, it nevertheless clearly identified the facts and reasoning underlying that judgment which, in its opinion, were applicable to the present case (Paras. 32-37). Next, having regard to the applicant's complaint that the BoA breached its obligation to take into consideration the previous Case-Law of the Office, the GC found that, given that the BoA had sufficiently set out the facts and the legal considerations of decisive importance in the contested decision, it was not required to give specific reasons in order to justify its decision relating to the Office's earlier decisions. With particular reference to the judgment in case T-250/10 of 16 September 2013, (KNUT), the BoA cannot be required to comment on every judgment of the EU judicature (Paras. 41-44).

**ON THE COMPARISON OF THE GOODS:** The GC found that, as far as the NATURE of the goods is concerned, the fact that the "sporting articles" covered by the earlier marks and "toys" covered by the mark applied for may be composed of the same materials is not in itself sufficient to establish that the goods are similar, given the wide variety of goods which can be made of leather, plastic, wood or metal. The same material can be used to manufacture a wide range of totally different goods (Para. 58). Secondly, contrary to what the applicant claims, the

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law



existence of a simplified form and a reduced size for “children’s educational and developmental activity toys” makes it possible precisely to distinguish them from, and not to confuse them with, “sporting articles”. In the present case, “children’s educational and developmental activity toys” are aimed at relatively young children and can be distinguished from “sporting articles” (even if they imitate them) by a lower level of technicality, a different appearance (reduced size, light weight), safety appropriate for children in accordance with Directive 2009/48/EC of the European Parliament and of the Council of 18 June 2009 on the safety of toys (OJ 2009 L 170, p. 1) and a generally lower price. That reasoning applies a fortiori to “children’s bath toys” which have no sporting equivalent (para. 59). Thirdly, as can be seen from the judgment in (KNUT), cited before, in principle there is NO RELATIONSHIP OF SUBSTITUTABILITY OR COMPLEMENTARY between, on the one hand, “gymnastic and sports articles not included in other classes” in Class 28 and, on the other, “toy dolls, games; toys; stuffed plush animals” in the same class, in that the goods in question have a DIFFERENT PURPOSE. While “gymnastic and sports articles” are intended specifically for physical fitness, the function of “games, like toys”, is in principle to entertain. The fact that one purpose (for example, physical exercise) does not exclude another purpose (for example, entertainment) and that both purposes may be “interconnected” in a product, does not rule out the possibility of identifying a dominant, or in other word “PRIMARY”

PURPOSE OF A PRODUCT: The term “use” means the generally intended use of the product and not any diverted or occasional use. A “FLUID TRANSITION” or an area of overlap between two categories of goods with essentially different purposes does not mean that all the goods concerned by those categories of goods are similar (Paras. 63-65). Furthermore, since the nature and intended purpose of the goods covered by the marks at issue are different, they are NOT INTERCHANGEABLE and are therefore NOT COMPETING (Para. 74). Although sometimes, depending on the circumstances, there may be some interchangeability between the goods at issue, this occurs only in one sense, that is to say only the consumers of some toys covered by the mark applied for are likely to resort to the corresponding “sporting articles” covered by the earlier marks in the event of an increase in the price of those toys. The overlap in the consumers of the goods at issue, namely children and adults, it is not sufficient in itself to establish a similarity between goods, since all goods which are AIMED AT THE SAME CONSUMERS are not necessarily identical or similar (Paras. 78-79). With regard to the MANUFACTURE AND DISTRIBUTION CHANNELS of the goods covered by the marks at issue, the GC found that these are different. Although it is possible that “sporting articles”, on the one hand, and “children’s bath toys and children’s educational and developmental activity toys” on the other, are produced by the same undertakings and offered through the same distribution channels, such

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM’s European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law



phenomena are marginal and cannot, without other evidence in support, lead the GC to take the view that those two categories of goods share the same distribution channels. Finally, the fact that the goods in question may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant, since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (Paras. 88-83). As regards the opponent's argument that the BoA failed to take into account the Office's consistent practice confirming that there is a similarity, at least tenuous, between "sporting articles and toys, games and playthings", the GC found that the decisions put forward by the parties reveal only the existence of a not entirely consistent decision-making practice on the part of the Office. The GC recalled the Case-Law according to which the Office is under a duty to exercise its powers in accordance with the general principles of EU law, such as the principles of equal treatment and sound administration. Therefore, the Office must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. Those two principles must however be reconciled with the principle of legality. Consequently, no party to proceedings before the Office may rely, to his advantage and in

order to secure an identical decision, on an unlawful act committed to the benefit of someone else. Furthermore, the examination of any trade mark application must be stringent and full, and must be undertaken in each individual case. Therefore, the BoA did not err in finding that the goods at issue were different. (Paras. 89-91). In relation to the opponent's argument that the national trade mark offices within the EU, (more specifically the German Federal Patents Court) relied on in the judgment in (KNUT) and found those goods as similar, the GC reminded that the Community trade mark regime is an autonomous system that applies independently of any national system. In addition, the reasoning based on the judgment in (KNUT) cannot be transposed to the present case (Paras. 92 and 93). In the light of above, The GC concluded that in the contested decision it was rightly found that the goods at issue were different, thereby stating clearly that there was no similarity between them. Therefore, the BoA was fully entitled to find that there could be no likelihood of confusion, even taking into account the identity of the signs, since an essential condition for the application of Article 8 (1) (b) CTMR, that is to say the identity or similarity of the goods, was not met (Para. 97).

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## Case law

**Case T-453/13; Horst Klaes GmbH & Co. KG v OHIM; Judgment of 12 February 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Common element, Complementary goods and services, Figurative trade mark, Figurative element, Likelihood of confusion, Nature of goods and services, Visual identity, Phonetic identity, Similarity of the goods and services, Similarity of the signs, Specialised public, Statement of grounds, Visual similarity

**FACTS:** The applicant sought to register the word mark Klaes as a CTM for goods and services among others within Class 42 with a following description: Updating of computer software; User management and authorisation on computer networks; Consultancy in the field of computers; Computer system analysis; Software design services; Design of computer systems; Computer programming; Electronic data security; Design and development of computer software; Computer animation (programming); Computer programming; Hardware and software consultancy; Implementation of computer programs on networks; Installation of computer programs; Configuring computer networks by means of software; Conversion of computer programs and data (other than physical alteration); Duplication of computer programs; Maintenance and installation of software; Server



administration; Rental of computer software; Restoration of computer dates; Recovery of computer data the “contested goods”. An opposition based on the earlier figurative mark represented below was filed on the grounds of Article 8 (1) (b) CTMR in relation to services registered in Class 42 with to following description: Scientific and technological services and design and engineering relating thereto in the field of the development and manufacture of goods of plastic, and tool development relating thereto. The Opposition Division upheld the opposition. The Board of Appeal dismissed applicant’s appeal finding a high degree of similarity between the signs and a complementary link between the goods at issue. The applicant filed an action before the General Court (GC).

### CTMA

**Klaes**

### Earlier mark

**Klaes**

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

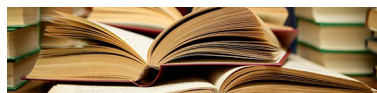
■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

**SUBSTANCE:** The GC firstly recalls in relation to Article 44 (1) of Procedural Rules that a general reference to other documents cannot compensate the lack of essential elements of the pleas in law which must appear in the action itself (Para. 14). Further, in regards to the substance, the GC finds that the earlier mark composes of the same word element as the contested mark and that the figurative elements of the earlier mark would not be considered as original. Thus the marks are visually almost identical. Phonetically, they are identical and, since the word element has no meaning, the conceptual comparison is not possible. Overall, the marks are similar to a high degree (Paras. 25-26). Within assessment of the similarity of the services covered, the GC confirms existence of complementarity between them and thus certain similarity. The GC finds that while the disputed services are distinct in nature, the fact remains that there is no reason, in the absence of evidence to the contrary, to exclude the fact that the tasks set by the signs in question can enter the range of services that can be provided by the same type of business. It cannot be excluded that a company specializing in technology services and tools in the development and manufacturing of plastic products can also have an expertise in creating new software and updates software. In the absence of contrary evidence, the services at issue can be matched by their destination and use (Para. 34). The LOC was found despite advanced attention of the specialised public (Para. 37).



**Case T-215/13; Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM; Judgment of 15 July 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Revocation grounds, Evidence of use, Figurative mark, Right to be heard, Complementary evidence, Declaration, Nature of use, Use not as registered, Extent of use, Sales figures, Distinctive element, Enhanced distinctiveness, Functionality continuity

**FACTS:** The Office registered the figurative trademark



in respect of “insulating materials” in Class 17 and “building materials (non-metallic)” in Class 19. Following an application for revocation of the contested mark based on Article 51 (1) (a) CTMR, and the submission of evidence of use, the Cancellation Division (CD) partially revoked the rights of the CTM owner as regards “building materials (non-metallic)”, with the exception of “building materials having insulating properties” in Class 19. By contrast, it rejected the application for revocation in respect of the goods in Class 17. On appeal, the Board (BoA) upheld the appeal in part by revoking the contested

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

mark in respect of all of the goods in Class 19. By contrast, it confirmed the CD's assessment as regards the goods in Class 17.

### CTM



**SUBSTANCE:** ON THE ALLEGED INFRINGEMENT OF ARTICLE 51 (1) (a) CTMR: The General Court (GC) confirmed the findings of the BoA. As to the extent of use requirement, the GC found that the contested sign appears on the CTM owner's website and on pictures of the goods at issue, as well as in advertising material, where it is used in association with, among others, the word marks **EUROFLOOR**, **EUROTHANE**, **EUROWALL**, **POWERDECK**, and **POWERROOF** or as replacing their first letter "o", i.e .

**EURλFLOOR, EURλWALL  
PλWERDECK, PλWERROOF  
EURλTHANE,**

which are also registered in the name of the CTM owner. The BoA rightly found that the goods at issue had been marketed under the contested mark, on the basis of a declaration of an external auditing undertaking. That declaration was the outcome of a check which the external auditing



undertaking carried out on a sample of randomly selected invoices relating to the relevant period. Furthermore, the result was compared with the turnover in the CTM owner's accounting software (Paras. 40-54). Turning to the nature of use requirement, the GC noted that the use of the word marks in question in which the contested figurative mark is incorporated (as shown above) reflects the commercial need of being able to refer to that mark orally without its losing its distinctive and recognisable character (Para. 56). The contested mark does not lose its distinctive character since it is rather a juxtaposed element, which is substituted for a letter, retains its independence and does not constitute a unit in connection with those other marks. The Greek letter lambda in white written in a red circle also confers enhanced distinctiveness on the word marks of which it is part (Para. 57). The BoA exercised its discretion by taking into account the above mentioned declaration of the external auditing undertaking, although it had been filed after the expiry of the time-limit set. ON THE ALLEGED INFRINGEMENT OF ARTICLE 75 CTMR: Although the CD had infringed the invalidity applicant's right to be heard by not giving it the possibility to submit its observations on the belatedly filed above declaration, the fact remains that the invalidity applicant was able to submit its observations in that respect before the Board, which duly took them into consideration before adopting the contested decision. Consequently, in accordance with the principle of functional continuity, the BoA was able to correct that irregularity (Paras. 73-80).

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**Case T-278/13; Now Wireless Ltd v OHIM; Judgment of 30 January 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Evidence of use, Extent of use, Place of use, Proof of use, Proprietor consent, Relevant territory

**FACTS:** The application for the revocation of the figurative CTM NOW registered for goods in Classes 35, 41 and 42 and limited later to goods in class 42 due to non-use was rejected by the Cancellation Division and confirmed by the Board of Appeal (BoA).

The cancellation applicant filed an action to the General Court (GC) claiming an infringement of Article 51 (1) (a) and/or Article 51 (2) CTMR.

CTM



**SUBSTANCE:** The GC dismissed the action. It observed that the single plea in law, alleging infringement of Article 51 (1) (a) and/or Article 51 (2) CTMR, concerning the genuine use of the mark, consists in essence of four parts, alleging: (i) use of the contested mark has not been demonstrated for the services concerned; or (ii) the BoA incorrectly assessed the use of such services in that it did not subdivide them precisely and narrowly; or (iii) the BoA wrongly inferred that consent had been granted for use of the contested mark beyond that explicitly granted by the licence in the present case; or (iv) the BoA incorrectly assessed the extent of the genuine use, which must extend beyond a limited geographical area to be sufficient use to constitute use in a Member State or in the European Union (EU) (Para. 10). The first and second parts of the single plea which relate to the use of the contested mark claimed for the services concerned were examined together and rejected. The assessment of genuine use must be based on the services as specified in the application for registration and not on a possible marketing concept. The BoA was therefore wrong to find, that “all these services would form part of the service package known as “wireless broadband””. It appears that the contested mark was registered for the services concerned and does not cover “wireless broadband” as such. Nevertheless, the items of evidence analysed by the BoA establish use of the contested mark for all the services concerned (Para. 21). It is not necessary, in the present case, to define a sub-category of services as claimed by

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

the applicant (Para. 26 with references to further Case-Law). With regard to the third part of the single plea in law, the intervener relied upon acts of use of the contested mark by its licensee as evidence of its genuine use. Those factors formed a sufficiently firm basis to allow the conclusion that the contested trade mark had been used with its proprietor's consent (Para. 40). With regard to forth part of the single plea in law, although the concept of genuine use excludes all minimal and insufficient use as the basis for a finding that a mark is being put to real and effective use on a given market, nevertheless the requirement of genuine use does not seek to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks (Para. 40). In addition, it is apparent from the Case-Law that the territorial borders of the Member States should be disregarded in the assessment of "genuine use in the [EU]" (Para. 46). Having regard, in particular, to the evidence provided, the use of the mark in the geographical area comprising London and the Thames Valley was sufficient to constitute genuine use in the EU (Para. 49).



**Case T-306/13; Silicium España Laboratorios, SL v OHIM; Judgment of 16 June 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Bad faith, License agreement, Ownership, Legitimate expectations, Burden of proof, Company name, Transfer of IP right, Declaration, Representative

**FACTS:** An application for a CTM was sought for the word sign LLRG5 for Classes 5, 32 and 44. A request was submitted to the Office to register the assignment of the application for the CTM to one of the shareholders of the invalidity applicant, Mr. R. The request for the application as well as for the assignment was made by an intermediary of Mr. R. on his behalf. The change of the proprietor was registered and published. Mr. R. and the invalidity applicant concluded an agreement that would confer to the later an exclusive license which stated, inter alia, that Mr. R. would not authorise others to use the names "LLRG5" or "G5". After Mr. R's death, the invalidity applicant filed with OHIM an application for registration of the transfer of the CTM LLRG5, based on the agreement between the referred parties. The application was refused on the ground that the agreement did not state that Mr. R had actually transferred the contested mark to the invalidity applicant. Subsequently, the invalidity applicant filed an application for a declaration of

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



invalidity of the CTM on the basis of an absolute ground for invalidity, namely that the proprietor of the CTM in question had acted in bad faith when filing the application for registration of the said mark. A document issued by the executor of Mr. R's will was provided to the Office certifying that the trade mark had been transferred to the CTM owner and the change of ownership was registered. The Cancellation Division (CD) rejected the request for a declaration of invalidity on the ground that there was no evidence of bad faith of Mr. R. when instructing an intermediary to file for an application for registration of the CTM. The invalidity applicant filed an appeal to the First Board of Appeal (BoA) against the CD's decision which was upheld, annulled the decision and declared the contested mark to be invalid. The BoA found, inter alia, that Mr. R. as a beneficial applicant had acted in bad faith when instructing an intermediary to file an application for registration of the said mark. The CTM owner filed an appeal to the General Court (GC) relying on a single plea in law.

CTM

**LLRG5**

**SUBSTANCE:** The CTM owner relied on one plea in law alleging the infringement of Article 52 (1) (b), namely that the BoA committed an error of law in finding that Mr. R. acted in bad faith in filing,

through another person, an application before the Office seeking the registration of the sign LLRG5 as a CTM (Para. 27). The GC noted that one of the relevant factors to determine whether there is bad faith, is when a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for, and the sign enjoys some degree of legal protection (Para. 32). The CTM owner considered that Mr. R. had a legitimate interest in applying for the registration of a CTM and disputes the probative value of matters that were taken into consideration by the BoA when determining bad faith (Para. 40). The GC rejected this argument since the invalidity applicant produced a formal statement by its representative, Mr. V., made before a solicitor as well as a set of documents which contained his opinion that the application for registration of the CTM, was made in bad faith due to the fact that the filing was made without the knowledge of the invalidity applicant (Paras. 42-43). With regard to the probative value of the statement, the GC pointed out that it did not fall solely into the category of self-supporting evidence but instead was substantiated by the documents that were submitted to the Office. It stated that the BoA did not err in law when it found that the application for a declaration of invalidity, based on bad faith on the part of Mr. R., had been substantiated by clear and convincing evidence, in particular, to the formal statement submitted (Para. 46). With regard to the argument that the BoA did not draw the conclusions it should have drawn from the evidence that was

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal





## Case law

produced, the GC found that it was apparent from the case file that Mr. R. could not have been unaware that the invalidity applicant used the sign LLRG5 as its company name (Para. 47). Furthermore, although it was not possible to establish with certainty what was the common intention between the parties with regard to the sign, no evidence was provided that could lead to the conclusion that Mr. R. had reserved rights to himself over that name (Para. 52). Therefore, the GC found that there was no error of assessment when the BoA found that the CTM owner did not prove the existence of the exclusive rights it alleged (Para. 58). The GC stated that Mr. R. did not give the invalidity applicant the possibility of considering whether it was appropriate to oppose the application for registration of the sign at issue, which led to the finding that the application could be held to be a "concealed act", carried out through an intermediary, with the intention of preventing the invalidity applicant from being able to use the sign (Para. 71). In this light, it was found that the BoA did not err in finding that the invalidity applicant had proved that the application for registration of the contested mark was made in bad faith on the part of Mr. R. (Para. 73). The GC dismissed the single plea in law and the application in its entirety as unfounded (Para 74).



**Case T-593/13; Siemag Tecberg Group GmbH v OHIM; Judgment of 30. January 2015; Language of the case: DE**

**RESULT:** Action dismissed

Keywords: Descriptive element, Distinctive element, Admissibility

**FACTS:** The Board of Appeal (BoA) confirmed the rejection of the word mark WINDER CONTROLS for goods and services in Classes 7, 9, 37, 41 and 42 pursuant to Article 7 (1) (c) and 7 (1) (b) CTMR. The applicant filed an action to the General Court (GC).

### CTMA

## WINDER CONTROLS

**SUBSTANCE:** The (GC) dismissed the action. The request for the oral hearing in the application to the GC is inadmissible, as it must be made within one month after the closure of the written procedure, Article 13 (a) Rules of Proceedings (Paras. 13 et seq.). With regard to the alleged infringement of Article 7 (1) (b) CTMR, if all elements of the mark are descriptive, their combination is, in general, also descriptive, unless the overall impression of the mark differs from the mere sum of those elements (Para. 28). The mark applied for consists of the

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

words “winder” and “control”, being both descriptive for the goods and services at issue (Paras. 35 and 36). The combination is not unusual (Para. 37). The BoA did not infringe the duty to state the reasons. Even if the products in question are of different art, they can be all used with a “winder control system” and build therefore a homogenous group (Para. 41). The mark is not distinctive, Article 7 (1) (b) CTMR (Paras. 52 et seq.)

**Case T-599/13; Cosmowell GmbH v OHIM; Judgment of 7 May 2015; Language of the case: DE**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Phonetic dissimilarity, Claim for alteration of OHIM decision, Figurative trade mark, Admissibility, Distinctive element

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods within Class 5. An opposition based, among others, on the earlier figurative mark represented below, registered for goods in Class 5. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the applicant’s appeal. The applicant filed an action before the General Court (GC).



### CTMA



### Earlier mark



**SUBSTANCE:** The GC annulled the BoA decision. It considered erroneous the BoA’s finding that the signs in question cannot be compared phonetically since only one contains the verbal element. The GC found that the earlier mark can be compared phonetically and will be pronounced as “tiger” whereas the CTM application will be pronounced as “Gelenkgold”, which makes them phonetically dissimilar (Para 65). The action for annulment is therefore successful, the request for alteration of the contested decision in the sense that the opposition be refused requires further assessment of the distinctive character of the earlier mark by the BoA and is inadmissible (Paras. 78, 84).

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM’s European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



**Case T-648/13; IOIP Holdings LLC v OHIM; Judgment of 10 February 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Descriptive element, Admissibility, Purpose of the goods and services

**FACTS:** The applicant sought to register/registered the word mark GLISTEN for goods within Class 3. The examiner refused to register the word as a Community trade mark (CTM) on the ground that it did not comply with Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) confirmed the rejection. The applicant filed an action to the General Court (GC) claiming an infringement of Article 7 (1) (b) and (c) CTMR.

CTMA

**GLISTEN**

**SUBSTANCE:** The applicant's second head of claim, requesting the GC to order the Office to accept registration of the mark applied for, is inadmissible in so far as it requests the GC to issue a direction to the Office (Para. 10). As regards the descriptive character pursuant to Article 7 (1) (c) CTMR of the word "glisten", the BoA correctly noted that it

means "to shine by reflecting light from a wet, oily or smooth surface" and found that, rather than carrying out a grammatical analysis of the word "glisten", consumers will focus on its meaning, which is unequivocal and which immediately informs them, without further reflection, of the purpose of the goods covered, namely to make objects shine. Thus, upon seeing the word "glisten" associated with the various cleaning products covered by the mark applied for, the relevant public will understand that those cleaning products will be used to make the cleaned objects, such as dishwashers and microwave ovens, shine (Paras. 19 and 20). The fact that the mark applied for may have been registered in the United States is not capable of demonstrating that the BoA erred in the application of Article 7 (1) (c) CTMR (Para. 32). It is not necessary to examine the applicant's second plea concerning the distinctive character of the mark applied for within the meaning of Article 7 (1) (b) CTMR. It is clear from the wording of Article 7 (1) CTMR that, if one of the absolute grounds for refusal listed in that provision applies, that suffices for the sign at issue not to be capable of registration as a CTM.

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**Case T-521/13; Alpinestars Research Srl v OHIM; Kean Tung Cho, and Ling-Yuan Wang Yu, Judgment of 7 July 2015; Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**Keywords:** Likelihood of confusion, Similarity of signs, Dominant element, Distinctive element, Visual similarity, Ending of mark, Common element, Phonetic similarity, Conceptual dissimilarity, Identity of the goods and services

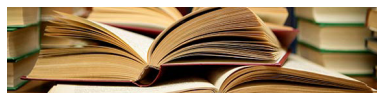
**FACTS:** The Interveners filed an application for the figurative sign shown below for products in Classes 18 and 25. An opposition based on the earlier mark shown below and registered as CTM for goods in Classes 18 and 25 was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division rejected the opposition, the applicant filed an appeal. The Boards of Appeal (BoA) dismissed the appeal.

CTMA



Earlier mark

**A-STARS**



### SUBSTANCE:

#### ON THE COMPARISON OF SIGNS

The General Court (GC) held that visually in the contested sign the word element “aster” is the dominant element since it has characteristics which enable it to make an immediate impression on the relevant public and that the decorative element in the shape of an arrow, which is less distinctive than that word element, is, on account in particular of its size and its white colour which is less visible than that of that word element, negligible, with the result that it is the element “aster” which the relevant public will remember. As regards, by contrast, the earlier mark, which is a word mark, in spite of the link made between the initial letter “a” and the element “stars” by a hyphen, the sign cannot be broken down visually into two elements (Paras. 25 and 26). Although the marks contain five and six letters respectively, the GC regarded them as being similar in length. Although the differences at the end of the earlier mark preclude the signs from being held to be identical, the fact none the less remains that the part which is common to the signs gives rise to a visual similarity between the word elements, particularly because the public generally pays more attention to the initial part of word marks (Para. 28). Therefore contrary to the assessment of the BoA the GC held that the similarity between the signs at issue is not capable of being offset to a significant extent by the fact that the word element “aster” in the mark applied for is written in black in a stylised font, is in bold, slopes slightly to the right and has a decorative

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



element placed above it, whereas the earlier sign consists only of the word element “a-stars” (Para. 29). The GC therefore takes the view that there is an average degree of visual similarity between the signs at issue, in spite of the differences between them and not a low degree as stated by the BoA (Para. 31).

Phonetically the GC disagreed with the BoA and concluded that it is unlikely that the consumer will repeat the vowel “a” in the mark applied for in order to pronounce the sign as “a-aster”. It must therefore be held that the mark applied for will be pronounced as two syllables and not three. As regards the pronunciation of the earlier mark, the hyphen between the letter “a” and the word “star” must indeed be taken into account with regard to the part of the relevant public which has some knowledge of English and English pronunciation. The earlier mark will thus be pronounced as two elements which may easily be identified by that part of the relevant public. By contrast, it cannot be ruled out that for the non-English-speaking part of the relevant public, the presence of the hyphen will have no effect and the earlier mark will be pronounced as two syllables which are difficult to perceive with the “a” being pronounced in the same syllable as the initial letter “s” of the element “stars”. As regards the phonetic stress, it may be placed, both in respect of the earlier mark and the mark applied for, on the first or second syllable depending on the language spoken by the consumer (Paras. 36 and 37). The GC decided that contrary to what the BoA held the signs

at issue are highly similar phonetically, at least for the non-English-speaking part of the relevant public (Para. 41).

Finally on the conceptual comparison, the GC decided that the BoA was wrong to conclude that there was some conceptual similarity. The GC found that given the various possible meanings of the elements “stars” and “aster” and the remote conceptual link between them, there is no conceptual similarity between the signs at issue (Para. 53).

### ON THE LIKELIHOOD OF CONFUSION

The conclusion of the GC is that the goods at issue are identical, that there is an average degree of visual similarity between the signs at issue for the whole of the relevant public and a high degree of phonetic similarity between the signs at issue for at least the non-English-speaking public. Furthermore, there is no conceptual similarity between the marks at issue for the relevant public (Para. 61). In that regard, the GC reminded that although the marks at issue have been held to be conceptually different, it is also necessary, for conceptual differences between two signs to be capable of counteracting phonetic and visual similarities between the marks at issue, for at least one of those signs to have a clear and specific meaning for the relevant public, so that that public is capable of grasping it immediately (see judgment of 18 December 2008 in *Les Éditions Albert René v OHIM*, C-16/06 P, ECR, EU:C:2008:739, Para. 98 and the Case-Law cited) (Para. 62). The GC concludes that the earlier mark is not capable of directly conveying a clear meaning to the relevant public, with the

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, *Group Nivelles v OHIM – Easy Sanitary Solutions BV*, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law



result that the conceptual dissimilarity between the marks at issue cannot in the present case suffice to counteract the average degree of visual similarity and the high degree of phonetic similarity which the GC has held to exist (see, to that effect, judgment of 15 July 2011 in *Ergo Versicherungsgruppe v OHIM — Société de développement et de recherche industrielle (ERGO)*, T-220/09, EU:T:2011:392, Para. 39 and the Case-Law cited). Consequently, the GC held that there is a likelihood of confusion in the present case, at least for part of the relevant public (Para. 64).

**Case T-662/13; dm-drogerie markt GmbH & Co. KG v OHIM; Judgment of 25 June 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Company name, Dissimilarity of signs, Dissimilarity of the goods and services, Enhanced distinctiveness, Figurative element, Identity of the goods and services, Letter mark, Likelihood of confusion, Phonetic dissimilarity, Retail services, Similarity of the goods and services, Specialised public, Visual dissimilarity, Distinctive element, Graphical representation, Abbreviation, Acronym

**FACTS:** The applicant sought to register the figurative sign represented below as a CTM for goods within Class 14. An opposition based on the earlier word

mark dm, registered for goods inter alia in Class 14, was filed on the grounds of 8 (1) (b) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed opponent's appeal finding that the mark applied for would most probably be perceived as representing a highly stylised capital letter "M" whereas the earlier mark consisted of the combination of the letters "d" and "m" without any stylisation, and that there were no visual, phonetic and conceptual similarities between the marks at issue and thus NO LOC. The opponent filed an action before the General Court (GC).

### CTMA



### Earlier mark

dm

**SUBSTANCE:** The goods are aimed both at professionals and at general public in the EU. The level of attention is either rather high, as the goods in question tend generally to be expensive, or, where the goods are produced and sold in rather cheap variations, average, since such goods are purchased

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, *Group Nivelles v OHIM – Easy Sanitary Solutions BV*, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



to embellish the appearance of the human body (Paras. 18-21). As regards the comparison of the signs, the parties agree on the fact that the mark applied for may be perceived as at least including a stylised representation of the capital letter "M". The GC confirmed that the relevant public will not perceive the contested mark as a stylised representation of the capital letters "D" and "M", in which the first of those letters is interlinked with the second (Paras. 34-38). Inter alia the opponent cannot claim that the mark applied for will be perceived by the relevant public as consisting of the letters "d" and "m" on the ground that those letters represent the initials of the trade name "Diseños Mireia". That claim is based primarily on the premise that the relevant public will associate that mark directly with that trade name. However, this premise was not in any way substantiated, in particular by showing that that mark and that trade name are widely known (Para. 39). Also, the opponent cannot argue that the applicant uses its mark together with a reference to its trade name, since the comparison must be based on the contested sign as registered or as appealing in the application for registration (Para. 40). Visually, the very specific graphic form of the contested mark has the effect of counteracting to a large extent the point of similarity relating to the fact that that contested mark may be understood as a reference to the letter "m" written as a capital letter, which is one of the two letters of which the earlier mark consists. Therefore the marks are visually dissimilar (Para. 46). Phonetically, on account of the very specific

graphic form of the contested mark, the relevant public will tend to describe it and not to pronounce it, therefore the marks are phonetically dissimilar (Para. 47). As regards the distinctive character of the earlier mark, the GC confirmed that having found that there was no similarity between the marks at issue, the BoA could rightly conclude that there was no likelihood of confusion, irrespective of the alleged enhanced distinctive character of the earlier mark (Para. 54). In any case, the opponent's claim regarding the enhanced distinctiveness was not substantiated by any evidence, since it cannot be deduced merely from the fact that a mark has a certain reputation in respect of retail services that that reputation extends automatically to all goods sold under that mark (Para. 56). The GC confirmed that there cannot be held to be any likelihood of confusion in the present case, regardless of the degree of distinctive character of the earlier mark and regardless of the identity or similarity of the goods at issue (Para. 61).

**Case T-715/13; Lidl Stiftung & Co. KG v. OHIM + Horno del Espinar, S L; Judgement of 5 May 2015;**  
**Language of the case: EN**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Conceptual similarity, Dominant element, Figurative trade mark, Likelihood of confusion, Phonetic similarity, Retail services, Right

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

to be heard, Right of defence, Similarity of the goods and services, Substantial procedural violation, Visual similarity, Relevant territory, Similarity of the signs, Renewal

**NORMS:** Article 75 CTMR, Article 79 CTMR, Article 8 (1) (b) CTMR

**FACTS:** The CTM applicant sought to register the figurative sign Castello represented below as CTM for goods in Classes 29, 30, 31. An opposition based on an earlier Spanish figurative sign Castelló below, covering for services in Class 35, was filed on the grounds of 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition in its entirety. The Board of Appeal (BoA) dismissed the appeal. The Opponent brought an action before the General Court, relying on three pleas in law: (i) infringement of the second sentence of Article 75 CTMR; (ii) infringement of Article 79 CTMR; and (iii) infringement of Article 8 (1) (b) CTMR.

### CTMA



### Earlier mark



**SUBSTANCE:** ON THE INFRINGEMENT OF ARTICLE 8 (1) (b) CTMR:

The GC rejected the plea and confirmed the BoA's assessment. The GC confirmed the assessment of the BoA according to which the relevant public was the Spanish public at large and the level of attention was lower than average, considering that the goods and services covered by the signs at issue were foodstuffs intended for mass consumption, purchased frequently and at a modest price (Para. 26). The GC held that the BoA was fully entitled to conclude that the goods covered by the mark applied for and the services covered by the earlier mark were similar to a low degree. The BoA highlighted that even if the consumers concerned thought that the goods offered for sale by a retailer were generally made by third-party undertakings and not by the retailer, it nevertheless remains the case that those consumers might think that liability for the manufacture of the goods offered for sale by that retailer falls on that retailer where there is a similarity between the mark covering those goods and that of the retailer and where the latter mark covers retail services relating to the same goods (Paras. 31-35). Regarding the comparison of the signs, firstly, the GC stated that the BoA correctly found that the words "castelló" and "castello" constitute, respectively, the dominant components of the earlier mark and the mark sought (Para. 38). The GC held that the BoA was fully entitled to conclude that the signs were similar. With regard to the visual similarity, it considered that the font

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



and the presence of the accent on the letter “o” in the earlier mark were negligible differences (Paras. 39-41). In respect of the phonetic similarity, the GC highlighted that the presence of the accent and the pronunciation of the phrase “castelló y juan s.a.” and the word “dulces” were not sufficient to lead to the conclusion that the signs are not similar (Paras. 42-44). Concerning the conceptual similarity, the GC noted that the signs would be perceived by the relevant public as referring to a family name and that the presence, in the earlier mark, of the words “dulces” and “y juan s.a.” is not liable to call into question the BoA’s conclusion (paras. 45-47). The GC confirmed the overall assessment made by the BoA, highlighting that it did not make any error in concluding for likelihood of confusion (Paras. 49-52). ON THE INFRINGEMENT OF ARTICLE 79 CTMR AND OF THE SECOND SENTENCE OF ARTICLE 75 CTMR:

The GC examined the pleas together. First of all the BoA was fully entitled to rely on the documents sent by the applicant and, without first hearing the applicant, find that no request for proof of genuine use had been lodged during the proceeding before the OD (Paras. 57-62). Secondly, the GC found that the ground concerning non-notification of the observation in response lodged by the opponent during the proceeding before the BoA was without a factual basis (Paras. 64-65). Moreover, the GC rejected the argument concerning the failure to notify the filing of documents showing the renewal of the other mark of the opponent, considering that the BoA did not rely on such mark in adopting its

decision (Para. 67). However, the GC found that the BoA did not allow the applicant to submit its observations on documents showing the renewal of the earlier mark, since they constituted one of the foundations of its decision (Paras 69-72): the GC held that such procedural irregularity has had a concrete effect on the ability of the applicant to defend himself (Para. 85). Therefore, the the first plea in law, alleging an infringement of the second sentence of Article 75 CTMR, was upheld (Para. 88) and the decision was annulled.

**Cases T-98/13 and T-99/13; C.M.T. - Compagnia Manifatture Tessili S.r.l., v OHIM - Camomilla S.p.A. (CAMOMILLA); Judgment of 9 July 2015; Language of the case: IT**

**RESULT:** Actions dismissed

**KEYWORDS:** Bad faith, Burden of proof, Likelihood of confusion, Dissimilarity of the goods and services, Complementary goods and services

**FACTS:** Camomilla S.p.A., (the CTMR owner) was granted CTM registration for the below mentioned figurative marks for goods in Classes 16, 18, and 24 and for goods in Classes 3, 9, 14, 16, 21, 24 e 28. Compagnia Manifatture Tessili S.r.l., (applicant before the GC or applicant), submitted two applications for a declaration of invalidity against the marks at issue, based on the below mentioned

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

figurative Italian mark registered for “clothing items” in Class 25.

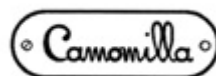
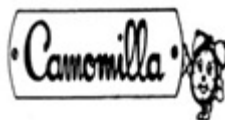
The applications were filed under Article 52 (1) (b) CTMR and Article 53 (1) (a) CTMR in combination with Articles 8 (1) (b) and 8 (5) CTM. The Cancellation Division (CD) dismissed the applications for invalidity. The Board of Appeal (BoA) confirmed the CD’s decision and dismissed the appeal. The BoA found that the applicant did not show that the contested mark was registered in bad faith under Article 52 (1) (b) CTMR. In relation to Article 53 (1) (a) CTMR in combination with Article 8 (1) (b) CTMR, the BoA found that there was no likelihood of confusion since there was no similarity between the goods at issue. Therefore, the ground based on Article 8 (1) (b) CTMR was also dismissed.

The applicant filed two actions before the General Court (GC), alleging the infringement of Article 52 (1) (b) CTMR, the infringement of Article 53 (1) (a) CTMR in combination with Article 8 (1) (a) (b) CTMR and the infringement of Article 53 (1) (a) in combination with Article 8 (5) CTMR. The GC joined the two cases.

**SUBSTANCE:** INFRINGEMENT OF ARTICLE 52 (1) (b) CTMR - Bad Faith: The GC reminded that there is not a definition of “bad faith” in the legislation, but that the Case-Law has given some important guidance about how to interpret this concept. The GC confirmed the Case-Law that the three factors set out in the judgment C-529/07, *Chocoladefabriken Lindt & Sprüng* (identity/confusing similarity of the signs; Knowledge of the use of an identical or



## CTMAs



## Earlier marks



confusingly similar sign and dishonest intention on the part of the CTM owner) are only examples drawn from a number of factors which can be taken into account in order to decide whether the applicant was acting in bad faith at the time of filing the application. For example, account may also be taken of the commercial logic underlying the filing of the application for registration of the sign as a Community trade mark and the chronology of events relating to the filing (Paras. 37-42).

The GC recalled in particular the Case-Law according to which the mere knowledge of the earlier marks is not sufficient, in itself, to conclude that the CTMR owner was acting in bad faith. Consequently, in

## First Page

■ New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, *Group Nivelles v OHIM – Easy Sanitary Solutions BV*, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal





## Case law



order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration. The CTMR owner's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case. To that respect, the GC noted that the applicant only argued that the same disputes between the parties were capable to show the conscious and deliberate intention of the CTMR owner to appropriate the Camomilla mark, previously used and register by the applicant. Those disputes would show that the filing of the Community marks was made to the only purpose of reinforcing the parallel national marks, by so extending their protection to goods not compatible with those of the applicant. Therefore, according to the applicant, the sole objective of the CTMR owner was that of preventing the applicant from entering the EU market. The GC found that the existence of a previous dispute between the parties does not show per se that the party that registered its national mark also as a Community mark acted in bad faith. The GC further found that there was no evidence showing that the applicant had the intention to exploit its national mark in the market sectors at issue, neither that the CTMR owner knew about that intention at the relevant time (Paras. 46-50). The GC also recalled the Case-Law for which good faith is presumed until proof to the contrary is adduced. Therefore, the invalidity applicant needs to prove that there was bad faith on the part of the CTM

owner at the time of filing the CTM. Consequently, the applicant's observations, devoid of any evidence to support them, are not sufficient for proving bad faith from the CTMR owner (Para. 51). The first applicant's plea was therefore dismissed.

INFRINGEMENT OF ARTICLE 8 (1) (a) (b) CTMR IN COMBINATION WITH ARTICLE 53 (1) (a) CTMR: The GC found that the arguments put forward by the applicant are not such to put in question the assessment made by the BoA on the similarity of the goods at hand. The applicant only made some statements of principle without giving any substantial reason to show that the finding of the BoA was erroneous. (Paras. 66, 67). The only argument that some of the goods such as glasses, suitcases or sport bags may be sold in the same places is not significant since in supermarket, for example, consumers may find any kind of goods. In relation to fashion items, the GC noted that. Although, the search for an aesthetic harmony is common to all the sector of fashion and clothing, it is a too vague factor to justify the conclusion that all those goods are complementary each other and, therefore, similar (Paras. 68, 73). In light of the above, the BoA was right in finding that the goods at hand were dissimilar and that there were no risk of confusion between the marks. Therefore, also the plea alleging infringement of Article 8 (1) (b) CTMR was dismissed. The GC found that it was not necessary to examine the further pleas of the applications.

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## Case law

**Case T-100/13; C.M.T. - Compagnia Manifatture Tessili S.r.l., v OHIM - Camomilla S.p.A. (CAMOMILLA); Judgment of 9 July 2015; Language of the Case: IT**

**RESULT:** Action upheld (BoA decision annulled)

**KEYWORDS:** Bad faith, Burden of proof, Burden of proof, Likelihood of confusion, Nature of use, Evidence of use, Complementary evidence

**FACTS:** On 09/09/2009, Camomilla S.p.A., (the CTMR owner) was granted CTM registration for the word mark CAMOMILLA for, among others, goods in Classes 3, 9, 11, 14, 16, 18, 20, 21, 24, and 25, 27, 28, 30.

Compagnia Manifatture Tessili S.r.l., (applicant before the GC or applicant), submitted an application for a declaration of invalidity of the mark at issue, based on the below indicated figurative Italian mark registered for "clothing items" in Class 25.

The application was filed under Article 52 (1) (b) CTMR and Article 53 (1) (a) CTMR in combination with Articles 8 (1) (b) and 8 (5) CTM. The Cancellation Division (CD) dismissed the application for invalidity. The Board of Appeal (BoA) confirmed the CD's decision and dismissed the appeal. The BoA found that the applicant did not show that the contested mark was registered in bad faith under Article 52 (1) (b) CTMR. In relation to Article 53 (1) (a) CTMR in combination with Article 8 (1) (b) CTMR, the BoA found that the genuine use of the earlier mark was



not proven, in particular as far as the nature of the use was concerned. The BoA also found that the additional documents filed before the BoA in order to show the use of the earlier mark could not be taken into account since they had been filed out of time. The BoA stated that belated evidence could be admitted only when "new elements" occurred to the extent that it became necessary to assess that evidence, which was not the case. Therefore, the ground based on Article 8 (1) (b) CTMR was dismissed.

The applicant filed an action before the General Court (GC), alleging three pleas in law: the infringement of Article 52 (1) (b) CTMR, the infringement of Article 53 (1) (a) CTMR in combination with Article 8 (1) (b) CTMR and the infringement of Article 53 (1) (a) in combination with Article 8 (5) CTMR.

### CTMA

**CAMOMILLA**

### Earlier mark



## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



**SUBSTANCE:** INFRINGEMENT OF ARTICLE 52 (1) (b) CTMR – BAD FAITH: The GC reminded that there is not a definition of “bad faith” in the legislation, but that the Case-Law has given some important guidance about how to interpret this concept. The GC confirmed the Case-Law that the three factors set out in the judgment C-529/07, *Chocoladefabriken Lindt & Sprüng* (identity/confusing similarity of the signs; Knowledge of the use of an identical or confusingly similar sign and dishonest intention on the part of the CTM owner) are only examples drawn from a number of factors which can be taken into account in order to decide whether the applicant was acting in bad faith at the time of filing the application. For example, account may also be taken of the commercial logic underlying the filing of the application for registration of the sign as a Community trade mark and the chronology of events relating to the filing (Paras. 33-36).

The GC recalled in particular the Case-Law according to which the mere knowledge of the earlier marks is not sufficient, in itself, to conclude that the CTMR owner was acting in bad faith (Paras. 38-36). Consequently, in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration. The CTMR owner's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case. To that respect, the GC noted that the applicant only argued that the same disputes between the parties

were capable to show the conscious and deliberate intention of the CTMR owner to appropriate the Camomilla mark, previously used and register by the applicant. Those disputes would show that the filing of the Community marks was made to the only purpose of reinforcing the parallel national marks, by so extending their protection to goods not compatible with those of the applicant. Therefore, according to the applicant, the sole objective of the CTMR owner was that of preventing the applicant from entering the EU market (Paras. 38-39).

The GC found that the existence of a previous dispute between the parties does not show per se that the party that registered its national mark also as a Community mark acted in bad faith (Para. 41). The GC further found that there was no evidence showing that the applicant had the intention to exploit its national mark in in the market sectors at issue, neither that the CTMR owner knew about that intention at the relevant time. The GC also recalled the Case-Law for which good faith is presumed until proof to the contrary is adduced. Therefore, the invalidity applicant needs to prove that there was bad faith on the part of the CTM owner at the time of filing the CTM. Consequently, the applicant's observations, devoid of any evidence to support them, are not sufficient for proving bad faith from the CTMR owner (Paras. 41-44). The first applicant's plea was therefore dismissed.

INFRINGEMENT OF ARTICLE 8 (1) (b) CTMR IN COMBINATION WITH ARTICLE 53 (1) (a) CTMR: The applicant argues that the BoA erred in not taking

## First Page

- New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, *Group Nivelles v OHIM – Easy Sanitary Solutions BV*, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015
- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law



into account the evidence filed out of the time given by the CD to show genuine use of the earlier marks, without exercising its power and admitting it as complementary to the evidence already submitted. The GC noted that, as it is apparent from the wording of Article 76 (2) CTMR, the Office may disregard facts which were not submitted or evidence which was not produced in due time by the parties. In stating that the latter “may”, in such a case, decide to disregard facts and evidence, that Article grants the Office a wide discretionary power to decide, while giving reasons for its decision in that regard, whether or not to take such information into account (Paras. 68-69).

Rule 40 (6) CTMIR, expressly states that the Office will reject the application for invalidity if the applicant does not provide proof of use before the time limit expires. (Para. 73). In this case, the applicant submitted relevant evidence within the time limit and presented additional evidence after the time limit has expired. The GC noted that, according to the Case-Law, in such cases only when the late evidence is manifestly irrelevant, the BoA cannot exercise its discretionary power. On the contrary, taking such facts or evidence into account is particularly likely to be justified where OHIM considers, first, that the material which has been produced late is, on the face of it, likely to be relevant to the outcome of the proceedings brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters

being taken into account (Paras. 73-78).

In the case at hand, the elements of evidence submitted in late, namely pictures showing the mark on the goods and copies of invoices, appear to be *prima facie* relevant to the decision of the proceedings. Neither results from the file that the applicant had abuse the time-limits set by knowingly employing delaying tactics or by demonstrating manifest negligence. It has just added elements of evidence complementary to the evidence already submitted on time. In light of the above, the GC annulled the contested decision (Paras. 79-81).

**Cases T-492/13 and T-493/13; Schmidt Spiele GmbH v OHIM; Judgment of 3 March 2015; Language of the case: DE**

**RESULT:** Actions partly upheld (BoA decisions partially annulled)

**Keywords:** Distinctive element, Lack of reasoning, Distinctiveness acquired by use, Figurative trade mark

**FACTS:** The applicant sought to register the figurative signs as depicted below for goods and services in Classes 9, 16, 28 and 41. The examiner rejected the applied-for trade marks as being devoid of any distinctive character (Article 7 (1) (b)). The Board of Appeal (BoA) dismissed the appeals. The applied for signs would represent a depiction of

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

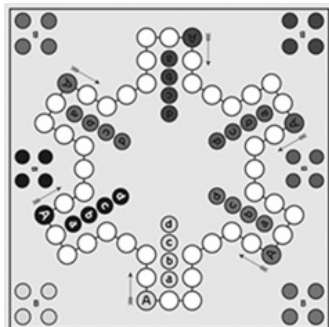
■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

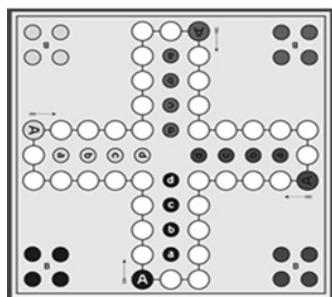
## Case law

the board of a game and consequently represents the outer appearance of the goods. The alleged acquired distinctiveness according to Article 7 (3) CTMR has not been shown.

### CTMA in Case - T-492/13



### CTMA in Case - T-493/13



**PROCEDURE:** The applicant asked already in the application for an oral hearing. The General Court (GC) stated that according to Article 135a of the Rules of Procedure of the General Court (RPGC), once the written procedure is closed, the parties are informed by the GC that they may ask for an oral hearing indicating the reasons. The applicant's request in the application has been filed at an earlier stage before that invitation according to Article 135a RPGC and may not be taken into account. The GC added that the request for an oral hearing and the decision upon this request may only be done once the whole submissions of the parties are known. Consequently in the case at hand the GC decided not to hold an oral hearing (Para. 8 to 12).

**SUBSTANCE:** INFRINGEMENT OF ARTICLE 7 (1) (b) CTMR: The GC stated that the applicant's opinion that the signs would not represent the depiction of the board of a game is to be refused. The present signs do actual contain all the elements of the well-known game called "Mensch, Ärgere Dich nicht" or a variant thereof which in particular in the centre of Europe enjoys a great popularity (Paras. 19-21). The consequence is that with respect to the goods in Class 28 which refer to games the applied for signs cannot indicate their origin because they merely indicate their subject matter (Para. 37). However, the GC reminded that a global reasoning is only possible when the goods and or services have a sufficient connection between each other. In the case at hand, the contested decision extended the

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal





## Case law

reasoning applicable to games to neighbouring goods and services which is legitimate. But if the link with games becomes very weak an additional reasoning would have been necessary in order to sufficiently reason the decisions (Para. 41). The GC therefore specified the goods and services for which the reasoning of the BoA was sufficient and concluded that for the remaining goods and services the decisions are not well reasoned (Paras. 44-54). INFRINGEMENT OF ARTICLE 7 (3) CTMR: The GC confirmed the contested decision to the extent that the applicant did not show any acquired distinctiveness which does not only refer to the German speaking Member States but in general to the whole EU (Para. 59).

**Case T-514/13; AgriCapital Corp. v OHIM; Judgment of 10 June 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Complementary goods and services, Dissimilarity of the goods and services, Likelihood of confusion, Nature of goods and services, Purpose of the goods and services, Similarity of the signs

**NORMS:** Article 8 (1) (b) CTMR, Rule 2 (4) CTMIR



**FACTS:** The applicant sought to register the word mark AGRI.CAPITAL as a CTM for services inter alia within Class 36 corresponding to following description "Building promoter services, namely in particular in connection with installations for generating and distributing electrical and thermal energy from renewable energy sources; development of usage concepts (facility management contracting); management of buildings; management of land; real estate management and brokerage, rental and leasing of real estate (facility management); real estate affairs; leasing of farms; The aforesaid services not in connection with publishing and/or published products".

An opposition based on the earlier word CTMs AgriCapital and AGRICAPITAL, both registered for services in Class 36, first mark corresponding to "financial services, financial consultancy", the latter to "consulting and investment banking services for companies in agricultural sector", was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal of the opponent based on the dissimilarity of the services concerned. The opponent filed an action before the General Court (GC).

**SUBSTANCE:** Regarding the admissibility of a document submitted to the GC at the oral hearing, the GC recalls that it is not its function to review the facts in the light of documents produced for the first time before it (Para. 18). The GC confirms

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



### CTMA

**AGRI.CAPITAL**

### Earlier mark

**AgriCapital**  
**AGRICAPITAL**

findings of the BoA in that the services designated by the marks at issue are intended for an average consumer in all the Member States of the EU, but that he or she is likely to exercise a higher degree of attention in view of the considerable sums of money involved in financial or real estate transactions (Para. 27).

THE LACK OF SIMILARITY BETWEEN “real estate management and brokerage services” AND “financial services”: Financial services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are provided by financial institutions for the purposes of the management of their clients’ funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or of various financial operations, real estate services are services connected with a property, namely, in particular, the

lease, the purchase, the sale or the management of a property (Para. 38). Regarding the distribution channels real estate services are not, in principle, provided on the same premises as financial services (Para. 42).

THE LACK OF SIMILARITY BETWEEN “building promoter services” and “financial services”: Building promoter services involve the seeking of finance by the building promoter for the purpose of the acquisition of buildings or land. However, seeking financing cannot be considered to be a financial service directly provided by the building promoter to its clients, equivalent to brokerage (Para. 54). Although it is common for building promoters to offer their clients advice regarding the financing of their purchase in the context of the marketing of building programmes, such advice cannot be assessed as being financial advice, such as that covered by the applicant’s earlier marks. Such advice is akin to that which any seller of property of a certain value might set out for its clients regarding the financial interest that they could have in acquiring the property in question (Para. 55). Regarding complementarity, in a market economy, a substantial portion of activities require financing or investment, with the result that financial services might, by their nature, be associated with the majority of those activities and not only with the activities of a building promoter (Para. 61). The link between building promoter services and financial services is not, in itself, sufficiently close to lead the relevant public to think that those services are

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## Case law

provided by the same undertaking (Para. 62). In the absence of arguments specific to the services of “development of usage concepts”, The GC finds that the applicant has failed to demonstrate that the BoA had erred in law in finding that there was no similarity between those services and the “financial services” (Para. 69).

The lack of similarity between the services covered by the earlier marks and those in respect of which registration of the mark AGRI.CAPITAL is sought cannot be offset for the purposes of the assessment of the likelihood of confusion, by the similarity, even if that were of a high degree, between the marks at issue (Para. 75). Thus there could not be a likelihood of confusion between the marks at issue (Para. 76).

**Case T-100/14; Tecalan GmbH v OHIM; Judgment of 30 April 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Restriction of the list of goods and services, Visual similarity, Phonetic similarity, Identity of the goods and services, Similarity of the goods and services, Likelihood of confusion, Relevant territory, Specialised public, Company name, Principle of legality

**FACTS:** The applicant sought to register the word mark TECALAN as a CTM for goods within Class 17. An opposition based on the earlier word mark



TECADUR, registered for goods in Class 17, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant’s appeal. The applicant filed an action before the General Court (GC) claiming an infringement of Article 8 (1) (b) CTMR.

CTMA

TECALAN

Earlier mark

TECADUR

**SUBSTANCE:** The GC dismissed the action. It affirmed the likelihood of confusion. The relevant public is that of the whole European Union (Para. 19), consisting of professionals as well as general consumers and showing a high or above average level of attention (Para. 24). The limitation of the goods by the CTM applicant made in the oral hearing cannot be accepted as it changes the subject matters of proceedings (Para. 34). The goods are identical or similar (Para. 43). The marks are visually and phonetically similar (Paras. 52 and 54). The conceptual comparison is not possible, as none

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM’s European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



of the marks have a meaning (Para. 56). The fact that the CTM application corresponds to the name of the company used since 1962 is not relevant for the assessment of the likelihood of confusion (Para. 65). The decision of German Patent Office that rejected an opposition based on a mark TECA against the mark TECALAN is not relevant, as, firstly, the Community trade mark system is autonomous from the national systems and, secondly, the marks involved are different (Para. 66).

**Case T-553/14; Wm. Wrigley Jr. Company v OHIM; Order of 24 June 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element , Figurative element, Laudatory mark

**FACTS:** The Board of Appeal (BoA) confirmed the examiner's decision that the trade mark applied for goods in Classes 3, 21 and 30 lacked distinctive character, Article 7 (1) (b) CTMR. The applicant filed an action to the General Court (GC).

CTMA



**SUBSTANCE:** By an order pursuant to Article 111 RoP the GC dismissed the action as manifestly unfounded. The GC rejected the only plea in law – the claimed infringement of Article 7 (1) (b) CTMR – confirming its Case-Law regarding the distinctive character: Any distinctive character of a compound mark may be assessed, in part, in respect of each of the terms or elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character (Para. 15). However, where it does not appear that there is concrete evidence, such as, for example, the way in which the various elements are combined, to indicate that a compound trade mark, taken as a whole, is greater than the sum of its parts, such a trade mark is devoid of distinctive character in respect of the goods and services concerned (Para. 16). The word “extra” is an adjective meaning “beyond or more than the usual, stipulated or specified amount or number; additional” and it denotes a promotional or laudatory meaning for all the goods covered by the mark applied for. The typeface used for the word “extra” is banal and the various tones used give the word only a slightly three-dimensional aspect. The stylisation of the word is thus simple. The figurative element of the sign applied for, consisting in a sphere or full circle divided into two halves in different tones, is a banal shape which will be perceived as a simple decorative element in the

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

background. Thus, neither the figurative element of the sign applied for nor the stylisation of the word “extra” will divert consumers’ attention away from the clear message conveyed by the word. The mark applied for, as a whole, will therefore be perceived as a simple promotional message and not as an indication of the commercial origin of the goods at issue (Para. 20). With regard, in particular, to the applicant’s claim that the contested decision did not give a single example of candy with the shape and colours of the figurative element of the sign applied for, the GC found it sufficient to note that, given that it is well known that those goods may be in the shape of a full circle and may exist in different tones, the BoA was not required to provide examples (Para. 25).

**Case T-552/14; Wm. Wrigley Jr. Company v OHIM; Order of 24 June 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Distinctive element, Figurative element, Laudatory mark

**FACTS:** The Board of Appeal (BoA) confirmed the examiner’s decision that the trade mark applied for goods in Classes 3, 21 and 30 lacked distinctive character, Article 7 (1) (b) CTMR. The applicant filed an action to the General Court (GC).



## CTMA



**SUBSTANCE:** By an order pursuant to Article 111 RoP the GC dismissed the action as manifestly unfounded. The GC rejected the only plea in law – the claimed infringement of Article 7 (1) (b) CTMR – confirming its Case-Law regarding the distinctive character: Any distinctive character of a compound mark may be assessed, in part, in respect of each of the terms or elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character (Para. 15). However, where it does not appear that there is concrete evidence, such as, for example, the way in which the various elements are combined, to indicate that a compound trade mark, taken as a whole, is greater than the sum of its parts, such a trade mark is devoid of distinctive character in respect of the goods and services concerned (Para. 16). The word “extra” is an adjective meaning “beyond or more than the usual, stipulated or specified amount or number; additional” and it denotes a promotional or laudatory meaning for all the goods

## First Page

■ New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal





## Case law

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### Case T-169/14; Ferring BV v OHIM; Judgment of 13 May 2015; Language of the case: EN

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Specialised public, Similarity of the goods and services, Nature of the goods and services, Purpose of the goods and services, Complementary goods and services, Visual similarity, Phonetic similarity, Relevant territory

**FACTS:** The Board of Appeal (BoA) confirmed the rejection of the opposition against the CTM application Koragel for goods in Class 5 which opposition was based on the earlier CTM Choragon registered for "pharmaceutical products and substances". The BoA held that the goods designated by the mark applied for were identical to the "pharmaceutical products and substances" protected by the earlier mark as regards the "pharmaceutical preparations" and similar to them as regards the "veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical use, plasters, materials for dressings, disinfectants and also material for stopping teeth and dental wax". In contrast, it ruled out any similarity with the goods designated by the earlier mark as regards "preparations for destroying vermin, fungicides and herbicides, on the one hand, and food for babies", on the other hand. As regarded the mark comparison the BoA found them visually similar to a low and phonetically to a higher degree. It ruled out

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015
- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## Case law

the conceptual comparison. The opponent filed an action raising a single plea in law, an infringement of Article 8 (1) (b) CTMR.

CTMA

**Koragel**

Earlier mark

**Choragon**

**SUBSTANCE:** The General Court (CG) confirmed the finding that there is no likelihood of confusion and dismissed the action. According to settled Case-Law, for a CTM not to be registered, it suffices that a relative ground for refusal for the purposes of Article 8 (1) (b) CTMR exists only in part of the territory considered (Para. 28). In the present case, therefore, the merits of the applicant's single plea should be examined particularly with regard to German-speaking consumers, since the applicant claims that there is a likelihood of confusion "at least" in the minds of those consumers and concentrates its arguments on that part of the relevant public (Para. 29). The level of attention of the relevant public for all the goods at issue will be at least above the average, i.e. "pharmaceutical and



veterinary preparations; Sanitary preparations for medical purposes; Dietetic substances adapted for medical use, food for babies; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants; Preparations for destroying vermin; Fungicides, herbicides" (Para. 40). The applicant does not dispute the BoA's findings concerning the similarity with the goods designated by the earlier mark of goods other than "preparations for destroying vermin, fungicides and herbicides and food for babies". Unlike "herbicides, preparations for destroying vermin and fungicides" cover a large spectrum of goods which is not restricted to goods intended for the protection of plants. Thus, in the light of the intended purpose of part of the "preparations for destroying vermin", their complementary nature in relation to "pharmaceutical or veterinary preparations" and their distribution channels, it must be held that there is a low degree of similarity of that category with the goods covered by the earlier mark (Para. 51). For similar reasons, it must be held that there is a low degree of similarity between "fungicides" and the goods covered by the earlier mark (Para. 54). In the light of a certain connection between some "foods for babies and pharmaceutical products and substances" in respect of their intended purpose, their method of use and their distribution channels, it must be held that there is a low degree of similarity between those goods (Para. 58). The visual similarity is low and the aural similarity is above average for the German speaking public. The conceptual comparison is not

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

possible (Paras. 64, 66 and 69). The specific features of the conditions for the marketing of the goods at issue do not justify giving more importance in the present case to the aural comparison than to the visual comparison (Paras. 79 et seq.).

**Case T-631/14; Roland SE v OHIM; Judgment of 16 July 2015; Language of the case: FR**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, International registration, Right to be heard, Likelihood of confusion, Dominant element, Distinctive element, Graphical representation, Visual dissimilarity, Phonetic dissimilarity, Position mark, Descriptive element, Dissimilarity of signs

**FACTS:** The applicant sought to register the mark represented below as a CTM for “high heel shoes” within Class 25. An opposition based on the earlier figurative international mark designating the EU represented below, registered for goods in Class 25, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed the opponent’s appeal. The opponent filed an action before the General Court (GC).



### CTMA



**‘Other’ type of mark:** The trademark consists of the colour red (Pantone No 18.1663TP) applied to the sole of a shoe as shown (the outline of the shoe is therefore not part of the trademark but serves to show the positioning of the trademark).’

### Earlier marks



**SUBSTANCE:** FIRST PLEA: INFRINGEMENT OF ARTICLE 75, SECOND SENTENCE: The opponent claimed that it was not allowed to present observations in reply to the intervener (applicant’s letter of 27 March 2014 by which the intervener requested the BoA to render its decision as soon as possible. Moreover, it claimed that it was communicated to it after the BoA’s decision was

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM’s European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



taken. The GC finds that the said letter was not taken into account in the BoA's decision and in any case it would have had no concrete incidence on the substance (Paras. 24-25). Therefore, there was no infringement of the right to be heard.

SECOND PLEA: INFRINGEMENT OF ARTICLE 8 (1) (b) CTMR: The opponent alleged that the red colour was predominant in both marks. The GC finds that the red colour is not predominant in the earlier mark (Para. 46). The rectangle shape is banal and the rectangle is not dominant in the overall impression of the sign (Para. 47). The red colour itself is a minor part of the earlier mark (Para. 48). Moreover, the GC confirms that the red rectangle is decorative and of secondary importance (Para. 49). Each element of the earlier mark has the same importance, none of them being more distinctive (Para. 56). The opponent's argument that the earlier mark might be applied on the sole of high heel shoes is irrelevant. The earlier mark must be considered as registered. The graphic representation in the registration defines the scope of protection of the mark. The analysis of the likelihood of confusion should not depend on the trade mark owner's commercial intentions (Para. 58). The GC confirms that the signs are visually dissimilar. The phonetic comparison was not challenged. The earlier mark will be referred to as "my shoes". As regards the contested mark, the Regulations do not mention "position marks" as a category of marks. According to the Case-Law such marks are similar to the categories of figurative marks and 3D marks (Para. 63). There is no phonetic

similarity. The contested mark, if pronounced, will be referred to as a description of the sign (Para. 64). There is no conceptual link in the coincidence of the red colour (Para. 69). The verbal element "my shoes" is descriptive of shoes. Therefore it has a low degree of distinctiveness. Even if it is true that both marks refer to shoes, this idea is endowed with a low distinctiveness, even very low, taking into account the goods at hand (Para. 74). The signs do not have a sufficient conceptual link. The GC thus confirms that the signs are globally dissimilar.

**Case T-197/14; La Zaragozana, S.A. v OHIM; Judgment of 21 May 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Visual similarity, Phonetic similarity, Conceptual dissimilarity, Likelihood of confusion, Descriptive element, Identity of the goods and services, Figurative element

**FACTS:** The applicant filed an opposition against the registration of the CTM application GREEN'S (fig.) filed for a list of goods in Class 32 and the existence of likelihood of confusion. It was based in the Spanish trade mark registration AMBAR GREEN for goods also in Class 32. The Opposition Division (OD) upheld the opposition for all the contested goods. The applicant filed an appeal and

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

the Board of Appeal (BoA) annulled OD decision. It found that the signs were visually similar to a below average degree and phonetically slightly similar. Conceptually, it considered that the relevant Spanish consumer would associate the term "GREEN" with the notion of organic and environmental friendly, and consequently, would see this element as descriptive and the earlier mark as an ecological line of "AMBAR beers". The element "GREEN'S" would be identified by this public as denoting possession from someone called "GREEN" due to the intensive use of Saxon genitive in trade.

### CTMA



### Earlier mark

**AMBAR GREEN**

**SUBSTANCE:** The relevant public is composed of average consumer from the general public who is reasonably observant with a level of attention from normal to low. The General Court endorses the definition of the relevant public from the BoA (Paras. 32-33). The goods in dispute are identical. Signs: At



complex trade marks, figurative might occupy an equivalent position to the verbal part (Para. 31). Highly similar verbal elements do not necessarily imply visual similarity because the specific manner of a figurative part can affect the overall impression as to render them different (Para. 32). The signs are visually similar to a low degree. The phonetic differences are located at the initial part of the signs, the one to which consumer tend to focus. The signs have a different number of syllables, rhythm and intonation (Para. 38) and present only a low degree of phonetic similarity. Conceptually, "GREEN" is used in the current language of the food market in order to denote organic products (Para. 42). The use by the applicant of the house mark "AMBAR" with other signs supports the notion that consumer would identify "AMBAR" as the principal elements and "GREEN" as indicating a type of beer (Paras. 44-45 and 55). GREEN'S would not be identified by part of the Spanish public as denoting possession; some people have very little knowledge of English (Para. 47). However, it is likely that average consumer see this element as having an Anglo-Saxon origin without any meaning but the figurative part convey the idea of a traditional public house. It is unlikely that Spanish public attribute the same organic meaning to the application (Para. 48). Consequently, the signs are not conceptually similar. Conceptual differences might counteract visual and phonetic similarities when at least one of the sign has a clear meaning. In view of the differences located at the initial part and the different ideas conveyed by the signs, likelihood of confusion is safely excluded even when applied to identical goods.

## First Page

- New online design application form

James Nurton  
Interviews | Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law

**Case T-140/14; Bora Creations SL v OHIM; Judgment of 4 June 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Descriptive element, Distinctive element, Laudatory mark, Nature of goods and services, Principle of legality

**FACTS:** The applicant sought to register the word mark GEL NAILS AT HOME as a CTM for goods and services within Classes 3, 8, 11 and 21. The examiner refused to register the word as a CTM on the ground of articles 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) dismissed the opponent's appeal. It found that the sign GEL NAILS AT HOME as a whole was immediately understandable by the relevant public which would perceive it as a description of the disputed goods intended for (gel) nail modelling at home. As a result, the BoA concluded that the sign was descriptive under article 7 (1) (c) CTMR and was devoid of distinctive character under article 7 (1) (b) CTMR. The applicant filed an action before the General Court (GC).

**CTMA**

**GEL NAILS AT HOME**



**SUBSTANCE:** With regards to the descriptive character of the sign, the GC considered that the combination of the two expressions “gel nails” and “at home” is generally understandable by the relevant English-speaking public (Para. 22). The GC emphasized that the expression does not differ from the general English grammar, is not a lexical invention and does not require any specific thinking to understand its meaning (Para. 23.). As such, both the expressions taken apart and the sign taken as a whole are descriptive of the goods and services applied for (Paras. 23 and 25). As regards the goods and services applied for, the GC found that the BoA was right in considering that the message behind the sign in question concerned all the goods of the applicant, all of them being susceptible to be used to model nails at home or for gel nails care at home (Para. 28). Moreover, the argumentation of the applicant clearly proved that it understood that the ground of rejection of its CTMA applied to all the goods listed in the application (Para. 29). Finally, as regards the claim of the applicant that the Office should be bound by its previous decisions, the GC dismissed it (Paras. 30-36). Since it is sufficient for the mark to be refused the registration if one of the absolute grounds is applicable, the GC did not adjudicate on the second plea in law regarding 7 (1) (b) CTMR (Para. 39).

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law



**Case T-352/14; The Smiley Company SPRL v OHIM / The Swatch Group Management Services AG; Judgment of 15 July 2015; Language of the Case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Likelihood of confusion, Similarity of the goods and services, Similarity of the signs, Identity of the goods and services, Retail services, Complementarity goods and services, International registration, Nature of goods and services, Visual similarity, Phonetic similarity, Conceptual similarity

**FACTS:** The Smiley Company SPRL, (applicant before the GC or applicant), filed an application for registration of the word sign HAPPY TIME as a Community trade mark for goods and services in, inter alia, in Classes 14 and 35. On 20 September 2011, The Swatch Group Management Services AG, (the other party before the GC), filed a notice of opposition to registration of the mark applied for in respect of all the goods and services applied for. The opposition was based on the earlier international registration word mark HAPPY HOURS, having effect in the European Union and designating the following services: Class 35: "Retailing of timepieces and jewellery; retailing of timepieces and jewellery via global computer networks (Internet)" and Class 37: "Repair and maintenance of timepieces and jewellery".

The grounds relied on in support of the opposition

were those set out in Article 8 (1) (b) CTMR. The Opposition Division (OD) partially upheld the opposition in relation to the goods applied for in Class 14. The Board of Appeal (BoA) dismissed the appeal. The BoA stated that for the purposes of assessing the likelihood of confusion, it would consider "the natural meaning of the goods and services specified in the application" for registration. Thus, the BoA did not rule on the likelihood of confusion concerning, in particular, auctioneering services and it pointed out that neither party had presented any arguments in that respect. The BoA found that there was a likelihood of confusion between the two marks at issue because of the similarity of the signs and the identity and similarity of the goods and services at hand.

The applicant filed an action before the General Court (GC), alleging the infringement of Article 8 (1) (b) CTMR.

**CTMA**

**HAPPY TIME**

**Earlier mark**

**HAPPY HOURS**

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law



**SUBSTANCE:** The GC confirmed the existence of a likelihood of confusion between the conflicting marks. In relation to the comparison of the goods and the services, it confirmed the finding of the BoA that there is some similarity between the contested “goods in precious metals or coated therewith, not included in other classes; jewellery; horological and chronometric instruments” in Class 14 and the services “Retailing of timepieces and jewellery; retailing of timepieces and jewellery via global computer networks (Internet)” in Class 35 of the earlier mark. The GC recalled its Case-Law that goods or services are complementary where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (see judgment of 22 January 2009 in *Commercy v OHIM — easyGroup IP Licensing (easyHotel)*, T-316/07, ECR, EU:T:2009:14, paragraph 57 and the Case-Law cited). The GC found in particular that that close connection exists between the goods and services at hand: the goods that are the subject of the retail services covered by the earlier mark are identical to the goods covered by the mark applied for; the services at issue are generally offered in the same places as those in which the goods covered by the mark applied for

are offered for sale. Finally, the GC found that, even if the consumers concerned believed that the goods sold by a retailer were generally made by third-party undertakings and not by the retailer, it nevertheless remains the case that those consumers might believe that liability for the manufacture of the goods sold by that retailer falls on that retailer where, first, there is a similarity between the mark covering those goods and the retailer’s mark and, second, the latter mark covers retail services relating to the same goods (Paras. 26-32).

As far as the signs are concerned, the GC further found that there is a certain degree of visual similarity and a low degree of phonetic similarity between the signs. Conceptually, the BoA correctly stated that both of the signs refer to a state of being happy over an unspecified period. Therefore, the BoA was entitled to conclude that there is a very strong conceptual similarity between those signs (Paras. 34-44). Following the foregoing, the GC held that, given that the goods and services display some similarities and that there is an overall similarity between the marks at issue, the BoA did not err in finding that there was a likelihood of confusion. Therefore, the ground plea alleging infringement of Article 8 (1) (b) CTMR was dismissed.

## First Page

- New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, *Group Nivelles v OHIM – Easy Sanitary Solutions BV*, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal

## Case law

**Case T-618/14; Grupo Bimbo, S.A.B. de C.V. v OHIM; Judgment of 29 June 2015; Language of the case: ES**

**RESULT:** Action dismissed

**KEYWORDS:** Three dimensional mark, Distinctive element, Well known facts need no evidence, Burden of proof, Nature of goods and services, Shape of the product, Burden of proof

**FACTS:** The applicant sought to register the 3D mark represented below as a CTM for goods in Class 30, namely “corn fritter snacks or tortilla chips, extruded corn”. The examiner refused to register the application in its entirety, on the basis of Article 7 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. It found that the CTMA represents a basic geometrical form that does not differ substantially from others in widespread use in the snack sector. The possible differences between this form and a simple, ordinary cylinder are not easily perceptible and will not enable the relevant public to recognise said form at the time of a subsequent purchase. Since these appreciations are based on well-known facts, it is for the applicant to show that consumer's habits on the relevant market are different.

The applicant filed an action before the General Court (GC) claiming a violation of Article 7 (1) (b) CTMR.



### CTMA



**SUBSTANCE:** The GC confirmed the findings of the BoA as to the nature of the goods at issue (food products for everyday consumption) and the relevant public (average consumer) (Paras. 16 and 17).

It recalled the Case-Law regarding the distinctive character of 3D marks consisting of the shape of the goods at issue, concluding that in such cases, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character. Inversely, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7 (1) (b) CTMR (Paras. 24-26). The BoA concluded that the CTMA at issue did not depart significantly from other forms commonly used for snacks and that it is usual to find in any supermarket snacks in various similar forms. This conclusion was based on well known facts and, as

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

such, there was no need for the Office to submit evidence to support it. It was for the applicant, to the extent it challenged this finding based on well known facts and invoked the distinctive character of the CTMA, to submit proof in this regard (Paras. 30-32).

The evidence submitted by the applicant (two examples of other types of cylindrical snacks) is not sufficient to prove that the differences between their shape and that of the CTMA are substantial enough to make consumers perceive the latter as the trade mark of a specific manufacturer (Para.38).

**Cases T-395/14 and T-396/14, Best-Lock (Europe) Ltd v OHIM – Lego Juris A/S ('Form einer Spielzeugfigur I and II'), Judgments of 17 June 2015, Language of the case: EN**

**RESULT:** Actions dismissed

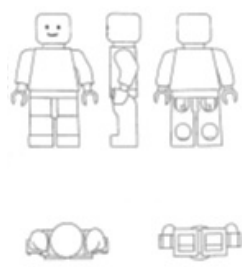
**KEYWORDS:** Admissibility, Absolute grounds, Shape of the product, Technical function of a design, Technical result, Three-dimensional mark, Bad faith

**FACTS:** The invalidity applicant applied for a declaration of invalidity of the 3D-CTMs represented below as regards the goods 'Games and playthings; decorations for Christmas trees' (Class 28) based upon Article 52 (1) (a) in conjunction with Article 7 (1) (e) (i), Article 7 (1) (e) (ii), and Article 52 (1) (b) CTMR. The Cancellation Division rejected the request as it

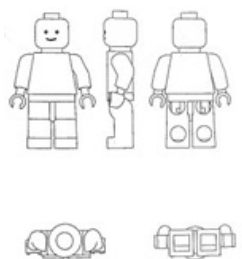


found that none of the grounds of invalidity invoked by the invalidity applicant were met. The Board of Appeal (BoA) dismissed the appeal.

### CTM in Case T-395/14



### CTM in Case T-396/14



**SUBSTANCE:** As requested by the Office (and the intervener), the General Court (GC) dismissed the action for annulment of the BoA's decision as inadmissible for failure to comply with Article 44 (1) (c) RoP-GC – which provides that an application 'shall

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal





## Case law



state the subject-matter of the proceedings and a summary of the pleas in law on which the application is based'. As regards Article 7 (1) (e) (i) CTMR, the GC found that the invalidity applicant had merely asserted that the contested CTMs consist of a shape determined by the nature of the goods themselves – but neither put forward any argument to support that assertion nor provided any reasoning to show that the BoA's findings in that regard were incorrect. Therefore, the minimum requirements of Article 44 (1) (c) RoP-GC were not met. As regards Article 7 (1) (e) (ii) CTMR, the GC observed that the invalidity applicant had only submitted general assertions and not put forward any argument in its application for annulment specifically contesting the BoA's detailed assessments which formed the basis for its finding that the applicant had not shown that any technical result could be attributed to that shape. Therefore, the GC found that the invalidity applicant had not validly contested the BoA's interpretation or application of Article 7 (1) (e) (ii) CTMR for the purposes of a judicial review under Article 65 CTMR. With respect to Article 52 (1) (b) CTMR, the GC found that the applicant had neither put forward any evidence in the application to substantiate its assertions that the CTM owner had filed the contested CTMs in bad faith, nor referred, with the minimum level of detail required to the evidence submitted during the proceedings before the Office, nor submitted arguments to contest the specific findings made by the Office with regard to the CTM owner's bad faith.

In addition, the GC observed *ad abundantiam* that the action based upon Article 7 (1) (e) (ii) CTMR was, in any event, unfounded – confirming the BoA's finding that the contested CTMs do not consist exclusively of the shape of goods which is necessary to obtain a technical result. On the one hand, the GC confirmed the BoA's finding that the contested CTMs' essential characteristics – i.e. those necessary to give to the shaped toy figures a human appearance – are the head, body, arms and legs. However, no technical result is connected to or entailed by the shape of those elements, which do not, in any event, allow the figure to be joined to interlocking building blocks. On the other hand, the GC noted that the toy figures' hands, the protrusion on its heads and the holes under its feet and inside the backs of its legs do not, *per se* and *a priori*, reveal any technical function – and, if so, what that function is. In any event, even assuming that they may have such a function – namely that of enabling them to be joined to other elements, in particular interlocking building blocks – those elements were not considered to constitute an essential characteristic of the shapes in question. Finally, the GC approved the BoA's finding that the 'result' of that shape is simply to confer human traits on the figure in question, and the fact that the figure represents a character and may be used by a child in an appropriate play context is not a 'technical result'.

## First Page

- New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

- Data carriers and recorded content

## Registered Community Design

- 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

- July 2015

- August 2015

## ETMDN Updates

- Expansion of TMview, Designview and other International Cooperation initiatives at OHIM
- BOIP implements Back Office
- Hungary implements trade mark e-filing

## More News

- €500 million lost every year throughout the EU due to fake sports equipment
- Update of the performance achieved by OHIM: Service Charter results for 2015 Q2
- Online IP Management: OHIM's European Workshop Roadshow
- National Case-Law Collection meeting

## Case Law

- Luxembourg trade mark and design news
- New decisions from the Boards of Appeal



## Case law



### New Decisions from the Boards of Appeal

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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 29 April 2015 – R 1490/2014-4 – ROOM SEVEN; Language of the case: EN**

**RESULT:** Decision confirmed.

**KEYWORDS:** Admissibility, International registration, Filing date.

**FACTS:** The appellant sought to convert International Registration (IR) for the word mark 'Room Seven' – registered for goods in Classes 18, 24 and 25 – into national trade mark applications in the United Kingdom, Spain, France, Austria and Germany. An opposition was filed against the goods in Class 18 on the bases of several earlier marks. The Opposition Division rejected the opposition for the goods in Class 18 'leather, imitations of leather; animal skins and hides' and upheld it for the goods in Class 18 'goods made of these materials (leather

and imitations of leather) and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery' on the basis of a likelihood of confusion. The appellant filed an appeal against that decision, however, the appeal was dismissed (R 955/2012-4). The appellant filed an action before the General Court, but later requested that the proceedings be discontinued. On the basis of this withdrawal the appellant requested the conversion of the IR into national trade mark applications as detailed above. The Office rejected the request for conversion on the basis of its inadmissibility.

**SUBSTANCE:** The withdrawal of an appeal means that the decision appealed becomes final. Merely filing an action to the General Court and then, immediately afterwards, withdrawing or discontinuing it did not have the effect that the Board's decision had no effect, but to the contrary it had become final, and in particular this could not have the consequence that the mark could be converted into national trade mark applications as if no proceedings before the Opposition Division or the Board of Appeal had taken place and as if no negative decision against the appellant had been issued.

[Link to eSearch Case Law](#)

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

**Decision of 12 June 2015 – R 3056/2014-2 – SIMITÇİ DÜNYASI (FIG. MARK) / SD SIMIT DÜNYASI (FIG. MARK); Language of the case: EN**

**RESULT:** Decision confirmed.

**KEYWORDS:** International registration, Figurative trade mark, Colour mark, Complex mark, Complementary evidence, Substantiation of earlier right, Filing date, Request for proof of use, Legal certainty, Competence of the Boards.

**FACTS:** The CTM applicant sought to register the figurative mark represented below for goods and services in Classes 30, 35 and 43. The opponent filed an opposition against all the goods and services in Classes 30 and 43 based on an international trade mark registration (IR) for goods and services in Classes 30 and 43. The opponent invoked Article 8(1) (a) and (b) CTMR. The Opposition Division (OD) rejected the opposition in its entirety.

**SUBSTANCE:** The Board found that before the OD the opponent had failed to provide any evidence concerning the earlier international trade mark registration within the set time-limit. In the appeal, together with the statement of grounds, the opponent submitted, for the first time, an extract from the WIPO's Romarin database. The question arose whether the Board could admit this belated evidence.



### CTMA



### Earlier International Trade Mark



According to the PROTI SNACK (C-120/12 P) and KENZO (T-322/13) judgments, Rule 20(1) CTMR (implying that the opposition should be rejected as unfounded if the opponent did not substantiate its earlier right within the set time-limit) was not a provision to the contrary liable to preclude the discretion enjoyed under Article 76(2) CTMR. Furthermore, the third paragraph of Rule 50(1) CTMIR had to be applied at this particular stage of the appeal proceedings, which gave the Boards the discretion to decide whether or not to take into account additional or supplementary facts and evidence which were not presented within the time-limits set or specified by the OD. However, since the

## First Page

■ New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

opponent did not substantiate its earlier right, there was an absolute lack of evidence at first instance, so that the evidence submitted for the first time before the Board could not be considered as additional or supplementary and was, thus, inadmissible.

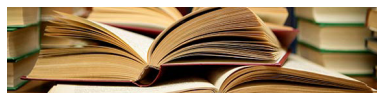
The Board interpreted, though, that pursuant to Article 76(2) CTMR, it would nevertheless have discretion to accept the documents filed belatedly, irrespective of whether or not they were considered additional or supplementary. However, even in that case, the Board would use its discretion not take them into account. A party had no unconditional right to have facts and evidence submitted out of time taken into consideration by the Office. Apart from the lack of legitimate reasons given by the opponent, the file did not show that there were any surrounding circumstances likely to justify the opponent's delay in the submission of the evidence.

[Link to eSearch Case Law](#)

**Decision of 22 July 2015 – R 568/2015-4 – EXELTIS RETHINKING HEALTHCARE / EXELON; Language of the case: English**

**RESULT:** Closed without decision.

**KEYWORDS:** Admissibility, Restriction of the list of goods and services.



**FACTS:** An opposition was filed against the application to register the figurative mark represented below for, inter alia, pharmaceutical preparations for special purposes in Class 5. The opposition was based on the earlier CTM 'EXELON' registered for pharmaceutical preparations in Class 5. The Opposition Division upheld the opposition and rejected the application in its entirety.

### CTMA



### Earlier CTM

**EXELON**

**SUBSTANCE:** The applicant requested the limitation of the goods which was rejected by the Board as inadmissible, because of its lack of clarity and precision. In addition, since the opposition was withdrawn, the Board concluded that the opposition proceedings had lost their purpose and should be closed.

[Link to eSearch Case Law](#)

## First Page

■ New online design application form

James Nurton  
Interviews

| Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**Decision of 30 June 2015 – R 2157/2014-2 – i (FIG. MARK); Language of the case: EN**

**RESULT:** Decision annulled.

**KEYWORDS:** Function of trade mark, Figurative trade mark, Figurative element, Complex mark, Letter mark, Minimum degree of distinctiveness, Distinctive element, Specialised public, Abbreviation, Graphical representation, Nature of the goods and services.

**FACTS:** The examiner refused registration of the figurative sign 'i' (as represented below) for goods and services in Classes 9, 10, 44 and 45, on the basis of Article 7(1)(b), (c) and Article 7(2) CTMR. The examiner found that the sign was the abbreviation for 'internet' or 'interactive', therefore the mark applied for would immediately inform consumers that the goods and services were, for example, computer tracking and monitoring devices using the internet in order to check, report and transmit patients' data or interactive monitoring medical services.

CTMA



**SUBSTANCE:** The Board found that the figure applied for was not so simple that it could be denied registration on the grounds cited by the examiner. The trade mark applied for was certainly restrained in detail in its execution, but taken in its entirety it was neither a simple geometric figure, a simple reproduction of the letter 'i', nor a mark that was entirely banal for the purposes of trade mark law.

As noted by the applicant, the mark could also be seen, for example, as the letter 'i' and a hooded arch which was a minimalistic representation of a human being. The semicircle contained in the mark made it resemble a stick figure, i.e. a simple drawing of a person. It was also possible that taking the mark as a whole into consideration, it would not be seen as containing the letter 'i' at all, but just a stylized geometric figure.

The Board was of the opinion that the figurative mark's simple but specific composition could certainly be remembered and it would enable the relevant public to identify the commercial origin of the goods and services in question and distinguish these from other goods and services. The trend nowadays was for figurative marks to be simple and stylised in their design. Consumers were, therefore, accustomed to perceiving relatively simple figurative marks as signs. The combination of the components in the mark, although perhaps not highly imaginative, and the way that they were integrated with each other, meant that the

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

trade mark applied for was able to function as a commercial indication of the origin of the goods and services in question and distinguish these from other goods and services.

[Link to eSearch Case Law](#)

**Decision of 22 July 2015 – R 2146/2014-2 – IO**  
**Language of the case: EN**

**RESULT:** Decision annulled.

**KEYWORDS:** Abbreviation, Descriptive element, Function of trade mark, Nature of the goods and services, Restriction of the goods and services.

**FACTS:** The examiner, following third-party observations, partially refused the registration of the word mark 'IO' for goods in Class 9 and services in Class 42, on the basis of Article 7(1)(b), (c) and Article 7(2) CTMR. The examiner found that the mark applied for was the abbreviation for input/output, therefore the sign immediately informed consumers without further reflection that the goods and services applied for involved the two-way flow of data.



**SUBSTANCE:** The Board found that the expression I/O was the abbreviation for 'input-output', not the expression 'IO' of the mark applied for. The omission of the forward slash '/' in the mark applied for was striking for the part of the relevant public who was aware of the meaning of the abbreviation 'I/O' and even for that part of the public, consequently, any descriptive meaning perceived would not be immediate or direct in relation to the contested goods in Class 9, 'computer programs intended for professional use for operation, monitoring, control, configuration and optimization of information technology infrastructure and related operating equipment and systems', or in relation to the contested services in Class 42, 'computer co-location services for enterprise and professional customers, namely, providing facilities for the location of computer servers with the equipment of others'. The term 'input-output' did not refer to an essential characteristic of these goods or services, but was a very broad term that was, at most, somewhat allusive in relation to the contested goods and services. There was not, however, a sufficiently direct and specific relationship between that mark and the services in question for the mark to be barred from registration.

[Link to eSearch Case Law](#)

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

**Decision of 30 June 2015 – R 2846/2014-5 – CAMOUFLAGE; Language of the case: EN**

**RESULT:** Decision partially annulled.

**KEYWORDS:** Function of trade mark, Distinctive element, Descriptive element, Specialised public, Relevant territory, Nature of the goods and services.

**FACTS:** The examiner partially refused registration of the word mark 'CAMOUFLAGE' for certain goods in Class 28 and services in Class 41, on the basis of Article 7(1)(b), (c) and Article 7(2) CTMR. The examiner found that the mark applied for would immediately inform consumers that the goods were devices destined to conceal or deceive by camouflage.

**SUBSTANCE:** The Board found that the mark was to be refused, but not for all the goods and services indicated in the contested decision. The Board allowed the trade mark registration to proceed in relation to archery game related services ('provision of entertainment facilities' and 'organization and conducting of archery parties, archery events, games and competitions; provision of archery training, archery lessons' in Class 41), where camouflage was not really desirable. Competitive archery and games featuring medieval archery were not a sport or event where camouflage would be expected to be used, since competitors had to remain visible for the public and to each other.

[Link to eSearch Case Law](#)



**Decision of 30 June 2015 – R 1653/2014-2 – maternity worldwide (FIG. MARK) / MATERNITY una apuesta por la mujer y la maternidad (FIG. MARK); Language of the case: EN**

**RESULT:** Decision annulled.

**KEYWORDS:** Figurative trade mark, Figurative element, Complex mark, Colour mark, Likelihood of confusion, Dominant element, Distinctive element, Common element, Similarity of signs, Identity of signs, Visual similarity, Phonetical similarity, Conceptual similarity, Nature of goods and services, Purpose of goods and services, Minimum degree of distinctiveness, Weak element, Identity of the goods and services.

**FACTS:** The applicant sought to register the figurative mark 'maternity worldwide' (as represented below) for services in Classes 35, 36, 41, 42 and 44. The opponent filed an opposition on the basis of an earlier Spanish trade mark registration for the figurative mark represented below, and registered for services in Classes 41, 44 and 45. The opposition was based on Article 8(1)(b) CTMR and was directed against all services of the application. The Opposition Division partially upheld the opposition namely for all services in Classes 35, 41, 42 and 44. It allowed the application to proceed for the remaining services, namely all services in Class 36.

## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal



## Case law

### CTMA



### Earlier mark



**SUBSTANCE:** The Board found that the low degree of visual and phonetic similarities and the certain conceptual similarity between the contested figurative mark 'maternity worldwide' and the earlier figurative Spanish mark 'MATERNITY una apuesta por la mujer y la maternidad' were offset by the fact that the similarity rested mainly on a highly allusive term, 'MATERNITY', in relation to the services in conflict. Also, there were visual conceptual differences in the marks' figurative elements. Confronted with the highly allusive element 'MATERNITY' the Spanish public would focus its attention on the non-coinciding elements of the marks which were not negligible. The figurative nature of the two marks, with different figurative elements, and the fact that the single common word element was not dominant in any of them, reinforced the finding that they were dissimilar overall. Thus, the Opposition



Division erred in finding that there was a likelihood of confusion, even in respect of identical services.

[Link to eSearch Case Law](#)

**Decision of 9 July 2015 – R 879/2013-2 – HISPANO SUIZA; Language of the case: EN**

**RESULT:** Decision annulled.

**KEYWORDS:** Bad faith, Burden of proof, Distinctive element, Figurative element, Figurative trade mark, Filing date, Reputation, Scope of the proceedings, Similarity of the signs, Unfair advantage.

**FACTS:** The CTM proprietors sought to register the word mark 'Hispano Suiza' (as represented below) for goods in Classes 12, 14 and 25. The cancellation applicant requested a declaration of invalidity pursuant to Articles 52(1)(b) and 53(1)(a) CTMR in conjunction with Article 8(1)(b) and 8(5) CTMR which was based on the earlier French trade mark registrations represented below. The request was based on some of the goods and services covered by the registrations (Class 7 – Transmission and propulsion mechanisms, motors of all types for fixed or mobile installations, for land, nautical, aerospace vehicles; Class 9 – Measuring apparatus and instruments; Machine and machine control of pieces with complex geometry of the automotive, aerospace, aeronautics, marine, and

## First Page

■ New online design application form

James Nurton  
Interviews

Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal

## Case law

nuclear industries, parts and accessories; Class 13 – Weapons, firearms, tanks, ammunition and projectiles, rocket-propelled craft ballast resistor.).

The Cancellation Division (CD) partially accepted the cancellation request and declared the registration of Community trade mark No 7 415 011 partly invalid for the following goods: 'Vehicles; apparatus for locomotion by air; brake linings for vehicles; brake segments for vehicles; brake shoes for vehicles; brakes for vehicles; ejector seats for aircrafts; hydraulic circuits for vehicles; rudders; screw-propellers; shock absorbing springs for vehicles; suspension shock absorbers for vehicles; undercarriages for vehicles; vehicle suspension springs, tires for vehicle wheels; tires, solid, for vehicle wheels; and vehicle wheel tires [tyres]; vehicle wheels' in Class 12.



**SUBSTANCE:** The Board found that there was no doubt that the CTM proprietors were aware that the 'Hispano Suiza' marks enjoyed reputation in relation to motor vehicles. Further, the evidence as mentioned in the contested decision showed that the extent of that reputation had been considerable in the past; that it could have diminished over the years, but that it still survived at the time when the contested decision was adopted, at least as a historical brand, which was still 'alive' in the sense that a thriving market for second-hand vintage and concept cars existed. It was only after checking the legal situation that the CTM proprietors applied for registration of the mark at issue, taking over, unchanged, the word element of the earlier figurative marks. Similarly, it was clear that the CTM proprietors were aware of the earlier registrations in France.

It could be inferred from the particular circumstances of the case that the real purpose of the CTM proprietors application for registration of a Community trade mark was to 'free-ride' on the reputation of the cancellation applicant's registered marks and to take advantage of that reputation. The CTM proprietors acted in bad faith when applying for the registration of the contested mark. The existence of bad faith, when the application for registration was filed entailed, in itself, the nullity in its entirety of the mark at issue.

[Link to eSearch Case Law](#)

### CTMA

**Hispano Suiza**

### Earlier French Trade Marks



## First Page

■ New online design application form

James Nurton Interviews | Tobias Cohen Jehoram

## Community Trade Mark

■ Data carriers and recorded content

## Registered Community Design

■ 13/05/2015, Group Nivelles v OHIM – Easy Sanitary Solutions BV, T-15/13, Shower Drains, EU:T:2015:281

## Statistical Highlights

■ July 2015

■ August 2015

## ETMDN Updates

■ Expansion of TMview, Designview and other International Cooperation initiatives at OHIM

■ BOIP implements Back Office

■ Hungary implements trade mark e-filing

## More News

■ €500 million lost every year throughout the EU due to fake sports equipment

■ Update of the performance achieved by OHIM: Service Charter results for 2015 Q2

■ Online IP Management: OHIM's European Workshop Roadshow

■ National Case-Law Collection meeting

## Case Law

■ Luxembourg trade mark and design news

■ New decisions from the Boards of Appeal