

# Alicante News

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## Counting the cost

The economic impact of counterfeiting and piracy in the cosmetics and personal care sector

March  
2015



**Gabrielle Olsson Skalin** talks to James Nurton

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### The economic impact of counterfeiting and piracy in the cosmetics and personal care sector

Sales of counterfeit perfume, makeup and personal care items like sunscreen and shampoo throughout the EU mean that legitimate manufacturers, retailers and distributors lose €4.7 billion of revenue each year. That equates to 7.8% of the total sales in the cosmetics and personal care sector throughout the EU-28.

That lost revenue translates into 50,000 lost jobs, as the legitimate industry sells less than it would have done in the absence of counterfeiting, and therefore employs fewer workers.

Those findings are contained in a new report from OHIM, acting through the EU Observatory on Infringements of Intellectual Property Rights.

#### Main findings:

7.8% of sales lost by the sector due to counterfeiting	51,561 direct jobs lost
€4.7 billion of revenue lost annually by the sector	78,959 direct and indirect jobs lost
€4.8 billion of sales lost in related sectors	€1.7 billion of government revenue lost (social contributions and taxes)

The report follows the publication of two major studies on the contribution to economic performance and employment of IPR intensive industries and citizens' perceptions of IP in the European Union.

The study's scope, throughout the sector officially labelled "Manufacture of Perfumes and Toilet Preparations" by Eurostat, was wide. The products included perfumes, toilet water, shampoos, toothpaste, soap and sun cream. The study also found that when the knock-on effect on suppliers is taken into account, legitimate businesses across the EU lose €9.5 billion of sales revenue because of counterfeiting, with around 80,000 jobs lost.

Furthermore, €1.7 billion of government revenue is lost due to the presence of counterfeiting, reflecting income taxes, social contributions and VAT that are not paid by the producers and sellers of counterfeits.

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The report was launched on March 10, using data from exclusively official sources. OHIM's own [IP Perception Study](#), released in 2014, links in with the chosen methodology, as does the first report from OHIM and the EPO, the [IP Contribution Study](#).

This report is the first in a series of reports which will be released over the coming months, assessing the impact of counterfeiting in the EU economy. A dozen separate sectors will be analysed, which are known or thought to be the subject of counterfeiting - sectors like clothing, footwear and accessories; medicines; tobacco; luggage and handbags; alcoholic beverages, as well as the sectors of games and toys, computers and automotive parts, watches and jewellery. The cosmetics and personal care sector is the first of such studies and quantifies the scope, scale and impact of IPR infringement in the sector.

Taken together, these studies are complementary and provide a complete and objective picture of the negative impact of counterfeiting and its consequences for legitimate businesses, governments, consumers, and ultimately society as a whole.

These studies focus on key results such as lost sales, revenue and employment, as well as on knock-on effects on other industries and on government revenue.

In parallel, the Observatory has embarked on two different joint studies. One with the [Organization for Economic Cooperation and Development \(OECD\)](#) aims to estimate the value of counterfeit goods in international trade and the second one with the support of the [Joint Research Centre of the European Commission](#) is intended to study infringements in the music, film and e-book industries

Full details on this first study can be found [here](#).

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## The James Nurton Interview



### Gabrielle Olsson Skalin, General Counsel, Inter IKEA Holding Services S.A., Waterloo, Belgium

#### What is your background?

After graduation I worked as a clerk for a court for two years. I quickly found out I was not interested in that as most cases are criminal cases, bankruptcies and the like so not very positive things!

I soon decided I would like to work for a company and IKEA were looking for a lawyer so I started there. I didn't start in trade marks but the company I now work for is the franchisor and the owner of the trade



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marks, so we look after everything in IP including the trade marks and the rest of the IKEA concept that we franchise. That is the core of our activities. So it is natural that over time I have become more involved in trade marks, though I also deal with franchise agreements, licensing and other kinds of law.

#### How big is your team?

We are four people plus me working in IP, and we have two people working on franchising and licensing contractual issues. We are all centralised in Waterloo in Belgium, which is very convenient for the EU and for OHIM's Brussels office. There is always a lot going on in Brussels! Personally I have been here in Belgium for 20 years.

#### What do you like about working for a big company like IKEA?

The most interesting thing working for a global brand is that so much happens all the time. I have been fortunate to work for a business that has been expanding since I started, and the business has been very sound in general. When I come in each morning, I have a list of things to do and almost never is everything done. There's always something else happening and it's very diverse work.

#### What kind of work do you do?

I'm not personally directly involved in trade mark filing but more on the bigger cases and the franchising/licensing side. For example I am overseeing a big trade dress case in China where a company has copied almost everything from an

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## The James Nurton Interview



IKEA store and the consumer wouldn't be able to tell the difference.

Our growth is not so much in Europe now but more in the United States and Asia. My team is responsible for all the IP rights worldwide. We cover most countries worldwide, as we have to prepare in case we want to enter a market in the future – even in 10 years' time. We have a good IP portfolio I would say.

Apart from trade marks, domain names are important for us. We do protect designs, but not too much as the IKEA idea is to have low-price furniture and we are not afraid of competition. But we do also file design and even patents if it strengthens our business idea. The Community design is very interesting as it is a low price and you can cover a range of products with a single application. That may be relevant for some of our products, but others cannot be protected by design or copyright.

In terms of trade marks, we focus very hard on the IKEA brand – that is what we really protect and litigate over to make sure we have good protection. That is by far our main focus. We also protect other brands such as product names but the IKEA brand is the most important. We have protected both colours and shapes. We had for example a loading ledge that you use instead of a pallet, which we protected as a trade mark.

### Has the brand remained consistent over the years?

Our trade mark manual shows that the logo has been exactly the same since 1983, with the blue and yellow colours. Before that it was basically the same, but also with different colours. If you go back to the 1950s, the logo was a bit different. But the trade mark has been consistent for the past 30 years, and the philosophy of the company has also been the same since before I started.

In a lot of markets we are declared as a well-known trade mark, which always helps. On the other hand, we may be more of a target: we see a lot of companies that try to take a free ride on the IKEA name and reputation. For example, companies not directly related to us but working in transport might register [ikeatransport.com](http://ikeatransport.com) and then use the blue and yellow IKEA Logo on their website without authorisation. We also see a lot of fraud where there are gift cards, or a draw or a sweepstake, where people believe they are participating in a competition. They get upset with IKEA because they think we are behind it, but it is fraudulent. Another problem is resellers, who register something with IKEA in the domain name, and use our logo or colours, and they might sell genuine IKEA products as well as other products. The internet helps all these activities: it's easy for a small company anywhere in the world to reach out to the entire world.

We try to monitor and go after these problems where we see them. We have to prioritise and see what is damaging for us. If it's something that is not

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commercial, we might not spend a lot of energy on it but if it is a commercial site we want to stop them if possible. There is so much out there it's impossible to go after everything.

### What about the new gTLDs?

I'm still curious to see how they will work, and whether consumer behaviour will change. We have registered in some of those that we think are relevant, like .furniture. We have about 60 or 70 registrations but we don't know how much they will be used at the moment. We have also registered in the Trademark Clearinghouse, which is relatively easy for us as we have one main brand, unlike say consumer goods companies that have many different brands.

### What do you think of the Community systems?

We have registrations in all 28 countries so the CTM is the natural way to go when we want to register something. It's a cost-efficient way to secure the right in the EU.

Of course there is always room for improvement. What we see, and I know OHIM recognises this, is the need to harmonise decisions, so the decision does not depend on the examiner you get, and also at the Board of Appeal. I know OHIM is working on this with the new Guidelines and the Grand Board to make the decisions more consistent.

And of course the CTM system legislative package is very much needed to update the legislation and make sure it is more harmonised between the national offices and OHIM. We have discussed this a lot, and on behalf of INTA I have met with different MEPs and members of the Commission. There are some things we are happy with, and some things less so. I certainly think it's a step in the right direction and I hope it will be passed in the near future. But with the Trilogue system is not always that easy to get agreement.

### What is your involvement with INTA?

I just left the Board of Directors in December after five years and last year I was vice-president. I'm still on various committees and I represent INTA at the ABBC meetings of OHIM.

IKEA has been a member of INTA for a long time, back when it was called USTA. I went to the Annual Meeting and got to meet people, and participate on a volunteer basis. I found it very valuable to get to know people in the organisation. As an in-house counsel it has been very valuable to meet other in-house counsel. We work with trade mark attorneys on a daily basis but you can share different ideas with other in-house counsel, not just legal but also practical. For example, I have discussed gTLDs with many other in-house counsel, including those on the Board who went to Icann meetings on a regular basis.

I'm going to the next INTA Annual Meeting in San Diego in May. I always look forward to these

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meetings and to seeing friends that I have made. Although I personally focus on INTA, we have other people at the company who are involved with other associations such as MARQUES.

### What do you think the future holds for trade marks?

The internet and online will continue to be a big challenge, which will only increase. It will be interesting to see what happens with the new gTLDs.

I was recently at a conference in New York on 3D printing, which is also really interesting. If it happens as some people predict, then I can see all sorts of challenges to trade mark and copyright owners. I was astonished at both the quality of the technique, which is rapidly improving, and the cost to buy printers, which is decreasing. Now it's easier for almost anyone to buy printers and the materials that can be used for printing and their combination are increasing too.

There are also opportunities for IP owners. It might require you to change your business model: for example, you might license rather than sell. A lot of people still want to have the real thing and if you give a licence so people can print the real thing at home that might be one possibility. So they need to know they are getting it from the right source, and it is good quality. That is especially true with spare parts. Of course, this is all speculation! There are certainly a lot of things to consider.

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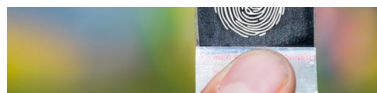
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## Community Trade Mark



### Analysis of Third Party Observations (Article 40 CTMR) - 2014

The general public can intervene in the registration procedure of a Community Trade Mark application ('CTMA') if they consider that it should be refused under any of the absolute grounds for refusal of Article 7 CTMR. In particular, they can file the so-called third party observations (TPOs) before OHIM where they explain why the CTMA should be refused and under which specific absolute ground. The legal basis for TPOs lies in Article 40 CTMR and the Communication of the President No 02/09 of 9 November 2009.

After receiving a TPO, OHIM analyses whether the observations raise serious doubts about the registrability of the CTMA to the effect that, if the CTMA has been published, the examination of the application should be reopened or if it has not been published, an objection is raised. It should be noted however that third parties do not become a party to the proceedings before OHIM and they are not informed of any action taken by OHIM.

The purpose of this article is to provide an analysis of the trends of TPOs filed during 2014 and compare them with previous years.

#### 1. TPOs filed

The following table shows the CTMAs per type filed during the period 2009-2014 and the number of TPOs received. The number of CTMAs has been increasing over time whereas the number of CTMAs which have been the object of a TPO has been rather stable since 2012. They represent 0.19%-0.2% of the total number of CTMAs filed.

It should be noted that 95 out of the 230 TPOs filed in 2014 involve a geographic term. This represents 41% of the total TPOs filed in 2014, 3% less than the previous year.

**Table 1. Comparison CTMA/TPO**

	Total CTMAs	TPOs filed	%
<b>2009</b>	88,289	117	0.13%
<b>2010</b>	98,349	186	0.19%
<b>2011</b>	105,914	249	0.24%
<b>2012</b>	107,962	201	0.19%
<b>2013</b>	114,413	232	0.20%
<b>2014</b>	117,456	230	0.20%

Source: OHIM, TPO database

<sup>1</sup>TPOs filed which claimed refusal on the basis of Article 7(1)(g), Article 7(1)(j) and/or Article 7(1)(k).

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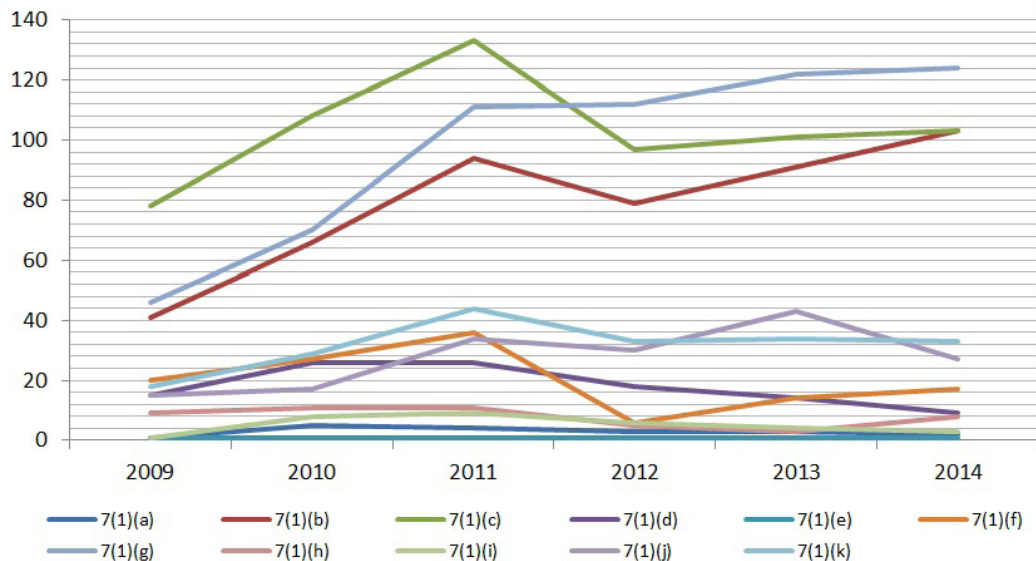


### 2. TPOs filed per Absolute Ground

As it can be seen from Chart 1 below, most of the TPOs filed from 2009 through 2011 were based on descriptiveness (absolute ground for refusal of Article 7(1)(c) CTMR). However, from 2012 onwards, TPOs were principally based on deceptiveness (Article 7(1)(g) CTMR) followed by descriptiveness and lack of distinctiveness (Article 7(1)(b) CTMR). This tendency remained in 2014.

On the other hand, TPOs filed on grounds related to graphical representation (Article 7(1)(a) CTMR), customary signs (Article 7(1)(d) CTMR) and protection of geographical terms, in particular affecting wines and spirits (Article 7(1)(j) and (k) CTMR) show a decrease in 2014 compared to 2013.

**Chart 1. TPOs per Absolute Ground 2009-2014**



Source: OHIM, TPOs database

(\*) One TPO may be based on more than one absolute ground.

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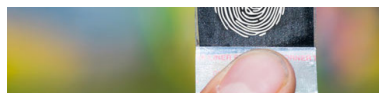
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As in previous years, the protection of flags and other symbols (Article 7(1)(h) and (i) CTMR) and issues related to shapes (Article 7(1)(e) CTMR) are amongst the absolute grounds for refusal that normally have the lowest number of TPOs filed.

The table shows the number of TPOs that the OHIM received from 2009 to 2014 per Absolute Ground.

**Table 2. TPOs filed by absolute ground**

	2009	2010	2011	2012	2013	2014
7(1)(a)	1	5	4	3	3	2
7(1)(b)	41	66	94	79	91	103
7(1)(c)	78	108	133	97	101	103
7(1)(d)	15	26	26	18	14	9
7(1)(e)	1	1	1	1	1	1
7(1)(f)	20	27	36	6	14	17
7(1)(g)	46	70	111	112	122	124
7(1)(h)	9	11	11	5	3	8
7(1)(i)	1	8	9	6	4	3
7(1)(j)	15	17	34	30	43	27
7(1)(k)	18	29	44	33	34	33

Source: OHIM, TPOs database

(\*) One TPO may be based on more than one absolute ground.

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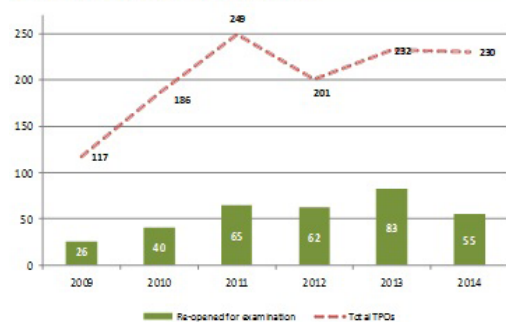
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### 3. TPOs that re-opened the examination

As shown in Chart 2, in 2014 the past years increasing tendency in the number of reopened examinations has changed. Whereas in 2013 more than 1/3 of the CTMA subject to TPOs have been re-examined, in 2014 less than ¼ have been re-opened.

Chart 2. TPOs that re-opened the examination 2009 - 2014



Source: OHIM, TPO database

### 4. Conclusion

The number of TPOs received by OHIM is relatively small compared to the number of CTMAs filed. This tendency, which continues over time, is one of the indicators that OHIM's examination of the applications is quite efficient and well perceived by the public.

On the other hand, having regard to the percentage of TPOs which trigger a re-examination of the trade mark, there is no doubt that TPOs prove to be a useful tool for OHIM to capture any inconsistency in its practice and correct it at an early stage.

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This article summarises three General Court judgments on related subject matters which had the same outcome. The judgments deal with appeals against the Third Board of Appeal decisions at OHIM. They were decisions R 291/2012-3, R 293/2012-3 and R 688/2012-3, for invalidity proceedings ICD 8325 for registered Community design No 001618703-0001, invalidity proceedings ICD 8322 for registered Community design No 001137152-0001, invalidity proceedings ICD 8324 for registered Community design No 001137152-0002 respectively (the RCDs).

The RCDs, registered and published in 2009 for a heat exchanger and two heat exchanger inserts (see the RCDs below), were challenged in invalidity proceedings filed 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 requirements of visibility pursuant to Articles 4(1) and (2) CDR, novelty and individual character requirements of Articles 5 and 6 CDR and for exclusion from protection pursuant to Articles 8(1) and (2) CDR. All three invalidity applications were upheld on the basis of Articles 4(1) and (2). The appropriate CDR provisions state that 'a Community design applied to or incorporated in a product which constitutes a component part of a complex product is only to be considered to be new and to have individual character if the component part, once it has been incorporated into the complex product, remains visible during normal use of the product and to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character'. The notion of 'normal use' is defined in Article 4(3) CDR as 'use by the end user, excluding maintenance, servicing or repair work'. The Invalidity Division found, based on the evidence submitted by the invalidity applicant on how the heat exchanger is used (see the final images below), that the RCDs were not eligible for protection because the heat exchanger and the heat exchanger inserts are necessary component parts of a boiler – a complex product and because the inserts are placed in the heat exchanger and the heat exchanger itself is entirely placed in the boiler box and therefore invisible during normal use.

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The RCD's holder appealed, claiming that the heat exchanger and heat exchanger inserts do not necessarily have to be component parts of a boiler but also of industrial installations and therefore visible, for which the holder submitted the evidence. The RCDs holder also contested that the assessment has to be done at the point of purchase/sale of the items, not at the stage when the units are in operation.

The Third Board of Appeal upheld the contested decisions. The Board of Appeal defined the normal use of the heat exchanger and heat exchanger units as that of the end product which includes a boiler for domestic use, and it defined the end user as the person buying a boiler for installation, thus excluding professionals in building or maintenance companies who install boilers in homes.

In particular the Third Board of Appeal stated that the documents submitted by the parties could lead to the conclusion that the products at issue were intended for purely domestic use, that they formed part of a boiler which, for reasons of safety and thermal and acoustic insulation, was constructed as a closed system, covered on all sides by metallic plates, so that during the normal use of the boiler, the heat exchanger and the inserts would remain invisible and for the purpose of application the requirements of Article 4(2) CDR it is irrelevant that the heat exchanger and heat exchanger inserts can be sold separately.

The applicant appealed to the General Court, claiming that the Court should annul the Board's decision and reject the invalidity application because the Board of Appeal erred in ruling that the appearance of a heat exchanger and heat exchanger inserts could not be separated from boiler performance (i.e. they were designed according to their expected performance) and relying solely on evidence submitted by the other party to the proceedings, ruled that the heat exchanger and the inserts were necessarily incorporated into a boiler. The Board of Appeal had incorrectly assessed the evidence. To support its arguments, the applicant put forward, inter alia, OHIM first instance decision file No ICD 8335 issued shortly before the three contested decisions, which dealt with another design of heat exchanger of the RCD holder. In this decision the Invalidity Division concluded, that a heat exchanger was not the exclusive component of a boiler and could be used for various different applications, such as industrial installations, in the chemical or pharmaceutical industries, oil temperature cooling, liquid and gas cooling or domestic installations, floor heating and waste water heat recovery. According to the applicant, the Invalidity Division took the view that it had not been sufficiently and undoubtedly proven that the heat exchanger necessarily constituted an invisible part of a boiler during normal use, and that the end user was in a position to have a clear view of all the elements of the contested design while the heat exchanger was functioning without the necessity of opening a cover door or disassembling it.

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The General Court dismissed the applicant's plea entirely and confirmed the appealed decisions. In essence, it found that:

- The applicant did not challenge the findings of the Board of Appeal as regards the definition of the end user, the definition of the normal use of a household boiler, the definition of a heat exchanger and a heat exchanger insert, the general appearance of a boiler and the fact that it is irrelevant that a heat exchanger or a heat exchanger insert can be sold separately in order to satisfy the requirement of visibility provided for in Article 4(2) of Regulation No 6/2002, and because the Third Board of Appeal did not err in these findings, the Court confirmed them.
- The question raised is not whether the appearance of a heat exchanger or its insert may be separated from their performance, an issue falling within the scope of Article 8 of Regulation No 6/2002, which deals with designs dictated by their technical function and designs of interconnections, but whether the heat exchanger and the inserts at issue constitute visible parts of a complex product — in the present case, a boiler — in accordance with Article 4(2) of that regulation.
- The Board of Appeal did not err when it concluded affirmatively in response to both the questions relying on the evidence put forward by the invalidity applicant and not having any specific evidence to contradict these findings.
- As regards the first instance decision concluding the opposite,

[...]according to Community trade mark case-law, applicable mutatis mutandis to Community designs, OHIM is under a duty to exercise its powers in accordance with the general principles of EU law. While, in the light of the principles of equal treatment and sound administration, OHIM must take into account the decisions already taken in respect of similar applications and must consider with special care whether it should decide in the same way or not, the way in which those principles are applied must, however, be consistent with respect for the principle of legality. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any design application must be stringent and comprehensive, in order to prevent designs from being improperly registered. Such an examination must therefore be undertaken in each individual case. The registration or the retention of a design as a Community design depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the design at issue is caught by a ground for refusal or a ground for invalidity

(judgment of 1203/2014 in Tubes Radiatoriv OHIM — Antrax It (Radiateur), T 315/12, EU:T:2014:115, paragraph 74 and the case-law cited).

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- None of the evidence — particularly the assessment in Decision ICD 8335 invoked by the applicant — leads to the conclusion that the Board of Appeal erred in its findings in the contested decisions.

The Court delivered decisions on the merits even though the term of the RCDs protection had expired in the course of the proceedings.

To see the CJEU judgments click [T-615/13](#), [T-616/13](#) and [T-617/13](#)

**Contested RCD 001618703-0001**



1.1



1.2



1.3

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1.4



1.6



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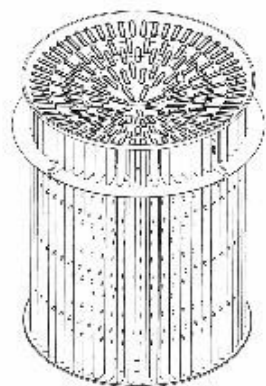
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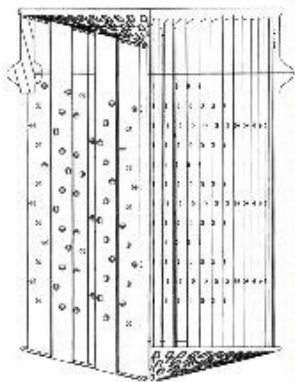


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Contested RCD 001137152-0001



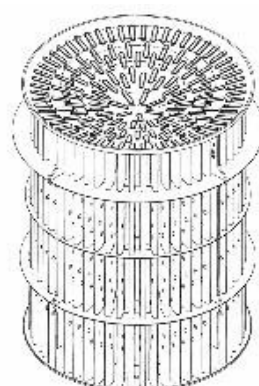
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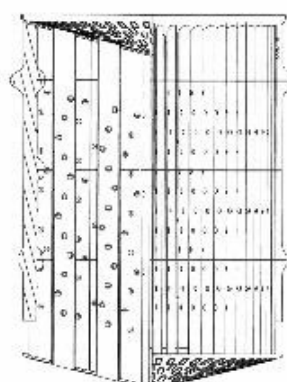
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Contested RCD 001137152-0002



2.1



2.2

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The heat exchanger in use:



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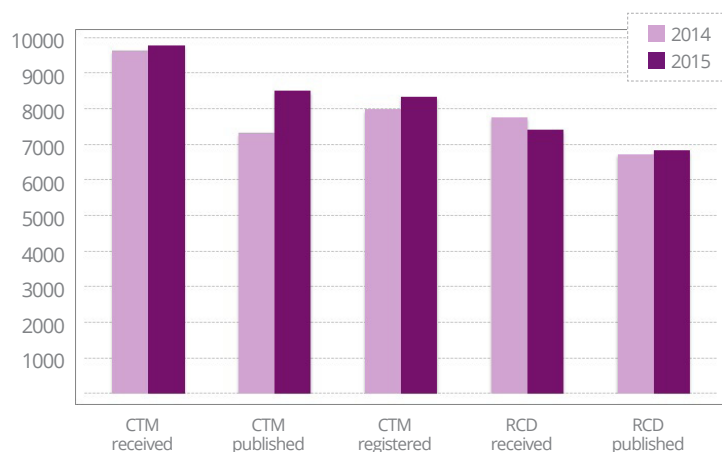


## Statistical Highlights



Monthly statistical highlights February*	2014	2015
Community Trade Mark applications received	9 625	9 760
Community Trade Mark applications published	7 311	8 497
Community Trade Marks registered (certificates issued)	7 970	8 327
Registered Community Designs received	7 759	7 406
Registered Community Designs published	6 722	6 824

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



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## Sweden implements e-filing

The Swedish Patent and Registration office (PRV) has implemented e-filing for trade marks from the Cooperation Fund.

The e-filing system helps to streamline the submission of electronic trade mark applications at the PRV, which has a long history of trade mark e-filing. It was developed under the framework of the Cooperation Fund, and was implemented due to collaboration between experts from the Swedish Office and OHIM.

More information on the implementation can be found [on the PRV website](#) (in Swedish).

## The Republic of Turkey joins Designview

As of 16 March 2015, the Turkish Patent Office (TPI) has made its design data available to the Designview search tool.

The incorporation of TPI is due to the efforts of the International Cooperation programme managed by OHIM in collaboration with its international partners.

With TPI on-board, there are now 28 participating offices in Designview. With the addition of 450,000

designs provided by TPI, Designview now provides information and access to around 4.1 million designs in total.

Since the introduction of Designview on 19 November 2012, the tool has served more than 920,000 searches from 139 different countries, with users from Spain, Germany and the UK among the most frequent visitors.

## Philippines joins TMview

As of 23 March 2015, the Intellectual Property Office of the Philippines (IPOPIL) has made its trade mark data available to the TMview search tool.

IPOPIL first joined ASEAN TMview which was developed by the Intellectual Property Offices of the ASEAN Member States with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III Phase II) administered by OHIM.

IPOPIL's decision to join TMview is a result of the International Cooperation programme managed by OHIM in collaboration with its partners worldwide. This latest extension brings the total number of offices participating in TMview to 38 and with the addition of about 325,000 trade marks from the Philippines, TMview now provides information and access to almost 25.3 million trade marks in total.

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Since the introduction of TMview on 13 April 2010, the tool has served more than 12.1 million searches from 151 different countries, with users from Spain, Germany and Italy among the most frequent visitors.

You can find out more at [www.tmview.org](http://www.tmview.org)

## Croatia implements CESTO

The Croatian National Office has recently implemented the Common Examiner Support Tool (CESTO).

CESTO was developed under the framework of the Cooperation Fund to aid examiners with absolute grounds examination.

This is the fifth tool to be implemented by the Croatian Office.

From October last year Croatia has also joined the Deployed Project Managers Network within OHIM to facilitate the tool implementation process in the Office.

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### OHIM at INTA's 2015 annual meeting in San Diego

OHIM will again have a presence at the INTA 2015 annual meeting in San Diego, California. Supported by a delegation of experts, including National Office representatives from Finland, Latvia and Slovakia, OHIM will be exhibiting from its redesigned booth # 1528, in the San Diego Convention Centre.

From the booth, OHIM experts will be on hand to demonstrate its range of free, online, global databases and tools to visitors (in English and in Spanish), as well as answering questions related to the European Trade Mark and Design Network activity and services.

The Office has developed a programme of free, short informative workshops during the exhibition opening hours which will showcase the tools and databases on offer:

- **Search and Classification** will demonstrate TMview, Designview, TMclass, eSearch plus and the eSearch Case Law tools
- **IP Services** will show you all you need to know about OHIM's 5-step e-filing and automatic Fast Track procedure including our Quality and Similarity tools

- **IP Enforcement and Awareness** demonstrates the functionalities of the Enforcement Database as well as eLearning for SMEs and our Learning Portal

OHIM will also moderate two Table Topics which form part of INTA's educational programme:  
Monday May 4 13:15-15:15 TM66 Update on the CTM: Absolute and Relative Grounds for Refusal  
Tuesday May 5 13:15-15:15 TT60 Registered Community Designs

### OHIM Information Meeting

OHIM's regular INTA information meeting takes place on the afternoon of Sunday May 3 at 13:30.

This interactive session aims to reinforce OHIM's best practices and will outline the future challenges by explaining the Office's simplification and accessibility strategies, and demonstrating how OHIM is modernising its state of the art IP tools for users and pushing synergies to reach across the world.

The session takes place in Room 10 at the San Diego Convention Center. More details on OHIM's activities at INTA are available on the dedicated OHIM INTA [web page](#).

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### IP Mediation Open Day

OHIM's first ever IP Mediation Open Day will take place at its headquarters in Alicante on June 15, 2015.

The [programme](#) of the event is now available, and registration is available [here](#)

The event features activity sessions with experienced mediators and focuses on the practical uses of mediation in IP

### Update of the performance achieved by OHIM

OHIM has published the [final report on its services over 2014](#), in terms of timeliness, quality and accessibility.

Overall timeliness of operations is improving even though the number of filings is increasing. Accessibility also reached very high levels of effectiveness during the second quarter, and has been improving over the last part of the year.

The launch of CTM fast track in November also allowed us to publish faster, with a maximum publication time of 2 weeks over the last quarter, while the regular track also came down to 7 weeks, achieving the Excellence target at the end of the year.

Opposition admissibility timeliness keeps improving as a result of a decrease in opposition filing, and improved overall from 24 to 13 days in the fourth quarter, reaching the Excellence area. The quality of Opposition decisions has also been closely monitored and the revision of the co-signing process has proven to be effective. The steady improvement in this area resulted in a quality indicator surpassing 92% for first time in the last quarter of 2014.

The notification of Cancellation decisions also appears steady in maintaining the high speed achieved at the beginning of the year, dropping from 26 weeks at the end of 2013 to 11 to 12 weeks in 2014. Resolution speed was reached, while also climbing to a record level of quality above 95%.

RCD invalidities have started to be checked to ensure the quality of our decisions. First results are starting to be analysed and these activities are starting points to improvement for 2015.

As regards to International Registrations, the accumulation of files with limitations and suspensions appearing over the second part of the year resulted in the decrease of results. Those cases will be analysed accordingly to ensure the accuracy of the reported figures and the correct monitoring of activities.

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Regarding Appeals, the trend keeps improving. Appeals reception in the last quarter shows a negative trend. Corrective actions have been implemented to ensure the monitoring of possible unfulfilled cases.

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

### OHIM joins EU Agency “troika”

OHIM has taken up its role in the “troika” of the coordination network of EU agencies, at a ceremony in Dublin.

The troika includes [Eurofound](#), which currently coordinates the network, and the outgoing coordination agency, the [Fundamental Rights Agency](#).

OHIM will serve as chair of the network in 2016. Over 40 agencies work across a variety of issues which affect EU citizens on a daily basis, including education, food safety, industry, working conditions, health and safety, justice, transport, business and innovation.

The EU Agency Network was established to improve coordination, information exchange and agreement of common positions on issues of shared interest across EU agencies, further improving their efficient and effective functioning.

### 2014 Case-Law Overview: From the General Court and European Court of Justice

The Legal Practice Service of OHIM has prepared an [overview of the Case-Law](#) from the General Court (GC) and European Court of Justice (CJ) in Luxembourg with regard to trade mark and design matters. This useful legal resource is published for information purposes, and includes abstracts of judgments, preliminary rulings and important orders rendered by the GC and the CJ in 2014.

The information is arranged in categories for easier browsing.

Users can find more detailed information in the [eSearch Case Law](#), OHIM's search tool for decisions of the Office, GC and CJ judgments and from the national courts.

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

**Case T-570/10 RENV; Environmental Manufacturing LLP v OHIM + Société Elmar, Judgment of 5 February 2015; Language of the case: EN**

**RESULT:** Action upheld (Board of Appeal Decision annulled)

**KEYWORDS:** Detriment to earlier mark, Dilution of distinctiveness, Figurative trademark, Reputation, Unfair advantage, First time on appeal, New evidence, Admissibility

**FACTS:** The Opposition Division (OD) had dismissed the opposition based on Article 8 (1) (b) and Article 8 (5) CTMR as no likelihood of confusion and the opponent had not adduced evidence of risk of dilution or free riding. The Board of Appeal (BoA) annulled the OD's decision, upholding the opposition based on Article 8 (5) CTMR. The BoA took the view that the use of the mark applied for would cause both a risk of dilution to the earlier marks and risk of free-riding, considering the high reputation of the earlier marks, the similarity of the marks and the similarity/identity of goods.

In its first judgment, the General Court (GC) dismissed the action, concluding that the BoA's reasoning was correct. The GC rejected the applicant's argument that 'the proprietor of the earlier mark [must] show an additional effect, caused by the introduction of the later mark, on the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered' (see Judgment of 27 November 2008, Case C-252/07, Intel, Rec. I-8823). Furthermore, the GC did not consider necessary to give a ruling on the risk of free-riding since it took the view that the BoA had correctly applied Article 8 (5) CTMR as far as the risk of dilution was concerned (GC, Judgment of 22 May 2012, Case T-570/10, Environmental Manufacturing v OHIM — Wolf (Representation of a wolf's head), paras 25-68). On appeal, the European Court of Justice (CJ) interpreted the aforementioned "Intel" judgment and further elaborated on the concept of "change in the economic behaviour of the average consumer". It found that the GC erred in law by failing to criticise the BoA's failure to conduct an analysis of the effects of the use of the mark applied for on the economic behaviour of the average consumer of the goods covered by the earlier marks (CJ, Judgment of 14 November 2013, Case C-383/12, Environmental Manufacturing v OHIM — Wolf (Representation of a wolf's head), paras 34-47). The CJ thus annulled the GC judgment and the case was remitted to the GC.

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### CTMA



### Earlier marks



**SUBSTANCE:** The GC, firstly, upheld the CTM applicant's complaint alleging infringement of Article 8 (5) CTMR in so far as the BoA incorrectly found that there was a risk of dilution (Para. 41). The GC noted that the opponent did not establish the existence of evidence of a "change in the economic behaviour of the average consumer" of the goods/services for which the earlier mark was registered, or a serious likelihood that such a change will occur in the future (Paras. 38-40). Secondly, since the CTM applicant's complaint challenging the risk of dilution was upheld, the GC verified whether the BoA was justified in finding that there was a risk of free-riding (Paras. 42-66). It upheld also this CTM applicant's

complaint in so far as the BoA incorrectly found that there was a risk of free-riding (Para. 65). The BoA correctly found that the relevant public might establish a link between the opposing signs (Para. 54). However, the BoA erred in relying only on the long-standing reputation and highly distinctive character of the earlier mark (Para. 56). In the absence of "an exceptionally high reputation from which it might be presumed (...) that the probability of a risk of free-riding was so obvious that it was no longer necessary to verify whether the image of the earlier marks or the characteristics projected by those marks could be transferred to the goods covered by the mark applied for", the BoA was bound to examine whether the image conveyed by the earlier marks could be transferred to the goods covered by the mark applied for and, therefore, their power of attraction could be useful for the CTM applicant for the marketing of those goods (Paras. 57-58). Since the opponent did not submit any proof and argument both in respect of the "image" with which the earlier marks are associated and of the transfer of this image, the BoA could not conclude that use of the mark applied for would cause a risk of free-riding (Para. 59). The Office's arguments submitted before the GC in order to complement the BoA's reasoning were considered new and therefore inadmissible (Para. 64).

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**Case T-377/12; Spa Monopole, compagnie fermière de Spa SA/NV & Olivar Del Desierto, SL v OHIM, Judgment of 27 February 2015; Language of the case: FR**

**RESULT:** Action upheld (Board of Appeal Decision annulled)

**KEYWORDS:** Relative grounds, Reputation, Conceptual similarity, Distinctiveness of the earlier mark, Dominant element, Identical goods and services

**FACTS:** The intervener sought to register the figurative sign OLEOSPA represented below as CTM for Classes 3, 35 and 39. An opposition based on two Benelux marks SPA, covering goods in Classes 3 and 32 was filed on the grounds of Articles 8 (1) (b) and 8 (5) for the second mark. The Opposition Division (OD) upheld the opposition on the basis of Article 8 (1) (b) CTMR, finding that there was a likelihood of confusion between the marks for all goods and services challenged.

The Board of Appeal (BoA) annulled the OD decision and considered that the signs were similar to a low degree and that the common element SPA was weak for products in Class 3, and on the Article 8 (5) grounds it held that although the reputation of the mark was established for products in Class 32, the conditions of Article 8 (5) were not met.

### CTMA



### Earlier marks

SPA

**SUBSTANCE:** The GC took note that the applicant did not challenge the decision of the BoA on the relevant public which is the Benelux public and that its level of attention is average (Para. 24). The conclusion that the cosmetic products are identical was also confirmed (Para. 25). On the visual similarity, the GC confirmed the BoA's assessment that the contested mark presents visual differences with the earlier mark. Although the signs share the term SPA which is visually highlighted in the contested sign the BoA is correct when it held that the signs are visually similar to a low degree (Para. 30). On the phonetic comparison the GC approved the assessment that the signs are phonetically similar to a low degree (Para. 31). On the conceptual similarity, the BoA was correct to hold that the term SPA for cosmetic products evokes the places devoted to hydrotherapy and relaxation. The term oleo was correctly assessed as referring to oil because of its Latin origin (Para. 33). However the BoA contradicted

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itself when it held that although the signs refer to a centre where balneotherapy and relaxation services are provided it concluded that there was a weak conceptual similarity. The conceptual similarity is strong (Para 35). On the overall assessment, the GC held that the BoA erred in the evaluation of the distinctiveness of the earlier mark; the BoA's conclusion on this Para was based in the wrong assessment that as the term SPA evokes a centre for relaxing and beauty care the term was weak for cosmetic products (Para 41). The GC referred to its Case-Law which establishes that the distinctiveness of a sign must be determined in relation with the goods and services. A term may be descriptive for certain goods and services and distinctive for others (Para 41). On this Para the GC quoted its previous Case-Law on the mark SPA (Judgment SPA Therapy of 25 march 2009 T-109/07, Rec, EU:T:2009:81 Paras 24 and 28, Judgment of 25 march 2009, SPALINE (T 21/07, EU:T:2009:80, Para 31) where the term was considered distinctive for cosmetic products (Para 42). Because it has a normal distinctive character the term SPA will play a distinctive autonomous role within the contested sign (Para 44). In conclusion, as the goods are identical, the earlier signs enjoy a normal distinctiveness and taking into account the autonomous position of the terms SPA in the earlier sign, there is a risk of confusion (Para. 45), the BoA erred in concluding that there was no risk of confusion (Para. 46). As the opposition succeeds on the Article 8 (1) (b) ground there is no need to decide on Article 8 (5) (Para. 48).

**Cases T-617/13 and T/616-13 Aic S.A. v OHIM, Judgment of 20 January 2015, Language of the case: EN**

**RESULT:** Actions dismissed

**KEYWORDS:** Design, General principles of law, Locarno Classification, Novelty, Individual Character.

**FACTS:** The applicant Aic. S.A. is the proprietor of an RCD filed on 13 May 2009 (hereinafter the contested design). The goods to which the contested design is intended to be applied are in Class 23.03 of the Locarno Agreement and correspond to the following description: 'Heat exchangers inserts'. On 7 February 2001, ACV Manufacturing (invalidity applicant) filed an application with the Office for a declaration of invalidity of the contested design based on Article 25 (1) b) on the ground that it did not meet the requirements of Article 4 (1) and (2) of the CDR read in conjunction with Articles 5 and 6 and also Articles 8 (1) and (2) of the said Regulation. The Invalidity Division (ID), by decision of 13 September 2011 declared the design invalid pursuant to Article 25 (1) with Article 4 (2) of the CDR. On February 8, 2012 the applicant filed an appeal under articles 55 to 60 of the CDR against the ID decision which the Third Board of Appeal (BoA) dismissed. The BoA found that the heat exchanger insert to which the contested design was applied, was presented as a part of a complex product, namely a heat exchanger, which was in itself incorporated into an

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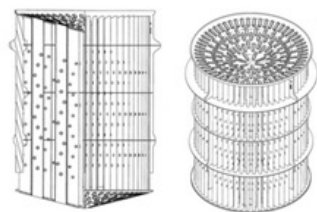
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even more complex product, in the present case, a household boiler. It also noted that no part of the heat exchanger insert remained visible after its installation in a boiler. In this regard, since the heat exchanger insert would be incorporated into a complex product it lacked both novelty and individual character since it was not visible during normal use of the complex product at issue for the purposes of Article 4 (2) CDR.

### RCD



**SUBSTANCE:** The applicant relied on a single plea in law alleging infringement of Article 25 (1) b read in conjunction with Article 4 (2) of the CDR (Para. 9). The main arguments put forward by the applicant were that the BoA did not take into account that the bottom of the heat exchanger has a characteristic conical shape which, as a result, requires the pipe bundles in the heat exchanger insert to have a special, specific shape (Para. 17). It was also claimed that the BoA incorrectly assessed the evidence

adduced by the parties and relied on presumptions that led to the finding that the contested design was applied to a part which necessarily formed part of the heat exchanger incorporated into a boiler intended for domestic use (Para. 18). The GC dismissed these arguments and confirmed the BoA's findings. In this light, firstly it is pointed out that the argument that the special, specific shape of the pipe bundles required in the heat exchanger insert as a result of the characteristic conical shape of the heat exchanger, should be rejected as unfounded. Since the heat exchanger was considered invalid on the basis of article 4 (2) CDR, the assessment should be if it constitutes a visible part of a complex product and therefore the shape of the heat exchanger cannot be of use when assessing the visibility of the insert once incorporated into a boiler, an issue that would fall within the scope of Article 8 CDR (designs dictated by their technical function) (Para. 21). Secondly, the GC refers to article 63 (1) CDR concerning the evidence taken into account by the BoA and indicates that it is for the parties to adduce evidence to support their claims and in this regard, the evidence adduced by the applicant did not relate to the heat exchanger inserts covered by the contested design. Therefore, the evidence provided by the applicant cannot be used to challenge the conclusions reached by the BoA (Para. 23). The GC concluded that the evidence produced before the BoA by the invalidity applicant made it possible to conclude that the contested design concerned a part intended to be incorporated into a complex

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product (Para. 24). Also, the GC notes that the applicant did not dispute that a heat exchanger insert is an internal part of a complex product, namely a heat exchanger (Para. 25) as well as did not provide any specific evidence to contradict any of the findings of the BoA (Para. 28). Nevertheless, the GC states that the Office is under a duty to exercise its powers in accordance with the general principles of EU law, namely of equal treatment and sound administration. Therefore, the examination of any design must be stringent and comprehensive in order to prevent designs from being improperly registered (Para. 32). However, in the present case none of the evidence provided by the applicant could reverse the BoA's decision, namely that it erred in finding that the heat exchanger was necessarily part of a complex product, namely a household boiler in which a heat exchanger is incorporated (Para. 33). Having the aforementioned into account, the GC rejected the plea in law and dismissed the action in its entirety (Para. 36).

**Case T-615/13; Aic S.A. v OHIM, Judgment of 20 January 2015, Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Design, General principles of law, Locarno Classification, Novelty, Individual Character.

**FACTS:** The applicant Aic. S.A. is the proprietor of an RCD filed on 2 October 2009 (hereinafter the contested design). The goods to which the contested design is intended to be applied are in Class 23.03 of the Locarno Agreement and correspond to the following description: 'Heat exchangers'. On 7 February 2001, ACV Manufacturing (invalidity applicant) filed an application with the Office for a declaration of invalidity of the contested design based on Article 25 (1) b) on the ground that it did not meet the requirements of Article 4 (1) and (2) of the CDR read in conjunction with Articles 5 and 6 and also Articles 8 (1) and (2) of the said Regulation. The Invalidity Division (ID), by decision of 15 December 2011 declared the design invalid pursuant to Article 25 (1) with Article 4 (2) of the CDR. On February 8th 2012 the applicant filed an appeal under Articles 55 to 60 of the CDR against the ID's decision which the Third Board of Appeal (BoA) dismissed. The BoA found that the heat exchanger was presented as part of a complex product and that no part of it remained visible after its installation in a boiler. In this regard, since the heat exchanger would be incorporated into a complex product it lacked both novelty and individual character since within the meaning of Article 4 of the CDR it was not visible during normal use of the complex product at issue for the purposes of Article 4 (2) CDR.

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### RCD



**SUBSTANCE:** The applicant relied on a single plea in law alleging infringement of Article 25 (1) (b) read in conjunction with Article 4 (2) of the CDR (Para. 9). The main arguments put forward by the applicant were that the BoA did not consider that the appearance of a heat exchanger could be separated from its performance and that it relied solely on the evidence provided by the other party to the proceedings, which showed that a heat exchanger was necessarily incorporated into a boiler (para 17). In this regard, it was claimed that the BoA did not provide an appropriate assessment of the prerequisite of visibility of the contested design during normal use. The General Court (GC)

dismissed these arguments and confirmed the BoA's findings. In this light, firstly it is pointed out that the question raised in the appealed decision is not whether the appearance of a heat exchanger may be separated from its performance, an issue dealing within the scope of Article 8 CDR, which deals with designs dictated by their technical function and designs of interconnections, but whether the heat exchanger at issue constitutes a visible part of a complex product according to Article 4 (2) CDR (para 21). Secondly, the GC refers to article 63 (1) CDR concerning the evidence taken into account by the BoA and indicates that it is for the parties to adduce evidence to support their claims and in this regard, the applicant's criticism that the BoA relied on the evidence brought by the other party cannot be accepted (para 23). The GC concluded that the evidence produced before the BoA by the invalidity applicant made it possible to conclude that the contested design concerned a part intended to be incorporated into a complex product (Para. 24). Also, the GC notes that the applicant did not provide any evidence to contradict any of the findings of the BoA (Para. 25). Nevertheless, the GC states that the Office is under a duty to exercise its powers in accordance with the general principles of EU law, namely of equal treatment and sound administration. Therefore, the examination of any design must be stringent and comprehensive in order to prevent designs from being improperly registered. (para 28). However, in the present case none of the evidence provided by the applicant

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could substantiate the assertion that the BoA erred in finding that the heat exchanger was necessarily part of a complex product, namely a boiler for domestic use rather than for industrial use (para 29). Also, the BoA did make an assessment with regard to the possibility of the heat exchanger being used in installations other than a boiler for domestic use. However, the applicant did not provide any further evidence concerning the use of the heat exchanger to which the contested design is applied (para 30). Having the aforementioned into account, the GC rejected the plea in law and dismissed the action in its entirety (para 32).

**Case T-76/13; Compagnie des montres Longines, Francillon SA, Staccata Srl, v. OHIM, Judgment of 12 February 2015, Language of the case: EN**

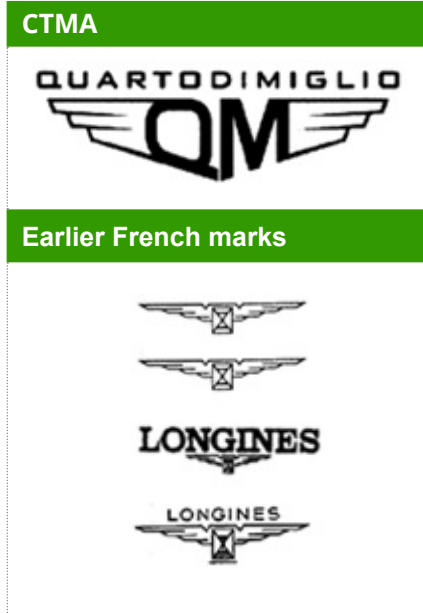
**RESULT:** Action dismissed.

**Keywords:** Relative grounds, Dissimilarity of signs, Conceptual similarity, Similarity of the goods and services, Reputation, Graphic representation, International registration, Figurative trademark, Dominant element, Survey

**FACTS:** The intervener sought to register the figurative sign represented below as a CTM for Classes 9, 14. An opposition based on several International figurative registrations for goods in Classes 9 and 14 was filed on the grounds of Articles

8 (1) (b) and 8 (5) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division (OD) rejected the opposition on both bases on the ground that there was no likelihood of confusion.

The Board of Appeal (BoA) confirmed the OD decision. It concluded that there was no likelihood of confusion between the signs even for identical goods.



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**SUBSTANCE:** On the relevant public and the level of attention, having regard to the broad descriptions of the categories of goods in Classes 9 and 14, which are referred to in the trade mark application and are identical to the goods on which the opposition is based and that those categories mostly include goods which may be purchased by anyone, that is to say even by consumers who are members of the general public, the General Court (GC) held that even as regards a number of categories of goods which are aimed, more specifically, at certain professionals or at a scientific public, it cannot, in principle, be ruled out that those categories include goods purchased by the general public. However, that general consideration cannot be applied to categories of goods such as ‘... surveying, ... signalling, checking (supervision), ... apparatus and instruments’, ‘apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity’ or ‘automatic vending machines and mechanisms for coin-operated apparatus; cash registers’ in, inter alia, Class 9. The goods in those categories are generally, if not exclusively, purchased by a public which consists of professionals or by scientists. In relation to goods purchased by those professionals and scientists, it must be held that the level of attention will be high, on account of the technical nature and the cost of those goods. As regards the other goods, which are purchased by consumers who are members of the general public, it has already been held that, if they are goods which are not purchased

regularly and are generally bought through a salesperson, the average consumer’s level of attention must be taken to be higher than usual, and therefore fairly high (see, to that effect, Judgment of 12 January 2006 in *Devinlec v OHIM — TIME ART (QUANTUM)*, T 147/03, ECR, EU:T:2006:10, (paragraph 63). The fact remains that that is not true of all the relevant goods in the present case, since certain horology goods, chronometric instruments, items of costume jewellery or calculating machines may be purchased without consumers even paying particular attention to them, in particular when they are ‘inexpensive’ goods. Consequently, the GC concluded that the BoA could not reasonably restrict the relevant public solely to the general public which generally has a level of attention that is ‘higher than usual and therefore fairly high’. On the visual comparison of signs, first, it cannot be held that the graphic element, consisting of extended wings, is dominant either in the mark applied for or in the earlier composite marks. In the former case, it is necessary to point out the particularly significant impact of the letters ‘q’ and ‘m’, which are situated in the middle of the mark applied for, and the fact that the word ‘quartodimiglio’ is situated at the top of that mark and has the same breadth as the mark. In the latter case, in both of the earlier composite marks, the word ‘longines’ is also situated at the top of the marks and is written in sufficiently broad and easily legible characters to be capable of being easily remembered by the relevant consumers. Although it is true that in the earlier international mark No

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298063, the element consisting of a 'winged hourglass' covers a larger part of that mark than the word 'longines', it must, however, be stated, first, that that word is still easily legible and memorisable and, secondly, that the enlarged graphic element enables consumers to perceive clearly the representation of an hourglass, which also facilitates the differentiation of that mark from the mark applied for (Para. 49). Secondly, the GC took the view that the BoA was right to carry out a meticulous comparison of the representations of the wings in the mark applied for and in the earlier marks and to find that there was a significant difference in the forms of stylisation of those wings (Para. 51). Thirdly, added to those differences is the presence of the word 'quartodimiglio' in the mark applied for, a word which, as the BoA rightly stated, is also perceived by consumers and distinguishes that mark even more both from the purely figurative earlier marks, which do not contain any word elements, and from the composite earlier marks, in which it is a different word, namely 'longines', which will be remembered by consumers (Para. 52). Therefore there is a very low degree of visual similarity between the marks at issue (Para. 54). In relation to the conceptual comparison, the GC concluded that it cannot be held that there is a high degree of conceptual similarity between the marks due to the fact that all the marks at issue contain representations of wings. Confirming the findings of the BoA, in particular in paragraph 26 of the contested decision, even though there is a certain

semantic analogy between the mark applied for and the earlier marks, it is only low in degree, since the stylisations of the wings refer to different types of birds. Moreover, the conceptual differences between the marks at issue are marked for the consumers who perceive and pay attention to the hourglass in the earlier marks and for Italian-speaking consumers, for whom the word 'quartodimiglio' in the mark applied for will have a meaning. The BoA erred in finding, in the contested decision, that the signs do not share a conceptual similarity (Para. 54). On the enhanced distinctiveness, the GC found that the applicant has not put forward any evidence or argument capable of substantiating the conclusion that the earlier marks have a high degree of inherent distinctiveness. In those circumstances, it is necessary to take into account a normal degree of inherent distinctiveness, inasmuch as it is not, moreover, apparent from the analysis of those marks that there are specific reasons for taking the view that the degree of inherent distinctiveness is low, for example as a result of the presence of elements which are descriptive of the goods at issue. Even though the BoA certainly found that the earlier composite mark containing the word 'longines', in addition to the graphic element, and corresponding to international registration No 610902, was highly distinctive because of the recognition of that mark on the market, the BoA, by contrast, also rightly found, in view of the evidence provided by the applicant, that the earlier marks that consisted solely of the representation of a

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'winged hourglass' did not have such a high degree of distinctiveness. The applicant cannot therefore invoke the enhanced distinctiveness of its earlier marks which do not include the word 'longines' (Para. 62). As regards the likelihood of confusion or association, the GC held, in the light of an overall assessment of the visual and phonetic differences between the marks under comparison, that the BoA was right to rule out, irrespective of a certain conceptual similarity, any likelihood of confusion or association, even where the goods are identical (Para. 76). Finally, on Article 8 (5), the BoA was right when it stated that the applicant did not provide specific evidence which makes it possible to establish that consumers were accustomed to focusing, in particular, on the 'winged hourglass' element in the earlier composite marks as used. The GC pointed out that that evidence does not contain any opinion polls of the relevant public relating, inter alia, to its perception of the composite marks used or the question of which elements were memorised or, at the very least, recognised by that public, when faced with various marks in the course of its shopping, as referring to the applicant's goods. In particular, the applicant has not, in addition, submitted opinion polls in which target persons who were shown only the figurative sign representing a 'winged hourglass' had to state whether they knew that sign and, if so, what they associated it with. The evidence which the applicant put forward before the Office regarding the use of the earlier marks consisting of a 'winged hourglass'

is not sufficient for it to be held that they have been proved to have a reputation or enhanced distinctiveness. Consistent items of evidence show the long-term use of a composite mark corresponding, in essence, to earlier international registration No 610902, not only in Switzerland, but also in certain Member States of the European Union which are relevant in the present case (Para. 100). The Board of Appeal did not err in finding that it had not been proved that the earlier marks that consisted solely of a 'winged hourglass', taken as registered, have a reputation. In spite of the continuous quantitatively and qualitatively significant use over a period of time of a composite mark consisting of the graphic element of a 'winged hourglass' and the word 'longines', corresponding, in essence, to international registration No 610902, it is the latter word which will attract the attention of consumers and will probably be retained by them, and it has not been shown that a substantial part of the relevant public, in one or more of the Member States of the European Union in respect of which a reputation has been claimed, is also aware of the earlier marks consisting solely of the graphic element of a 'winged hourglass' and associates them, without effort, with the applicant's horology and chronometric goods, which are the only goods to which the claim in respect of reputation relates (Para. 108). Although it has already been stated that the reputation of the earlier composite marks including the word 'longines' was regarded as proved, in principle, on the basis of evidence relating

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to the use of a graphic device corresponding to international registration No 610902, the BoA was also right in finding that Article 8 (5) CTMR was not applicable, on account of the significant differences between those marks and the mark applied for (Para. 122). The earlier composite mark at issue differs visually and conceptually from the mark applied for in such a significant manner that no link may be made between them, notwithstanding the reputation of that earlier mark and the identity of the goods at issue. The GC draws attention, in that regard, in particular, to the notable differences resulting both from the actual design of the wings at issue, short and thick in one case and thin and longer in the others, and from the presence of the word elements 'longines' and 'quartodimiglio'. The same conclusion applies in respect of international registration No 298063 inasmuch as it has also been accepted indirectly that it has a reputation (Para. 126).

**Case T-46/13; Sabores de Navarra, A.I.E. v OHIM, Judgment of 21 January 2015, Language of the case: ES**

**RESULT:** Action dismissed

**KEYWORDS:** Relative grounds, Proof of use, Relevant territory, Distinctive element, Dominant

element, Ornamentation, Use not as registered, Elements which alter distinctiveness, Place of use, Labels, Invoices, Figurative trademark, Geographical origin, Principle of legality, Characteristics of the goods and services

**FACTS:** The applicant filed an invalidity action against the CTM 'KIT, EL SABOR DE NAVARRA' (in English: The flavour of Navarra) registered for goods in Classes 29, 30 and 33. It was based on the earlier CTM registration as represented below for goods and services in Classes 29, 30, 33, 39 and 42. The CTM proprietor requested that the invalidity applicant filed proof of use of the earlier CTM. The Cancellation Division (CD) partially upheld the application for some of the contested goods. Both parties filed an appeal against this decision. The Board of Appeal dismissed the appeal filed by the invalidity applicant and upheld the one filed by the CTM proprietor on grounds that the evidence of use submitted show of use of signs that differ in essential aspect of the signs as registered and alter its distinctive character. Therefore, the evidence submitted does not demonstrate genuine use of the earlier CTM.

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### Earlier CTM



### Signs appearing as the Proof of Use

**SABORES DE NAVARRA**



### Sign as compared by by BoA



**SUBSTANCE:** With regard to the place of use the General Court (GC) found that submitting labels drafted in certain languages is in itself insufficient for showing genuine use. Other kind of evidence in support of real use such as invoices, that confirm sales are necessary (paragraph 28). The figurative sign as appearing on the evidence and the one compared in the contested decision only differ in ancillary and ornamental elements as well as on the colours and are insufficient to alter the distinctiveness of a trade mark. (Para.34). In order to evaluate whether the distinctive character of a mark has been altered, it is necessary to examine the distinctive and dominant character of the elements which have been omitted in view of their inherent characteristics and relative position among the different elements of the marks as registered (Para. 36). When a sign is composed of one or various non-distinctive elements, its modification or omission has not sufficient impact as to alter the distinctive character of the mark as a whole (Para. 36). The GC focused on the perception of the Spanish consumer because the proof of use essentially refers to this territory. The expression ‘Sabores de Navarra’ (Flavours of Navarra) will be seen by the Spanish public as an expression essentially descriptive because it informs about the geographical origin and characteristics of the goods in question. ‘Sabores’ is descriptive from the moment on which it designates a characteristic of these goods (Para. 39 and 44). “La sabiduría del sabor” (the wisdom of flavour) is not a descriptive expression, it uses a human quality, the

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wisdom (la sabiduría) to a feeling (sabor – flavour). Consequently, the distinctive character of the earlier is essentially located in this expression (Paras. 40 and 41) and its omission in the signs as used have a sufficient entity as to alter the distinctive character of the mark as registered (Para. 42). The applicant's arguments concerning the perception of the public not located in Spain are insufficient to declare the illegality of the contested decision because the proof of use does not reflect effective use outside Spain (Para. 45). Alteration of the mark as registered is present even under the assumption that the 'Sabores de Navarra' is the dominant element of the sign from the visual and phonetic perspective (Para. 46). Principles of equal treatment and sound administration shall be reconciled by the principle of legality (Para. 47).

**Case T-318/13, 12 February 2015, Vita Phone GmbH v. OHIM, Language of the Case – DE.**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Descriptive element, Complementary goods and services, Common element

**FACTS:** The applicant sought to register the word mark LIFEDATA as a CTM for goods and services in Classes 10 and 44. The examiner refused the

application on the ground that it was descriptive and lacked distinctive character according to Article 7 (1) (c) (b) CTMR. The Board of Appeal (BoA) rejected the appeal based on Article 7 (1) (b) CTMR. The General Court (GC) dismissed the action.

**CTMA**  
**LIFEDATA**

**SUBSTANCE:** The GC confirmed all the findings of the BoA decision, namely, that the relevant public consisted of professionals of the medical and related technical sector and of general end consumers. The assessment had to be carried out against the English-speaking public and professionals of other Member States with sufficient English command (Para. 19). The mark was composed of current English terms which referred to a) to the condition being alive and b) data and information, based on scientific work and used for analysis and calculation (Para. 21). In English, compound nouns were often used (Para. 23). The mark was just the sum of its parts (Para. 26). It was immaterial that 'Lifedata' could be understood as a reference to biographic data. In connection with goods and services of the medical sector it was likely that the public linked the sign with medical data. In any case, the descriptive content of one meaning was enough for the refusal (Para. 33). Registrations of USPTO were not

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relevant and the Office was not bound by previous decisions (Paras. 37-40). The goods in Class 10 had a common function, the capture and transmission of body values or biosignals. The use of such goods permitted the public to transmit and access data in spite of physical distance. The services in Cl. 44 were tele-medical services permitting the wireless capture of data of patients and its transmission. The services could only be rendered with the goods. Thus, the common function of the goods and the fact that the services could only be rendered with the goods in question justified that the goods and services constituted a sufficient homogenised group permitting the BoA to motivate the non-distinctiveness of the sign in relation to all the goods and services together (Para. 51).

**Case T-543/13; Three-N-Products & Munindra Holding v OHIM; Judgment of 5 March 20154, Language of the case: EN**

**RESULT:** Action dismissed (BoA Decision confirmed)

**Keywords:** Relative grounds, Parallel proceedings, Likelihood of confusion, Similarity of signs, Common element, Figurative element, Visual dissimilarity, Beginning of mark, Admissibility

**FACTS:** The intervener filed an application for the verbal signs shown below for products in Classes 5 and 30. An opposition based on the earlier marks



shown below and registered as CTM's for goods in Classes 5 and 30 was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division rejected the opposition, the applicant filed an appeal. The Board of Appeal (BoA) dismissed the appeal.

### CTMA

PRANAYUR

### Earlier marks (Benelux trademarks)



**SUBSTANCE:** On the earlier verbal mark, the General Court (GC) took note that the earlier word mark was cancelled by the Office and that that cancellation was confirmed by the GC in its judgment (AYUR, paragraph 11 (EU:T:2013:583) and, on appeal, by the

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European Court of Justice (CJ) in its order in Three-N-Products v OHIM, paragraph 11 (EU:C:2014:2078). Accordingly, the GC held that there is no longer any need to adjudicate on the plea in law concerning the risk of confusion with that mark.

On the earlier figurative sign



the GC confirmed the BoA's assessment that despite the existence of a common word element in the marks at issue, the presence of another word element which is at least equally important as that common element, the different lengths of the signs and the difference in the initial letters and the presence in the earlier figurative mark of additional figurative elements gives rise to an overall visual impression of the marks at issue which is different (Para 34). Phonetically, the GC held that the BoA was right to find a low degree of phonetic similarity between the marks at issue, because only the last syllable of the two signs is identical. The presence of an additional word element at the beginning of the sign applied for can only help to also differentiate the marks at issue phonetically (Para 35). On the conceptual similarity the GC referred to the cases in which the GC has already had occasion to point out that the relevant public will not easily make the connection between the element 'ayur' and the word 'ayurveda' designating a form of traditional Hindu medicine (Judgment in AYUURI NATURAL, paragraph 25 above, EU:T:2011:653, paragraph 47)

and that, although a conceptual comparison could be made by a part of the relevant public, made up of those most specialised in matters of alternative medicine, no conceptual comparison appears possible for the general public (see, to that effect, AYUURI NATURAL, EU:T:2011:653, paragraph 53) (Para. 36). The conclusion of the GC is that the two marks are fanciful terms not referring to any concept known by the most significant part of the relevant public. Therefore the BoA was correct to conclude that it was impossible to make a conceptual comparison (Para 37). On the overall assessment, the GC concluded that the signs are different visually, slightly similar phonetically and no conceptual comparison is possible between them. The elements of differentiation outweigh the common word element 'ayur' to such an extent that the overall impression of the two marks is different and therefore the signs are different. As one of the cumulative conditions required by the Case-Law is not satisfied, the GC held that without there being any need to rule on the distinctive character of the earlier mark, it must be concluded that, despite the partial identity of the goods at issue, there is no likelihood of confusion between the figurative mark Ayur and the mark applied for (Paras. 38 and 39). Finally on the other figurative signs the GC concluded that this second plea in law must be declared inadmissible under Article 44 (1) (c) of the Rules of Procedure of the GC, since the applicant does not present any legal analysis regarding the existence of a likelihood of confusion

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with those other marks. Accordingly it rejected the second plea in law and the action in its entirety as no infringement of Article 8 (1) (b) of Regulation No 207/2009 has been established.

**Case T-123/14; BSH Bosch und Siemens Hausgerate GmbH v OHIM, Judgment of 28 January 2015; Language of the case: EN**

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

**KEYWORDS:** Relative grounds, Likelihood of confusion, Similarity of the signs, Visual similarity, Phonetic similarity, Conceptual similarity, Similarity of the goods and services, Relevant public, Dominant element, Weak element, Weak trade mark, Laudatory mark, Beginning of mark

**FACTS:** The applicant sought to register the word mark 'AquaPerfect' as a CTM for a range of goods in Class 7, including pumps other than machine or motor parts, namely hydrophores, water pumps (electro pumps, motor pumps), pumps for heating installations; electric apparatus used in the kitchen for chopping, grinding, crushing, mixing and crumbling, namely mixers, blenders, kitchen robots, electric knives, meat-grinding machines, garbage disposal machines; dishwashers, washing machines and dryers in Class 7. An opposition was based on the earlier word mark 'waterPerfect', registered, among others, for electrical household and kitchen

machines and apparatus (included in Class 7), in particular electrical kitchen machines and apparatus including grinders/crushers, mixing and kneading devices, fruit pressing machines, de-juicers, juice centrifuges, grinding machines, cutting devices, electrically powered tools, in Class 7. The opposition was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition for all the contested goods. The Board of Appeal (BoA) annulled the decision of the OD. The BoA found that there was no likelihood of confusion because the earlier mark had a low distinctive character, the level of attention of the relevant public was higher than the average, the only common element between the signs was the laudatory element 'perfect', and the signs had only a low degree of visual and phonetic similarity. The applicant filed an action before the General Court (GC) arguing, an infringement of Article 8 (1) (b) CTMR.

### CTMA

**AquaPerfect**

### Earlier marks

**waterPerfect**

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**SUBSTANCE:** The General Court (GC) upheld the appeal. The GC firstly found that, although the BoA's finding that the relevant public had a higher level of attention was not disputed, there were also some daily consumer goods (household products) to be taken into account for which the consumers' level of attention was normal (paras. 21-23). The identity and similarity of the goods was not challenged and was confirmed. In relation to the similarity of the signs, the GC found that, visually, the signs are similar in length, that the common element is longer than the different elements 'aqua' and 'water'. Furthermore, the different elements are, despite their difference, equivalent in terms of length. Therefore, the similar elements prevail globally over the dissimilar elements and the degree of visual similarity is average and not low (Para. 32). At the phonetic level, the GC confirmed that the signs differ in their first two syllables. On the other hand, the signs have the same number of syllables (four), and they share their last two syllables. Furthermore, the signs have the same length and, in both cases, the vowel 'a' is followed by an occlusive unvoiced consonant, 't' and 'q', respectively. Consequently, the signs at issue must be considered phonetically similar, at an average degree. The fact that the dissimilar elements are positioned at the beginning of the signs, which in general is the part with the greater weight, is not significant in this case because the similar elements between those signs prevail globally over the dissimilar elements (Para. 33). Conceptually, the EU consumer may be assumed to

know that the element 'aqua' of the mark applied for has the meaning of 'water'. The same conclusion is valid for the element 'water' of the earlier mark and for the common element 'perfect' being part of the basic vocabulary of the English language (Para. 34). The word 'perfect' will be perceived as a synonym for 'great quality' and thus as a laudatory adjective by the relevant public. Consequently, for a large part of the relevant public, the signs at issue have the same semantic content: they are both alluding to the idea that the goods in question are made in order to obtain excellent water, or are high quality waterproof products or are excellent products which use water (paras. 35-38). The GC recalled that, according to settled Case-Law, a linguistic difference between signs that requires the consumer to make a translation may prevent the relevant public, at least to some degree, from making an immediate conceptual comparison. The GC found however that, in the present case, the term 'aqua' is a common Latin term, the meaning of which may be assumed to be known by the consumer of the European Union. Moreover, all the elements of the signs will be understood by a large part of the general public, even non-English-speaking. Consequently, the signs at issue do have some conceptual similarity. Therefore, the signs are overall similar to an average degree (paras. 39-41). In relation to the weakness of the common element 'perfect', the GC found that, while that element may indeed be considered to have a weak distinctive character, the fact remains that none of the other elements making up the same

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signs can be considered to have a greater distinctive character or be dominant. The elements 'aqua' and 'water' also have a weak distinctive character owing to the fact that the relevant goods all involve, in one way or another, water. Accordingly, the fact that the element 'perfect' has a weak distinctive character, and that it is positioned at the end of the signs while their dissimilar elements are at the beginning, has no consequence on the overall impression of the signs at issue (Para. 42). The GC also found that the argument concerning the weak distinctive character of the earlier mark is not directly relevant in the comparison of the signs and it will, if necessary, be taken into account in the global assessment of the likelihood of confusion (Para. 43). The GC concluded that, in the light of the identity or the similarity of the goods covered by the signs at issue, their average similarity, particularly at the visual and phonetic level, and the normal level of attention of a part of the relevant public, the BoA was incorrect to find that there was no likelihood of confusion between the marks at issue (Para. 49). That conclusion is not called into question by the finding that the earlier mark has a weak distinctive character. Without it even being necessary to rule on the validity of that finding, such a finding would not prevent a likelihood of confusion being found in the present case. Therefore, although the distinctive character of the earlier mark must be taken into account in assessing the likelihood of confusion, it is only one factor among others involved in that assessment. In the present case, notwithstanding the assessment

of the distinctive character of the earlier mark, the existence of a likelihood of confusion may be established in the light of the similarity of the signs at issue and the identity or similarity of the goods in question, account being taken of the level of attention of a part of the relevant public (Para. 50).

**Case T-106/14; Universal Utility GmbH & Co KG v OHIM, Judgment of 27nd February 2015, Language of the case: DE**

**RESULT:** Action dismissed

**KEYWORDS:** Absolute grounds, Descriptive element, Principle of non-discrimination, Principle of legal certainty

**FACTS:** The applicant sought to register the word mark GREENWORLD as a CTM for goods and services in Class 4, 35 and 39. The examiner refused registration of the mark on the ground that it is descriptive and non-distinctive for the goods and services at stake. The relevant English consumers will understand the word "Green" not only as a colour, but also in a sense of "environmentally friendly". In its entirety, "Greenworld" will therefore be understood as "environmentally friendly world". In relation to the relevant goods and services, the consumers will immediately perceive the descriptive content of the trade mark in a sense that the offered goods and services are environmentally

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friendly and help to build a more ecological world. As the mark is descriptive in its entirety, it also lacks distinctiveness. The Board of Appeal dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

CTMA

**GREENWORLD**

**SUBSTANCE:** The GC emphasized that it is not sufficient for a mark composed of several words that each element is descriptive on its own. Rather, the combination of the words must also be found to be descriptive as a whole (paras. 17, 18). The English speaking public will understand "green" and "world" in their descriptive meaning. The combination "Greenworld" complies with English grammar and syntax rules and does not add any new, non-descriptive meaning to the trade mark. The fact that "Green" has more meanings than just "environmentally friendly" is irrelevant, as it is sufficient that the mark is descriptive in one possible meaning (Para. 32). The fact that the Office has registered the word mark "Green World" for goods and services in Class 7, 37, 39 and 42 is irrelevant for the present proceedings. The question of whether a mark is registrable is to be decided solely on the basis of the CTMR and not on basis of any prior Office practice (Para. 37). Even if the situation that led to

the registration of "Green world" were identical with the present scenario - quod non - Case-Law provides that the Office must, when examining an application for registration of a Community trade mark, take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. Nonetheless, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. Consequently, 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 committed to the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full in order to prevent trade marks from being improperly registered (Para. 37). In the present case, in light of the goods and services and the relevant consumer perception, the application has been rightly found to be descriptive (Article 7(1) (c) CTMR). Therefore, the applicant cannot rely on prior decisions of the Office in order to challenge the findings in the present case (Para. 38). A decision concerning the alleged violation of Article 7 (1) (b) CTMR is not necessary, as it is sufficient if one of the absolute grounds for refusal listed in Article 7 CTMR applies for the sign at issue not to be registrable as a Community trade mark (Para. 40).

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**Case T-372/12; El Corte Inglés, SA v OHIM, Judgment of 4 February 2015, Language of the case: EN**

**RESULT:** Action dismissed

**KEYWORDS:** Dominant element, Figurative element, Identity of the goods and services, Phonetic similarity, Relevant language, Similarity of the goods and services, Visual similarity, Dissimilarity of signs, Conceptual dissimilarity, Relative grounds, Beginning of mark

**FACTS:** The applicant sought to register the figurative mark represented below as a CTM for goods in Class 12. An opposition based on the earlier figurative and word marks and applications represented below, registered for goods in Class 12 was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal finding that in the view of the low degree of visual and phonetic similarity between the signs and the higher than average level of attention of the relevant public, there is no likelihood of confusion. The applicant filed an appeal before the General Court (GC).

### CTMA

**APRO**

### Earlier marks

**B-PRO**  
by Boomerang  
PRO MOUNTAIN  
PRO OUTDOOR

**SUBSTANCE:** Comparison with the earlier mark 'B-PRO by Boomerang': Visually, in the context of the overall impression created by the earlier Spanish mark, the word element 'by Boomerang' cannot be regarded as negligible. It is still of a size that enables the relevant public to decipher and read it easily, particularly as the relevant public's level of attention will be higher than average. The assessment of the similarity of the signs at issue cannot be made solely on the basis of the dominant element 'b-pro' (Para. 33). The insertion of a hyphen is an important difference, given that B-PRO is a short sign. The shorter the sign is, the more easily the public will be able to perceive each of its different components. The presence of the element 'by Boomerang' in

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the earlier mark will be perceived by the relevant public as an additional element of dissimilarity between the signs at issue (Para. 34). Phonetically, the first syllables will be pronounced differently and the differences between the signs at issue will be accentuated by the presence of the element 'by Boomerang' in the earlier Spanish mark (Para. 36). Conceptually, only the earlier Spanish mark could be associated with the concept of 'advantage, benefit; in favour of' and with the concept of 'professional'. Additionally, the element 'by Boomerang' is likely to accentuate the conceptual difference between the signs at issue, since the relevant public will perceive that element as an indication of the origin of the goods at issue (Para. 38). The BoA was entitled to examine the conceptual implications that the relevant public might infer from the component 'pro' of the element 'b-pro' because the presence of the hyphen confirms that the element is composed of two separate components (Para. 39). The GC found therefore a low degree of similarity and confirmed BoA decision that no likelihood of confusion exists between the signs (Paras. 41 and 45). Comparison with 'PRO MOUNTAIN' and 'PRO OUTDOOR': The same conclusion was held in the case of the other earlier marks where the GC found either weak or very weak similarity because of the considerable differences between the signs owing to the presence of the elements 'mountain' and 'outdoor' (Para. 49).

**Case** T-388/13; **Costa Crociere SpA v OHIM, Judgment of 26 February 2015; Language of the case: EN**

**RESULT:** Action dismissed.

**KEYWORDS:** Relative grounds, Likelihood of confusion, Identity of the signs, Similarity of the goods and services, Purpose of the goods and services, Complementary goods and services, Distinctive element.

**FACTS:** The applicant sought to register the word mark SAMSARA as a CTM for a range of services in class 44, namely: spas, Turkish baths, sauna services, health spa services, all provided on board cruise ships. An opposition was based on the earlier word mark SAMSARA, registered for soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices in Class 3. The opposition was filed on the grounds of Articles 8 (1) (b) and 8 (5) CTMR. The Opposition Division (OD) upheld the opposition for all the contested services on the basis of Article 8 (1) (b) CTMR. The Board of Appeal (BoA) confirmed the decision of the OD. The BoA found that the goods in Class 3 and the services in Class 44 at issue were similar to an average degree and that the signs were identical and that, consequently, there was a likelihood of confusion. The applicant filed an action before the General Court (GC) arguing an infringement of Article 8 (1) (b) CTMR.

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### CTMA

SAMSARA

### Earlier marks

SAMSARA

**SUBSTANCE:** The General Court (GC) dismissed the appeal. The GC firstly held that the goods and services at issue share the same overall purpose which is beauty and health care. In particular, soaps, cosmetics, perfumes and other goods in Class 3 and spas, Turkish baths and sauna services in Class 44 are both used to wash, purify and keep the human body in good condition or make it more attractive. The earlier mark's services often include cosmetic treatments requiring the use of soaps, fragrances, oils and other beauty products. The establishments which provide such services may also offer for sale beauty and health products bearing their mark. Therefore, the distribution channels might overlap and the targeted public is identical. There is also some complementarity between those goods and services: the treatments in spas, Turkish baths etc. is usually followed by the application of body lotions and moisturising creams. The fact that the applicant provides its services on board cruise ships does not in any way alter their overall purpose. There is

nothing in the file to indicate that the applicant's services exclusively serve a curative purpose. On the contrary, the fact that the services are provided on board cruise ships confirms that the public does not consist solely of persons who need medical treatment. Consequently, the claim relating to the dissimilarity of the goods and services at issue must be rejected (Paras. 25-34). The GC found then that the actual circumstances of use of the earlier mark are not relevant since the applicant had not requested proof of use of the earlier mark (Para. 36). In relation to the applicant's argument that the word SAMSARA lacks, or has a low degree of distinctiveness, and it is descriptive of the services it covers in Class 44, the GC found first that the great majority of the consumers will not associate any meaning with that word since they ignore that it means 'eternal cycle of life' in Sanskrit. Secondly, even if some of the consumers know the meaning of that word, the BoA was entitled to find that the abovementioned meaning was not descriptive of either the goods for which the earlier mark enjoys protection or the services covered by the trade mark application (Para. 38). It follows from the foregoing that the BoA did not err in finding that, given the average degree of similarity of the goods and services at issue and the identity of the signs, there was a likelihood of confusion in respect of all the contested services

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

#### Decision of the Second Board of Appeal of 3 February 2015 in case R433/2014-2 (SV)

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

The applicant sought to register the figurative mark



for goods Classes 19, 21 and 22.

By a decision, the examiner partly rejected the application for some goods in Class 22 as being ineligible for registration under Article 7(1)(b) and 7(2) CTMR. The examiner based his decision on the fact that the trade mark was an extremely simple and commonplace representation of the goods themselves.

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

The Board ruled that there was a trend nowadays for figurative marks to have a simple and stylized design. The consumers are therefore not unaccustomed to perceive relatively simple figurative marks as designations of origin. The combination of the two parts of the trade mark – the tent and the oval – and the manner in which they were integrated with one another rendered the trade mark capable of fulfilling the function of an indication of origin. Regardless of the manner in which the oval in the background was perceived, the trade mark as a whole indicated that this was a trade mark and not a simple and banal reproduction of the goods and their intended purpose. The relevant public – regardless of whether the general public or professional buyers – could be expected to immediately perceive the trade mark as a commercial indication of the origin of the goods also in relation to the refused goods. This same perception could be expected even in relation to the goods 'string', in spite of the fact that the level of attention paid to this kind of goods was usually low.

The Board upheld the appeal and annulled the contested decision.

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### Decision of the Second Board of Appeal of 23 February 2015 in case R793/2014-2 (SV)

*Absolute grounds for refusal – Article 7(1)(f) CTMR – word mark, contrary to public policy or accepted principles of morality*

The applicant sought to register the word mark 'FUCK CANCER' for goods and services in Classes 25, 28, 35, 38, 41 and 44.

The examiner refused the application under Article 7(1)(f) CTMR, as the mark 'FUCK CANCER' was held to be of such a vulgar and indecent nature that it was clearly contrary to public policy or accepted principles of morality.

The applicant appealed the examiner's decision.

The Board stated, in particular, that based on the marketing and display of the goods and services applied for, it could not be excluded that children might encounter the trade mark. The word 'FUCK' was an expression which very many people today, even those with normal levels of sensitivity and tolerance, experienced as a particularly vulgar and offensive expletive, especially the English-speaking public, for whom the sexual undertone and indecent connotation of the word was even clearer than for other people. Further, the fact that the word was often censored in newspapers and television

broadcasts also indicated that it was regarded as too offensive for the general public to be confronted with.

The Board upheld the contested decision and dismissed the appeal.

[Link to eSearch Case Law](#)

### Decision of the Fifth Board of Appeal of 30 January 2015 in case R0175/2014-5 (EN)

*Opposition – Article 8(1)(b) CTMR – figurative mark, similarity of goods in Class 12, recent case-law from the General Court*

The applicant sought to register the figurative mark

**RACEKING**

for goods in Class 12.

The opponent filed an opposition pursuant to Article 8(1)(b) CTMR, based on the earlier Spanish trade mark 'RACE', inter alia, registered for the following goods in Class 12: 'Vehicles; apparatus for locomotion by land, air or water'. The contested goods in Class 12 were: 'Tyres; Inner tubes for tyres'.

The Opposition Division upheld the opposition for all the contested goods due to the similarity of the goods and the signs.

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The applicant filed an appeal against the decision.

The Board analysed the similarity between vehicles and tyres, taking into account previous decisions of the Boards, and also the recent case-law from the General Court - ENDURANCE and Lambretta.

The Board confirmed the similarity of the goods and the signs under comparison. Consequently the appeal was dismissed.

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### Decisions of the Second Board of Appeal of 20 January 2015 in case R697/2014-2 (EN)

*Opposition – Article 8(1)(b) CTMR - earlier marks with reputation, proof of reputation, lack of evidence, dissimilar goods and services, lack of translation*

The applicant sought to register the figurative mark

 melissa

for services in Class 35.

The opponent filed an opposition according to Article 8(1)(b) CTMR against all the services applied for, based on the earlier German trade mark

registrations 'Galeria', 'Galeria Living' and



All the earlier rights were registered for various services in Class 35. The opponent claimed that its earlier marks possessed a high degree of reputation in Germany in relation to the services in Class 35.

The Opposition Division upheld the opposition and rejected the contested application in its entirety on the basis of the earlier figurative mark



The applicant filed an appeal against the Opposition Division's decision.

The Board found that the term 'GALERIA' was distinctive to a low degree for the German public when applied to the 'presentation of goods and services in department stores; operating department stores, namely arranging and concluding contracts for the purchase and sale of goods; providing commercial information also via Internet, included in this class' in Class 35 covered by the earlier mark as well as for the contested mark's retail services because, it would be immediately perceived as a place where goods were exhibited and sold. The

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presence of the distinctive and dominant part 'melissa' in the contested figurative sign 'galeria melissa' outweighed the low visual, aural and conceptual similarities between the contested sign and the earlier German figurative mark 'GALERIA' and sufficed to exclude any likelihood of confusion, even for highly similar services.

The Board annulled the contested decision.

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### Decision of the Fifth Board of Appeal of 23 January 2015 in case R1419/2013-5 (IT)

*Opposition – Article 8(4) CTMR – appellation of origin*

The applicant sought to register the figurative mark

**VALDIZZE**

for goods in Class 33.

The opponent filed an opposition, which was upheld by the Opposition Division.

The applicant appealed the decision.

The Board found that use of more than mere local significance (and even a certain reputation) was duly proved for the earlier appellation of origin 'Prosecco di Conegliano-Valdobbiadene, Superiore Cartizze'.

The relevant law (in particular, Article 118m (2)(b) of Council Regulation (EC) No 491/2009 of 25 May 2009 amending Regulation (EC) No 1234/2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products) protects an appellation of origin, inter alia, against any evocation of the same. According to relevant case-law, such evocation occurs when the term used to designate a product includes a part of a protected appellation of origin in such a way that the consumer is led to have in mind, as a reference image, the product protected by the appellation of origin, even without any risk of confusion (C-87/97 Cambozola).

The Board upheld the opposition on the basis of an earlier Italian appellation of origin claimed under Article 8(4) CTMR and dismissed the appeal..

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### Decision of the Forth Board of Appeal of 28 January 2015 in case R2425/2013-4 (FR)

*Cancellation proceedings – Article 51(1)(a) CTMR – revocation, genuine use, reasons for non-use*

The CTM proprietor registered the word mark 'WEBSHIPPING' for goods and services in Classes 35, 38, 39 and 42.

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The cancellation applicant filed an application for revocation on the basis of the ground in Article 51(1) (a) CTMR.

The Cancellation Division allowed the application for revocation due to there being no proper reasons for non-use. The reasons for non-use constituted an exception to the requirement of use and had to be interpreted strictly.

The CTM proprietor appealed the Cancellation Division's decision.

The Board found the following legitimate reasons for non-use: A revocation request filed by a direct competitor who used the CTM and had been condemned for infringement. In such a situation the CTM proprietor could not be expected to use the CTM alongside the infringer's and therefore constituted a proper reason for non-use.

The Board annulled the contested decision. The CTM, therefore, remains registered.

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### Decision of the Fifth Board of Appeal of 22 January 2015 in case R28/2014-5 (DE)

*Cancellation proceedings – Article 52(1)(a),(b) CTMR, Articles 7(1)(b) and (c) CTMR – descriptiveness/non-distinctiveness of a tourist attraction, geographical origin of the goods/services in question*

The CTM proprietor registered the word mark 'NEUSCHWANSTEIN' for goods and services in Classes 3, 8,14-16, 18, 21, 25, 28, 30, 32-36, 38 and 44.

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 and Article 52(1)(b) CTMR.

The Cancellation Division rejected the declaration of invalidity.

The cancellation applicant appealed the Cancellation Division's decision.

The Boards decision dealt with the question of whether a famous castle, which was also a tourist attraction, was descriptive for the geographical origin of the products covered by the sign or devoid of any distinctiveness. In the Board's opinion, the sign was apt for registration. Even if some consumers were to perceive the sign as referring also (but not exclusively) to the famous castle it could still fulfil its function as a badge of commercial origin.

The Board dismissed the appeal.

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### Decision of the Second Board of Appeal of 3 February 2015 in case R131/2014-2 (EN)

*Cancellation proceedings – Article 52(1)(a),(b) CTMR, Articles 7(1)(b) and (c) CTMR – figurative mark, distinctiveness*

The CTM proprietor registered the figurative mark



for goods in Class 16.

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), (c) CTMR and Article 52(1)(b) CTMR.

The Cancellation Division rejected the declaration of invalidity.

The cancellation applicant appealed the Cancellation Division's decision.

The Board found that the expression 'TIMEBOOK System' taken as a whole constituted an immediate, direct and easily understandable indication of the kind and the intended purpose of 'planners; tear off calendars; organisers'. It did not create an impression which was sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it was composed. The figurative elements composing the

mark were insufficient to render the mark distinctive. The link between the contested mark and the goods was sufficiently close for the sign to fall within the scope of the prohibition laid down by Article 7(1)(c) and 7(2) CTMR for the average consumer in the UK, Ireland, Malta, Sweden, Denmark, Finland and the Netherlands.

Consequently, the Board annulled the contested decision rejecting the request for a declaration of invalidity.

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### The Registry also recommends

#### Decision of the Fourth Board of Appeal of 3 March 2015 in case R196/2014-4 (EN)

*Employee representation – Article 92(2) CTMR – employee representative, missing authorization – proof of economic connection*

A natural person, who claimed to be an employee of the applicant, indicated on the application form that he was acting as a professional representative on the applicant's behalf.

The Operations Department refused the application on absolute grounds. The decision was taken

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against the applicant for the CTM and was notified to the attention of the natural person.

A notice of appeal was filed against the decision and was signed by the natural person.

The Board invited the natural person to provide an authorization signed by the applicant and to prove the economic connection between the applicant and the natural person. In response the natural person presented a general authorization to represent the applicant before the Office and stated that his employer was fully owned by the applicant.

The Board found that the applicant was a company established as a corporation in the USA, with no business address in the EU and needed to be represented before the Office pursuant to Article 92(2) CTMR. The natural person was not acting as a professional representative but as an employee representative. The natural person was an employee of a German subsidiary of the applicant and intended to act for the applicant. The documents submitted by the individual were insufficient to prove an economic connection between the applicant and the individual's employer. The general authorization was not directly issued by the applicant. Neither did the evidence cover the entire chain of authorizations from the applicant to the individual acting in the present proceedings. The general authorization filed had to be considered invalid.

The Board dismissed the appeal as inadmissible.

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