

# Alicante News

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## OHIM's digital journey



February  
2015



Anamarija Stančić Petrović talks to James Nurton

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### OHIM's digital journey

January 2015 marked the first full year of OHIM's new website; a site which is designed with four key objectives in mind - more security, more tools, more user empowerment and more digital communication.



**1 hub for all things web:  
Inside OHIM online**

OHIM's website is the channel through which we connect and interact with our users, whether at work, on route or at home. Out of the 223\* countries and territories connecting to our website worldwide, 60% of the traffic comes from the European Union. The figures speak for themselves: already the new site has clocked up more than 3 500 000 page views per month, with 45 000 users registered.



**+ 3 500 000  
page views per month**

From the early days of our website, during which it experienced instability problems, to the high performing site it is today, we have carried out numerous communication and training activities to accompany our users in their digital journey with us. Out of 121 errors reported, 110 were fixed. Out



of 31 planned improvements, 27 have been implemented. Complementing the technical work done, OHIM has also launched regular workshops and webinars to train users on new aspects and functionalities of our website.

**31 improvements planned  
27 implemented**



Our online interactions with users tell us what we have done right so far and about what they believe we can improve. Security is of paramount importance to all and the new OHIM website uses an authentication system to better protect the integrity of our users' information. With around 9 000 people connecting via this secure channel on a daily basis, and on average 93 new accounts being created every day, security is guaranteed.

The introduction of our free of charge accelerated procedure for the publication of trade mark applications and the change in the trade mark examination process have generated a change in our users' behaviour. The popularity of our Fast Track and new payment practice introduced in November last year have resulted in nearly a quarter of all applications taking the faster route. Now, some applications are published just three days after they are received.

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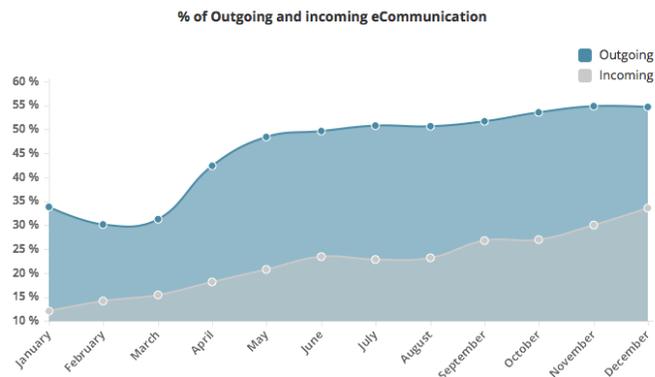
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To empower our users proactively, we have created a User Area, enabling users to manage their IP portfolios, to communicate with us and make changes in the CTM and RCD registry. Now, more than 60% of name and address changes are performed online by our users.

Over the past year, the greater part of our communications with users has been made electronically accounting for more than 680 000 communications. Close to 60% of all the communications we send to our users are electronic and with the number of communications received via this route topping 30% , the Office is well on its way to our goal of becoming a paperless office and cutting back on our environmental impact.

We are only into the second month of 2015 but we have plenty of challenges ahead. We aim to launch a new filing application for International Registrations as well as achieving full electronic communication for these registrations in the future. We will be adding new features to designs e-filing and increasing usability via our printable online applications and increased size of online attachments. Our web is taking shape and our website without doubt, is the channel through which we connect and interact more powerfully, safely and more efficiently with our users.



### One year 4 key objectives



More  
security



More  
tools



More user  
empowerment



More  
eCommunication

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## The James Nurton Interview



Anamarija Stančić Petrović,  
Director – Croatia office, Petosevic

**How did you become interested in the IP field?**

This is a tricky question. I started in 1996 when I joined a small IP boutique law firm in Zagreb in a temporary job working in IP administration. That was before I had a law degree. I found it very interesting and decided to stay in the field: I completed a law degree and then a master's degree in law specialising in IP from Queen Mary College of Law.



Anamarija Stančić Petrović

In 2004 I joined the Petosevic firm when it opened a representative office in Croatia, which then became fully incorporated with the firm in 2005 and I now head the team in Croatia. It will be our 10th anniversary in July this year.

Altogether in the group we have about 120 people in 15 countries, with 12 people in Croatia. There are three lawyers, including me, and an attorney-at law as well as administrative staff and paralegals. We do all kinds of work from prosecution to enforcement. My speciality was patents but now I do more and more work in trade marks. Patent litigation in Croatia is very rare.

I had previously studied musicology so I didn't have a clue that I would end up in this particular field in my career!

**What did you like about IP?**

It was connected with my interests, particularly the copyright and trade mark aspects. I found IP really interesting but I wasn't particularly interested in other areas of the law, such as criminal law.

**How has IP changed in Croatia in the past decade?**

We have reformed and harmonised the law and we became a full member of the EU in July last year. There have been a lot of amendments to the law and practice in the country.

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## The James Nurton Interview



We have found the Community systems efficient and cost-effective for securing trade mark protection compared to the cost of applying for national marks. The trend is changing and that's good. Before we joined the EU, only about 10% of Croatian corporations managed to protect their IP and very few small businesses did so. Now we see an increase in filing and use of the CTM system.

The Community system works well and enables local companies to protect and enforce their rights in Croatia and abroad. We also find the case law databases are very helpful in our daily work today.

Drawbacks include that a right in one country can block a CTM application. Another issue we see is the costs of filing Community trade marks – having lower fees for one-class filing would make the system more accessible to small businesses.

One trend we see is that the economic crisis in Croatia has caused a growth in the grey market and a lot of circulation of counterfeits particularly in the past year. Customs forces are doing their job quite well and stop most goods at the border but we also see local companies abuse the system and we have a lot of bad-faith filings of national trade marks. CTM owners have to fight for their rights by filing cancellation actions or court actions.

### What can people do about these bad faith filings?

It is an obstacle. All the CTMs were extended to Croatia as of July 1 last year. Companies monitor rights in all these countries and they suddenly discover that local trade mark rights for identical or similar marks are on the market. We cannot claim bad faith in the opposition procedure, but we can try to cancel the mark after registration or initiate a court action. Those who acquired bad-faith marks used to file lots of Customs applications, so genuine goods were being stopped due to local trade mark rights. It is really a big problem.

We are trying to oppose when we can but in most cases we have to pursue a cancellation action. In our trade mark law the holder of the national right can block the trade mark registration, so this is quite a big issue that we are dealing with.

### How well do the court proceedings work in Croatia?

The courts lack structure and expertise. The Commercial Court has six judges specialising in the field but they still have to be trained and everything takes far longer than it should. Most trade mark cases are connected with Customs enforcement. In infringement cases, we can settle almost all disputes we see but when it comes to Customs most of the cases end up at the courts and the litigation can last two years or more. There are also problems with the storage and destruction of goods.

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## The James Nurton Interview



### What's been the most unusual case you have worked on?

A few years ago we managed to close the fake Hard Rock Café in Zagreb, which was opened in the early 1990s during the war. No one knew it was not the original Hard Rock Café and it was very popular; lots of TV shows were broadcast from there. Many people thought it was the original.

Our client had registered Hard Rock Café but had not used the mark in Croatia, so that presented a problem when we filed an infringement case. The other party filed for non-use. So we claimed the copyright on the Hard Rock logo, we won the case on that basis and the client was very happy, so I am proud of that case.

We don't yet have the original Hard Rock Café in Zagreb but there are rumours that one will open soon.

### What other issues do you see becoming more important?

Cases arising from infringement on the internet and social media are increasing. In general, issues arising from new technology are becoming more common.

Also the Unitary Patent system is looming, and we have an amended Copyright Law coming. I read some articles recently about the law needing to move on from the Paris and Berne Convention to

adapt to modern technologies and businesses. I think that is interesting; it is hard for the law to keep up with technology.

In Croatia we also have to adapt to the European systems. And we are considering the UPLA Convention on plant varieties, and how to improve the regulation of Customs. There will be a lot of changes still to come in IP law and practice. We are adjusting to the European system and struggling with that and the continuing economic crisis, which is a major problem.

### Is it a good time to be working in IP?

Yes – it is very challenging as the practice is constantly evolving.

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his judgment rules on the appeal against the decision of OHIM's Third Board of Appeal, R 981/2012-3, Argo Development and Manufacturing Ltd v Clapbanner Ltd, in relation to invalidity proceedings (ICD 8429) for registered Community design No 001684325-0001 (RCD, see two views below).

The RCD, registered and published in 2010, was challenged in invalidity proceedings on the grounds of Article 25(1)(b) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR) for non-compliance with the novelty and individual character requirements of Articles 5 and 6 CDR. The applicant submitted four prior registered Community designs: No 000796446-0001; No 000796446-0002; No 000796446-0003; No 000796446-0004 (see views below). In substance, the applicant claimed that the RCD did not differ from the prior designs. All, the contested RCDs as well as the prior designs, relate to rectangular-shaped flat signboards with vertical lines on them, to indicate where they fold, and with a handle positioned at each end.

The RCD holder argued, inter alia, that in an article such as a card, simply folded in an accordion style,

even a small variation can have a profound impact on the design and cannot be considered immaterial, and that such a variation existed in the handles of the designs at issue: Whereas in the prior designs they were cut out, in the RCD they would have to be pressed out when the article was used for the first time. The cut-out handles in the prior designs increase the manufacturing costs, whereas the folded pressed-out parts in the RCD strengthen the handles. In any case the differences have a significant impact on the appearance of the products.

The invalidity application was upheld. The Invalidity Division found the ground for invalidity of lack of individual character justified with respect to prior design No 000796446-0001 and No 000796446-0002. It was ruled that the RCD and the prior designs differed as regards the handles which covered only a small area of the cardboard. The Invalidity Division stated:

[...] in use, it does not make a difference whether the handle portions were only perforated originally and later pressed out by the end user or whether they were cut out from the beginning. The informed user will not take into account whether the manufacturing costs of the perforation option are lower. For the informed user, the features of appearance present at the time of use are the most important. And in use, namely when the folded cardboard is held by the pressed-out or

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cut-out handles, respectively, the RCD is very similar to the prior designs. As a result, the RCD fails to produce an overall impression on the informed user different from the overall impressions produced by the prior designs.

The applicant appealed.

The Third Board of Appeal annulled the decision and dismissed the invalidity application, finding that the prior designs do not deprive the RCD of novelty or individual character. It stated that the parties agreed that the articles in comparison were typically made of lightweight cardboard and might have been folded as an accordion, and they were used by clutching their shorter sides with the hands or holding them high above the head. The informed users were both the persons who use the signboards at group events and the bodies that buy the signboards to put messages on them and then distribute them to the persons participating in those events.

Quoting from decision (paragraphs 25 and 26):

In the Board's opinion, the attention of a 'particularly observant' user will be immediately [be] attracted by the design of the handles in the signboards which are at issue here for the following reasons. The first is that the handles are the only part of the signboards where the designer has some freedom of creativity.

The second reason is that the handles are a very important part of the product, since the signboards are used by raising them high with the hands. The handles of these signboards can be designed in several ways and the evidence submitted by the parties confirms this degree of freedom. In designs No 796-446-0003 and No 796-446-0004, the handles are superimposed to the signboard. In designs No 796-446-0001 and No 796-446-0002, the handles are carved or cut out into the sides of the signboard. In the contested design, the handles are neither superimposed nor carved or cut out. They are represented as a perforated line (in the cardboard) that the user may press, thereby 'creating' handles.

The rest of the signboards at issue are essentially a piece of cardboard having a rectangular shape and divided in portions that can be folded as an accordion. These are two features where the degree of designer's freedom is very limited. The rectangle is the most obvious shape for a signboard because it allows for more writing space and to hold it high comfortably without impairing the holder's ability to see around it. For example, round, triangular or octagonal signboards would be utterly unpractical. Therefore, the rectangular shape is not an aspect of the design where the designer has a great freedom of choice. The same applies to the portioning

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of the signboard in slices of cardboard that can be folded as an accordion. If the signboard is to be quickly and practically folded as well as unfolded, folding it as an accordion or a ladies' fan is the method that immediately comes to mind. The degree of designer's freedom as regard this feature is almost absent.

The applicant appealed to the General Court, claiming that the Court should annul the Board's decision, grant the invalidity application and declare the contested design invalid. In essence, the applicant contended that the handles in the RCD did not remain visible during normal use of the product within the meaning of Article 4 CDR, the RCD was neither new nor did it have individual character with respect to the prior designs and it was registered in bad faith.

The General Court dismissed all the applicant's pleas and confirmed the appealed decision. It found that:

- Article 4(2) RCD lays down a particular rule applying specifically to a design applied to or incorporated in a product which constitutes a component part of a complex product within the meaning of Article 3(c) CDR (the Court referred to judgment of 09/09/2014, T-494/12, Biscuit, EU:T:2014:757). Nothing on file indicated that the contested design constituted a complex product or that the handles constituted a component part of

the product, therefore there was no basis for exclusion pursuant to Article 4(2) CDR.

- The RCD and the prior designs are not identical as regards the handles. Those differences cannot be considered to be immaterial details since they are perceptible when the RCD and the prior designs are placed side by side. The prior designs, therefore, do not constitute an obstacle to the novelty of the contested RCD.
- In the assessment of the individual character of the RCD, four matters have to be taken into account (i) the nature of the product to which the RCD applies, (ii) the informed user of the design, (iii) the designer's degree of freedom in the development of the design and (iv) the overall impressions produced on the informed user by the designs at issue.
- The conclusions of the Third Board of Appeal that the RCD applies to a rectangular cardboard signboard divided into pleats, which can be folded like an accordion, that the signboard can be used in an unfolded position in order to convey a message or in a folded position to produce a sound effect, and that the informed users are both the persons who use those signboards at group events and the bodies that buy those signboards and then distribute them to the persons participating in those group events were undisputed by the applicant. The

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Third Board of Appeal did not err in them.

- The applicant has not shown that there is 'ample opportunity to create a different design' for the advertising article designed and used as described above, and has not demonstrated other methods of folding in order to enable a signboard to fulfil its function. The rectangular shape and folding in accordion style are the most practical shape and method to hold an announcement above the head and clap the article to produce the sound effect. The Third Board of Appeal therefore did not err assessing that the designer had a very limited degree of freedom as regards the shape of the signboards and an almost non-existent one as regards their division into accordion-like foldable pleats. However, the Board of Appeal was justified in taking the view that the handles were the only part of the signboards for which the designer had some creative freedom.
- With reference to judgment of 18/03/2010, T-9/07, Representation of a circular promotional item, EU:T:2010:96, § 72 (quoted below for more convenience) the aspect of limited degree of freedom of the designer and differences in the handle portions played an essential role in the assessment of the overall impression produced by the designs at issue on the informed user. The handles in the RCD were sufficiently different from those in all four earlier designs

to conclude that the RCD produces a different overall impression on the informed user.

- Bad faith is not a ground for claiming the invalidity of a registered Community design, moreover, not having been invoked in the application but only at a later stage in the course of the administrative proceedings, it could not be taken into consideration.

To see the CJEU judgment click [here](#)

18/03/2010, T-9/07, Representation of a circular promotional item, EU:T:2010:96, § 72:

In the specific assessment of the overall impression of the designs at issue on the informed user, who has some awareness of the state of the prior art, the designer's degree of freedom in developing the contested design must be taken into account. Thus, [...] insofar as similarities between the designs at issue relate to common features, [...], those similarities will have only minor importance in the overall impression produced by those designs on the informed user. In addition, the more the designer's freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user.

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Contested RCD 001684325-0001



Fig. 1



Fig. 2

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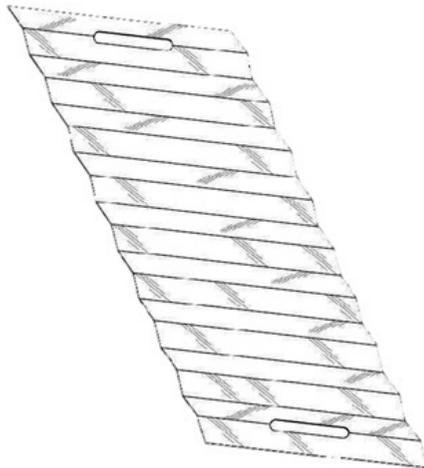
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Prior designs:



000796446-0001  
Fig. 1



000796446-0001  
Fig. 2

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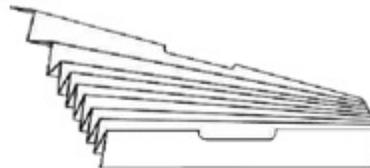
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000796446  
-0001  
Fig. 3



000796446-0001  
Fig. 4



000796446-0001  
Fig. 5

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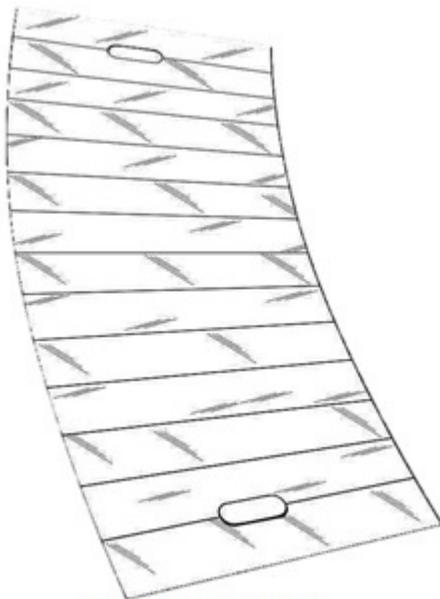
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000796446-0002  
Fig. 1



000796446-0002  
Fig. 2

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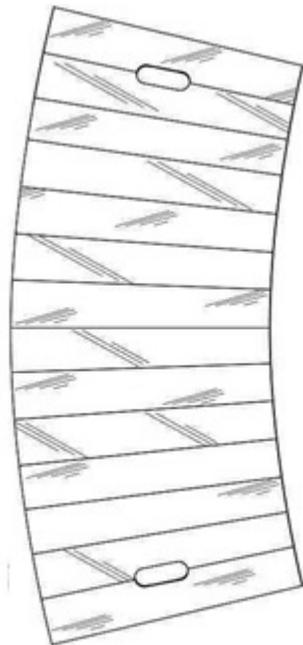
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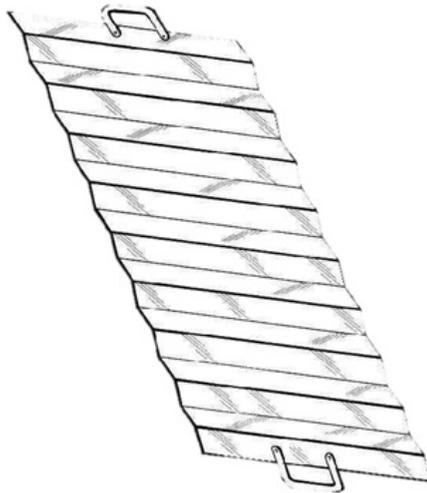
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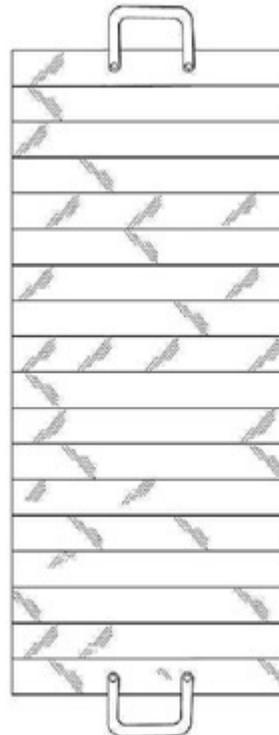
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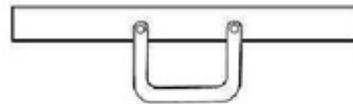
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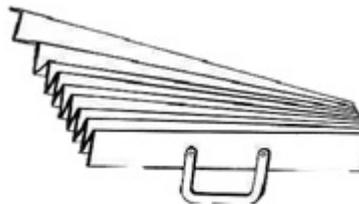
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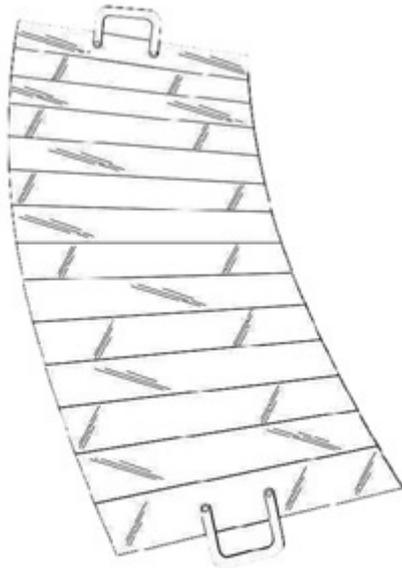
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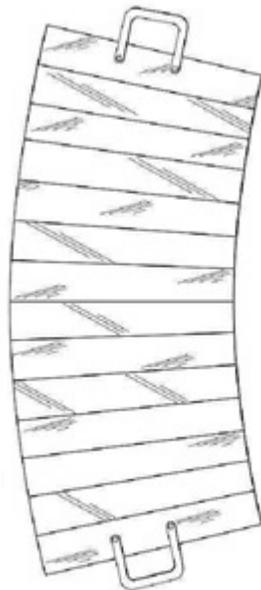
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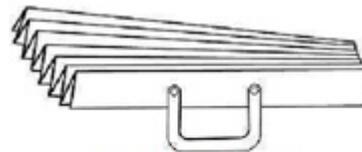
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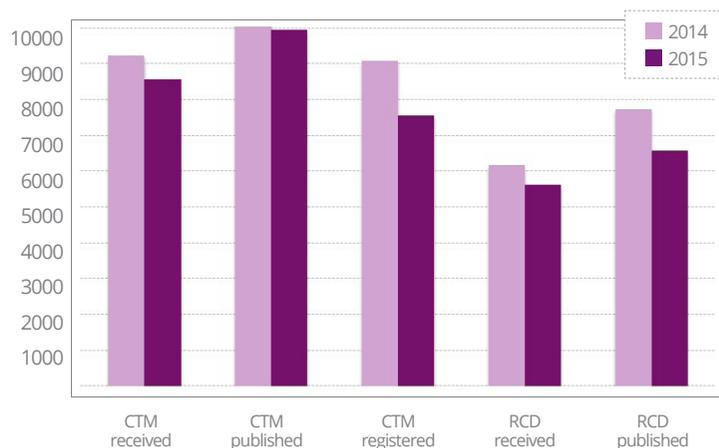


## Statistical Highlights



Monthly statistical highlights January*	2015	2014
Community Trade Mark applications received	8 568	9 220
Community Trade Mark applications published	9 956	10 345
Community Trade Marks registered (certificates issued)	7 562	9 066
Registered Community Designs received	5 606	6 153
Registered Community Designs published	6 576	7 718

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



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## INPI joins the Harmonised Database

The French National Institute for Intellectual Property (INPI) has joined the Harmonised Database of Goods and Services for trade mark classification, available through TMclass.

With the integration of INPI, all EU national and regional IP offices now form part of the tool.

TMclass is the largest trade mark classification database in the world. It offers quick and easy goods and services classification and contains around 65,000 pre-validated terms in 23 EU languages, all of which are pre-approved by all EU national and regional IP offices and OHIM.

The Harmonised Database has clear and practical benefits for users in France and across the EU. It helps to improve the predictability of EU IP office decisions, and helps to simplify the classification process by providing a common list of goods and services pre-approved by all EU offices.

The open and collaborative communication between INPI and all those working in the framework of the European Trade Mark and Design Network has been a key part of this latest integration. INPI is a valuable partner in the shared endeavours of the Network, as it continues to deliver benefits to end users.

The full integration of all EU IP offices into the tool, and the joint work carried out between all the offices on the wider projects is another example of the results that can be delivered to benefit users.

The Harmonised Database, with its newest participating office, INPI, is available through TMclass at: <http://tmclass.tmdn.org>. Goods and Services in this database are accepted by all EU Offices and translated into all EU IP office working languages.

## Hungary joins Designview

The Hungarian Intellectual Property Office (HIPO) has joined Designview, the registered designs search tool.

DesignView is the largest free, online search tool for registered designs available.

With the addition of HIPO, there are now 27 participating offices in DesignView. The addition of 13,000 Hungarian designs means there are now more than 3.65 million designs in the tool.

Since its introduction on 19 November 2012, the tool has served more than 800.000 searches from 135 different countries, with users from Spain, Germany and the UK among the most frequent visitors

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The Hungarian Office has also implemented the Common Examiner Support Tool (CESTO), which provides a harmonised search of key databases to support examiners.

The two implementations are as a result of cooperation and joint work between OHIM's Cooperation Fund teams and IP experts at HIPO.

## E-Services live in Slovenia

The e-Services online system is now live in the Slovenian Intellectual Property Office (SIPO).

E-Services was developed by the Cooperation Fund and implemented in close collaboration with IP experts in SIPO. It complements e-filing for trade marks and designs, by offering an electronic transfer of rights option (for trade marks and designs); an electronic change of owner data for trade marks and designs; online trade mark and design renewal and electronic trade mark opposition.

The Slovenian office implemented e-filing for trade marks and designs in November 2014. It is available, in Slovenian, through the following link: <http://www.uil-sipo.si/sipo/office/about-us/announcements/news-repository/clanki/7-more-e-services-now-available-at-sipo/>.

## Latest European TMDN News now available

The latest edition of ETMDN News – the newsletter of the European Trade Mark and Design Network – is now available in 23 EU languages: [BG](#) [CS](#) [DA](#) [DE](#) [EN](#) [EL](#) [ES](#) [ET](#) [FI](#) [FR](#) [HR](#) [HU](#) [IT](#) [LT](#) [LV](#) [MT](#) [NL](#) [PL](#) [PT](#) [RO](#) [SK](#) [SL](#) [SV](#)

EuropeanTMDN news is edited by the Office for Harmonization in the Internal Market (OHIM). The newsletter is aimed at Europe's intellectual property community. It presents a review of the Network's drive to share best practice, harmonise working methods and remove barriers from business. For enquiries, please contact:

[OHIMcommunicationservice@oami.europa.eu](mailto:OHIMcommunicationservice@oami.europa.eu)

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### First set of updated Guidelines enter into force

On 01/02/2015, the first set of OHIM's updated Guidelines entered into force, following their adoption by the President of the Office on December 4, 2014 ([Decision EX-14-4](#)). The corresponding documents are available under [the current trade mark practice page](#) and [the current designs practice page](#) of the Website.

The texts can be accessed in English, French, German, Italian or Spanish under a clean version or under a version with track changes. With the latter, the user can clearly distinguish the changes that have been implemented since the version adopted last year by the President.

The changes in the Guidelines have been summarized in [the last edition of Alicante News](#). Don't hesitate to have a look to get an overview of the modifications the Office has implemented.

The update of the second work package of the Guidelines is set to deliver results around mid-2015; therefore the full cycle of revision will be completed by then.

### Harmonised Database updated with the Nice 10.15

The changes to the Nice Classification which were agreed during the course of 2014 have been introduced in OHIM's Harmonised Database in January 2015 in all EU languages with the collaboration of all National Offices and the BOIP. The Nice committee of experts conclude on the insertion, change and deletion of terms with regard to the Nice classification content and a new version of the Nice list is published every year.

### Payment by credit/debit card: changes affecting our online services

On January 24 2015 OHIM changed to a new banking services provider for credit and debit card payments. The new banking platform is more secure and is fully compliant with the current payment card industry (PCI) standards.

This will imply some changes in the payment step of OHIM's online application forms.

As from Saturday January 24 users were directed to a new payment interface 'Comercia Global Payments,'

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managed by the bank La Caixa. This payment platform is currently only available in the five languages of the Office (English, French, German, Italian and Spanish). For information in the remaining 18 EU official languages, users will find a link to a help file in the payment step of their application explaining [how to proceed](#) when paying via debit or credit card.

For any assistance, please [contact us](#).

## TM5 ID List Operational

The TM5 Partners launched the TM5 ID List Search Tool on 26 January. This tool allows users to quickly and efficiently search the shared ID database known as the TM5 ID List.

The list is composed of some 14,000 pre-approved descriptions of goods and services (IDs) associated with the trade marks for which protection is sought. Applicants can be assured that IDs in the list will be accepted at all TM5 partner offices (JPO, KIPO, OHIM, SAIC and USPTO), thus increasing the predictability and consistency of decisions and legal certainty among the participating offices.

All IDs are available in English and the list is currently searchable in English only. However,

translations of some IDs are also available in other TM5 languages (Chinese, Japanese, Korean and 23 EU languages) and work is ongoing both to extend the translations to the complete list and to make ID List searchable in the other languages.

The TM5 website is available [here](#), and the TM5 ID List can be accessed directly [here](#).

## Available now: Design decisions in eSearch Case Law

[eSearch Case Law](#) is OHIM's search tool for OHIM's decisions, judgments from the Court of Justice of the European Union and the National Courts. Now for the first time, this searchable database features both trade mark and design decisions.

The case law search tool has also been aligned with OHIM's database of Community trade mark and design information [eSearch plus](#) and it now offers a specific tab for design decisions.

More information on the tool, plus a video tutorial and a slideshow, is available [here](#)

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## Case law



### Luxembourg trade mark and design news

#### A. Court of Justice: Orders, Judgments and Preliminary Rulings

**Case C-608/12 P; Greinwald GmbH v OHIM, Order of 8 May 2014, Language of the case: FR**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Competence of the CJ, Matters of fact appealed to CJ, Relative grounds, Conceptual similarity, Similarity of signs, Likelihood of confusion

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods within Classes 29, 30 and 32. An opposition based on the earlier figurative mark represented below, registered for goods in Classes 29, 30 and 31, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) annulled the OD's decision and rejected the registration of the mark applied for. The applicant filed an action before the General Court. The GC annulled the decision of the BoA finding the marks were highly conceptually similar and based on that there was also a certain degree of overall similarity between the signs. The BoA found

that despite the conceptual similarity found by the GC, there was a low degree of overall similarity and hence there was no likelihood of confusion. The GC annulled the second decision of the BoA stating that the BoA could not call into question GC's assessment of the similarity between the marks. The applicant submitted an action to the European Court of Justice (CJ).

#### CTMA



#### Earlier Marks



**SUBSTANCE:** The CJ found the appeal inadmissible, since the applicant, contrary to the requirements of Article 169 (2) of the Rules of Procedure of the CJ, criticized reasoning of the GC without precise identification of specific points in the grounds of

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the GC's decision that were contested. (Paras. 27 and 33). In its single plea in law, the applicant had not provided any argument to explain why under his opinion the GC had committed an error of law in application of Article 8 (1)(b) CTMR (Para. 30). In regards of applicant's requirement to annul the decision based on incorrect examination of the similarity between beers and other goods covered by Classes 29 and 30 the CJ stated that, in accordance with Article 256 (1) TFEU and Article 58, first Paragraph, of the Statute of the CJ, the GC has an exclusive jurisdiction to find and examine the relevant facts and the evidence submitted to it. (Paras. 34 and 36).

**Case C-141/13 P; Reber Holding GmbH & Co. KG v OHIM, Judgment of 17 July 2014, Language of the case: DE**

**RESULT:** Appeal dismissed

**KEYWORDS:** Evidence of use, General principles of law, Nature of use, Place of use, Proof of use, Request for proof of use, Insignificant amount, Extent of use, Relative grounds, Characteristics of the goods and services, Sales figures, Promotional material, Principle of legality, General reference to previous submissions, Competence of the GC/CJ, Principle of non-discrimination

**FACTS:** The applicant sought to register the figurative represented below as a CTM for goods within Classes 21 and 30. An opposition based on the earlier national word mark Walzertraum (in English: Waltz dream) registered for goods in Class 30, with the following description: bakery products, confectionery, chocolate products and sweets, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) upheld the applicant's appeal finding that the opponent did not provide sufficient proof of use of the earlier mark. The opponent filed an action before the General Court (GC). The GC dismissed the action. The opponent filed an appeal before the European Court of Justice (CJ) alleging the violation of Article 42 (2) in connection with Article 42 (3) CTMR and the violation of the principle of equal treatment.

### CTMA



### Earlier Marks

**Walzertraum**

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**SUBSTANCE:** The CJ emphasized that the qualification of genuine use depends on the characteristics of the goods or services concerned and on the relevant market. Therefore, not every proven commercial operating can be deemed automatically as a genuine use of the mark at issue (Para. 32). The GC correctly applied the concept of genuine use when conducted an overall assessment taking into account the sales volume of the product protected by the mark, the nature and characteristics of the product, the geographic extent of the use of the mark, advertising carried on the website of the opponent and the continuity of the use of the earlier mark, realizing some interdependence between the factors likely to prove genuine use of the mark (Paras. 33 and 34). The examination of the genuine use must be based on the goods as specified in the trade mark application and not on a possible marketing concept (Para. 43). Application of the principles of equal treatment and sound administration must be always exercised with respect to the principle of legality (Para. 45). The appeal to CJ which merely repeats or reproduces the pleas and arguments previously submitted to the GC without specifically identifying the error in law vitiating the judgment under appeal, is in reality an application for a re-examination of the action submitted to the GC which falls outside the jurisdiction of the CJ (Para. 54). In regards of the argument on incorrect determination of the category of goods, the GC was correct in holding that the relevant market is a German chocolate market

(Para. 56). The GC is not bound by the decisions of the Office therefore the argument on the difference of the treatment related to a previous decision of the Office is unfounded (Para. 57).

**Case C-31/14P; OHIM v Kessel medintim GmbH and Janssen-Cilag GmbH, Judgment of 11 December 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Restriction of the list of goods and services, Amendment, Matters of fact appealed to CJ, Relative grounds, Likelihood of confusion

**FACTS:** An opposition against the CTMA PREMENO applied for “vaginal ovules” in Class 5 was upheld on the basis of the earlier mark PRAMINO, registered in Germany for “prescription medicines”. The use of the earlier mark was proven for “prescription medicines, namely hormonal contraceptives”. The goods were considered identical, the marks similar, the likelihood of confusion was affirmed. In the appeal against this decision the CTM applicant requested a limitation of the goods applied for to “non-prescription vaginal ovules against vaginal dryness and vaginal infections” When dismissing the appeal, the Board of Appeal (BoA) considered the limitation inadmissible and upheld the finding of the likelihood of confusion. The General Court

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(GC) annulled (in T-536-10) the BoA decision due to an infringement of Article 43 (1) CTMR. The Case-Law has recognized that a therapeutic indication is a relevant criterion for restriction of goods in Class 5. The limitation is admissible as far as it concerns “vaginal ovules against vaginal dryness and vaginal infections”. It is not admissible as far as the goods applied for were restricted to “non-prescription” medicines. This criterion is not valid due to the lack of uniform rules on of the obligation to sell medicines under prescription within the EU. The inadmissibility of the limitation as far as it concerned the non-prescription medicines only, cannot lead to the conclusion that it was entirely irrelevant. The BoA had to take into account the other part of the restriction which is based on the therapeutic indication. The Office filed an appeal claiming an infringement of Article 43 (1) CTMR in conjunction with Rule 2 (2) CTMIR and of Article 43 (2) CTMR in conjunction with the bounding effect of limitation request.

**SUBSTANCE:** The European court of justice (CJ) rejected both pleas. Pursuant to article 43 (2) CTMR in conjunction with Rule 2 (2) CTMIR the limitation of the goods has to indicate clearly the nature of goods concerned (Para. 36). As decided by the GC, the limitation was admissible as far as it was based on the therapeutic indication. The fact that it also contained a reference to the prescription obligation did not necessary make it inadmissible (Paras 39 and 40). The question if the limitation to “non-prescription medicines” is admissible is a question of fact. The GC did not need to examine this question. It decided merely that the limitation was rejected incorrectly despite the fact that it was based on the admissible criterion of a therapeutic indication (Para. 43). The judgment of the GC cannot be read in the way that the GC decided that the Office had to accept the limitation partially and not to take into consideration the remaining pArticle It did not infringe the principle of the binding effect of the CTM application (Para. 51).

CTMA

**PREMENO**

Earlier Marks

**PRAMINO**

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## Case law



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

**Case T 539/11; Deutsche Bank AG v OHIM; Judgment of 25 March 2014; Language of the case: FR**

**RESULT:** Action dismissed.

**KEYWORDS:** Absolute grounds, General principles of law, International registration, Laudatory mark, Nature of goods and services, New evidence, Slogan mark, Lack of reasoning, Statement of grounds, Nice Classification, Principle of legal certainty, Principle of legality

**FACTS:** The applicant obtained an international registration designating European Union for the word sign Leistung aus Leidenschaft (in English: "Performance from Passion"), registered for the goods and services within Classes 35, 36 and 38. The examiner refused the sign protection in the EU on the ground that the trademark applied for was devoid of any distinctive character. The Board of Appeal dismissed applicant's appeal finding that the mark applied for was a promotional slogan; hence a higher level of attention of part of the relevant public is required. It found that the mark was a statement that might be applied to all services covered by the trade mark and to all providers of these services. The mark conveyed to consumers the idea that the services offered by the applicant were of a very high

quality because they were supplied by a particular provider; however, it did not contain any elements that the relevant public could keep in its memory as an indication of a specific commercial origin. The applicant filed an action before the General Court.

### CTMA

### LEISTUNG AUS LEIDENSCHAFT

**SUBSTANCE:** In regards of the alleged failure to state reasons, the competent authority may use a general reasoning for all the goods or services concerned where the same ground of refusal relates to one category or group of goods or services (Para. 14). Sufficiently direct and specific link between the goods and products is required in order to form a category or group of goods or services of sufficient homogeneity for which the Office is allowed to provide general reasoning. The fact that the goods or services are within the same Class under the Nice Agreement is not sufficient for this purpose (Para. 15). All services concerned may be supplied with a particular commitment, be it advertising, insurance services, financial services or telecommunications. Given the very general meaning of the mark at issue, there was no need to provide more detailed reasons for each category of services concerned (Para. 16). The average consumer normally perceives a mark as a whole and does not proceed to analyse its

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various details. The competent authority should therefore consider overall impression of the mark when assessing whether the mark is or is not devoid of distinctive character. However, this does not preclude the competent authority from, at first, examining different elements of the mark applied for which may be even useful in the overall assessment (Para. 36). The mark appears to be a promotional slogan transmitting to the relevant public laudatory message that the applicant offers services with a particular commitment and is dedicated to their providing also with a particular devotion (Para. 45). The identity of the beginnings of the two usual names of which the mark is composed is quite usual in German and is solely the result of the juxtaposition of two simple terms from basic German vocabulary. The rhythm of the pronunciation of the combination of the words is also usual (Para. 47). The existence of identical or similar registration on national level does not constitute a ground for admitting the registration of the mark devoid of distinctive character (Para. 53). The applicant did not even specify the grounds based on which the national authorities decided to register the word signs to which it referred and which might have been taken into account in the application of Article 7(1)(b) (Para. 54). The Principle of equality and sound administration must be assessed with respect to the legality. A person who applies for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act that

was to the advantage of someone else (Para. 62). For reasons of legal certainty and sound administration, the examination of any application must be strict and complete in order to prevent trade marks from being improperly registered (Para. 63).

**Case T-473/11; Longevity Health Products, Inc. v OHIM; Judgment of 28 April 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Identity of the goods and services, Phonetic similarity, Relative grounds, Representative, Similarity of the signs, Visual similarity, Used in the course of trade

**FACTS:** The applicant sought to register the word mark MENOCHRON as a CTM for goods within Classes 3 and 5. An opposition based on the earlier word mark MENODORON, registered for goods in Classes 3 and 5, was filed on the grounds of Article 8(1)(b) and 8(5) CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant's appeal finding that based on the average distinctive character of the earlier mark, identity of the goods and high visual and average phonetic similarity of the signs the likelihood of confusion cannot be excluded even if the increased degree of attention of the relevant public is taken into account. The applicant filed an action before the General Court (GC).

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### CTMA

MENOCHRON

### Earlier Marks

MENODORON

**SUBSTANCE:** The GC rejects applicant's argument on sufficient knowledge of the relevant public of Latin and Greek on one hand and in-depth knowledge in the medical field on the other hand allowing it to understand the individual elements of which the marks at issue consist (Para. 39). Therefore, the comparison of the signs at issue must be based on all of the syllables of the signs (Para. 40). From the visual point, the only difference is limited to the fifth and sixth letters of the marks at issue (Para. 41). In regards of the phonetic comparison, the marks differ in the length and rhythm of pronunciation because they are composed of different number of syllables (Para. 42). The GC concludes that marks have an enhanced degree of visual similarity and average degree of phonetic similarity (Para. 44). The GC emphasises that the covered goods are identical. As a result of this identity the extent of differences between the marks at issue is reduced (Para. 46). Such an argument which essentially

amounts to consider that the phonetic aspect of a brand is always decisive in assessing the likelihood of confusion has no basis in Case-Law. Certainly, as part of the overall assessment of likelihood of confusion the visual, phonetic or conceptual aspects of the signs are not always of the same weight and it is then to examine the objective conditions in which the marks may be presented on the market (Para. 48). There is a likelihood of confusion.

**Case T-173/11; Kurt Hesse and Lutter & Partner GmbH v OHIM; Judgment of 27 November 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Complementary goods and services, Detriment to earlier mark, Identity of the signs, Likelihood of association, Likelihood of confusion, Reputation, Relative grounds, Similarity of the goods and services, Unfair advantage, Well known trade mark, General reference to previous submissions

**FACTS:** The applicant sought to register the word mark Carrera as a CTM for goods within Class 9. An opposition based on the earlier word marks CARRERA registered for goods in Class 12 was filed on the grounds of Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) upheld the opponent's appeal finding that the signs are identical and there exists likelihood of confusion in respect

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of part of the goods applied for (mobile navigation apparatus, in particular satellite-based mobile navigation apparatus). In regards of the remaining goods the BoA found that the mark applied for would take unfair advantage of the distinctive character of the earlier marks. The applicant filed an action before the General Court (GC). Subsequently, the application was partially transferred.

CTMA
<b>Carrera</b>
Earlier Marks
<b>CARRERA</b>

**SUBSTANCE:** The GC emphasised that, under Article 44 (1) (d) of the Rules of Procedure, all heads of claim must be accompanied by pleas and arguments enabling both the defendant and the GC to assess the merits. Since the subsidiary heads of claims are not accompanied by any plea or argument, they must be rejected as inadmissible (Para. 26 – 27). As to the plea on violation of Article 8 (1) (b) CTMR, the GC stated that the application does not exclude the mobile navigation devices that are intended to be used or that might be used in motor vehicles (Para. 44). When a consumer uses a mobile navigation device in a motor vehicle, in particular

the device intended to be used in such vehicles it must be considered that a close relationship exists between them. In this case, motor vehicles are in fact essential for correct use of these mobile navigation devices, given in particular that the elements present on the screen of these devices or navigation instructions are obviously intended for the driver of a motor vehicle driving on public roads. In these circumstances, it cannot be denied that the mobile navigation devices are for the same public as vehicles and a functional complementarity between them exists, so consumers may think that the responsibility for production of all these goods lies with the same company (Para. 45). In regards to the plea on violation of Article 8 (5) CTMR, the GC stated that as to the conditions of taking unfair advantage of the distinctive character or the reputation of the earlier marks, the applicants cannot maintain that the opponent was required to prove the actual and present damage to its marks. Accordingly, the documents provided by the applicants in order to prove that they had made extensive use of the marks applied for, and as a result, to require the opponent to prove not only the existence of a serious risk of future damage but the existence of an actual and present detriment to its marks, is irrelevant (Para. 67 – 68). According to the BoA there exists a “transfer of image” of earlier marks in favour of the marks applied for, since all the goods covered by the marks applied for can be used in motor vehicles and they may be associated with the technique and mobility as well as motor vehicles (Para. 70). The fact that the goods covered by the marks applied for are not intended to be installed in motor vehicles in the factory, does not exclude that

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these goods can be used in the motor vehicles (Para. 72). There is a likelihood of confusion.

**Case T-493/12; Sanofi SA v OHIM, Judgment of 24 September 2014; Language of the case: EN**

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

**KEYWORDS:** Claim for rejecting CTM application, Similarity of signs, Likelihood of confusion, Ending of mark, Visual similarity, Phonetic similarity, Similarity of the goods and services

**FACTS:** The applicant sought to register the word mark GEPRAL as a CTM for goods within Class 5, corresponding to the description 'oncological preParations and preParations for cardiovascular treatments'. Sanofi SA filed an opposition based on the earlier word mark DELPRAL, registered for goods in Class 5, corresponding i.a. to the description 'pharmaceutical preParations for the treatment of the disorders of the central nervous system', was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA), however, annulled the decision of the OD on the ground that there was no likelihood of confusion. The BoA reasoned its decision saying that there was a low degree of similarity of between the goods as well as between the signs at issue and relatively high degree of attentiveness of the relevant public. The opponent filed an action before GC relying i.a. on infringement of Article 8 (1) (b) CTMR.

CTMA

GEPRAL

Earlier Marks

DELPRAL

**SUBSTANCE:** In regards of the goods in question, GC emphasized that those two sub-categories are not only encompassed in the category 'pharmaceutical products' or 'pharmaceutical preparations', but are also, on account of being medicines subject to medical prescription, marketed through the same distribution channels which in itself indicates a certain degree of similarity between the goods (Para. 22). On the other hand, the attentiveness of the relevant public in respect of medicines is high and the therapeutic indication, which is different in regards of the goods in the present case, is of decisive importance (Para. 23 and 24). The products cannot be regarded as being in competition or interchangeable with each other. Therefore, the goods were similar only to a low degree. In respect of the comparison of the signs, according to GC the Office may not contend that the relevant public pays particular attention to the beginning of the signs. In the present case, given the identity of the final sequence of letters 'pral', the slight visual

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dissimilarity of the elements 'Ge' and 'Del' and the visual impression of similarity produced by the signs at issue as a whole, the relevant public is not likely to spot those differences in isolation and pay particular attention to them. The GC therefore found a high degree of visual similarity (Para. 30 and 31). Regarding the phonetic similarity, the BoA did not conclude correctly that the syllables 'del' and 'gep' had perceptible differences. The phonetic comparison ought to have been made between the syllables 'del' and 'ge', on the one hand, and the syllables 'pral', on the other. Such comparison leads to at least an average degree of phonetic similarity between the signs (Para. 33). The overall high degree of similarity between the marks is coupled with a low degree of similarity between the goods in question which constitutes a relevant factor in the context of the global assessment of the likelihood of confusion. It could lead the relevant public, even if it has a higher than average degree of attentiveness, to believe that those medicines come from the same undertaking or from economically-linked undertakings marketing a 'family of products', all designated by the common ending 'pral' (Para. 40). GC therefore concluded that there is a likelihood of confusion and annulled the contested decision.

**Case T-510/12; Conrad Electronic SE v OHIM; Judgment of 18 November 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Allusive trade mark,

Beginning of mark, Common element, Conceptual similarity, Descriptive element, Enhanced distinctiveness, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relative grounds, Similarity of signs, Visual similarity, Weak element

**FACTS:** The applicant sought to register the word mark EuroSky as a CTM for goods in Class 9. The opponent lodged an opposition against the application on the basis of, inter alia, the earlier Community trade mark SKY (word) for goods in Class 9. The Opposition Division held that a likelihood of confusion between the marks existed for identical goods and granted the opposition in its entirety. The appeal filed by the applicant was dismissed.



**SUBSTANCE:** The General Court confirmed the existence of likelihood of confusion between the conflicting marks. The goods in Class 9 are directed to the general public and to specialists. The degree of attention varies from average to high (Para.

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33). The goods covered by the marks are identical (Para. 35). The conflicting signs are visually and phonetically similar to a medium degree (Para. 40-42). It is true that the beginnings of the signs are different. However, this is outweighed by the fact that the first element of the mark applied for 'Euro' describes the origin of the goods. The consumers will therefore pay less attention to this element (Para. 40). Conceptually, the common element "Sky" is also weak: The public will associate the concept of 'Sky' with the place where the satellites necessary for the functioning of the goods at issue are placed. The term therefore describes a possible use of the goods, namely apparatus which function on the basis of satellite communication (Para. 46). Overall, the marks are also conceptually similar to an average degree (Para. 47). The earlier mark 'SKY' enjoys an enhanced distinctiveness due to its extensive use for Class 9 goods on the British market as shown by the opponent. The set-top-boxes depicted in the documents also bear the trade mark of the producer. Thus the public will know that the opponent is not the producer of the goods. However, the consumers will still believe that the products marketed under the trademarks 'Sky digibox', 'SKY+' and 'SKY' derive from the opponent (Para. 64-65). Moreover, although the relevant moment for proving the enhanced distinctiveness is the filing date of the contested mark (13 July 2005), documents relating to the period between 1998 and 2003 also serve to prove the enhanced distinctiveness of the 'SKY' mark (Para. 67-68). Overall, bearing in mind the identity of the goods, the average degree of similarity between the signs and the enhanced distinctiveness of the earlier mark

'SKY', the Board of Appeal was correct to conclude that there existed a likelihood of confusion between the marks (Para. 71).

**Cases T-374/12 and T-375/12; Brouwerij Van Honebrouck v OHIM; Judgment of 25 November 2014; Language of the case: FR**

**RESULT:** Action dismissed.

**KEYWORDS:** Beginning of mark, Burden of proof, Coexistence of trademarks, Distinctive element, Dominant element, Identity of the goods and services, International registration, Likelihood of confusion, Phonetic similarity, Proof of use, Sales Figures, Invoice, Internet, Declaration, License agreement, Relative grounds, Similarity of signs, Visual similarity

**FACTS:** The applicant obtained the international registration with the designation of European Community for the word mark (T-375/12) and figurative mark (T-374/12) represented below, registered for the goods and services within Class 32, namely beers, ales. An opposition based on the earlier French word mark CASTEL BEER, registered for goods in Class 32, beers, was filed on the grounds of Article 8 (1) b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal finding that (i) the opponent proved the genuine use of the earlier mark, (ii) the goods are identical and (iii) the marks are visually similar in the way that the more distinctive part of the earlier mark

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“CASTEL” coincides with the sole word element of the application. Further, the figurative element of the application has only a decorative function. The marks are not conceptually similar, except for a part of relevant public that will perceive the meaning of both terms “KASTEEL” and “CASTEL” as “castle”. The applicant filed an action before the General Court (GC).

CTMA



Earlier Marks

CASTEL BEER

**SUBSTANCE:** As to the first claim, the applicant claims the violation of Article 76 (1) CTMR in so far that the BoA examined a claim related to the coexistence of the marks in France, although the applicant revoked this claim preserving his right to invoke it later (Para. 26 and 28). The BoA dealt with applicant’s claim on coexistence only for the clarity purposes and the examination of this claim was just superabundant (Para. 29). The first claim of the applicant cannot cause annulment of the

contested decision and therefore was dismissed by the GC (Para. 31). In regards to the second claim, the applicant claims that the evidence submitted by the opponent has not proved sufficiently the genuine use of the earlier mark in France (Para. 33). The requirement of genuine use is not aimed for evaluation of the commercial success of the trademark holder, for a control of the strategy of an enterprise or even to reserve the trademark protection only for quantitatively important commercial operations (Para. 41). The turnover and the amount of sales of the goods sold under the earlier mark cannot be assessed in absolute terms and must be related to other factors, such as the volume of commercial activity, production or marketing capacity or the degree of diversification of the undertaking using the trademark and the characteristics of the products or services on the market concerned (Para. 42). Since the internet article submitted as an evidence of genuine use does not relate to the relevant period, it cannot prove the genuine use as sole evidence. It must be considered, however, that the duration of commercial life of such product generally extends over time and the continuity of the use also provides indications to be taken into account for establishing that the use was objectively intended to create or maintain a market share. Therefore the evidence not covered by the relevant period, nevertheless far from being devoid of interest, must in this case be considered and evaluated in conjunction with other elements, as it can bring evidence of actual commercial exploitation and reputation of the mark (Para. 51). In regards of genuine use, it is not possible to make a distinction within the category

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of goods “Beers” in terms of their origin for the purposes of examination of the importance of use. The criterion of purpose or destination is a key criterion in the definition of a sub-category of the goods and services since it guides the choice of the consumer when searching for a product or service that can meet its specific needs. In case of beers the purpose of the goods is identical, irrespective of their origin (Para. 58). In regards of the affidavit serving as evidence, it is appropriate to verify the credibility and veracity of the information contained therein, taking particular account of the origin of the document, the circumstances of its issuance and its recipient, and to ask whether the document appears sound and reliable. In this case, the certificate in question comes from a manager of a branch of a company which, although linked to the intervener by a trademark license agreement, is a third party, independent of the intervener. In addition, the information provided by the certificate is supported by sales invoices for the products concerned (Para. 61). For the third claim, the applicant claims that the BoA did not assess correctly the existence of the risk of likelihood of confusion. The applicant alleges that since the beers marketed under the earlier mark are of Cameroon origin, they are aimed at a specific public (Para. 71). The trademark rights cover each category of goods or services for which the trademark is protected or registration is sought. The commercial choices made, or that may be made, by the trademark holders are factors that have to be distinguished from the rights derived from the marks and, insofar as they depend on the will of the holders of those marks, are likely to change. Therefore, unless the list of the goods covered by

the marks in conflict has changed, such factors may not have any impact on the relevant public to be taken into account within the assessment of the existence of likelihood of confusion (Para. 72). In respect of the comparison of goods, objective circumstances of commercialisation of the goods covered by the marks should be taken into account when assessing the likelihood of confusion, not particular circumstances which may vary over time and according to the will of the marks holders, such as their commercial intentions (Para. 80). In respect of the comparison of signs, the elements of resemblance between the earlier mark and the mark applied for, i.e. six common letters placed in the same order, outweigh the dissimilarities between the marks, i.e. the first letters of the word elements “Kasteel” and “Castel”, the figurative element of the mark applied for and the repetition of letter “e” in the mark applied for. The figurative element of the mark applied for is only of a decorative nature and the word element “beer” contained in the earlier mark is descriptive for the goods in question. According to an overall visual assessment, the signs have a certain degree of similarity (Para. 95-98). The marks are also phonetically similar (Para. 103). From the conceptual point of view, the meaning of terms “castel” and “kasteel” of the signs will not be easily understood by a significant part of the relevant public because of the infrequent use of the term “castel” in French (Para. 106). Therefore, the marks will not be conceptually similar for French consumers, except for those who are capable to perceive the words “castel” and “kasteel” as evoking both the concept of “castle” (Para. 109). Based on the aforementioned, the risk of confusion of the

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marks in conflict was found (Para. 114). Contrary to the applicant's conclusions, where the products are likewise to be ordered orally, certain importance must be ascribed to the phonetic aspect of the comparison of the signs (Para. 115). The action was dismissed.

**Case T-331/12; Sartorius Lab Instruments GmbH & Co. KG v. OHIM; Judgement of 26 February 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Figurative trade mark, Position mark, Absolute grounds, Minimum degree of distinctiveness, Design, Burden of proof, Ornamentation

**FACTS:** The Board of Appeal (BoA) confirmed that the mark represented below lacked distinctiveness, considering that: all goods in cl. 7, 9, 10 and 11 are equipped with similar decorated electronic screen and the mark would be perceived by the professional public as an ornament/decorative element rather than as a badge of origin. The CTM applicant filed an action before the General Court (GC).

CTMA



**SUBSTANCE:** The GC dismissed the action and endorsed the BoA's findings. The CG set out, first of all, that «a position mark» can be registered as CTM if all the CTMR requirements, mainly distinctiveness, are fulfilled (pp. 13, 15). Secondly, it affirmed that the mark must be considered to be indistinguishable from the appearance of the products and that the Case-Law developed in respect of those cases is also applicable to the case at hand, namely that those signs are distinctive only if they depart significantly from the norms or customs of the sector (p. 23). The GC dismissed in particular the CTM applicant's argument that the BoA did not take into account the higher level of attention of the relevant public to details (p. 30). In this regard, the GC was of the opinion that, the CTM applicant had not proven the aforesaid higher level of attention (p. 32). The CTM applicant provided pictures of similar products, but he did not explain how such documents can prove a higher level of attention by the professional public to details. The BoA's evaluation was correctly based on facts which are well known or which may be learnt from generally accessible sources (p. 31). Electronic screens of medical devices are usually characterized by simple, coloured and decorative elements on the borders. They are perceived by the professional public as an ornament rather than a badge of origin (p. 38). The contested mark does not depart significantly from the norms or customs of the sector: it is not unique, original or unusual in the sector (p. 39, p. 40). Moreover, the CTM applicant had not proven acquired distinctiveness in consequence of the use of the simple trade mark (p. 41).

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**Case T-516/12, 25 September 2014, Ted-Invest FOOD v. OHIM, Language of the Case – EN.**

**RESULT:** Action dismissed

**KEYWORDS:** Relative grounds, Likelihood of confusion, Complementarity of the goods and services, Similarity of the signs, Conceptual similarity, Dominant element, Abbreviation, Geographical origin

**FACTS:** A request for a declaration of invalidity was filed on the grounds of Article 53 (1) (a) in conjunction with Article 8(1) (b) CTMR against the figurative CTM registration represented below. It was based on the earlier Community word mark as registered for goods in Classes 20 and 24 a directed against the goods of the CTMR in Classes 20 and 24. The Cancellation Division (CD) upheld the application for a declaration of invalidity on the ground that there was a likelihood of confusion under Article 8 (1) (b) CTMR. The appeal lodged by the applicant against that decision was dismissed by the BoA, which confirmed the findings of the CD. In particular, the BoA found that the similarity between the marks, together with the identity and similarity of the goods gave rise to a likelihood of confusion. The BoA's decision was appealed before the General GC (GC).

In relation to the comparison of the goods at issue, the GC found in particular that there was similarity to an average degree between 'beds' and 'mattresses' covered by the contested mark in Class 20, on one hand, and 'pillows' in Class 20 and 'bedding products (such as bed linens, bed sheets) in Class 24 covered

by the earlier mark. These goods share the same primary purpose (enhance the rest and sleep), are directed to the same users and sold in the same outlets. Finally, there is a relation of complementarity between them (Paras. 22-28). As far as the signs are concerned, the GC confirmed the BoA's findings that they are visually similar to a low degree and phonetically they are similar to an average degree, since at least half of the verbal elements composing each of the signs are pronounced in a similar way.



At the conceptual level, the GC found that the common element 'scandia' alludes to Scandinavia. The element 'sensi' (abbreviation of the adjective sensitive in several European languages) and the element 'home' both convey the idea of comfort. Therefore, the GC concluded that, as a whole, the signs at issue are likely to evoke "Scandinavian comfort" and are therefore conceptually similar (Paras. 33-36). In relation to the distinctive character

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of the earlier mark, the GC noted that the element 'home' has a low distinctive character in connection to the relevant goods which are intended for indoors. The word 'scandia' is an ancient and poetic name for Scandinavia. Therefore, it would not be perceived as a reference to the geographical origin of the goods but rather as a simply evocative term to a style of the goods. In the light of the foregoing, it must be concluded that the earlier mark as a whole has normal inherent distinctiveness (Paras. 38-45). Therefore, the BoA's finding that that 'scandia' is likely to be perceived as the dominant element of the signs at issue must therefore be upheld. It follows from the foregoing that the difference between the signs is insufficient to exclude all likelihood of confusion between the marks on the part of the public.

**Case T-5/12; BSH Bosch und Siemens Hausgeräte GmbH v OHIM; Judgment of 14 July 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Claim for allowing CTM registration, Distinctive element, Examination of facts ex officio, Function of trade mark, Minimum degree of distinctiveness, Slogan mark, Well known facts need no evidence

**FACTS:** The applicant sought to register the word mark Wash & Coffee represented below as a CTM for goods and services within Classes 25, 37 and 43. The examiner refused to register the word as a CTM

in respect of some of the services (Classes 37 and 43) on the ground that in relation to the services at issue the mark was devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal finding that the terms used are basic English words and will be therefore easily understandable to English speaking part of the relevant public, the services are addressed to large public and the sign with respect to the services at issue indicates that these two kinds of services will be offered together. The applicant filed an action before the General Court (GC).

CTMA

WASH & COFFEE

**SUBSTANCE:** On the plea on violation of Article 7 (1) (b) CTMR, the GC rejected the argument of the applicant that the BoA should have examined only the services covered by the mark applied for and not their specific combination. The BoA proceeded correctly when it firstly examined separately the words which constitute the sign and the services covered by it and then examined the mark as a whole in relation to those services (Para. 36). Contrary to the applicant's argument that, if the concept of service is unusual, a slogan that conveys information about this concept should be unusual too, the GC held that the BoA could properly establish that it resulted from the unambiguous

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reading of the words “wash” and “coffee” that they had a clear conceptual content which easily appeared in the combination of these two terms constituting the mark (Para. 37). The fact that the relevant public has probably never been presented the combination of the services at issue does not prevent it from immediate understanding of the promotional message of the slogan Wash & Coffee (Para. 39). As regards the plea on violation of Article 76(1) CTMR, whilst it is Office’s task to establish in its decisions the accuracy of facts that have not been raised by the applicant, such is not the case where it alleges facts which are well-known (Para. 46 and 47). The BoA upon its assessment held that it was a well-known fact that the message conveyed by the combination of the terms used for trade mark would be perceived by target consumers as an offer of the combination of services at issue (Para. 51). Since the applicant failed to demonstrate that the assessment of the BoA was incorrect, his plea on violation of Article 76 (1) CTMR was rejected (Para. 52).

**Case T-493/12; Sanofi SA v OHIM, Judgment of 24 September 2014; Language of the case: EN**

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

**KEYWORDS:** Claim for rejecting CTM application, Similarity of signs, Likelihood of confusion, Ending of a mark, Visual similarity, Phonetic similarity, Similarity of the goods and services

**FACTS:** The applicant sought to register the word mark GEPRAL as a CTM for goods within Class 5, corresponding to the description ‘oncological preparations and preparations for cardiovascular treatments’. Sanofi SA filed an opposition based on the earlier word mark DELPRAL, registered for goods in Class 5, corresponding i.a. to the description ‘pharmaceutical preparations for the treatment of the disorders of the central nervous system’, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA), however, annulled the decision of the OD on the ground that there was no likelihood of confusion. The BoA reasoned its decision saying that there was a low degree of similarity of between the goods as well as between the signs at issue and relatively high degree of attentiveness of the relevant public. The opponent filed an action before GC relying i.a. on infringement of Article 8 (1) (b) CTMR.

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GEPRAL

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DELPRAL

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**SUBSTANCE:** In regards of the goods in question, GC emphasized that those two sub-categories are not only encompassed in the category 'pharmaceutical products' or 'pharmaceutical preparations', but are also, on account of being medicines subject to medical prescription, marketed through the same distribution channels which in itself indicates a certain degree of similarity between the goods (Para. 22). On the other hand, the attentiveness of the relevant public in respect of medicines is high and the therapeutic indication, which is different in regards of the goods in the present case, is of decisive importance (Para. 23 and 24). The products cannot be regarded as being in competition or interchangeable with each other. Therefore, the goods were similar only to a low degree. In respect of the comparison of the signs, according to GC the Office may not contend that the relevant public pays particular attention to the beginning of the signs. In the present case, given the identity of the final sequence of letters 'pral', the slight visual dissimilarity of the elements 'Ge' and 'Del' and the visual impression of similarity produced by the signs at issue as a whole, the relevant public is not likely to spot those differences in isolation and pay particular attention to them. The GC therefore found a high degree of visual similarity (Para. 30 and 31). Regarding the phonetic similarity, the BoA did not conclude correctly that the syllables 'del' and 'gep' had perceptible differences. The phonetic comparison ought to have been made between the syllables 'del' and 'ge', on the one hand, and the syllables 'pral', on the other. Such comparison leads to at least an average degree of phonetic similarity between the signs (Para. 33). The overall high

degree of similarity between the marks is coupled with a low degree of similarity between the goods in question which constitutes a relevant factor in the context of the global assessment of the likelihood of confusion. It could lead the relevant public, even if it has a higher than average degree of attentiveness, to believe that those medicines come from the same undertaking or from economically-linked undertakings marketing a 'family of products', all designated by the common ending 'pral' (Para. 40). GC therefore concluded that there is a likelihood of confusion and annulled the contested decision.

**Case T-239/12; Jyoti Ceramic Industries PVT. Ltd v OHIM, Judgment of 1 July 2014, Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relative grounds, Relevant language, Similarity of the goods and services, Similarity of the signs, Specialised public, Visual similarity, Figurative element

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 5, 10 and 40. An opposition based on the earlier word mark CERCON, registered for goods in Classes 5, 9 and 10, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal upheld opponent's appeal finding that there exists a likelihood of confusion, since the goods and

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services covered by the signs are identical or at least similar and there is visual and phonetic similarity of the signs. The applicant filed an action before the General Court.

CTMA



Earlier marks

**CERCON**

**SUBSTANCE:** The relevant public in relation to which the likelihood of confusion must be analysed consists in respect of the goods in Classes 5 and 10 of specialists trained in dentistry and for the services in Class 40 of both, general final consumer and specialists trained in dentistry, and the attention of the relevant public is considered to be increased, since the goods and services covered are related to health (Para. 28 and 30). Nothing precludes finding of the existence of visual similarity between a verbal and a figurative mark, since both types have a graphical form capable of creating a visual impression (Para. 43). If the relevant public is not aware of the fact that ceramic products get their own characteristics due to their cooking at a high

temperature, the representation of simple curved blue and orange shapes symbolising two flames can be considered rather banal and unimaginative, and is thus negligible in the overall impression of the mark. The graphical element of the CTMA may be perceived by the relevant public as a simple decorative element and not as an element indicating the commercial origin of the goods (Para. 45). Nothing rules out that the second syllable “con” which is identical in both signs will retain as much attention of the relevant public as the first syllables of the signs at issue (Para. 47). The principle that the consumer pays particular importance to the beginning of the mark applied for should not be assessed independently on the circumstances of this case, particularly on the specific characteristics of the signs at issue (Para. 48). Phonetically, the signs are composed of two syllables of the same length and are pronounced very similarly in English as well as in German (Para. 58 and 59). Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even where an earlier mark is of weak distinctive character, there may be a risk of confusion, particularly because of the similarity of the signs and goods or services covered (Para. 78).

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### Case T-149/12; *Investrónica, SA v OHIM*; Judgment of 16 January 2014; Language of the case: EN

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

**KEYWORDS:** Competence of the GC, Common element, Complex mark, Conceptual similarity, Descriptive element, Distinctive element, Dominant element, Figurative element, Identity of the goods and services, Likelihood of confusion, Phonetic identity, Visual dissimilarity, Relative grounds

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods within Class 9. An opposition based on the earlier figurative mark represented below, registered for goods in Class 9, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) upheld the applicant's appeal finding that the identity of the goods was offset by the dissimilarity of the signs at issue. Although the word element 'micro' was common to the signs at issue, because of its descriptiveness it could not be perceived by the relevant public from a visual or conceptual point of view as the distinctive and dominant element of a composite mark. The opponent filed an action before the General Court (GC).

**SUBSTANCE:** The GC emphasizes that the comparison of the signs must be made by examining each of the marks in question as a whole which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. It is only if all the

#### CTMA



#### Earlier marks



other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (Para. 30). There is no need to examine the absolute grounds for refusal referred to in Article 7 CTMR in the context of opposition proceedings (para. 35). The fact that a national mark has been registered means that that mark has a minimum of inherent distinctiveness, since the harmonization Directive precludes registration of a mark which is devoid of distinctive character (Para. 36). The inherent distinctive character of the registered national mark can be challenged only in cancellation proceedings brought in the Member State concerned (Para. 37). As regards the mark applied for, the fanciful element preceding the word element is negligible; the word element 'micro' therefore constitutes the dominant element of the sign (Para. 48). That conclusion is not called into question by the argument that the word element is not only devoid of distinctive character,

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but is descriptive (Para. 49). Certain circumstances may justify that a descriptive element has a dominant character (Para. 51). The design of the mark applied for covers a quarter of the surface, while the other three quarters are occupied by the word element. In that specific context, the public eye is necessarily attracted, not by the colours used or the design, but by the word element, the position of which is predominant. It can therefore only be considered as dominant even assuming that it is descriptive (Para. 52). Also in case of the earlier mark the attention will be drawn primarily to the word and not to the particular combination of colours and letters that constitute it. It follows that the word element "micro" must be regarded as the dominant element of the earlier national figurative mark (Para. 53). In so far as the word element 'micro' is the dominant visual element of the mark applied for, it is clear that, notwithstanding the descriptiveness of the word element there is a large degree of conceptual similarity between the signs at issue (Para. 60).

**Case T-618/13, Oracle America. Inc. V OHIM; Judgment of 11 December 2014; Language of the case: EN**

**RESULT:** Action dismissed

**KEY WORDS:** Relative grounds, Admissibility, New evidence, Dominant element, Likelihood of confusion, Dissimilarity of signs, Phonetic dissimilarity, Identity of goods and services, Reputation

**FACTS:** The applicant filed a CTM application for the word mark AAVA CORE for goods and services in Classes 9, 38 and 42. An opposition was lodged based on the earlier reputed Community word mark JAVA, registered for goods and services in Classes 9, 38 and 42. The grounds invoked were Articles 8(1)(b) and 8(5) CTMR. The Opposition Division rejected the opposition and the Board of Appeal (BoA) dismissed the appeal filed by the opponent. The BoA, in so far as the opposition was based on Article 8(1)(b) CTMR, held that, in the absence of similarity between the signs at issue, there was no likelihood of confusion, even if the goods and services were identical and even though the earlier trade mark enjoyed a reputation. Secondly, in so far as the opposition was based on Article 8(5) CTMR, the BoA held that 'no certain degree of similarity' had been established between the signs, such that the public concerned would establish a link between them. The opponent filed an action before the General Court (GC).

### CTMA

**AAVA CORE**

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**JAVA**

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**SUBSTANCE:** The GC confirmed that a general reference in the application to the pleadings and annexes that the opponent lodged before Office is inadmissible (Para. 17). The relevant public is made up of the general public and professionals inter alia in the scientific, information technology and telecommunications sectors. The goods and services covered by the trade marks at issue are identical. The word 'aava' will be perceived as a distinctive word. With regard to the part of the relevant public which speaks Finnish, that word, which refers in particular to the concept of 'open', bears no relation to the goods and services covered by the trade mark applied for (Para. 31). The word CORE, for at least a large proportion of the public, which does not have special knowledge of English and of digital electronics, will not be perceived as being descriptive of some of the goods at issue, but as an invented word, and, therefore, distinctive (Para. 32). Even if it were necessary to hold that the word 'core' is descriptive and cannot be considered to be the dominant element in the sign, that would not however mean that it must, on that basis alone, be regarded as insignificant (Para. 35). The relevant public will notice the difference existing in the first letter making up the signs, namely the letter 'a' in the trade mark applied for and the letter 'j' in the earlier trademarks. That difference is increased by the unusual repetition of the letter 'a' at the beginning of the word 'aava' (Para. 43). The signs at issue, when assessed in their entirety, are not visually similar and they are phonetically dissimilar (Paras. 46-52). For the relevant public, the trade mark applied, AAVA CORE, either has no meaning, or refers to the concept of 'open', or to certain digital electronics

materials. Secondly, the earlier trademarks refer, in all the languages of the European Union, to the island of Java. It follows that the signs are not similar. The reputation of the trade mark JAVA has no impact on the perception of its conceptual contents (Paras. 57-58). There is no likelihood of confusion between the signs in the light of their lack of similarity (Para. 65) and the opposition must therefore fail as far as based on Article 8 (5) CTMR.

**Case T-197/13; Marques de l'État de Monaco (MEM) v OHIM; Judgment of 15 January 2015, Language of the case: FR**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, International registration, Absolute grounds, Descriptive element, Distinctive element, Preliminary ruling, Name, Lack of reasoning, Geographical origin, Relevant territory, General principles of law, Principle of legality, Competence of the GC/CJ

**FACTS:** The applicant, the Principality of Monaco was granted, by the World Intellectual Property Organisation (WIPO), an international registration covering the territory of the EU. That registration, which was based on the word mark MONACO, was transferred to the Office on 24 March 2011. The goods and services concerned were in Classes 9, 12, 14, 16, 18, 25, 28, 35, 38, 39, 41 and 43. The examiner refused to register the sign as a CTM for magnetic data carriers, paper and cardboard goods not included in other Classes, printed matter,

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photographs, transport, travel arrangement, entertainment, sporting activities and temporary accommodation in Classes 9, 16, 39, 41 and 43 on the basis of Article 7(1)(b) considering that the word 'Monaco' could be used, in trade, to designate origin, geographical destination or the place of supply of services, so that the trade mark has, in respect of the goods and services concerned, a descriptive character. The Principality of Monaco which in the meantime has transferred the marks to Les Marques de l'État de Monaco (MEM), a Monegasque public-limited company, contested Office's decision before the Board of Appeal (BoA). The BoA dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

### CTMA

## MONACO

**SUBSTANCE:** On the lack of reasoning, the GC rejected the claim explaining that the decision had a very rigorous and detailed analysis (points 26 to 29 of the contested decision) of the different types of products and services applied for (Para. 20). As regards the violation of Article 7 (1) (c) CTMR, first of all the GC analysed the claim that EU law was not applicable to Monaco and other similar international law grounds and held that under EU law, any legal entity, including a public law entity, may apply to benefit from the protection of the

Community trade mark (Para. 29). This is, not only true for companies based in the territory of a State which is not a member of the EU, but also for the non-member States themselves, since those States are, within the meaning of EU law, public law entities (Para. 30). As a result, when the Principality of Monaco formulated its request to have the EU designated for the international registration of the trade mark at issue, it placed itself within the scope of application of EU law and, therefore, one of the absolute grounds for refusal could be relied upon against it (Para.32). On the request to send a preliminary ruling to the European court of justice (CJ), although the GC considered it was not obliged to answer this ground it decided to examine why this claim could not be accepted (Para. 36). Analysing articles 256 TFUE and 51 of the Statute the GC held that it was not competent to send preliminary rulings to the CJ and concluded that this ground was in any case inadmissible (Paras. 38 and 40). On the interest behind the prohibition of Article 7 (1) (c), the GC refused the argument of the Principality of Monaco that the interest behind the prohibition is not the interest of a third country such as Monaco explaining that when the applicant filed an application and it accepted to be judged by the EU regulation (Paras. 43 and 44). As regards the relevant public, the GC dismissed the argument that the public must be defined in relation with the concepts of reputation and luxury. The GC held that whatever the relevant public is they will understand the term Monaco as a reference to the geographical territory located in Europe (Para. 53). Moreover it confirmed the analysis of the BoA when it defined the public and the level of attention taking into

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consideration the different products and services (Para. 55). In respect of the descriptive character of the word MONACO, the GC confirms that the word 'monaco' corresponds to the name of a globally-known principality, not least due to the renown of its royal family, its organisation of a Formula 1 Grand Prix and its organisation of a circus festival. Knowledge of the Principality of Monaco is even more established amongst EU citizens, notably on account of its borders with a Member State (France), its proximity to another Member State (Italy) and its use of the same currency as 19 of the 28 Member States, the Euro. There is therefore no doubt that the word 'monaco' will evoke, regardless of the linguistic background of the relevant public, the geographic territory of the same name (Para. 52). According to the GC, the Office was also correct to find that the word 'monaco' could be used, in trade, to designate origin, geographical destination or the place of supply of services, so that the trade mark has, in respect of the goods and services concerned, a descriptive character. Furthermore, as a descriptive mark is necessarily devoid of distinctive character, the GC holds that the trade mark MONACO is devoid of distinctive character.

**Case T-307/13 Capella EOOD v. OHIM; Judgment of 9 December 2014; language of the case: ES**

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

**KEYWORDS:** Admissibility, Reasons for non-use, Revocation grounds, Error by OHIM, General principles of law

**FACTS:** The applicant requested the revocation of the CTM ORIBAY, registered for goods and services in Classes 12, 37 and 40. Regarding the goods in Class 12, the request quoted the goods for which the mark had been registered, but added: 'with the exception of four subcategories of goods for which the applicant admitted that the mark had been used. The Cancellation Division (CD) declared the revocation as requested by the applicant. The Board of Appeal (BoA) annulled the CD decision and dismissed the revocation request. It declared inadmissible the Class 12 request, as it should have been directed against all the products for which the CTM had been registered. The BoA took the view that it is not possible to apply for revocation for lack of use while at the same time admitting that the mark has been used. The applicant invokes breach of Article 51(1) (a) and Article 56 CTMR as well as of Rule 37(a) (iii) CTMIR.

CTM

ORIBAY

**SUBSTANCE:** The Office did not defend the decision of the BoA. The General Court (GC) stated, that when a mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently,

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an applicant for revocation who considers that the contested mark has been genuinely used for part of the products or services can legitimately exclude from the revocation request those products or services (Para. 25). The BoA erred in declaring the request inadmissible (Para. 30). It also erred in considering that the request breached the general principle *nemo potest venire contra factum proprium* (No one may set himself in contradiction to his own previous conduct) (Para. 32).

**Case T-195/13 dm drogerie markt GmbH & Co. KG v OHIM, Judgment of 14 January 2015; Language of the case: HU**

**RESULT:** Action dismissed

**KEYWORDS:** Relative grounds, Visual dissimilarity, Phonetic similarity, Conceptual dissimilarity, Dissimilarity of signs, Likelihood of confusion, Distinctive element, Reputation

**FACTS:** The applicant sought to register the word mark CAMEA represented below as a CTM for goods in Classes 3, 5 and 16. An opposition based on the earlier word mark BALEA represented below, registered for goods in Classes 3, 5 and 8, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) dismissed the opponent's appeal and confirmed the OD's decision. The opponent filed an action before the General Court (GC). It alleges an infringement of Article 8 (1) (b) and the highly distinctive character of the earlier mark.

CTMA

**CAMEA**

Earlier marks

**BALEA**

**SUBSTANCE:** The relevant consumer is the average consumer (not disputed). The opponent argues that all of the goods at issue in Class 3 are identical. The GC rejected this argument because the global assessment of the likelihood of confusion did not ground on the differences between the goods in conflict (Para 24). The GC emphasized that the marks are visually not similar, considered in their entirety. The differences are also very noticeable phonetically; there is only a low degree of phonetic similarity. The signs may be perceived as meaningless or they are conceptually different, there is a lack of conceptual similarity. The signs at issue are globally dissimilar. There is no likelihood of confusion. Likelihood of confusion presupposes that the signs are identical or similar. This conclusion cannot be affected by the fact that the earlier mark has a highly distinctive character. The identity or similarity between the marks at issue is not met in the present case and the reputation of the earlier mark cannot invalidate this finding.

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**Case T-685/13; Copernicus-Trademarks Ltd v OHIM, Judgement of 21 January 2015; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Relative grounds, likelihood of confusion, Phonetic similarity, Conceptual similarity, Visual similarity

**FACTS:** The CTM applicant sought to register the mark represented below for goods in Class 9. An opposition based on the earlier mark represented below, registered for identical goods in Class 9, was filed on the grounds of Article 8 (1) (b) CTMR. 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

**BLUECO**

Earlier marks

**BLUE COAT**

**SUBSTANCE:** The GC confirmed the BoA's finding of an average to high degree of attention of the relevant consumers of the respective goods in Class 9 (Para. 27). Further, the GC made clear that the evaluation of the visual similarity of two word marks has to take into account the presence of letters in the same order. The contested trade mark application is fully contained in the earlier mark, which is an important indicator for the similarity of the marks (Para. 33). Furthermore, the differing, additional element "at", positioned at the end of the earlier mark, plays only a subordinate role in the overall perception of the mark (Para. 35). The marks are aurally highly similar for the English consumers due to the same letter string "BLUECO". The GC rejected the applicant's argument that the consumers would phonetically double the middle vowel "E" within the younger mark, allegedly leading to a three syllable pronunciation "BLUE ECO". Since the word "BLUE" is part of the common English vocabulary, there is no reason to assume that the consumers will actually perform this exercise (Para. 40). Furthermore, the respective endings "CO"/"COAT" are phonetically not that far apart for the English consumers. Conceptually, the marks are similar with regard to the basic English word "Blue", indicating a colour. The applicant has not demonstrated that "BLUE" has any descriptive connection with any of the goods in Class 9. Therefore, the distinctiveness of the earlier mark is of an average degree (Para. 51). The argument of the applicant that in the present case the likelihood of confusion is ruled out due to the

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fact that the earlier mark has a clear and common meaning must be dismissed. It is true that - under certain circumstances - conceptual differences can neutralize visual and phonetic similarities, if at least one of the signs has a clear meaning for the relevant consumers. However, in the present case, both marks share the same concept with regard to the identical initial element "BLUE" (Para. 54). Therefore, the mere fact that the earlier mark has a clear meaning for English consumers is not sufficient to rule out a likelihood of confusion in light of the visual, conceptual and high aural degree of similarity between the marks and the identity of the goods (Para. 55). Based on the foregoing, the action was dismissed.

**Case T-519/13; Leder & Schuh International AG v OHIM; Judgment of 9 December 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Beginning of mark, Similarity of signs, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Visual similarity

**FACTS:** The applicant sought to register the word mark VALDASAAR as a CTM for goods and services in Classes 18, 25 and 35. The opponent lodged an opposition against the application on the basis of

its earlier Community trade mark Val d'Azur for goods in Class 25. The Opposition Division (OD) granted the opposition partially in relation to the contested goods and services in Classes 25 and 35. The appeal filed by the applicant was partially successful: The Board of Appeal annulled the decision of the OD and refused the opposition in relation to the services in Class 35. On the other hand, the appeal was dismissed and a likelihood of confusion was confirmed as regards the goods in Class 25 of the mark applied for. The applicant filed an application before the General Court (GC) as far as the opposition was granted against the contested goods in Class 25.

CTMA

**VALDASAAR**

Earlier CTM

**Val d'Azur**

**SUBSTANCE:** In its application before the GC, the applicant limited itself to claiming that the contested decision 'infringed the Community Trade Mark Regulation'. However, contrary to

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the argument brought forward by Office, the application is still admissible: It follows from the context of the application that the applicant relied on an infringement of Article 8(1) (b) CTMR. Besides, it is clear when reading the Office's response that it was in a position to understand the claims made by the applicant. Consequently, the application was admissible (Para. 14-18). As to the substance, the GC confirmed the existence of a likelihood of confusion between the conflicting marks. The goods in Class 25 are directed to the general public. The degree of attention is average (Para. 28). The goods covered by the marks are identical (Para. 29). Visually, the signs have a similar length and share the first five letters. The fact that the earlier mark consists of small and capital letters whereas the contested sign is made up exclusively of capital letters is irrelevant as both marks are word marks. The conflicting signs are visually similar to a certain degree (Para. 31). From a phonetic point of view, the beginnings of the marks are pronounced identically. The consumers normally pay particular attention to the first element of a trade mark when being confronted with it (Para. 36). Consequently, the signs are phonetically similar to a medium degree (Para. 37). A conceptual comparison is not possible as the contested sign will be perceived as a phantasy term without any meaning (Para. 40). The earlier mark enjoys a normal degree of inherent distinctiveness for the goods in Class 25 (Para. 45). In view of the visual and phonetic similarity between the signs and the identity of the goods at issue, there is a likelihood of

confusion between the marks within the meaning of Article 8 (1) (b) CTMR (Para. 50).

**Case T-105/13; Ludwig Schokolade GmbH & Co. KG v OHIM, Judgment of 12 December 2014;**  
**Language of the case: DE**  
**RESULT: Action dismissed**

**KEYWORDS:** Allusive trade mark, Complementary goods and services, Evidence of use, Likelihood of confusion, Minimum degree of distinctiveness, New evidence, Phonetic similarity, Similarity of signs, Similarity of the goods and services, Visual similarity, Catalogue, Invoice, Declaration

**FACTS:** The applicant sought to register the word mark TrinkFix as a CTM for goods in Classes 29, 30 and 32. The opponent lodged an opposition against the application on the basis of its earlier German and Community trade mark Drinkfit (word) for goods in Classes 29 and 32. Upon request by the applicant, the opponent submitted evidence of use relating to both earlier rights. The Opposition Division (OD) granted the opposition partially in relation to some of the contested goods in Classes 29, 30 and 32. The appeal filed by the applicant was refused.

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### CTMA

**TrinkFix**

### Earlier CTM and German mark

**Drinkfit**

**SUBSTANCE:** The applicant claimed an infringement of a) Article 42 (2) (3) CTMR in connection with Article 15 CTMR and b) Article 8 (1) (b) CTMR. As regards the first claim (proof of use), the GC confirmed that the evidence submitted by the opponent was sufficient to show genuine use of the earlier marks for milk, milk beverages and yogurt beverages in Class 29 ('the earlier goods'). It is irrelevant that the sign 'Drinkfit' was not depicted on the products themselves according to some of the submitted evidence. The function of a trade mark does not require the trade mark to be physically placed on the goods (Para. 28-38). Moreover, the use of the trade mark as a label does not alter the distinctiveness character of the registered form and therefore constitutes valid use of the registered word mark 'Drinkfit' (Para. 43-53). Overall, the catalogues and product packaging, the invoices and the affidavit are sufficient to prove use of the earlier marks (Para. 54). Concerning the second claim, the GC confirmed the existence of

a likelihood of confusion between the conflicting marks. The goods are directed to the general public and to specialists. The degree of attention of the general public is average (Para. 60). The contested goods powders and powder mixes for making mixed milk beverages and milk powder in Class 29 are highly similar to the earlier goods (Para. 67). There is also an average degree of similarity between the earlier goods and coffee whitener in Class 29 (Para. 67). Moreover, there is a certain degree of similarity between the earlier goods and cocoa, cocoa drinks and cocoa powder, chocolates, drinking chocolate, coffee and artificial coffee, tea, fruit teas, iced tea and non-medicinal herbal teas, beverage powders containing chocolate, coffee and tea based beverages, cappuccino beverages and beverage powders in Class 30 of the contested mark (Para. 75). Finally, the earlier goods and the contested non-alcoholic beverages and powders making those beverages are also similar to a certain degree (Para. 92). The signs are visually similar (Para. 105-109). Phonetically, the signs are similar to a high degree (Para. 112-114). Moreover, the signs are conceptually similar from the perspective of the German-speaking consumers. For other consumers, the signs are conceptually not similar or a conceptual comparison cannot be made (Para. 138). In view of the visual and, more importantly, strong phonetic similarity (Para. 141-142) between the signs and the similarity of the goods at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1)(b) CTMR despite the fact that the inherent distinctiveness of the earlier marks is rather low for a part of the relevant public (Para. 144-145).

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### Case T-53/13; Vans, Inc. v OHIM, Judgment of 6 November 2014, Language of the case: EN

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Distinctive element, Ornamentation, Distinctiveness acquired through use, Nice Classification, Evidence of use, Figurative element, Relevant territory, Lack of reasoning.

**FACTS:** The applicant sought to register a community mark represented for goods within Classes 18 and 25. The mark applied for was the figurative sign represented below: The application was rejected in its entirety based on article 7 (1) b) CTMR. The sign at issue was considered devoid of distinctive character and the fact that the mark applied for had already been registered in some Member States was considered to be irrelevant. Lastly, it was rejected on the basis of Article 7 (3) CTMR finding that the mark applied for had not acquired distinctive character through use. An appeal was filed to the Fifth Board of Appeal (BoA) which was dismissed on the basis that the trade mark applied for was devoid of any distinctive character within the meaning of article 7 (1) (b). In this regard, the relevant public of the mark applied for would only recall the concept of a wavy line, which is too vague to identify the goods as coming from a certain producer and that the graphic lines and stripes are commonly used in the Classes applied. Furthermore, the sign would lead the relevant public to perceive it as having a merely

ornamental function. Lastly, the BoA found that the applicant did not provide enough evidence to prove that the relevant public would identify the goods covered by that mark and that it had acquired any distinctive character through use in the European Union as a whole for the purposes of Article 7 (3) CTMR. The applicant filed an action before the General Court (GC) relying on three pleas of law.

#### CTMA



**SUBSTANCE:** The first plea alleging the infringement of Article 76 (1) was rejected as unfounded. In this regard, the applicant argued firstly, that the BoA refused to take into account all of its arguments and the evidence provided. The GC found that this fact cannot constitute an infringement of Article 76 CTMR but could only give rise to an infringement of a substantive provision, which the GC only assessed under the plea regarding Article 7 (3) (Para. 22). Also, with regard to the substantiation of lack of distinctive character of the mark applied for, the applicant argued that the BoA failed to examine the distinctive character of the mark in relation to each of the sub-categories of goods concerned. The GC pointed out that the findings of the BoA concerning these arguments constituted sufficient statement of reasons, namely why the mark applied for was

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devoid of distinctive character in respect of the goods in Classes 18 and 25 (Paras. 37 to 39). The second plea alleging the infringement of Article 7 (1) b) was also rejected as unfounded. The applicant stated that the BoA erred in finding that the mark applied for was devoid of any distinctive character, namely that the consumers, who are accustomed to the use of single graphic lines and stripes on sports shoes as an indication of commercial origin, would not perceive the mark applied for not as decoration but as an indication of origin (Para 42). The GC confirmed the BoA's assessment with regard to the lack of distinctive character of the mark in the sense that the relevant public would perceive the mark applied for as a simple line which combines slants and curves and therefore would not make it possible to individualise any of the goods in relation to other goods in competition (Para. 75). Lastly, the third plea put forward by the applicant was also rejected as unfounded. The applicant mainly argued that the BoA erred in finding that the mark applied for had not acquired distinctive character through use for the purposes of Article 7 (3) CTMR (Para. 90). The applicant argued that the evidence provided was sufficient to prove the acquisition of distinctive character acquired through use and that it was possible to establish the renown both of the undertaking as well as of its trade marks (Para. 91). In this regard, the GC dismissed the applicant's arguments namely, by indicating that it is apparent that proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising material (Para. 100). Also the mere fact that the sign had been used in the territory of the European Union for a certain time is

not sufficient to show that the target public for the goods in question would perceive it as an indication of origin (Paras. 104-106). In this light, the GC considered that the items of evidence filed by the applicant did not establish that the relevant Class of persons, or a significant proportion of it, could identify the goods covered by the mark applied for and in this regard, that it would be perceived by the relevant public as an indication of the commercial origin of the goods in question (Para. 107).

**Cases T-458/13 and T-459/13, Joseba Larrañaga Otaño y Mikel Larrañaga Otaño v OHIM, Judgment of 16 October 2014, Language of the case: SP**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Descriptive element, Distinctive element, General principles of law, Nice Classification, Principle of legality, Principle of non-discrimination

**FACTS:** The applicants sought to register a community mark represented for goods within Classes 13, 23 and 25 (Case T-458/13) and Classes 2, 6 10 and 22 (Case T-459/13). The mark applied for was the word mark GRAPHENE. The application was rejected in its entirety based on article 7 (1) b) and c) CTMR. An appeal was filed to the Second BoA of Appeal (BoA) which was dismissed on the basis that the trade mark applied for was descriptive and lacked distinctive character within the meaning of article 7 (1) b) and c) CTMR. In this regard, the BoA found that

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relevant public would be both the general public as well as the specialized one, namely the professionals of textiles. In this light, the BoA considered that the trade mark designates a term that refers to a specific composition of the product itself (graphene) and therefore concluded it was descriptive for the English-speaking relevant public. In addition, the BoA found that the trade mark applied for lacked distinctive character since the relevant public would associate it as the characteristics of the product and not to its commercial origin. The applicants filed an action before the General GC (GC) relying on three pleas of law.

CTMA

**GRAPHENE**

**SUBSTANCE:** The first plea alleging the infringement of article 7 (1) c) was rejected as unfounded. In this regard, the applicant argued firstly, that it is possible to register a trade mark with a specific meaning as long as it does not refer to the products covered by the trademark (Para. 13). The GC found that that the BoA did a correct assessment of article 7 (1) c) since the trademark applied for would be understood by the relevant public as descriptive of a characteristic of the product itself and also for its composition (Para. 24). Secondly, the GC found that it is enough for the BoA to provide a global motivation with regard to the descriptive character for a category

or group of goods and/or services insofar as they have a direct and sufficient link between them (Para 26). By the second plea, the applicant alleged the infringement of article 7 (1) b). Concerning this plea, the applicant mainly argues that 'graphene' is not the usual denomination used to describe the products covered and does not give the relevant public the information about its characteristics (Para 31). However, the GC recalled that there are no grounds to examine the substance of this plea as long as one of the Paragraphs of article 7 (1) is fulfilled and therefore prevents the trademark to be registered. Since the BoA analysed the pleas in law of the applicant regarding Article 7 (1) c) there is no reason to further analyse the infringement of Article 7 (1) b) (Paras. 31-32). Lastly, the third plea concerning the infringement of the principle of no discrimination was also dismissed by the GC. The applicants argued that the principle of no discrimination, and in addition the principles of equality and sound administration were disregarded by the BoA (Para. 34). In this light, the applicants argued that the registered trademark 'Grafeno' for the Classes 3, 7, 9 and 12 and the registered trademark 'Graphene' for the Classes 4, 5, 8, 11, 14 to 21, 24 and 26 to 34, did not have any objection to registry with regard to lack of distinctive character for the products in question and that it lead to the violation of the aforementioned principles (Para. 35). The GC rejected such argument referring to well established Case-Law, regarding the fact that the GC is only bound by the 207/2009 Regulation and not by any decisions taken by the Office (Para 35). Furthermore, the GC points out that one who applies to register a trademark cannot claim in his/

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her favour a possible illegal action in order to obtain an identical result (Para 36). Also, the GC states that each registration must be assessed on a case-by-case basis depending on specific criteria and factual circumstances in order to verify if there are any grounds to refuse the registration of a trade mark (Para 36). Lastly, the GC found that the BoA had applied the aforementioned article properly and therefore it was justified to refuse the registration based on the absolute grounds stated in Article 7 (1) c) (Paras. 37-39).

**Case T-133/13; Pro-Aqua International GmbH v OHIM; Judgment of 22 January 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Descriptive element, Distinctive element, Function of trade mark, Laudatory mark, Slogan mark

**FACTS:** The applicant sought to cancel the CTM WET DUST CAN'T FLY for goods and services in Classes 3, 7 and 37. The Cancellation Division's decision, rejecting the application for invalidity based on Article 7(1)(b) and (c) and Article 52(1)(a) CTMR, was confirmed by the Second Board of Appeal (BoA). The applicant filed an action before the General Court (GC) relying on two pleas in law.

### CTM

## WET DUST CAN'T FLY

**SUBSTANCE:** The GC dismissed both pleas on which the action was based, the alleged infringement of Article 7(1) (b) and (c) CTMR. On Article 7(1) (c) CTMR, the GC confirmed the BoA decision that the expression 'wet dust can't fly' does not describe the functionality or operation of the cleaning products and apparatus in Cl. 3 and 7 or maintenance services in Cl. 37. The intended purpose is not to moisten dust in order to prevent it from dispersing but to make the dirt disintegrate and disappear (Paras. 23-29). The applicant's argument that at least non-native English-speakers will perceive the mark in a descriptive way because they will not notice that 'moistened dust is no longer dust once it has become wet' is not substantiated and is contradictory in itself, all the more so since the applicant claims that the mark is composed of commonly used English words (Para. 31). Considering that the mark is not descriptive of the goods and services and cannot be understood as a conventional way of describing the functionalities of cleaning appliances and cleaning tools, it is not necessary to ensure that that expression is made available to competitors (Para. 33). On Article 7 (1) (b) CTMR, there is no evidence on file that that the combination of the words 'dust' and 'wet' is commonly used in the context of filters and

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cleaning systems. The expression 'wet dust can't fly' calls for an interpretative effort since the intended purpose of the goods and services in question is not to 'wet the dust in order to prevent it from flying'. The slogan exhibits a degree of originality and a certain resonance which make it easy to remember (Para. 50). Although the slogan may be slightly suggestive, there is no evidence to support the specific assumption that the goods and services concerned are superior (Para. 52). The laudatory connotation of a word mark does not mean that it cannot, none the less, be appropriate for the purpose of guaranteeing to consumers the origin of the goods or services which it covers (Para. 53).

**Case T-240/13; Aldi Einkauf GmbH & Co. OHG v OHIM, Judgment of 26 November 2014, Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Admissibility, Beginning of mark, Conceptual dissimilarity, Dissimilarity of signs, Figurative element, International registration, Phonetic dissimilarity, Substantiation of earlier right, Visual dissimilarity, Translation

**FACTS:** The applicant sought to register the figurative mark as a CTM for goods and services in Classes 29, 32 and 35. The opponent lodged an opposition against the application on the basis of two earlier Community trade marks for the sign 'ALDI' (word) and an earlier international registration (IR) with designation to the European Union (EU) for the sign

'ALDI' (word). The earlier marks were registered for a wide range of goods and services, inter alia, in Classes 29, 32 and 35. The Opposition Division rejected the opposition and held that a likelihood of confusion between the marks did not exist. The appeal filed by the opponent was dismissed.

CTMA



Earlier marks

ALDI

**SUBSTANCE:** First, the GC rejected the opponent's claim that the Board of Appeal (BoA) had committed an error by holding that the existence and validity of the earlier IR with designation to the EU had not been proven. The GC pointed out that the Office excerpt of the earlier IR submitted by the opponent did not prove the existence of the earlier right as required by Rule 19 (2) (a) CTMIR. The Office is not the responsible office for the administration of international registrations (Para. 28). Moreover, the list of goods and services is published by WIPO only in three languages (English, Spanish and French) but not in all five languages of the Office. If the Office excerpts of IRs designating the EU were

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generally acceptable this would mean a preferential treatment for the languages German and Italian (for which a translation is missing) if the language of the opposition proceedings was in German or Italian. Such a preferential treatment is not foreseen by the law (Para. 30). On the other hand, if the Office excerpts of IRs designating the EU were only acceptable if the language of the opposition proceedings was in English, French or Spanish, this would create a situation of legal insecurity and would be contrary to the principle of equal treatment (Para. 31). Consequently, the BoA correctly decided to disregard the earlier international registration as its existence had not been proven by the opponent (Para. 32). Second, the GC confirmed that a likelihood of confusion between the conflicting marks did not exist. The goods and services at issue are directed to the general public and, in relation to some services like advertising, to specialists. The degree of attention varies from average to high (Para. 41). The conflicting signs are visually different. The figurative elements and the additional word 'foods', must not be disregarded when comparing the signs (Para. 54-55). The overall visual impression of the conflicting signs is clearly different (Para. 59-60). The signs are also phonetically different bearing in mind, in particular, the additional element 'foods' of the contested mark (Para. 64). Finally, the marks are also conceptually not similar (Para. 73). Since one of the requirements of Article 8 (1) (b) CTMR, namely the identity or similarity of the marks, is not fulfilled in this case, a likelihood of confusion does not exist (Para. 76).

### **Case T 484/13; Lumene Oy v OHIM, Judgment of 18 November 2014; Language of the case: EN**

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

**KEYWORDS:** Absolute grounds, Claim for allowing registration, General principles of Law, International registration, Laudatory mark, Principle of legality, Slogan mark, Competence of the Boards

**FACTS:** The applicant obtained an international registration designating European Union for the word mark THE YOUTH EXPERTS, registered for the goods and services within Classes 3 and 5. The examiner refused the sign protection in the EU in respect of some of the goods applied for (the "contested goods") and accepted the CTM application for the remaining goods (the "non-contested goods") on the ground that the trademark applied for was devoid of any distinctive character in respect of the contested goods. The Board of Appeal (BoA) dismissed applicant's appeal finding that the trademark applied for was unsuitable as an indication of the commercial origin of all the goods in Classes 3 and 5. The applicant filed an action before the General Court (GC).

CTMA

THE YOUTH EXPERTS

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**SUBSTANCE:** The GC raised of its own motion a question whether the BoA had competence to re-examine the application for registration of the CTM in question in respect of all the goods covered by that application, when the examiner had allowed the registration in respect of some of the goods covered (Para. 19). Pursuant to the first sentence of Article 59 CTMR, the BoA was legitimately affected of the appeal only to the extent that the lower authority had rejected the applicant's claims and exceeded the limits of its powers in so far as it re-opened of its own motion the examination of the application in the light of absolute grounds of refusal in respect of the non-contested goods covered by the application (Para. 23-24). The contested decision was therefore annulled to the extent that the trademark applied for was declared devoid of any distinctive character in relation to the non-contested goods (Para 25). In regards of the alleged infringement of Article 7 (1) (b) CTMR in relation to the contested goods the GC stated that the relevant public, confronted with the trade mark applied for, would not be led to perceive it as an indication of commercial origin, but as purely promotional information promising expertise in a particular field (Para. 45). Having concluded that the sign at issue was devoid of any distinctive character for the purposes of Article 7 (1) (b) CTMR, the BoA did not have to examine whether the sign might also be caught by the absolute ground for refusal of registration referred to in Article 7(1)(c) CTMR (Para 48). As regards the arguments alleging failure to follow the decision-making practice of the Office, the Office must take into consideration the decisions taken in respect of similar applications and consider with special care whether it should decide in the

same way or not. A person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act that was to the advantage of someone else (Para. 56). Since the legality of the contested decision regarding the non-registrability of the sign THE YOUTH EXPERTS as a CTM in respect of the contested goods is established directly on the basis of Article 7 (1) (b) CTMR, the contested decision cannot be called in question merely because the BoA did not follow the decision-making practice of the Office (Para. 58). Accordingly, the Office and, as the case may be, the judicature of the European Union are not bound by a decision given in a Member State, or indeed a non-member country, to the effect that the sign in question is registrable as a national mark (Para. 59). The single plea in law was rejected as unfounded as regards the contested goods (Para. 62).

Case T-266/13; Brainlab AG v OHIM, Judgment of 26 September, Language of the case: DE  
RESULT: Action dismissed

**KEYWORDS:** Absolute grounds, Claim for allowing registration, Nature of the goods and services, Relevant language, Specialised public, Principle of morality

**FACTS:** The applicant sought to register the word mark Curve as a CTM for goods and services within Classes 9, 10, 35, 38, 41, 42, 44 and 45. The examiner refused to register the word as a CTM on

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the ground that the word is a plural of Romanian word *curvă*, meaning in English “prostitute” or “whore”, which is of a very vulgar content and will be perceived by the relevant public as an insulting and obscene statement. The Board of Appeal dismissed applicant’s appeal.

CTMA

CURVE

**SUBSTANCE:** The General Court held that the relevant public in respect of which the existence of the absolute ground of refusal under Article 7 (1) (f) should be examined is the Romanian-speaking public (Para. 15). The relevant public is not limited only to the public to which the goods and services covered by the mark are directly addressed. It must be taken into account that signs covered by the ground under Article 7 (1) (f) offend equally other persons who are confronted with such sign accidentally without being interested in these products and services (Para. 19). Given the offensive meaning of the mark in Romanian, there is a reason to suppose that the sign will immediately attract the attention of anyone who will face it (Para. 23). The applicant did not provide any evidence on that, in the absence of any foreign language element accompanying the sign in question, the general Romanian-speaking public will perceive the sign as a foreign word. The fact that applicant’s web sites are

exclusively in English is irrelevant for determination of the public perception of that sign, appearing alone, usually in written form, and affixed directly to the products in question or used in connection with the services in question (Para. 24). Use of German equivalent of the Romanian word as a name for the association of prostitutes or for their international day is of no consequence in the assessment of shocking and offensive nature of the mark applied for, insofar as the use of the word in the society in question does not minimize its inherently offensive and obscene character (Para. 31). It is the mark itself, i.e. the sign in relation to goods or services covered by the application that must be examined for the purpose of the assessment whether it contradicts the public order or morality (Para. 34).

**Joint cases T-494/13 and T-495/13; Sales & Solutions GmbH v OHIM; Judgment of 4 December 2014; Language of the case: DE**

**RESULT:** Actions dismissed

**KEYWORDS:** Absolute grounds, Characteristics of the goods and services, Descriptive element, Distinctive element, Figurative element, Figurative trade mark, Graphical representation

**FACTS:** The applicant registered (i) the word mark WATT (case T-495/13) and (ii) the figurative mark represented below (case T-494/13) as a CTM for services within Classes 35, 39 and 42. An application for invalidity was filed based on Article 7 (1) (b), (c) and (d) CTMR. The Cancellation Division upheld the

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application for invalidity on the ground of Article 7(1) (b) and (c) CTMR. The Board of Appeal dismissed CTM proprietor's appeal finding that the contested marks were descriptive and devoid of distinctive character in relation to the service concerned. The CTM proprietor filed an action before the General Court (GC).

CTMA

watt

**SUBSTANCE:** The fact that the term "watt" is not related exclusively to electricity but allows, more generally, quantifying the power of an energy system does not contradict that this term is commonly used in electricity (Para. 28). Further, it is not correct conclusion that the difference between watt (W) and for example watt-hour (Wh) or kilowatt-hour (kWh) is such that these concepts cannot be mixed up (Para. 30). The services at issue are addressed to private households as well as to professionals. The focus should be more on practical perception of the term "watt" in everyday life than on precise scientific definition (Para. 33). The term "watt" can be perceived by the relevant public as a direct reference to unit of measurement used in the field of energy and, in particular, electricity (Para. 34). To assume that a term is descriptive, it is sufficient that, in at least one of its possible meanings, the sign at issue designates a characteristic of the goods or

services covered by it (Para. 36). The services at issue in Class 35 fall within the services of an energy and water supply company which allows referring to the meaning of "watt" (Para. 40). The graphic elements of the figurative mark are not of the nature to confer on the mark a distinctive character (Para. 43). The decisions taken in one EU member state are a factor (without being decisive) that can only be taken into account for the purposes of registration of the CTM, however, nothing in the CTMR requires the Office or the GC to achieve similar results to those achieved by the national authorities in similar situation (Para. 45).

**Case T-322/13; Kenzo Tsujimoto v OHIM, Judgment of 22 January 2015, Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Competence of the Boards, Relative grounds, Reputation, Evidence of use, Dissimilarity of the goods and services, Unfair advantage, Use without due cause, Name, Substantiation of earlier right

**FACTS:** The CTM applicant filed an application for the word mark KENZO for services in Classes 35, 41 and 43 (all wine-related). The opponent relied on the earlier CTM KENZO claiming reputation for goods in Classes 3, 18 and 25. The Opposition Division (OD) dismissed the opposition stating that reputation was not proven. The Board of Appeal (BoA) upheld the appeal of the opponent. The CTM applicant

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brought an action before the General Court (GC) based on two pleas in law.

CTMA
<b>KENZO</b>
Earlier mark
<b>KENZO</b>

**SUBSTANCE:** On the infringement of Article 76 (2) CTMR, the GC dismissed the applicant's claim that the BoA was wrong to have taken into account the evidence of use filed outside the substantiation period to prove reputation and failed to exercise its discretion power. The GC referred to Case C-120/12 P Rintisch v OHIM and made it clear that it is the third subparagraph of Rule 50 (1) CTMIR which must be applied in proceedings before the BoA and not Rule 20(1) CTMIR (Para. 17). Furthermore, the BoA exercised its discretion under Article 76 (2) CTMR to decide that it was appropriate to take that evidence into consideration and, by finding that such evidence was genuinely relevant for the purposes of assessing the earlier trade mark's reputation, provided a statement of reasons for taking that evidence into account (Para. 19). On the infringement of Article 8 (5) CTMR, the GC

indorsed the BoA finding that the evidence filed during the substantiation period together with the evidence filed to prove use clearly showed reputation of the earlier mark in a significant part of the relevant territory (Paras. 24-31). The BoA also correctly established a risk of an unfair advantage by taking into account the iconic image conveyed by the earlier trade mark (which can be transferred to other sectors, such as the wine sector) and by finding that it was highly likely that the mark applied for would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the owner (Para. 43). As to the due cause for the use of the applicant's mark, the GC recalls that CTMR does not provide any unconditional right to register a surname as a Community trade mark, let alone to register a forename as a trade mark. Consequently, the fact that the applicant's forename is Kenzo is not enough to constitute due cause for the use of the mark applied for, for the purposes of Article 8 (5) (Para. 47).

**Case T-609/13, Blackrock, Inc. v. OHIM, Judgment of 29 January 2015; language of the case: EN**  
**RESULT: Action dismissed**

**KEYWORDS:** Absolute grounds, slogan mark

**FACTS:** The examiner refused registration of the word sign SO WHAT DO I DO WITH MY MONEY for services in Classes 35 and 36, namely investment

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advice and business and market research, on the basis of Article 7 (1) (b) and Article 7 (2) CTMR. The Board of Appeal (BoA) dismissed the appeal.

### CTMA

SO WHAT DO I DO WITH MY MONEY

**SUBSTANCE:** The relevant public consists of both English-speaking average consumers and professionals, such as commercial undertakings which are active in the fields of finance and investment. Their level of attention may be relatively low when it comes to promotional indications. The word sign applied for can be easily understood by the relevant public. It conveys a clear and unequivocal message which is immediately apparent and does not require any interpretative effort on the part of an English-speaking consumer. The BoA did not err in finding that it raises a general concern that the consumer should reflect on his financial situation and it merely raises a general demand for the services applied for on the part of the relevant public. According to the General Court (GC), the expression SO WHAT DO I DO WITH MY MONEY is unequivocal and does not have any particular semantic depth which would prevent the relevant public from making a direct link with the services covered. Furthermore, the fact that there might be many answers, or even no answer, to that question has no bearing on the consumer's understanding



of it. Finally, the GC confirms that the BoA correctly applied the Case-Law, namely the 'Vorsprung durch Technik' judgment.

**Case T-173/13; Selo Medical GmbH v OHIM, Judgment of 12. December 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Similarity of the goods and services, Similarity of the signs, Visual similarity, Phonetic similarity, Relative grounds, Likelihood of confusion

**FACTS:** The applicant sought to register the word mark represented below as a CTM for goods within Class 5. An opposition based on the earlier German word mark represented below, registered for goods in Class 5. The Board of Appeal (BoA) confirmed the decision of the Opposition Division that there was likelihood of confusion. The CTM applicant filed an action before the General Court (GC) claiming an infringement of article 8 (1) (b) CTMR:

### CTMA

SELOGYN

### Earlier mark

SELESYN

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**SUBSTANCE:** The GC dismissed the action. It rejected the argument that the perception of the professional public is of more relevance and recalled the Case-Law stating that the public of pharmaceutical preparation consists of both, professionals and patients (Para. 24). The goods are similar or identical (Para. 38). The signs coincide in the beginning and the end and are therefore visually similar (Para. 46). They cannot be seen as short signs (Para. 48). For the same reasons, they are also phonetically similar (Para. 48). Conceptually none of the marks has a meaning (Para. 53). A significant part of the public will not associate the letters “SELE” with “Selen”, as a substance contained in the goods concerned, because in German another words exist beginning with “SELE”, like “Selektion” (Para. 57 and 58). For this part of the public the distinctiveness of the earlier mark is therefore average. For the remaining part of the public the earlier mark is still not purely descriptive (Paras. 65 and 66). There is a likelihood of confusion.

**Case T-556/13; Verband der Kölnisch-Wasser Hersteller e. V. v OHIM, Judgment of 25. November 2014; Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Geographical origin, Descriptive element, Purpose of goods and services, Nature of the goods and services, Laudatory mark, Generic mark

**FACTS:** The applicant sought to register a word mark Original Eau de Cologne for perfumed water in Class 3. The Board of Appeal (BoA) confirmed the rejection of the trade mark by the examiner pursuant to Article 7 (1) (b) and 7 (1) (c) and 7 (1) (d) CTMR with the reasoning that the mark is a French description of the products “perfumed water” combined with the laudatory word “original”. The applicant filed an action before the Court claiming the infringement of Articles 7 (1) (c) in conjunction with Article 66 (2) CTMR, as well as of Articles 7 (1) (b) and 7 (1) (c) CTMR.

### CTMA

#### Original Eau de Cologne

**SUBSTANCE:** The General Court (GC) confirmed the rejection of the CTM application pursuant to Article 7 (1) (c) in conjunction with article 66 (2) CTMR. The GC recalled its Case-Law regarding the descriptive character of a trade mark pursuant to Article 7 (1) (c) CTMR (Paras. 11 et seq.) and emphasized that article 66 (2) CTMR makes an exception for a designation of geographical origin, which is not a ground of refusal in case of a collective trade mark (Para. 15). The CTM applied for consists, however, of a designation of a nature and purpose of the goods applied for (Para. 16). Its element “Eau de Cologne” describes a kind of perfume (Para. 20). The element “original” will be understood in the sense that the goods are

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originals and not copies (Para. 21). The argument of the applicant, that the addition of the element “original” to the element “eau de Cologne” renders it inherently distinctive in a way of “re-localisation” and give the sign a meaning of a geographical indication (“water from Cologne, a German city”) was rejected by the GC (Para. 26 et seq.)

**Case T-601/13; Wilo SE v. OHIM; Judgment of 12 December 2014, language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute Grounds, Laudatory mark, Principle of non-discrimination, Principle of legality, Slogan mark, First time on appeal, Admissibility, Characteristics of the goods and services, Well-known facts need to evidence, New evidence

**FACTS:** The Applicant sought the registration of the CTM Pioneering for You for goods and services in Classes 7, 9, 11, 37 and 42. The First Instance held that the mark is devoid of distinctive character (Article 7 (1) (b) CTMR). The Board of Appeal (BOA) upheld that decision. The General Court (GC) confirms the Case-Law that an appeal against a decision of the BoA has the aim of reviewing its legality. This means that the GC may only take into consideration the factual and legal situation as it has been present before the BoA. Consequently new facts and evidence submitted for the first time before the GC are inadmissible, with the only exception of well-known facts, which are to be considered on its own motion (Para. 12).

### CTMA

## Pioneering for You

**SUBSTANCE:** The GC ascertains that the applicant itself agrees with the findings of the BoA with regard to the meaning of the applied for sign. It would be understood as “innovative for you” (Para. 27). The applicant does not criticise the BoA’s assessment that the applied for sign would be perceived as a laudatory message stressing the positive characteristics of the goods and services. (Para. 28). However, the applicant contends that the sign is not exclusively laudatory and that the public would have at least for some of the goods a higher attentiveness. It further puts forward that the sign might be seen as a word play, which requires some mental effort to grasp its meaning (Para. 29 and 33). The GC disagrees with the applicant. It states that the uppercase used for the letter “Y” in the word “You” is not uncommon and would in any event have no impact, also following the Case-Law according to which a different spelling which may not be pronounced would not have any impact on the semantic meaning of the sign (see case T-640/11 [RELY-ABLE]) (Para. 35). The GC further states that the meaning of the sign is clear and does not leave any doubts. The structure of the sign is grammatically correct and does not trigger any mental process in order to find out its meaning. It is, as a whole, a

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simple message which would fit to any producers or service providers with the natural consequence that it may not indicate the origin of the goods or services (Para. 36). Concerning the attentiveness of the public, the GC referred to the constant Case-Law according to which the attentiveness in cases of slogans tends to be low, even for a specialized public. It further adds that even for a higher attentive public the applied for sign would still convey a laudatory message without any distinctive character (Para. 38). As far as the applicant's complaint on the infringement of equal treatment is concerned, because similar marks have been registered by the Office, the GC answered the following: First it made reference to the constant Case-Law which clearly states that decisions concerning registration of a sign as a Community trade mark which the BoA are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of BoA must be assessed solely on the basis of that regulation, as interpreted by the Community judiciary, and not on the basis of a previous decision-making practice of the BoA (Para. 41). The GC further stresses that even if a similar or identical sign has been previously registered, the later applicant cannot rely on that unlawful decision. The principle of equal treatment has to respect the principle of legality (Para. 42). Also the factual circumstances may vary from case to case. The claim that the Office should have adopted the same reasoning as in a specific previous case is unfounded, unless the applicant shows that the BoA has committed an error leading to the annulment of the contested decision (Para. 43).

**Case T-368/13 ; Boehringer Ingelheim International GmbH v OHIM, Judgment of 10 February 2015; Language of the case: FR**

**RESULT:** Action dismissed

**KEYWORDS:** Dissimilarity of signs, Similarity of goods, Identity of the goods, Likelihood of confusion, Relative grounds, Admissibility of defence, Competence of the GC, Conceptual dissimilarity, Common element, First time on appeal, Principle of party disposition, Well-known facts need no evidence

**FACTS:** The applicant sought to register the word mark ANGIPAX as a CTM for goods within Class 5 (Class heading). An opposition based on the earlier Community word mark ANTISTAX, registered for "pharmaceutical products" in Class 5, was filed on the grounds of Article 8 (1)(b) CTMR. The Opposition Division (OD) dismissed the opposition. The BoA of Appeal (BoA) dismissed the opponent's appeal.

CTMA

**ANGIPAX**

Earlier mark

**ANTISTAX**

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**SUBSTANCE:** The GC upheld the plea of the Office to declare inadmissible the AIPPI report filed by the opponent before the GC not submitted during the administrative phase (para. 19) and confirmed that a judgment from the Bundesgerichtshof submitted for the first time before the GC by the opponent for illustrative purpose was admissible (para. 20). The GC found that even assuming that the opponent did not present observations on the comparison of the goods before the BoA or even implicitly accepted the similarity of some of the goods its arguments before the GC are admissible. Those matters were part of the factual and legal framework before the BoA. All of those matters were dealt with by the OD in its decision, in response to the arguments of the parties or of its own motion, since those issues necessarily had to be resolved in order to rule in the opposition proceedings. Accordingly, the BoA necessarily based, or should have based, its decision on all matters of fact and of law which led to the decision contested before it. Such matters may therefore be debated as to their merits before the GC (paras. 49-55). The GC confirmed the BoA's finding that the degree of attention of the relevant public for all of the goods in Class 5 is higher than average because of their medical nature and including for "food for babies" (Paras. 31-47). The GC confirmed that the "dietetic substances for medical use; disinfectants; plasters and materials for dressings" and "pharmaceutical products" are similar (Para. 60); and that "food for babies" are lowly similar to "pharmaceutical products" (Para. 61).

Visually, despite some undeniable similarities, the use of the different letters and the structure of the words allow to consider that there are differences between the signs (Para. 69). Phonetically, none of the parties nor the BoA divided the earlier mark into the syllables "an", "tis", "tax", which would be the traditional way of breaking down words into syllables, which emphasises that in the public's mind the earlier mark is composed of two elements, namely "anti" and "stax" (Para. 72). Despite the identity in the first syllable of the signs "an" and the last two letters "ax", the signs are not highly similar (Para. 72). The second and third syllables are phonetically different (Para. 74). The BoA found that conceptually none of the signs had a clear meaning and then analysed the signs by dividing them in accordance with the Case-Law (Para. 81). It correctly found that "anti" refers to the notion of "against" (para. 83). The element "angi" may be perceived by some consumers as the abbreviation for angina and "pax" as a reference to peace, so that the public may consider that the product is aimed at calming angina (Para. 84). In dividing the signs, it cannot be concluded to the existence of a conceptual similarity (Para. 85). The BoA only referred to well-known facts in the pharmaceutical sector, in which the GC already found that it is not unusual for producers to refer to chemical or molecular compounds in order to emphasise the alleged effectiveness of a pharmaceutical product which is for sale (Para. 91). Even though the signs show some elements in common, they are not sufficient to conclude to

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a global similarity, taking into account the higher than average degree of attention of the public (Para. 94). Even if it were considered that the degree of attention of the public is normal, given the degree of similarity of the signs, it is excluded that the public attributes the same commercial origin to the products bearing the signs in conflict (Para. 95).

**Case T-11/14; Grundig Multimedia AG v OHIM, Judgment of 21 January 2015, Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Slogan mark, Principle of legality,

**FACTS:** The applicant sought to register the word mark Pianissimo as a CTM for goods within Class 7. The examiner refused to register the word as a CTM on the ground that it lacked distinctive character according to Article 7 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. The General Court (GC) dismissed the appeal. It found that the sign lacked distinctive character for the goods applied for in Class 7.

CTMA

**PIANISSIMO**

**SUBSTANCE:** The GC underlined that in the light of the characteristics of the products designated by the trade mark applied for that are included in class 7, namely machines or apparatus, the use of which is associated with noise, the word 'pianissimo', in its meaning of 'extremely silent' or referring to a very low sound volume for the Italian speaking public, will be perceived by the relevant public as a promotional formula indicating that those products function silently (Para. 24). As a result the GC found that the BoA was correct to hold, in the light of that meaning of the word 'pianissimo' that the sign at issue will not be immediately perceived by the relevant public as an indication of the commercial origin of the goods referred to, but as the description of one of their characteristics (Para.26). It also recalled that a word sign must be refused registration, under Article 7 (1) (b) CTMR, where, according to at least one of its possible meanings, it designates a characteristic of the products or services concerned (Para.27). As a result, the fact that the word 'pianissimo' means also 'very slowly', a meaning which the BoA did not take into consideration, is of no benefit to the applicant (Para.28). As regards the principle of equal treatment and good administration, the GC held that those principles needed to be reconciled with respect for legality (Para.38). This means that examination must be undertaken in each individual case. In this case the BoA undertook the full and specific examination of the trade mark applied for before refusing to register it (Paras. 38-40). And finally, the GC rejected the argument of the applicant, that 'pianissimo'

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will be for the vast majority of the European public associated with classical music and will have at least a certain degree of distinctive character (Para. 41). The GC underlined that the CTM has a unitary character and that therefore it must have distinctive character throughout the European Union. According to Article 7(2), it is sufficient that the signs do not have distinctive character in a part of the EU that may be comprised of a single Member State, in order to be refused (Para. 42).

**Case T-59/14, 29 January 2015, Blackrock, Inc., v. OHIM, Language of the Case – EN.**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Distinctive element, Slogan mark, Laudatory mark

**FACTS:** The applicant sought to register for the word mark INVESTING FOR A NEW WORLD as a CTM for services in Classes 35 and 36. The examiner refused the application on the ground that it lacked distinctive character according to Article 7 (1) (b) CTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. The General Court (GC) dismissed the appeal.

### CTMA

#### INVESTING FOR A NEW WORLD

**SUBSTANCE:** The GC confirmed the finding that the relevant public consists of both average consumers and professionals which understand English. The GC found, however, that the BoA's finding that the level of attention of the relevant public was relatively high because what were involved were financial services was incorrect. The attention of the public may be relatively low when it comes to promotional indications, whether what is involved are average end consumers even if, as in the present case, the services concerned are financial and monetary services (Para. 27). Nevertheless, since the BoA based its analysis on the premise that the level of attention of the relevant public was relatively high, its findings as regards the lack of distinctive character of the mark applied for could not have been different if it had taken the view that the level of attention of that public was relatively low (Para. 28). As correctly stated by the BoA, 'a new world' refers to an area of human activity or understanding'. It is true that, in the definition of the latter expression, the BoA did not refer expressly to the adjective 'new' - which, as the Office states, means 'recently created or having started to exist recently', but that is irrelevant as it is an adjective the

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meaning of which is well-known and unequivocal. The GC confirmed that the word sign INVESTING FOR A NEW WORLD, considered as a whole, may be easily understood by the relevant public, in view of the common English words of which it consists, as meaning that the services offered are intended for a new world's needs (Para. 32). Therefore, the BoA was right to find that the message conveyed by the expression at issue was that, when purchasing the services in question, the money or capital invested creates an opportunity in a new world, which carries a positive connotation. The mark applied for thus constitutes a banal expression which the relevant public will not need to analyse for it to be understood (Paras. 32, 33). The BoA was therefore right in finding that the sign at issue was devoid of any distinctive character within the meaning of Article 7 (l) (b) CTMR. The fact that the expression at issue may be interpreted in a number of ways does not alter the laudatory nature of that expression. In that regard, the applicant submits in particular, that the expression 'a new world' may evoke a 'more difficult world', namely one in which, for example, financial hazards and risks are greater. The fact remains, as the Office observes, that all those possible meanings put forward by the applicant still denote positive connotations of the sign applied for in relation to the services at issue (Paras 39 and 40). The BoA's reading of the judgment Audi v OHIM, C-398/08 P, "VORSPRUNG DURCH TECHNIK", must moreover be confirmed. Contrary to the applicant's opinion, inasmuch as the sign was a widely known

slogan which had been used by Audi for many years, it could not be excluded that the fact that members of the relevant public were used to establishing the link between that slogan and the motor vehicles manufactured by that company also made it easier for that public to identify the commercial origin of the goods or services covered (Paragraph 59 of the judgment). Furthermore, the mark "VORSPRUNG DURCH TECHNIK", had a distinctive character since it could constitute a play on words or be perceived as imaginative, surprising and unexpected, unlike the mark applied for (Paras. 50-52).

**Case T-85/14; Infocit - Prestacao de Servico, Comércio e Indústria, Ltd v OHIM; Judgement of 10 February 2015; Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Acronym, Certificate of the Chamber of Commerce, International registration, Reputation, Relative grounds, Likelihood of confusion, Similarity of the goods and services, Visual similarity, Phonetic similarity, Beginning of mark, Name, Non-registered trademark, Sign of mere local significance

**FACTS:** The CTM applicant sought to register the mark represented below for goods in Class 7, 9 and 11. An opposition was filed on the grounds of Article 8 (1) (b) CTMR, Article 8 (5) CTMR and Article 8 (4) CTMR,

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based on the following earlier rights, represented below: a) International Registration (IR), protected in several Member States including Germany for identical, similar and dissimilar goods in Classes 1-34; reputation was claimed for “printed matter” in Class 16; b) earlier non registered sign, used in the course of trade in Germany for the “development of norms, standards and technical rules as a service to industry, the State and Society as a whole”. The Opposition Division (OD) found that there was no likelihood of confusion, no sufficient evidence for the claimed reputation and consequently rejected the opposition based on Article 8 (1) (b) CTMR and Article 8 (5) CTMR. The opposition was also rejected with regard to Article 8 (4) CTMR, as the OD found that the conditions of Paragraph 15 MarkenG (German Law on the Protection of Trademarks and other signs) were not fulfilled. The Board of Appeal (BoA) annulled the OD decision and refused the CTM application in its entirety. It found a likelihood of confusion with regard to the identical and similar goods. With regard to the dissimilar goods, the BoA upheld the opposition based on Article 8 (4) CTMR in conjunction with Paragraph 15 (3) MarkenG. The applicant filed an action before the General Court (GC).

**SUBSTANCE:** The GC confirmed the BoA’s finding that the degree of attention of the relevant public (general public/professionals in Germany) for the respective goods in Class 7, 9 and 11 is slightly higher than average (Para. 28). The different

### CTMA

**DINKOOL**

### Earlier mark

a) **DIN**  
b) **DIN**

degree of similarity of the goods found by the BoA (identical, similar, dissimilar) was not contested by the applicant. Visually and aurally, the marks have a certain degree of similarity due to the identical word element “DIN”, positioned at the beginning of the respective marks (Paras. 36-44). Conceptually, the CTMA is a fanciful word in German. Nonetheless, the average consumer will break the word “DINKOOL” down into elements which, for him, have a meaning. “KOOL” will be understood as a misspelling of the common English word “cool”, which is often used in colloquial German in a sense of “good”, “excellent”, “perfect”. “DIN” may be perceived as either meaningless or as a reference to the opponent’s name (Deutsches Institut für Normung e.V.) of

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which it is an acronym. In the latter case, there is also a certain degree of conceptual similarity between the signs (Paras. 46-51). In this context, the applicant has not sufficiently explained its assertion that "DIN" will only be perceived as a reference to the opponent's name when used in isolation. In light of the visual, aural, and - for some consumers - conceptual similarities, the BoA was right to conclude that a likelihood of confusion (Article 8 (1) (b) CTMR) exists with regard to identical and similar goods (Paras. 56-58). Concerning the dissimilar goods and Article 8 (4) CTMR in conjunction with Paragraph 15 MarkenG, the applicant has not challenged the following findings of the BoA: a) Paragraph 15 MarkenG confers a right to prohibit the unauthorized use of a business sign, where there is a likelihood of confusion, or - irrespective of a likelihood of confusion - where the earlier sign has acquired a reputation in Germany and use would be detrimental to, or take unfair advantage of, the distinctiveness or reputation of the business sign; b) The earlier, unregistered sign "DIN" has been used in Germany in activities with more than mere local significance; b) the earlier sign enjoys reputation in Germany for the services claimed; d) The dissimilar goods at stake in Class 9 and 11 are technical goods, likely to be manufactured in accordance with agreed norms. The applicant submitted, in essence, that the signs at issue are dissimilar, because "DIN" will not be understood as a reference to the opponent's name unless it is used in isolation and because the contested sign is composed of the combination of

two English words, namely "DIN" and "COOL". This argument must be rejected for the same reasons it was rejected under Article 8 (1) (b) CTMR (Para. 70). The applicant's argument that, where a product is certified by the opponent, clear reference is made to that certification through the identification of the opponent by its full name or acronym, is not capable of invalidating the BoA's finding that the relevant public might believe that goods marketed under the trade mark "DINKOOL" were manufactured in compliance with the "DIN" norms established by the opponent. The applicant has failed to explain whether - and, if so, why - it is clear that the contested sign "DINKOOL" has nothing to do with the norms established by the opponent and why the relevant public could not possibly be led to believe that goods marketed under the contested sign were manufactured in compliance with the norms established by the opponent. In those circumstances, the application based on Article 8 (4) must fail (Paras. 69-75). Based on the foregoing, the action was dismissed. There is a likelihood of confusion.

**Case T-344/14 Lidl Stiftung v. OHIM; Judgment of 17 December 2014; language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute Grounds, Laudatory mark, Principle of non-discrimination, Principle of legality, Slogan mark, First time on appeal, Admissibility

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**FACTS:** The Applicant sought the registration of the figurative mark Deluxe as shown below for goods in Classes 29, 30, 31, 32 and 33. The First Instance held that the mark is devoid of distinctive character (Art. 7 (1) (b) CTMR). The Board of Appeal (BoA) upheld that decision. As to the procedure, the General Court (GC) confirms the Case-Law that an appeal against a decision of the BoA has the aim of reviewing its legality. This means that the GC may only take into consideration the factual and legal situation as it has been present before the BoA. Consequently new facts and evidence submitted for the first time before the GC are inadmissible, with the only exception of well-known facts, which are to be considered on its own motion (para. 9 -11).

### CTMA



**SUBSTANCE:** With reference to the word element "Deluxe" the GC states that the word element "Deluxe" is purely laudatory and promotional intended to inform on the positive qualities of the goods. At least the English and German speaking consumers will immediately grasp this meaning (para. 24). The expression does not require any mental effort or interpretation nor is it original or resonant (para. 25). The typeface of the sign

together with the figurative elements and the colour silver merely underline the message of elegance and quality of the expression "Deluxe" and do not add any distinctiveness to the overall impression (para. 26 and 27). The BoA correctly concluded that taken as a whole the applied for sign is devoid of distinctive character (para. 28). As far as the applicant's complaint on the infringement of equal treatment is concerned, because similar marks have been registered by the Office, the GC answered the following: First it made reference to the constant Case-Law which clearly states that decisions concerning registration of a sign as a Community trade mark which the BoA are called on to take under the CTMR are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of BoA must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice of those boards (para. 38). The GC further stresses that even if a similar or identical sign has been previously registered, the later applicant cannot rely on that unlawful decision. The principle of equal treatment has to respect the principle of legality (para. 40 and 41).

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#### Decision of the Fifth Board of Appeal of 12 December 2014 in case R1360/2014-5 (EN)

*Absolute grounds for refusal – Article 7(1)(b) and 7(2) CTMR, Article 66(1) and (3) CTMR, – certification marks, collective Community mark*

The applicant sought to register the word mark 'DOWNMARK' as a collective Community mark for goods and services in Class 20, 22, 24, 25 and 35.

Priority was claimed from a Canadian trade mark classified as a 'certification mark'.

The examiner refused the application under Article 7(1)(b), (c) and 7(2) CTMR on the ground that the collective trade mark was descriptive and lacked distinctive character. Article 7(1) CTMR also applies to collective Community marks. Even the lower

threshold of descriptiveness and distinctiveness requirements for collective marks compared to individual trade marks could not overcome the objection. An exception applies exclusively to signs which are descriptive of the geographical origin of the goods and services.

The applicant appealed the examiner's decision.

The Board found that a collective mark should, in principle, not be registered if there is any absolute ground for refusal pursuant to Article 7 CTMR. Currently there is no such thing as a certification, quality or guarantee mark in the CTMR. Those are different types of marks which should not be confused with a collective mark. A certification mark is not a subcategory of a collective mark. The collective mark is capable of distinguishing the goods or services of a member of the association, which is the proprietor of the mark, from those of other undertakings. It must be distinctive. Therefore, a collective mark cannot be registered as a (collective) Community trade mark if it is exclusively perceived as an indicator of quality or guarantee but not as an indicator of origin. The exception laid down in Article 66(2) CTMR did not apply because the application did not designate a geographical origin of the goods and services.

The Board concluded that the application should be rejected pursuant to Article 66(1) and (3) CTMR in connection with Article 7(1)(b) and 7(2) CTMR, and consequently, it dismissed the appeal.

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### Decision of the Second Board of Appeal of 10 December 2014 in case R 1993/2014-2 (EN)

*Absolute grounds for refusal – Article 7(1)(b) and 7(2) CTMR – figurative mark, distinctiveness, basic geometric shape*

The applicant sought to register the figurative mark



for goods and services in Class 9, 10, 41, 42 and 44.

By a decision the examiner rejected the application in its entirety for being ineligible for registration under Article 7(1)(b) and 7(2) CTMR.

The applicant filed an appeal against the examiner's rejection.

The Board held that the contested sign did not merely consist of a simple line, but rather of an arrangement of 22 black dots forming a curve with a wider shape at its ends and a narrower shape in its middle part. In fact, the dots were combined in different sizes, thus forming a curve with varying width. In view of this, the Board found that the contested sign could not be seen to be an extremely simple variation on a basic geometric shape. There was no indication at all that the contested sign was a mere variation on a basic shape commonly used on the goods or with the services, nor was it a well-

known fact, derived from common knowledge or everyday experience, that such a sign was banal or commonplace. In the Board's opinion, the contested sign was, at least to some degree, fanciful and, hence, distinctive. The Board agreed with the applicant that no valid reasons were put forward indicating that the contested sign would establish a link between the sign and all of the contested goods and services. The mere statement that all the goods and services were related to medicine did not suffice at all to argue that the contested sign was non-distinctive in relation to all such goods and services. The contested sign would indeed be perceived as an indication of origin, for example, when used as a logo, for instance, on the goods or on their packaging. In the Board's view, the mark applied for was simple; however, it was not commonplace for the goods and services in question. No sound reasons were given as to why it would not be capable of distinguishing the applicant's goods and services from those of competitors. In conclusion, the Board believed that the mark applied for had at least the minimum degree of distinctiveness necessary for it to surmount the barrier posed by Article 7(1)(b) CTMR. Therefore, no objection under Article 7(1)(b) CTMR arose.

The Board upheld the appeal and annulled the contested decision. The mark was accepted for publication for all the goods and services applied for.

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### Decision of the Second Board of Appeal of 11 December 2014 in case R 610/2014-2 (EN)

*Opposition – Article 8(1)(a),(b) and 8(5) CTMR - figurative mark, scope of appeal, cross-appeal*

The applicant sought to register the figurative mark



for goods in Classes 6, 7 and 9.

The opponent filed an opposition pursuant to Article 8(1)(a), (b) and 8(5) CTMR, based, inter alia, on earlier CTM



registered for 'apparatus, instruments and devices for recording and reproducing text, images, audio and video, expressly including those which contain 'books in electronic format' in Class 9 and 'telecommunications' services in Class 38.

The Opposition Division partially upheld the opposition and rejected the contested trade mark for some of the goods in Class 9. The CTM application was allowed to proceed for the remaining goods applied for in Classes 9, 7 and 6.

The applicant filed an appeal against the decision, seeking the annulment of the contested decision in so far as it partially rejected the CTM application, namely for the goods applied for in Class 9 found to

be similar and/or identical. The applicant based its arguments only on Article 8(1)(b) CTMR with respect to the contested goods in Class 9. The opponent did not dispute the contested decision's findings concerning the similarity or identity between the goods and the signs but did raise an objection to part of the contested goods in Class 9 which were found to be dissimilar to the earlier goods.

The Board found that for a submission/objection to be regarded as a cross-appeal, the party had to seek a decision annulling or altering the contested decision. Neither party contested the decision's findings as to the Article 8(5) CTMR ground. Thus, the scope of the appeal was limited to the rejection of the trade mark applied for under Article 8(1)(b) CTMR.

The Board upheld the contested decision partly rejecting the opposition and dismissed the appeal.

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### Decision of the Second Board of Appeal of 19 December 2014 in case R 2090/2013-2 (EN)

*Opposition – Article 8(1)(b) and 8(5) CTMR – word mark – detriment to reputation, detriment to the distinctive character of the earlier mark, dissimilar goods, prima facie evidence*

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The CTM applicant sought to register the word mark 'TDK' for goods in Classes 6, 17 and 19.

The opponent filed an opposition pursuant to Article 8(1)(b) and 8(5) CTMR, based, inter alia, on the earlier CTMs

**TDK-EPC**

registered for goods in Classes 7, 9 and 11

  
TDK EPC Corporation

registered for goods in Classes 7, 9 and 10 and 'TDK-EPC' registered in Classes 7, 9 and 10.

The Opposition Division issued a decision rejecting the opposition in its entirety because it was not well founded under Article 8(5) CTMR. The opponent could only prove reputation in the relevant territory for audio and videotape goods of its earlier marks. The Opposition Division concluded that the goods at issue were so different that the later mark was unlikely to bring the earlier marks to the mind of the relevant public.

The opponent filed an appeal against the decision and requested that the Board overturn it.

The Board found that the earlier mark 'TDK' had a reputation within the European Union for 'audio and videotape goods'. The goods 'building and heat insulation materials' were so different that the later mark was unlikely to bring the earlier marks to the

mind of the relevant public. It was not clear at all how the image of the earlier mark with reputation in the field of recording media products could be transferred to the applicant's goods concerning 'building materials' in Classes 6 and 19 and specific heating insulation material given that the goods and fields of business activity were very far apart. The opponent further argued that '[b]uilding and construction is a specific commercial area in which use of a TDK could diminish a reputation of the sort and nature of a company such as the opponent. This is due to the fact that the strong distinctive nature of the mark will be reduced and narrowed if it is used in relation to other areas of goods and services by other undertakings, such as use on the goods covered by the applicant by this mark'. This argument, which seemed to be a mixture of an allegation that there was detriment to the reputation and detriment to the distinctive character of the earlier mark, was no more than a mere statement which was not corroborated by any evidence which would demonstrate prima facie that there was a serious risk of a change in the economic behaviour or that the trade mark's power of attraction was reduced. The lack of any prima facie evidence was also applicable with respect to the opponent's mere statement that because of the contested goods' lack of quality, the reputation of the earlier marks would be tarnished and harmed.

The Board dismissed the appeal.

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### Decisions of the Fifth Board of Appeal of 13 January 2015 in the cases R149/2014-5, R150/2014-5 and R153/2014-5 (EN)

*Opposition – Article 8(5) CTMR - earlier marks with reputation, proof of reputation, lack of evidence, dissimilar goods and services, lack of translation*

The three cases were about very similar oppositions against CTMs comprising the word 'UNICORN'. The oppositions were based on a series of earlier Czech trade marks with reputation.

The applicant sought to register the word mark 'UNICORN-čerpací stanice' and the figurative marks



and



for goods and services in Classes 4, 35 and 37.

The oppositions were based on Article 8(5) CTMR.

The Opposition Division upheld the oppositions only for 'repair and installation services, repair information' in Class 37.

The opponent filed appeals and requested that the

Board annul the decisions and reject the CTMs in respect of all the goods and services applied for.

The Board found that the opponent had to prove reputation of its marks in the field of ITC (Information Technology and Communication), however the proof sent was only enough to show that the company name was known by the public, in general, but not its actual field of activity. The trade marks were known only amongst the specialist public. The contested goods and services were in Class 4 and in service classes related to fuel stations, therefore not related to the opponent's goods and services (dissimilar). The evidence, albeit consisting of hundreds of pages, only showed that the company name and the company's owner was known by the public, but not the company's actual field of activity which targeted a specialized public. It was also possible that relevant information was not translated into the language of the proceedings.

The Board dismissed the appeals.

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### Decision of the Second Board of Appeal of 23 January 2015 in case R 2553/2013-2 (EN)

*Cancellation proceedings – Article 52(1)(b) CTMR – bad faith at the moment of filing the contested CTM*

The CTM proprietors registered the figurative mark



for goods and services in Classes 29, 31 and 43.

The cancellation applicant filed a request for a declaration of invalidity against the CTM based on Article 52(1)(b) CTMR, alleging the CTM proprietors' bad faith at the moment of filing the contested CTM.

The Cancellation Division declared the CTM invalid in its entirety.

The CTM proprietor filed an appeal.

The Board held that the contested decision correctly found that it followed from the long-standing use within the same economic sector that at the time of filing the contested CTM, the CTM proprietors must have known of the cancellation applicant's use of its mark and of its reputation and that there might be a likelihood of confusion with the contested CTM. The Board also noted that the marks coincided in their colours, outlook, text and the form of the letters so strongly that it could hardly be a coincidence that

they looked so similar. It was also clear that the information regarding the European Commission's permission for the cancellation applicant and other companies to enter into the European Union's market was heavily publicised prior to the filing of the contested CTM. The various articles provided as evidence, especially from 2009, proved this. Working in the same sector, the CTM proprietors would have been aware of their competitor's movements and that it was highly likely that the cancellation applicant would be filing for a CTM in the near future. The contested decision correctly found that by filing and registering the contested CTM, the CTM proprietors had effectively put an obstacle in the path of the cancellation applicant in its expansion into the European Union's market. This would effectively prevent it from carrying out its business activities which it had been performing for a number of years prior to the filing of the contested CTM. As such, the objective circumstances of the evidence and facts led to a conclusion of bad faith.

The Board dismissed the appeal and upheld the decision to declare the CTM invalid.

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### Decision of the Fifth Board of Appeal of 20 January 2015 in case R 0612/2014-5 (DE)

*Cancellation proceedings – Article 52(1)(a) CTMR, Articles 7(1)(a) and (b) CTMR – indication of origin*

The CTM proprietor registered the word mark 'BASIC 40' for goods and services in Classes 6, 35 and 37.

The cancellation applicant filed a request for a declaration of invalidity against the CTM based on Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) and (c) CTMR.

The Cancellation Division rejected the declaration of invalidity because it found the CTM, in respect of the goods and services registered, to be distinctive and non-descriptive.

The cancellation applicant appealed the Cancellation Division's decision.

The Board held that the sign 'BASIC 40' had to be cancelled due to its descriptive character as regards building materials and metallic hardware in Class 6, and also for the services which were partially connected to the goods.

The Board annulled the contested decision and invalidated the CTM registration in its entirety.

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### Decision of the Third Board of Appeal of 9 December 2014 in case R 1643/2014-3 (IT)

*Registered Community Design – invalidity proceedings – Articles 6(1)(b) CDR – individual character, freedom of design, overall impression, informed user*

The design holder was the holder of the registered and published Community design for 'radiators for heating' represented with the following views:



The invalidity applicant filed an application for a declaration of invalidity pursuant to Articles 4 to 9 CDR and Article 25(1)(b) CDR. He argued that the RCD was devoid of any individual character within the meaning of Article 6(1)(b) CDR in view of multiple earlier international registrations, such as the ones depicted below.

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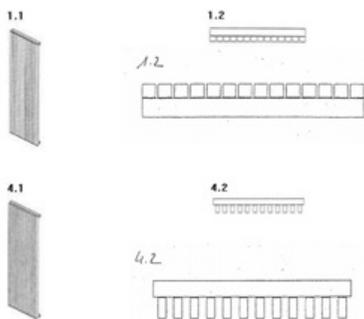
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The Invalidity Division declared the Community design invalid on the grounds that the RCD was devoid of any individual character.

The design holder filed an appeal against the Invalidity Division's decision.

The Board found that 1. the freedom of the designer was not limited by aesthetic considerations; 2. the overall impression resulted from the observation of the design (and product) from all visual perspectives; in that result, however, visual perspectives which were the most obvious and natural (bearing in mind how the product was used) had to be emphasised; 3. the argument about saturation of the art could be relevant in order to assess the overall impression – saturation of the art could increase the informed user's capacity of discernment – but it was necessary to substantiate this with, for example, market surveys, fairs, declarations from industrial associations, etc.

The Board dismissed the appeal and upheld the contested decision as regards the fact that the design lacked individual character.

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### The Registry also recommends

#### Decision of the First Board of Appeal of 9 January 2015 in case R2094/2013-1 (DE)

*Recordal issue – Register of Community Trade Marks, Article 93 CTMR, Rule 76(9) CTMIR, change of representative, association of representatives, employee representatives*

The CTM holder, a US entity, requested that it be represented before the Office by an 'association of employee representatives' which also had to be entered into the Register. The association of employee representatives consisted of patent assessors employed by a German affiliate of the CTM holder.

The Operations Department decided not to allow the entry into the Register.

The CTM holder filed an appeal against the decision.

The Board found that the appellant was a US entity with no domicile or principle place of business or real and effective industrial or commercial

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establishment in the Community and thus had to be represented before the Office in accordance with Article 93(1) CTMR. Article 93(1) CTMR states that representation may only be undertaken by a) a legal practitioner qualified in one of the Member States or b) professional representatives whose names appear on the list maintained for this purpose by the Office. Article 93(3) CTMR provides that legal persons with their domicile or principle place of business or real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee of that legal person. Such an employee (referred to in the first sentence) may also represent other legal persons which have economic connections with this legal person, even if those other legal persons have no domicile etc. within the Community. Thus, Article 93(3) CTMR means that an employee of the German entity may not just represent the German entity before the Office, but also an US affiliate of that entity. In general such an exception needs to be interpreted narrowly.

The Board held that an 'association of representatives' according to Rule 76(9) CTMR referred to legal practitioners within the meaning of Article 93(1)(a) CTMR and not to an employee representative within the meaning of Article 93(3) CTMR. The Board held that the 'association of employee representatives' in question was not an association of legal practitioners, and therefore, could not be recorded in the Register. An 'association of employee representatives' was not allowed to represent a party before the Office because it was neither a natural person nor a representative within the meaning of the CTMR.

The appeal was dismissed.

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