Alicante News

Up to date information on IP and OHIM-related matters

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May 2015

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IP Mediation Open Day at OHIM

On June 15, 2015, OHIM will hold its first ever IP Mediation Open Day. The event follows on from the successful OHIM IP Mediation Conference launched by the Office last year, and is part of OHIM's commitment to mediation, both through its own Mediation service and its outreach and awareness-raising activities.

Last year's conference, held in Alicante, attracted delegates and speakers from all over the world – proof positive that mediation is a fast-growing discipline globally, not just in the EU. OHIM's own Mediation service, launched in 2011, continues to receive an increasing number of cases. Several European Trade Mark and Design Network offices have long-established mediation centres, and mediation is beginning to embed itself within the IP landscape as a whole.

The Open Day builds on the work done by the Conference, the experience gained in the IP Mediation field and takes it a step further. The aim of the event, which is free to attend, is to provide an activity-based, highly participative session, which is designed to be as interactive as possible. The activity leaders are drawn from the public and private sector within IP and between them, they can give differing perspectives as to the uses and advantages of mediation as an alternative dispute resolution mechanism.

OHIM's own mediators will also take part in the event. Over the past four years, the Office's Mediation service has been steadily growing, and with it, its roster of mediators. Mediation at OHIM only takes place in case of appeals, but its mediators come from all across the Office, and can offer mediation services for free in a variety of EU languages.

OHIM's commitment to mediation is inspired by its users' needs. The Boards of Appeal at OHIM deal with around 2,700 cases per year, which take, on average, one and a half years to resolve. Some may also lead to further appeal, which can take even more time and which can be very expensive. Yet in many of the cases, while there are genuine legal conflicts, there is a possibility of reaching an agreement in which the business interests of both parties can be preserved.

Mediation is also a guarantee of confidentiality as regards the existence of the dispute, since the dispute is taken out of the public eye. It offers users a real alternative to litigation, and the forthcoming Open Day aims to fully explore its possibilities and utilities in the world of IP.

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The James Nurton Interview

Mireia Curell, Curell Suñol, Barcelona

What is your background?

I work at Curell Suñol, which was founded by my father Marcelino Curell Suñol. During my childhood I heard about inventions, patents, trade marks and copyright every day. I even remember my father telling us to sign our drawings with the copyright symbol at the bottom of the page!

Mireia Curell

My original background was literature and linguistics. I started work by translating documents and novels. After graduating I was hired by a big publishing group in Barcelona working on editorial tasks and I soon moved to relations with authors and attending book fairs and finally specialised in copyright and contract law.

At that point my father invited me to join the firm and I became an IP attorney. That was 28 years ago. I have moved towards working on trade marks but I still work on copyright sometimes.

When I was working in publishing I was already focused on the law and it was a good opportunity that my father offered me. I really enjoyed the trade mark world and became very much involved. I have always liked coordinating portfolios of clients worldwide, devising protection strategies and negotiations, which I consider to be very important.

What does your day-to-day work involve today?

At present I am the managing partner, so my main role is administering the firm. But I still like to be in contact with files and clients, and I do a lot of drafting work and coordinating international portfolios. Advising clients how to protect their rights all over the world is something that is important and that I really enjoy.

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The James Nurton Interview

Our clients are about 50-50 local and international, in many different areas. Domestically, we have important clients in the wine industry, as well as the electrical, optical, perfume and pharmaceutical areas. This is why I have focused on managing portfolios internationally.

How big is the firm?

The firm became a professional partnership company in 2009 and now we have six professional partners, all IP attorneys, some more focused on patents and some more on trade marks. We are an IP boutique and handle all IP-related services. We are a team of 45 people, with our main office in Barcelona and two branches in Madrid and Alicante. We are very involved in education programmes through the association of Spanish IP attorneys, the Barcelona Bar Association and continuing education courses.

How many trade mark applications do you handle in a typical year?

It is difficult to say. We probably file about 250 CTM applications each year, and roughly the same number of Spanish applications. We don't file as many Spanish applications as we used to: many clients tend to export so they choose the CTM route more than the national route. Sometimes we have clients only working in a local area, for example with Catalan slogans, and they stick to the Spanish trade mark.

What do you think of the CTM?

It is a success story. The EU-wide right for both trade marks and designs is a good option. The registration procedures are smooth, cost-effective and reasonably fast. But nothing is perfect and there are aspects that could be improved. In my opinion, a greater predictability and certainty would be welcome, in particular concerning trade mark examination on absolute grounds. I think OHIM's position is not always consistent but I know OHIM is working towards that.

Many of these issues have been tackled by the planned EU trade mark reform. In general, I welcome the changes proposed. I am very much in favour of the fee-per-class scheme; in Spain, we have never adopted the three-for-one system. It will avoid over-broad descriptions in trade mark applications, with claims for goods and services that are not intended to be used.

Streamlining is a good objective but it will not be easy. There is a lot of resistance to adopting administrative revocation and cancellation proceedings. This is a complicated issue because the national offices have to make changes to their structure and recruitment policies. In Spain it would require a change to the law on the judiciary. I understand why there is a long transitional period, which I think is seven years.

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Do you think people would use these procedures if they become available in Spain?

Yes, I think people will welcome them very much. There are trade marks that have not been used at all and bringing a judicial proceeding to revoke them is expensive and complicated. But these options should be there: depriving someone of a right is a delicate issue. In many cases you request revocation as a counter-claim in infringement proceedings, so that route should also be kept open. The administrative route will not always be suitable. I think they will be a good option in many cases.

I would have liked the registration fee to be kept. I'm in favour of a registration fee because sometimes applicants may lose interest in an application, which can be finally granted for goods that do not correspond to their core business. The automatic registration of a mark means that there are some trade marks in the system that are no longer wanted by the rights owner. It does not need to be a high fee, but a symbolic registration fee would be good. However, I know this has been dismissed and is not favoured by industry.

On renewal fees, I understand the need to lower them. Having a high price was a means to try to discourage trade marks that were no longer in use but I agree it was a high fee and a reduction was expected.

Tell us about your involvement in the Cooperation Fund?

The Management Board of the Cooperation Fund was formed by Lord Mogg representing public service, Jef Vandekerckhove representing industry and myself representing professionals in private practice. I was asked by the OHIM President to be a member of the Board and I was happy to do it. It has been a very good experience, and I am pleased to have had a role in helping to devise the tools aimed at raising the level of performance and accessibility in all the offices.

It was a challenge and a very exciting task. The results have been positive and most of the projects have been successfully completed. Most national and regional offices now have better tools, especially within the eastern countries. TMview and Designview are excellent tools. It has been a pleasure to work with the technical managers at OHIM.

We would have liked to complete the project on image searching, but that was not possible. I think useful solutions will be found in the near future. What was done was good but not satisfactory. The tool was not reliable enough. We were sorry to abandon that project but the others have been very successful. There is also a better atmosphere between the national and Benelux offices and OHIM now. There is still an impression that national

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and Community marks are in competition, but in my opinion they will always be needed and the complementarity must be defended.
We will finish the Cooperation Fund projects by the end of this year, and a new phase will start. At the beginning, it involved a lot of time for me and we often had meetings but now it is more of a monitoring task, taking a couple of days every two or three months. I think the tools have been welcomed by offices and users associations, and the impression has been positive. The tools will make a difference in the functioning of the offices. These tools make our lives easier.

What was the first trade mark you worked on?

I remember that the first matter I was entrusted with was the preparing of an application for the house mark of a company dealing with electrical components. I was given all of their catalogues and I had to draw up a list of goods in Class 9. It was quite tedious but I became very well acquainted with the international classification. Looking back, I'm sure it fulfilled the requirements of clarity and precision stated in the IP TRANSLATOR case!

What has been the most unusual case you have worked on?

A series of cases involving the mark DONUTS, which is very well known in Spain for small cakes. In particular defending this mark vis-à-vis new applications containing this word. It is registered as a trade mark in Portugal and Spain.

We have filed many oppositions and cancellations at OHIM, which we have won. It reveals the difficulty of finding fully convergent policies throughout the EU: the language issue is a serious issue. The level of knowledge of English in Spain in the 1970s, when the mark was registered, was very low, but still today the mark DONUTS works as a badge of origin. The owners of this trade mark have been very active in defending it, they have used it correctly, and not allowed competitors to use it as a generic term. They are always fighting bad use of the mark and are very effective. It's a good example of how to maintain a trade mark validly alive after registration. Registering a mark is not the end. Any bad use by third parties should be challenged.

Other interesting areas where we are active include the wine sector. We have seen many cases where there are conflicts between appellations of origin and trade marks. This is another area where convergence of practice can be difficult. We have defended clients' trade marks, for example where the appellation of origin Castilla-Leon was opposed to the mark Jean Leon, and we won. But in another case the trade mark Cuvée Palomar was objected on the grounds of the appellation of origin El Palomar and we were not successful.

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On a more frivolous level, in 1999 we had to file an opposition to the singer Bob Dylan on the grounds of the prior registration Dylan in class 25. That was a strange feeling as I was a fan! Fortunately we reached an agreement. That is one of the nice things about the OHIM procedure: the cooling-off period and the possibility of settling is very attractive. This will be introduced in Spain as a result of the EU reforms, which I think is a very good initiative.

Are there any other important developments in Spain?

In trade marks, convergence is an issue. In addition to the changes coming from the EU reforms there are questions related to distinctive character, which need to be clarified. I'm happy to see the Spanish Patent Office is publishing more guidelines to clarify practice for users.

There have been amendments to the Spanish Criminal Code. Importantly, the Code criminalises the facilitating of access, distribution or reproduction of works protected by copyright, including sports events, films and music. This is a new feature.

Also, the Spanish Patent Act of 1986 will be replaced by a new one, which will soon be passed. There will be important reforms in the patent-granting procedures, with mandatory examination of novelty and inventive step being introduced. It was due to be modernised, and the changes should make national Spanish patents more attractive.

What do you expect for trade marks in the future?

I am very positive about the future. Businesses have several routes to protect their rights. Harmonising practices, implementing new tools and efficient procedures will result in better and wider use of trade mark protection. I still think businesses must be aware that IP protection is important for their development, and at least in Spain education is very necessary, especially for SMEs. We must continue telling our industry how important protecting their IP assets is.

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Community Trade Mark

Proposal for changes to the Nice Classification accepted by the Committee of Experts

KC G&S Issues

During the 25th Session of the Committee of Experts of the Nice Union held from 27 April to 1 May 2015 and attended by representatives of KC G&S Issues, the OHIM presented the Proposal for changes to the Class Headings and Explanatory Notes prepared by the CP1 Working Group.

The Nice Classification is the primary system used to classify goods and services for the purposes of the registration of marks. For much of the time since its first edition, the Classification has been available and used in printed form, usually referred to whilst adding the necessary information into a paper application; but times have changed. These days, trade mark applications are increasingly e-filed, with classification advice available through an online alphabetical database. This evolution has changed the role performed by the class headings when terms are not found in the alphabetical list, requiring that they provide more decisive (and unambiguous) guidance. In this, some of the class headings fail. The proposal made aimed to improve the capacity of the Nice class headings to provide the guidance needed by today's users.

Specifically, the proposal aimed at bringing greater clarity and precision to 11 specific Nice Class Headings, and their explanatory notes in order to move towards producing a classification system that gives more directed and useful guidance to users and provides more accurate 'general indications' of the fields of goods and services in the respective class. The class headings concerned are those of classes 6, 14, 16, 17, 18, 20, 21, 22, 24, 28 and 31. These class headings have seen references to "and goods made of these materials, not included in other classes", and similar such wording removed from the class headings, among others, and instead more examples of the goods included, and not included, in those particular classes have been provided in the explanatory notes.

The proposal was the result of in-depth discussion and lengthy debates from Europe's finest classification experts from IP offices and with input from representatives of the User Associations MARQUES and INTA.

The proposal was approved by the WIPO Nice Committee of Experts in its entirety on 29 April and the changes will enter into force in the 2016 version of the 10th edition of the Nice Classification on 1 January 2016.

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Registered Community Design

The United States and Japan join the Hague System for the International Registration of Industrial Designs. What does it mean for users?

As of 13th May 2015, International applications for registration of industrial designs may be filed designating two new members of the Hague system: Japan and the United States (the US). The accession of these two countries has led to changes in filing with the International Bureau (IB) of the World Intellectual Property Organization (WIPO) which administers the system. This article aims at giving a brief overview of the new requirements that these accessions have triggered, as well as, highlighting OHIM's practice. The following notes will also reflect certain changes that were implemented by WIPO following the accession of the Republic of Korea in July 2014.

Unlike the Community design registration system (which is essentially limited to a formal check during the examination proceedings), the national Offices of US, Japan and the Republic of Korea carry out a substantive examination of design applications, and users should be prepared for specific requirements and a longer registration process if they designate these countries in the International application.

The above explains why the period in which OHIM can notify a refusal of an International application is 6 months from the date of publication of the design in the International Designs Bulletin, whereas in Japan, US and the Republic of Korea this period is 12 months. The Republic of Korea applies an exception for products belonging to classes 2, 5, or 19 of the Locarno Classification as regards the novelty check, and products belonging to Class 32 cannot receive protection in this jurisdiction at all. It is also important to know that if no notification is communicated by the Office of the Republic of Korea (either a refusal or a statement of grant of protection), the International registration does not automatically produce the effect in this designated country.

The OHIM does not receive International applications, meaning that EU users have to file either via their respective national Offices if they are Hague members, or directly at the IB of WIPO. However, the Offices of the US, Japan and the Republic of Korea will receive International applications, albeit upon the payment of transmittal fees. In Japan this fee amounts to 3,500 JPY per application. In the Republic of Korea this figure stands at 15,000 KRW if the International application is filed in paper and at 5,000 KRW for e-filing. For the US, the fee is 120 USD, but be aware; the US Office does a national security check which extends the time of forwarding an application to the IB of WIPO by up to 6 months.

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OHIM's practice fully complies with the Hague requirement of allowing multiple design applications, but only where these belong to a single class of Locarno classification. On the other hand, Japan and the US require unity of design in the application; only one independent and distinct design may be included in a single application. The treatment of such International applications in these jurisdictions, moreover, differs. In the US the applicant will be invited to choose the design that will proceed to registration, with the option to continue with the remaining designs as separate applications. In Japan multiple applications will be treated as if individual national applications had been filed, without the necessity of any action by the applicant.

It is important to note that if the US is designated, no deferment of publication of a design is possible. This is markedly different from what happens when the OHIM, Japan or the Republic of Korea are designated, where a design may be kept unpublished after registration up to 30 months from the date of filing (or the date of priority).

In the EU system, the maximum duration of protection is 25 years (with five-year terms of renewal) from the International registration date. In Japan and the Republic of Korea the maximum duration of protection is 20 years from the date of the establishment of a design right in these member States. The shortest period of all is in the US, where a design patent is valid for one term of 15 years from the grant the protection by the Office.

OHIM and the Republic of Korea do not re-publish the International registrations. Japan and the US re-publish the International registrations when the design rights are established.

All the Offices, including OHIM, have opted for individual fees. This is the part of the total costs of the International application which users pay for the examination proceedings to be completed by the designated Offices. For an EU designation this fee amounts to 67 CHF per design in the application and 34 CHF per design for renewal. In respect of designations of Japan, the individual fees stand at 582 CHF per design in the application; the first, second and third renewals costing 659 CHF each, the fourth and subsequent renewals being free. For a designation of the Republic of Korea the user pays 210 CHF per design in the application, 339 CHF for the first renewal, 800 CHF for the second renewal and 923 CHF for the third renewal.

The Republic of Korea applies level three of standard fees (under the Hague system) to applications and renewals for designs in products belonging to classes 2, 5 or 19 of the Locarno Classification. If the US is designated, the individual fee is paid in two parts: the first one for an amount of 733 CHF (discounted to 367 CHF in case of 'small entity' applicants and to 183 CHF in case of 'micro entity'

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applicants) upon filing, and the second one for an amount of 540 CHF (discounted to 270 CHF and 135 CHF in the above mentioned cases) upon request by the Office. All fees are payable directly to the IB of WIPO in Swiss Francs, but the USPTO also accepts payments in US dollars.

The IB of WIPO provides online support to guide the applicants through all changes. The application form (whose use is compulsory), and the e-filing interface contain new sections and four annexes, envisaging special situations. It should be remembered that the IB of WIPO disregards any contents of International application which are not requested or expressly permitted, and does not forward any disregarded documents to the designated national or intergovernmental Offices.

Differently from the practice at the OHIM, information identifying the creator is mandatory in an International application designating the US, Japan or the Republic of Korea. A successful US designation will also require a claim and an oath or declaration of the creator, the claim being a requirement for granting the filing date, and failure to comply will affect the date of the International registration. To avoid the loss of filing date, the IB of WIPO inserts the first product listed in the application if no indication of product is provided in the claim. More than one claim is not permitted.

The IB of WIPO has also added a section in the application form, specifying the types of views with a recommendation for its use in Japanese or US designations. Japan requires 6 views of a three-dimensional design, all in compliance with the method of orthographic projection. The Republic of Korea requires specific views of design if the protection is sought for a set of articles or typefaces.

In the US and the Republic of Korea, some specific evidence is required where the change of ownership is requested.

If Japan or the Republic of Korea is designated in the application, the section on the exception to lack of novelty may be provided in the application form and supported by the evidence submitted in the annex of the application.

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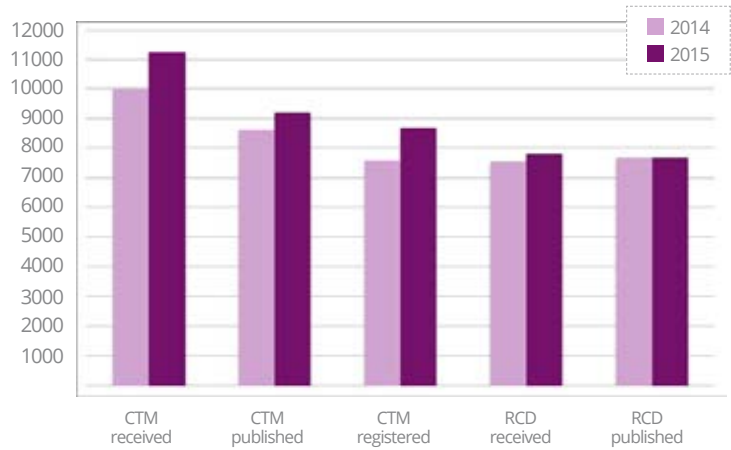
Statistical Highlights

Monthly statistical highlights April*	2014	2015
Community Trade Mark applications received	10 024	11 255
Community Trade Mark applications published	8 627	9 212
Community Trade Marks registered (certificates issued)	7 577	8 681
Registered Community Designs received	7 548	7 808
Registered Community Designs published	7 566	7 693

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



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ETMDN Updates

Croatia & Iceland join Designview

As of 11 May 2015, the Croatian Intellectual Property Office (SIPO) made its design data available to the DesignView search tool. And on 18 May 2015, the Icelandic Patent Office (ELS - IPO) also made its design data available in Designview.

With ELS - IPO on-board, there are now 31 participating offices in Designview. With the addition of more than 3.500 designs from ELS - IPO, Designview now provides information and access to more than 4,2 million designs in total.

Since the introduction of Designview on 19 November 2012, the tool has served about 935.000 searches from 137 different countries, with users from Spain, Germany and the UK among the most frequent visitors.

The Tunisian IP Office Institut National de la Normalisation et de la Propriété Industrielle (INNORPI) joins TMclass

As of 15 May 2015, The Tunisian IP Office Institut National de la Normalisation et de la Propriété Industrielle (INNORPI) joins TMclass.

These latest additions bring a total of 45 national and regional IP Offices, including OHIM, WIPO and OAPI, into the tool.

TMclass now offers users the opportunity to search and translate terms to and from any of the 34 available languages.

EuropeanTMDN News 5 out now

The latest edition of EuropeanTMDN reports on the latest activities and projects of the European Trade Mark and Design Network and its members.

This issue focuses on the Cooperation Fund's **e-filing** tool and how it is already contributing to strengthening IP protection across the EU. The User Perspective section is devoted to **ANDEMA**, the Spanish association representing the interests of brand owners, and its role in promoting and supporting IP awareness in Spain. Gerardo Penas, from the **Spanish Patent and Trademark Office** explains how CF's designs e-filing tool, implemented last year is contributing to streamline applications.

Together with current news from across the Network, readers will also find articles about the project managers deployed to IP offices to implement tools and solutions, and the new **User Satisfaction Survey** tool developed by the Cooperation Fund.

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The Pan-European Seal IP Campus Pilot 2015

The Pan-European Seal IP Campus Pilot 2015 took place at OHIM's premises between 11 and 13 May. Organised by OHIM and the European Patent Office, this IP awareness and dissemination event gathered together the 14 trainees of OHIM's Pilot Edition of the Pan-European Seal, as well as other in-house trainees, bringing the total number of participants to 34.

The event included conferences on intellectual property (IP) related topics, such as the economic value of EU trade marks and designs, the Community trade mark legislative reform, patents and economic growth, counterfeiting and piracy, design law, and IP in the fashion industry. Additionally, the programme included two visits to local IP intensive industries, a discussion panel on the role of IP in the global economy, and two career guidance sessions in the IP field.

The Pan-European Seal Professional Traineeship Programme is a comprehensive IP programme which bridges academia and the IP labour market, promoted in partnership with the EPO and managed by the OHIM Academy, together with strategic University partners. The Pilot Edition was launched in October 2014 with 14 graduates from the Institutes belonging to the EIPIN Network.

Situation report on counterfeit goods published

The first extensive and in-depth situation report on counterfeit goods in the EU has been released. The report is the result of a joint project by EU agencies Europol and the Office for Harmonization in the Internal Market (OHIM), through the European Observatory on Infringements of Intellectual Property Rights.

Although the majority of counterfeit products in circulation in Europe are manufactured outside the EU – and evade detection at the EU's external borders - research for the report highlights how domestic EU production is on the rise with cases originating in Belgium, the Czech Republic, Italy, Poland, Portugal, Spain and the UK.

The most significant enabler, the report finds, for distributing these counterfeit goods is the Internet. Counterfeiters are able to function across multiple jurisdictions, evading capture, and are also able to take down and set up new websites overnight without losing their customer base.

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Case law

Luxembourg trade mark and design news

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

Case C-445/13 P; Voss of Norway ASA, INTA v OHIM, Nordic Spirits, Judgment of 7 May 2015, Language of the case: EN

RESULT: Action dismissed

KEY WORDS: Three dimensional mark, Absolute grounds, Distinctive element, Burden of proof, Distortion of facts or evidence, Well-known facts need no evidence, Shape of the product

FACTS: The applicant obtained registration of the 3D mark shown below for goods in Classes 32 and 33.The cancellation applicant filed an application for a declaration that the contested trade mark was invalid on the basis, first, of Article 51 (1) (a) of Regulation No 40/94, read in conjunction with Article 7(1) (a) to (e) (i) to (iii) of that regulation, and, second, of Article 51 (1) (b) of that regulation. The Cancellation Division rejected the application for a declaration of invalidity but the Board of Appeal (BoA) annulled the decision on the basis of the lack of distinctive character of the mark. The CTM proprietor filed an action before the General Court (GC). By judgment of 28 May 2013 in case T-178/11, the GC dismissed the action and confirmed the conclusion of the BoA. The CTM proprietor supported by the International Trademark Association (INTA) filed an appeal before the European Court of Justice (CJ).

SUBSTANCE:

ON ARTICLE 99 CTMR AND RULE 37 CTMIR

The CJ held that the GC examined whether there was any concrete evidence which would indicate that the composite mark, taken as a whole, is greater than the sum of its parts and did not, contrary to what the INTA and the appellant submit impose the burden of proving the existence of such evidence on the appellant (Para.70). In those circumstances, it held that the arguments of CTM proprietor and the INTA are based on a misreading of the judgment under appeal and must therefore be rejected (Para.71). The GC carried out an analysis of the distinctive character of the components of the three-dimensional sign at issue in the light of the norms of the relevant sector, relying on well-known facts (Para.86). Consequently, the CTM proprietor and the INTA are not justified in claiming that the GC did not define the norms and

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customs of the sector of goods in respect of which the contested trade mark was registered (Para.87). In relation with INTA's argument that the GC erred in law by contrasting 'mere variant' with 'significant departure' in relation to the applicable norms and customs, instead of examining whether the contested trade mark deviates from the shapes that are customarily or normally used in the relevant sector to such an extent that consumers will be able to attach significance to it (Para. 88), the CJ held that the GC was correct to confirm that the BoA had not erred in finding that the average consumer in the European Union would perceive the contested trade mark, as a whole, merely as a variant of the shape of the goods for which registration of that trade mark was sought. The CJ concluded that the GC correctly held that the contested trade mark, as perceived by the relevant public, is not capable of individualising the goods covered by that trade mark and distinguishing them from those which have a different commercial origin (Para.94). Furthermore, in so far as the INTA criticises the GC for holding that the appellant's bottle does not depart significantly from the norms or customs of the relevant sector, the CJ stated that that analysis falls to be classed as an assessment of a factual nature (Para. 96).

ON ARTICLE 7 (1) (B)
The CJ confirmed that the GC correctly based its assessment as to whether the contested trade mark has distinctive character on the overall impression which is conveyed by the shape and the arrangement of the components of that mark, as required by the Case-Law (Para.109). The CJ added that it cannot be maintained that the GC did not carry out a sufficiently detailed analysis of the overall impression conveyed by the contested trade mark, inasmuch as the three-dimensional shape at issue consists of two elements namely a cylindrical basic shape and a non-transparent cap with the same diameter as that cylinder, and it is difficult to imagine other ways of combining those elements in a single three-dimensional form (Para. 110).

ON THE DISTORTION OF THE EVIDENCE IN THE FILE
The CJ concluded that the GC was correct when it held that the word 'section' used by the BoA in Paragraph 37 of the contested decision must be understood as meaning 'part' and according to the GC the vast majority of bottles have a part which is cylindrical (Para.118). So, contrary to what the appellant claims, the GC did not confine its analysis of the three-dimensional sign at issue to a comparison of the shape of that sign with a two-dimensional feature (Para.119). As regards the appellant's argument that the GC erred in law by applying to the contested trade mark the Case-Law according to which a combination of components, each of which is devoid of distinctive character, can have distinctive character, provided that, taken as a whole, it amounts to more than just a mere sum of its parts, the CJ pointed out that, as is apparent from Paragraphs 107 to 109 of the judgment, the GC correctly based its assessment as to whether

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the contested trade mark has distinctive character on the overall impression which is conveyed by the shape and the arrangement of the components of that mark, as required by the Case-Law (Para. 128).

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

Case T-257/11; Pangyrus Ltd. v OHIM, Judgment of 26 February 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Bad faith, Burden of proof, Relative grounds, Used in the course of trade, Evidence of use, Passing off, Invoices, Transfer of a trademark, Agreement, Use by another undertaking, Ownership

FACTS: The CTM holder registered the word mark COLOURBLIND as a CTM in respect of a range of goods and services in Classes 9, 16, 28, 35 and 41. The invalidity applicant sought the cancellation of the contested CTM on the grounds of Article 52 (1) (b) and Article 53 (1) (c), read in conjunction with Article 8 (4) CTMR. The Cancellation Division (CD) upheld the application for a declaration of invalidity, finding that bad faith had been established on the basis of Article 52 (1) (b) CTMR, and declared the contested trade mark to be invalid. On appeal, the Fourth Board of Appeal (BoA) annulled the CD's decision and dismissed the application for a declaration of invalidity in its entirety.

CTM
COLOURBLIND

SUBSTANCE: The General Court (GC) dismissed the appeal and confirmed the BoA's findings. Concerning the 'passing off' claim based on Article 53 (1) (c), read in conjunction with Article 8 (4) CTMR, the GC noted that the invalidity applicant had only filed two invoices, each of which concerned the sale of seven units of a learning product distinguished by the contested CTM, and that this could not prove a sufficiently significant use of the sign 'COLOURBLIND' in the course of trade by the invalidity applicant, so that the claim was dismissed. Concerning the bad faith claim based on Article 52 (1) (b) CTMR, the GC noted that it was not disputed by the parties that the 'COLOURBLIND' product consisting of an '"experimental learning" toolbox' was invented in 1991 by a physical person, a Mr C. (main shareholder and director of the CTM holder at the time of the invalidity request), who in 1993 had set up the invalidity applicant's company, Mr C. holding 99% of the latter's shares. Although Mr. C. was closely and continuously involved, from 1991 until 2003, in activities leading to the use of

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'COLOURBLIND' by the invalidity applicant first and later by another connected company, and was therefore necessarily aware of that use, such awareness on his part - noted by the GC - was not sufficient, in itself, to establish that the CTM holder (whom Mr. C. controlled) acted in bad faith. The GC dismissed the invalidity applicant's argument that Mr C.'s aim in filing the application for registration of the contested trade mark was to 'lay his hands' on the trade mark of a third party which he had had contractual or pre-contractual relations with. In that respect, the GC held that, owing to the connections between Mr C. and the invalidity applicant (the former holding in the early 90's 99% shares of the latter), the invalidity applicant could not be described as a third party in relation to Mr C. The GC also found that the main item of evidence relied upon by the invalidity applicant (a share purchase agreement) in order to argue that the rights in the contested CTM had been assigned to it by Mr. C. only contained a generic reference to 'warranties' and 'intellectual property' and that there was no mention of 'COLOURBLIND' in that agreement. The GC went on to note that, even assuming it to be established that the sign 'COLOURBLIND' was indeed covered by that agreement, all that was mentioned with regard to the invalidity applicant was its being the beneficial owner of rights in that sign, not that it had legal title to those rights The GC went on to say that, if there was an agreement between Mr C. and the invalidity applicant concerning the use of 'COLOURBLIND', it is possible that, owing to its implied or informal nature, it was not mentioned in the mentioned share purchase agreement. The GC held that, in the light of the evidence produced, it could not be excluded that Mr C. considered himself to have rights in the sign 'COLOURBLIND' up until the moment of its transfer to the CTM holder and that both the invalidity applicant and a third, connected company that had later made use of the sign were acting under an implied or informal agreement on the part of Mr C.

Case T-393/12; Kenzo Tsujimoto v OHIM, Judgment of 22 January 2015, Language of the case: EN

RESULT: Action dismissed

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

FACTS: The CTM applicant filed an application for the word mark KENZO for 'wine; alcoholic beverages of fruit; western liquors (in general)' in Class 33. The opponent relied on the earlier CTM KENZO claiming reputation for goods in Classes 3, 18 and 25. The Opposition Division (OD) dismissed the opposition stating that reputation was not proven. The Board of Appeal (BoA) upheld the appeal of the opponent.

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

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KENZO
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KENZO

SUBSTANCE: On the infringement of Article 75 CTMR, the GC dismissed the applicant's claim that the BoA had not addressed his argument to the effect that he merely wished to use his forename, Kenzo, for a certain range of goods and that this constituted due cause for the use and registration of the mark applied for. The GC held that the BoA had responded to this argument by finding that 'no due cause had been demonstrated', and that this response, although laconic, is adequate (Paras. 15-23) As regards the infringement of Article 76 (2) CTMR, the GC dismissed the applicant's claim that the BoA was wrong to have taken into account the evidence of use filed outside the substantiation period to prove reputation and failed to exercise its discretion power. The GC referred to Case C-120/12 P Rintisch v OHIM and made it clear that it is the third subparagraph of Rule 50 (1) CTMIR which must be applied in proceedings before the BoA and not Rule 20(1) CTMIR. Furthermore, the BoA exercised its discretion under Article 76 (2) CTMR to decide that it was appropriate to take that evidence into consideration and, by finding that such evidence was genuinely relevant for the purposes of assessing the earlier trade mark's reputation, provided a statement of reasons for taking that evidence into account (Paras. 26-36). As to the infringement of Article 8 (5) CTMR, the GC endorsed the BoA's finding that the evidence filed during the substantiation period together with the evidence filed to prove use clearly showed reputation of the earlier mark in a significant part of the relevant territory (Paras. 42-49). The BoA also correctly established a risk of an unfair advantage by taking into account the iconic image conveyed by the earlier trade mark (which can be transferred to other sectors, such as the wine sector) and by finding that it was highly likely that the mark applied for would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the owner (Paras. 53-58).

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Case T-505/12; Compagnie des montres Longines, Francillon SA. v OHIM; Judgment of 12 February 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Likelihood of confusion, Complex mark, Dominant element, Distinctive element, Figurative element, Dissimilarity of the goods and services, Reputation, Evidence of use

FACTS: The applicant sought to register the below figurative mark as a CTM for 'optical sunglasses' in Class 9 and 'clothing and footwear' in Class 25. An opposition was lodged, based on the earlier International figurative mark shown below, registered for 'watches, watch movements, cases, faces and bands, watchmaking materials; chronometers; chronographs; apparatus for timing sports events; pendulum clocks, pendulettes and alarm clocks; all chronometric instruments, jewellery watches, jewellery; timing installations, time display devices and panels' in Class 14. The opposition was filed on the grounds of Articles 8 (1) (b) and 8(5) CTMR. The Opposition Division (OD) dismissed the opposition in its entirety. On appeal, the Board of Appeal (BoA) confirmed the first instance's decision. The opponent filed an action before the General Court (GC) arguing an infringement of Articles 8 (1) (b) and 8(5) CTMR.

CTMA

Earlier marks

SUBSTANCE: The GC dismissed the appeal and confirmed the BoA's findings. As to the alleged infringement of Article 8(1)(b) CTMR, the GC found that the goods at issue are aimed at the general public and, as regards the goods protected by the earlier mark, also at specialist watch-making professionals. 'Optical sunglasses' and 'clothing and footwear' in, respectively, Classes 9 and 25 on the one hand and the various horological and jewellery goods on the other belong to adjacent market segments (Para. 46) and each category includes goods which are often sold as luxury goods under the famous trademarks of renowned designers and manufacturers. That fact shows that there is certain proximity between the goods at issue, in particular in the luxury goods sector (Para. 47). However, those

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goods differ in their nature, their intended purpose and their method of use (Para. 49) and they are not complementary (Para. 58). The GC held that it had not been shown that watches, other horological goods and jewellery were 'indispensable or important' for the use of clothing and footwear and vice versa in such a way that it may be held that there is aesthetic complementarity between them (Para. 69) and that consumers would consider it usual that those goods are sold under the same mark, inter alia on account of the fact that a large number of the producers or distributors of the goods are the same (Para. 70). The BoA did not err in excluding any likelihood of confusion on the sole basis of a comparison of the goods at issue (Para. 83). As to the alleged infringement of Article 8(5) CTMR, the GC held that it was apparent from the evidence provided by the opponent that its goods indeed had a significant, long-term presence, at least in some of the Member States of the European Union, in which the earlier mark is protected. However, it was apparent from the evidence that those goods were generally not, or rarely ever, marketed with the earlier mark on its own, but that they were designated by a composite mark which includes the word 'Longines' and the 'winged hourglass' element of which the earlier mark consists (Para. 101). Furthermore, it was not apparent from the evidence that consumers were accustomed to focusing on the 'winged hourglass' element in the composite mark used (Para. 103). The BoA did not err in finding that it had not been proved that the earlier mark, taken as registered, had a reputation (Para. 121). Thus, one of the basic requirements under Article 8(5) had not been met.

Case T-572/12; Nissan Jidosha KK v OHI, Judgment of 4 March 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Renewal, Principle of legal certainty, Figurative trademark, Declaration, Representative, Error by OHIM, Time limit, Grace period, Fee

FACTS: The applicant filed an application to register the figurative mark for a range of goods in Classes 7, 9 and 12. The mark was registered in respect of all those goods. When the expiry date of the registration approached, the Office informed the applicant that the mark was due for renewal. The applicant requested renewal only in respect of the goods in Classes 7 and 12.The Office therefore informed the applicant that the renewal of the mark in respect of the goods in Classes 7 and 12 had been recorded in the register of community trademarks (CTM) and that the registration in respect of the Class 9 goods had been removed from the register. Following the CTM proprietor's subsequent request that the Class 9 goods were included in the renewal of the mark, the Office refused the request and the administration of the Trademarks Division (TMD) subsequently confirmed that decision. On appeal, the First Board of Appeal (BoA) dismissed the

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appeal. In essence, the BoA found that the request for renewal of the mark in respect of the goods in Classes 7 and 12 constituted an express and unequivocal partial surrender, for the purposes of Article 50 CTMR, in relation to the goods in Class 9, which took effect vis-à-vis the proprietor of the mark at issue as soon as it was received. Not only was that surrender received, but it was also registered and the CTM proprietor notified accordingly. According to the BoA, the proprietor of the mark is bound by the declaration of surrender, which cannot be affected by the six-month grace period allowed under the third sentence of Article 47 (3) CTMR. For reasons of legal certainty, the CTM proprietor could not be allowed to reverse its decision not to renew the mark at issue in respect of certain goods.

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SUBSTANCE: The General Court (GC) dismissed the appeal and confirmed the BoA's findings. The GC found that the BoA had erred in treating the request for partial renewal as equivalent to a surrender, and that there was no evidence to support the conclusion that, as required under Article 50 CTMR, the proprietor of the CTM had declared to the Office in writing that it was surrendering the mark in respect of the Class 9 goods (Paras. 27-28). The GC noted that under the above provision claiming surrender must be declared to the Office in writing by the proprietor of the trade mark, whereas in the present case the form requesting the partial renewal had been submitted by a representative of the proprietor of the mark, and not by the proprietor itself (Para. 29). However, the GC held that that error by the BoA could not, in the circumstances of the case, result in the annulment of the BoA's decision. In that respect, the GC noted that the BoA's reasoning, although succinct, should be read in the light of the statement of reasons set out in the decision of the administration of TMD, which must also be taken into account. That decision, having been confirmed by the BoA, and its statement of reasons, form part of the context in which the BoA's decision was adopted (Paras. 32-33). The decision of the administration of TMD had clearly explained that the CTM proprietor was not entitled to the grace period, given that, during the initial period, its representative had requested renewal, and paid the related fees, in respect of two Classes only and that, consequently, the Office had renewed the registration only for those two Classes. It is clear from the wording of Article 47 (3) CTMR that the possibility of submitting a request for renewal after the expiry of the initial period is conditional on no request for renewal having been submitted during that period (Para. 38). If a request for partial renewal has been submitted before the date on which the existing registration expires and the related fees have been paid, the renewal

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takes effect from the day following that date. As of that date, the renewal has effect erga omnes (i.e. towards everyone) and, consequently, the principle of legal certainty precludes supplementation of the request for renewal after that renewal has taken effect (Para. 41).

Case T-359/12 ; Louis Vuitton Malletier v OHIM, Judgment of 21 April 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Distinctiveness acquired by use, Figurative trade mark, Shape of the products, Ornamentation, Burden of proof, Evidence of use, Catalogue, Invoice, Sales figures, Survey, Examination of facts ex officio, Principle of legality, Principle of non- discrimination, Relevant territory, Well known facts need no evidence

FACTS: The CTM holder registered the figurative mark shown below in respect of a range of goods in Class 18. The invalidity applicant sought the cancellation of the contested CTM on the grounds of Article 52(1) (a) and Article 7(1) (b), (c), (d), (e) (iii) and (f) CTMR. The Cancellation Division (CD) upheld the invalidity request on the basis of Article 7(1) (b) read in conjunction with Article 52(1) (a), and Article 7(3) read in conjunction with Article 52(2) CTMR. On appeal, the First Board of Appeal (BoA) confirmed the CD's decision. The BoA found that the chequerboard pattern, as represented in the contested trade mark, was a basic and banal feature composed of very simple elements and that it was well-known that that feature had been commonly used with a decorative purpose in relation to various goods, including those falling within Class 18. As to the claim of acquired distinctiveness, the BoA found that it had not been established that the contested trade mark had acquired distinctive character through the use which had been made of it in a substantial part of the relevant territory, namely in Denmark, Portugal, Finland and Sweden, either at its filing date or after its registration.

SUBSTANCE: The General Court (GC) dismissed the appeal and confirmed the BoA's findings. As to the issue of the inherent distinctive character of the contested mark, the GC recalled the established Case-Law relating to three-dimensional marks which consist of the appearance of the product itself and noted that it also applies to figurative marks consisting in the shape of the product concerned or a part of the shape of the product (Paras. 20-31). The GC dismissed the CTM proprietor's argument

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that consumers are accustomed to perceiving a pattern as an indication of the commercial origin of goods as irrelevant, noting that the fact that such signs are recognised as marks by consumers does not necessarily mean that they have an inherent distinctive character, as a mark may acquire distinctive character through use over time (Para. 34). The chequerboard pattern is a basic and commonplace figurative pattern which does not differ from the norm or customs of the sector inasmuch as such goods are generally covered with fabrics of different kinds, and the chequerboard pattern, due to its great simplicity, might constitute precisely one of those patterns (Para. 37). The chequerboard pattern is one that has always existed and has been used in decorative arts, which have an indisputable link with the goods in Class 18 (Para. 38). The juxtaposition of a chequerboard and of a weft and warp pattern does not give rise to any element that diverges from the norm or customs of the sector concerned (Para. 41). As regards the applicant's submission that other signs similar to the contested mark have been registered as Community trademarks, the GC recalled the established Case-Law to the effect that the principles of equal treatment and sound administration must be consistent with respect for legality (Paras. 47-51). Concerning the CTM proprietor's argument that it is for the invalidity applicant to rebut the presumption of validity of the mark and that the BoA could not legitimately rely on its own 'general experience' in order to rebut the above presumption, the GC held that the BoA's finding that the chequerboard pattern was a basic and banal figurative feature composed of very simple elements was a well-known fact which was corroborated by the evidence filed by the invalidity applicant (Paras. 61-64), so that the BoA had not infringed the rules on the burden of proof. As to the claim of acquired distinctiveness through use, the GC recalled the settled Case-Law to the effect that for Article 7(3) CTMR to be successfully invoked it is necessary to establish the acquisition of distinctive character through use in all the territory in which the mark did not, ab initio, have such character (Para. 85), in this case the whole of the EU. The GC added, referring to the previous judgment, that it would be Paradoxical to accept, on the one hand, that a Member State has to refuse to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other hand, that that same Member State has to respect a Community trade mark relating to that sign for the sole reason that it has acquired distinctive character in the territory of another Member State (Para. 86). The CTM proprietor failed to demonstrate that the contested mark had acquired distinctive character in consequence of the use that had been made of it in Denmark, Portugal, Finland and Sweden (Paras. 101-117).

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Case T-360/12; Louis Vuitton Malletier v OHIM, Judgment of 21 April 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Distinctiveness acquired by use, Figurative trade mark, Shape of the products, Ornamentation, Burden of proof, Evidence of use, Catalogue, Invoice, Sales figures, Survey, Examination of facts ex officio, Principle of legality, Principle of non- discrimination, Relevant territory, Well known facts need no evidence

FACTS: The CTM proprietor registered the figurative mark shown below in respect of a range of goods in Class 18. The invalidity applicant sought the cancellation of the contested CTM on the grounds of Article 52(1) (a) and Article 7 (1) (b), (c), (d), (e) (iii) and (f) CTMR. The Cancellation Division upheld the invalidity request on the basis of Article 7(1) (b) read in conjunction with Article 52(1) (a), and Article 7(3) read in conjunction with Article 52(2) CTMR. On appeal, the First Board of Appeal (the BoA) confirmed the CD's decision. The BoA found that the chequerboard pattern, as represented in the contested trade mark, was a basic and banal feature composed of very simple elements and that it was well-known that that feature had been commonly used with a decorative purpose in relation to various goods, including those falling within Class 18. As to the claim of acquired distinctiveness, the BoA found that it had not been established that the contested trade mark had acquired distinctive character through the use which had been made of it in a substantial part of the relevant territory, namely in Bulgaria, Denmark, Estonia, Latvia, Lithuania, Malta, Poland, Portugal, Slovenia, the Slovak Republic, Finland and Sweden, either at its filing date or after its registration.

SUBSTANCE: The GC dismissed the appeal and confirmed the BoA's findings. As to the issue of the inherent distinctive character of the contested mark, the GC recalled the established Case-Law relating to three-dimensional marks which consist of the appearance of the product itself and noted that it also applies to figurative marks consisting in the shape of the product concerned or a part of the shape of the product (Paras. 20-31). The GC dismissed the CTM proprietor's argument that consumers are accustomed to perceiving a pattern as an indication of the commercial origin of goods as irrelevant, noting that the fact that such signs are recognised as marks by consumers does not necessarily mean that they have an inherent distinctive character, as

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a mark may acquire distinctive character through use over time (Para. 34). The chequerboard pattern is a basic and commonplace figurative pattern which does not differ from the norm or customs of the sector inasmuch as such goods are generally covered with fabrics of different kinds, and the chequerboard pattern, due to its great simplicity, might constitute precisely one of those patterns (Para. 37). The chequerboard pattern is one that has always existed and has been used in decorative arts, which have an indisputable link with the goods in Class 18 (Para. 38). The juxtaposition of a chequerboard and of a weft and warp pattern does not give rise to any element that diverges from the norm or customs of the sector concerned (Para. 41). As regards the CTM proprietor's submission that other signs similar to the contested mark have been registered as Community trademarks, the GC recalled the established Case-Law to the effect that the principles of equal treatment and sound administration must be consistent with respect for legality (Paras. 47-51). Concerning the CTM proprietor's argument that it is for the invalidity applicant to rebut the presumption of validity of the mark and that the BoA could not legitimately rely on its own 'general experience' in order to rebut the above presumption, the GC held that the BoA's finding that the chequerboard pattern was a basic and banal figurative feature composed of very simple elements was a well-known fact which was corroborated by the evidence filed by the invalidity applicant (Paras. 61-64), so that the BoA had not infringed the rules on the burden of proof. As to the claim of acquired distinctiveness through use, the GC recalled the settled Case-Law to the effect that for Article 7 (3) CTMR to be successfully invoked it is necessary to establish the acquisition of distinctive character through use in all the territory in which the mark did not, ab initio, have such character (Para. 85), in this case the whole of the EU. The GC added, referring to a previous judgment, that it would be Paradoxical to accept, on the one hand, that a Member State has to refuse to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other hand, that that same Member State has to respect a Community trade mark relating to that sign for the sole reason that it has acquired distinctive character in the territory of another Member State (Para. 86). The CTM proprietor failed to demonstrate that the contested mark had acquired distinctive character in consequence of the use that had been made of it in Bulgaria, Denmark, Estonia, Latvia, Lithuania, Malta, Poland, Portugal, Slovenia, the Slovak Republic, Finland and Sweden (Paras. 101-117).

Case T-581/13; The Royal County of Berkshire Polo Club Ltd. v OHIM, Judgment of 26 March 2015, Language of the case: EN

RESULT: Action partially upheld (BoA decision partially annulled)

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KEYWORDS: Relative grounds, Likelihood of confusion, Common element, Dominant element, Distinctive element, Enhanced distinctiveness, Figurative element, Similarity of the signs, Visual similarity, Phonetic similarity, Conceptual similarity, Identity of the goods and services, Purpose of the goods and services, Statement of grounds, Lack of reasoning

FACTS: The applicant sought to register the below figurative mark as a CTM for a range of goods in Classes 9, 14, 18 and 25. An opposition was lodged, based on the earlier figurative mark shown below, registered for goods falling within, inter alia, Classes 9, 14, 18 and 25. The opposition was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) dismissed the opposition in its entirety. The Board of Appeal (BoA) partially annulled the OD's decision and rejected the contested mark for all the goods of Classes 9, 14, 18 and 25, while rejecting the opposition in respect of the goods in Classes 16 and 28. Importantly, the BoA held that the image of the polo player, and the words 'polo club', in the two signs in question had an inherent enhanced distinctiveness in relation to the goods in Classes 9, 14, 18 and 25 covered by the signs. The applicant filed an action before the General Court (GC) arguing an infringement of Articles 8 (1) (b) and 75 CTMR.

CTMA

Earlier CTMs

SUBSTANCE: Concerning in first place the applicant's claim that the statement of reasons for the BoA's decision was inadequate, due to an alleged lack of clarity as regards the finding that the level of attention of the average EU consumer of the relevant goods at issue is normal, the GC held that that the BoA had provided sufficient reasons, and clarified that if the reasons given are vitiated by errors, those errors will vitiate the substantive legality of the decision, but not the statement of reasons, which may be adequate even though it sets out reasons which are incorrect (Para. 23). As to the merit of the case, the GC confirmed that the level of attention of the relevant public is normal (Para. 35) and that the goods covered by the marks at issue and falling within Classes 9, 14, 18 and 25

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are identical (Para. 37). The BoA's finding relating to the enhanced inherent distinctiveness of the image of a polo player and the words 'polo club' cannot be upheld in its entirety: in that respect, the GC held that that image and those words have (i) weak inherent distinctiveness in relation to 'whips, harness and saddlery' in Class 18, given their close connection to the playing of polo; (ii) normal inherent distinctiveness in relation to 'articles of clothing, footwear and headgear' in Class 25, given that they can be used for polo playing, although there is nothing in their description to the effect that they relate to goods specifically designed for that purpose; (iii) inherent distinctiveness which is more enhanced, and at the very least normal, in relation to the other goods in Classes 9, 14 and to 'leather goods; imitation leather goods; trunks, travel bags, umbrellas, Parasols, walking sticks' in Class 18, given that they have no connection with the playing of polo (Para. 49). As to the comparison of the signs, the GC upheld the BoA's conclusion that there is some visual similarity between the signs finding that they both display the figure of a polo player astride a galloping horse and that the images of the polo player occupy a central position in each of the signs (Paras. 54-55). The aural similarity is relatively low, and the signs have a high degree of conceptual similarity, in so far as each refers to a polo club and displays a device of a polo player, and those devices are similar (Paras. 53-68). However, given that, when assessing the similarity of signs, account must be taken of their distinctive and dominant components, the overall similarity of the signs is lower where the marks are used in relation to 'whips, harness, saddlery' in Class 18 (Para. 73). With regard to the goods not directly related to polo playing, the BoA was right in concluding that there was a likelihood of confusion in the mind of the relevant public, whose level of attention is not particularly high (Paras. 78-79). With regard to 'whips, harness and saddlery' in Class 18, the similarity between the signs at issue is reduced significantly by the fact that their common elements have low inherent distinctiveness in relation to those goods, and the earlier marks must be regarded as having a low inherent distinctiveness in relation to those goods (Paras. 82-83). Since these goods are more likely to be purchased by the relevant public with the help of a specialised seller with whom the purchaser may speak, with the result that the aural similarity of the signs — which, in the present case, is relatively weak — will gain in importance, there is no likelihood of confusion in relation to 'whips, harness, and saddlery' (Paras. 84-85).

Case T-384/13; Intermark Srl. v OHIM, Judgment of 18 March 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Relative grounds, Descriptive element, Reputation, Complex mark, Similarity of the signs, Likelihood of confusion, Identity of the goods and services, Visual similarity, Phonetic similarity, Conceptual similarity

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FACTS: The applicant sought to register the mark displayed underneath for goods and services in Class 32 and 35. The opponent filed an opposition based on the earlier marks displayed underneath, registered, inter alia, for goods and services in Class 32 and 35. The opposition was based on the grounds of Article 8 (1) (b) and Article 8(5) CTMR. The Opposition Division (OD) upheld the opposition in its entirety. The Board of Appeal (BoA) dismissed the appeal, finding, in essence, that there was a likelihood of confusion (Article 8 (1) (b) CTMR), given the reputation of the earlier marks for the goods in Class 32, the identity of the goods and services and the similarity of the signs at issue. It also took the view that it was not necessary to analyse Article 8 (5) CTMR. The CTM applicant brought an action before the General Court (GC), putting forward a single plea in law, alleging infringement of Article 8 (1) (b) CTMR.

CTMA

Earlier CTMs

1)

2) COCA-COLA

SUBSTANCE: The GC pointed out at the outset, that, due to its size and position, the element "COLA" is the dominant element in the contested CTMA and the further element "Rienergy" plays a subsidiary - even though not negligible - role (Para. 34). Even though "COLA" might be descriptive for some beverages made from cola nuts, it is not descriptive for the services in Class 35. The weak distinctive character of an element of a composite mark does not necessarily imply that that element cannot constitute a dominant element, since it may, inter alia, because of its position in the sign or its size, make an impression on consumers and be remembered by them (Para. 35). Within the earlier marks, the element "COLA" is a non-negligible, or even a distinctive element. With regard to the visual comparison between the CTMA and the earlier figurative mark, the BoA, inter alia was right

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to find a certain degree of similarity. Phonetically, there is a degree of similarity, even if the contested marks´ element "Rienergy" will be pronounced by the relevant public. Conceptually, the word "COLA", common to the signs at issue, may be understood as referring to cola nuts. In that sense, there is a conceptual convergence. The additional, subsidiary word "Rienergy" in the CTMA is a "fantasy word", which is not able to weaken the conceptual similarity. The marks are similar overall (Paras. 40-43). With regard to a likelihood of confusion it must be borne in mind that the earlier figurative mark enjoys a reputation in respect of some goods in Class 32, especially, when it is depicted in its Classic white cursive script on a red background. Consequently, the assessment must take into account not only the fact that the dominant element in the CTMA reproduces one of the two word elements in the earlier mark, but also that this word element is depicted in white cursive script on a red background. Taking further account of the fact that the goods are identical, a likelihood of confusion exists (Paras. 44, 45). With regard to the earlier word mark, a likelihood of confusion cannot be ruled out for the same reasons, even though the similarities between the signs are visually less significant and the relevant public for the services in Class 35 consists of professionals. It has to be taken into account in this context that the word element "COLA", common to both marks, is the dominant element in the CTMA and is a distinctive element in the earlier mark for the services in Class 35. There is a certain degree of phonetic and conceptual similarity between the signs. Additionally, the services at issue are identical. Therefore, a likelihood of confusion in respect of the services in Class 35 exists (Para. 45).

Case T-580/13; Real Express SRL. v OHIM, Order of 21 April 2015, Language of the case: EN.

RESULT: Action dismissed

KEYWORDS: Admissibility, Relative grounds, Figurative trademark, Request for proof of use, Substantiation of earlier right, Time limit, New evidence, Clarity of party submission, Ownership, Name, Infringement, Competence of the Boards, Substantial procedural violation, Suspension of the proceedings, Right to be heard, Fax, Fee

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods and services in Classes 3 and 35. An opposition based on two earlier Romanian figurative marks, registered for goods and services in Classes 3 and 35, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) dismissed the opposition under Rule 20(1) CTMIR, noting that the opponent had not proven its entitlement as the owner of the earlier marks. The notice of opposition was filed in the name of Real Express, whereas the extracts from the Romanian Trade Mark Office (OSIM) and their English translations filed by the opponent showed

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that the earlier Romanian marks were registered in the name of SC Unibrand SRL. The OD held that the opponent had not provided any evidence regarding the change of the opponent's name emanating from the official source confirming that the change of name of the trade marks owner has been indeed registered or that OSIM has accepted as admissible the request for a change of name. Almost a month after the notification of the opposition decision and 8 months after the expiry of the time-limit to substantiate the opposition, the President of the Office received a fax from OSIM (fax of 16 July 2012) confirming that the proprietor of the earlier marks was Real Express as from June 2011. The Board of Appeal (BoA) dismissed the opponent's appeal, holding that Rule 20(1) in conjunction with Rule 19 CTMIR prevented it from exercising the discretion provided for in Article 76(2) CTMR and the relevant Case-Law.

CTMA

real.-

Earlier Mark/Sign

SUBSTANCE: The opponent raised infringements regarding essential procedural requirements and procedural rules. Most of the arguments raised by the opponent were rejected by the General Court (GC) as manifestly inadmissible on the ground that they lack clarity and coherence and that, consequently, they fail to satisfy the minimum requirements set out in Article 44(1)(c) (Para. 34). The remaining arguments of the opponent that met those minimum requirements were rejected as manifestly unfounded (Para. 37). According to the GC, the BoA did not find, in Paragraph 15, that the applicant had submitted the documents out of time but that those documents did not correspond to the required documentation from the administration by which the marks had been registered, on the ground that they did not serve to confirm the changes of name of the proprietor (Para. 38). The mere fact that the Office accepted the opposition fee, processed the requests for proof of use and suspended the opposition proceedings is not, on its own, sufficient for a finding that the Office accepted that Real Express was the proprietor of the earlier marks (Paras. 39 and 40). As to the opponent's argument that the proceedings were suspended without the opponent being given the opportunity to make its views known, the Office suspended the proceedings, in accordance with Rule 20(7) and Rule 21(2) CTMIR, on account of national proceedings against the opposition marks in Romania. Neither of those rules imposes an obligation on the Office to hear the parties before suspending the proceedings

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(Para. 41). The argument of the opponent that the decision of the OD was given while the proceedings were suspended is manifestly unfounded since the opponent was informed by the Office that the opposition would be rejected since it had failed to substantiate the earlier marks relied on in support of its opposition, which necessarily implied that the proceedings had been resumed (Para 42). Lastly, the GC also denied an infringement of Article 63(2) and Article 64(I) and (2) CTMR. The opponent did have the opportunity to present, before both OD and BoA, the facts and evidence concerning its entitlement to file the opposition, in accordance with the first provision, and, secondly, BoA did examine the entitlement issue, in accordance with the second provision (Para. 43). For the sake of completeness, the GC points out that, even if that mere assertion ought to have been interpreted as a complaint by the opponent that BoA failed to take the fax of 16 July 2012 into account, in disregard of Article 76(2) CTMR and Rule 20(1) CTMIR, it would have had to be dismissed for the same reasons as those upheld in the case C-120/12 P, Rintisch v OHIM (Para. 44). The BoA in essence took the view that Rule 20(1) CTMIR constituted a provision to the contrary for the purposes of Article 76(2) CTMR and that, consequently, it had no discretion to take the fax of 16 July 2012 - submitted by the applicant in order to establish ownership of the earlier marks - into account. In doing so, the BoA erred in law. Nevertheless, for the same reasons as those upheld in Paragraphs 36 to 41 of the judgment Rintisch v OHIM, the grounds set out by the BoA in Paragraph 20 of the contested decision are, in any event, capable of remedying the defect vitiating the contested decision, inasmuch as they permit the inference that the BoA actually exercised its discretion under Article 76(2) CTMR, for the purposes of deciding, in a reasoned manner and having regard to all the relevant circumstances, whether it was necessary to take into account the evidence submitted to it late, in order to give its decision (Para. 45).

Case T-587/13; Miriam Schwerdt v OHIM; Judgment of 21 January 2015; Language of the case: DE
RESULT: Action dismissed

KEYWORDS: Common element, Distinctive element, Dominant element, Figurative trade mark, General principles of law, Identity of the goods and services, Likelihood of confusion, Phonetic similarity, Relevant territory, Relative grounds, Visual similarity

FACTS: The applicant sought to register the figurative mark represented below as a CTM for goods within Class 31. An opposition based on the earlier Spanish word mark 'Clean Cat', registered for goods in Class 31, was filed on the grounds of 8 (1)(b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant's appeal finding a likelihood of confusion between the marks. According to the Board, the

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goods were identical; the signs were visually and phonetically similar, despite the occurrence of the figurative element the CTMA and the different order of the words. Except for the Spanish consumers, the marks shared the same concept. The opponent filed an action before the General Court (GC).

CTMA

Earlier mark

CLEAN CAT

SUBSTANCE: In respect of Article 8(1) (b) CTMR, the GC recalled that if the mark is composed of verbal and figurative elements, the verbal elements prevail (Para. 24). The marks were found visually similar. The verbal elements in the contested mark are not negligible; to the contrary, they are highly visible. The two word elements are identical. The inversion of the words itself as well as the presence of element '&' in the CTMA cannot lead to absence of visual similarity. Taking into account the goods at issue, the distinctiveness of the representation of a cat is weak (Paras. 25-27). The GC finds also a certain level of phonetic similarity. Even though the pronunciation defers because of the inversion of the word elements and the presence of '&', two out of free verbal elements in the CTMA are identical with the sole two elements of the earlier mark (Para. 29). The marks share the same concept, except for the non-English speaking Spanish public for which no common concept exists (Para. 31). The marks are therefore globally similar, even in case that no conceptual similarity is found. There is a likelihood of confusion (Paras. 32-33). In regards of the distinctive character of the earlier mark, the GC recalls that it is only one of the factors to be taken into account and even in case of a weak distinctiveness of the earlier mark, there still can exist the likelihood of confusion (Para. 36). As regards Articles 29 and following TFEU (Treaty of the Functioning of the European Union) a certain level of distinctiveness is recognised to the earlier national mark invoked in CTM opposition proceedings (Para. 43). The validity of registration of an earlier national mark cannot be contested within the CTM registration procedure (Para. 46). The interest of the CTM legislation is to enable the owners of earlier mark to oppose the registration of later marks which are taking an unfair advantage of the distinctive character of the earlier. Thus, far from granting an unjustified monopoly to the owners of the earlier marks, the regime enables them to protect and enhance the substantial investment made to promote the earlier mark (Para. 48). As regards Articles 16 and 20 of the Charter (of Fundamental Rights of the EU), the freedom to conduct a business does not constitute an absolute

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right, however, must be considered in relation to its function in society. It may be subject to a wide range of interventions of public authority in order to establish limits which are in public interest, such as in case of intellectual property (Paras. 54-56).

Case T-717/13; Chair Entertainment Group LLC v OHIM, Judgment of 29 April 2015, Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Beginning of mark, Common element, Conceptual similarity, Distinctive element, Likelihood of confusion; Phonetic similarity, Relative grounds, Relevant public, Similarity of goods and services, Similarity of signs, Visual similarity, Weak element, Nice Classification, Communication of the President

FACTS: The applicant sought to register the word mark SHADOW COMPLEX as a CTM for goods in Class 9. An opposition based, inter alia, on the earlier Community word mark BusinessShadow registered for goods and services in Classes 9 and 42, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the opposition and the Board of Appeal dismissed the appeal.

CTMA
SHADOW COMPLEX
Earlier mark
BusinessShadow

SUBSTANCE: The General court confirmed the existence of likelihood of confusion between the conflicting marks. The contested goods 'computer game software for personal computers and home video games consoles' are not only directed at a young public, but at the general public of the EU (Para. 26). The degree of attention is normal and not higher (Para. 27). The heading of the Class 9 goods covered by the earlier mark, 'computer software (recorded)', is sufficiently clear and precise (Para. 33). The approach taken in Communication No 2/12 is intended to draw the appropriate conclusions from the IP Translator judgment and is not contrary to the principles of the said judgment as claimed by the applicant (Para. 37). The goods covered by the earlier mark include those covered by the contested application (Para. 38). The general public will not understand the earlier mark BusinessShadow as being a single word but will recognize in it at least the term 'business' signifying economic activity (Para. 43). 'Business' and 'complex' are weak in relation to

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the goods in question for a large part of the relevant public (Para. 45). 'Shadow', meaning 'comparative darkness,' is the most distinctive element of each mark (Para. 47). Since both marks contain 'shadow', they are visually similar to an average and not only to a low degree (Para. 49). Phonetic similarity is low since the common element occupies a different position in each of the marks (Para 52). The marks are conceptually similar for the part of the public understanding the word 'shadow' (Paras. 55 and 57). The general public will not understand 'shadow' in the technical meaning of 'shadow copy' (Para. 56). Given the identity of the goods and that the element 'shadow' is the most distinctive part of each mark, a likelihood of confusion exists at least for the English-speaking part of the EU.

Case T-72/14; Compagnie des bateaux mouches SA v OHIM, Judgment of 26 March 2015, Language of the case: FR

RESULT: Action dismissed

KEYWORDS: International mark, Absolute grounds, Distinctive element, Distinctiveness acquired by use, Specialized public, General reference to previous submissions, Relevant language

FACTS: The applicant sought to register the verbal mark BATEAUX MOUCHES (fly boats) for services in Class 37 and designated the EU in an international registration. The examiner refused to register the sign as a CTM on the basis of Article 7 (1) (b) and (c) CTMR. The Board of Appeal (BoA) dismissed the applicant's appeal. The applicant filed an action before the General Court (GC).

CTMA

BATEAUX MOUCHES

SUBSTANCE: On Article 7 (1) (b), The GC confirmed the analysis of the contested decision in relation to the relevant public and held that the services of Class 37 are addressed to a professional public who has a high level of attention. It confirmed also that since the sign being in French it was the professional French speaking public to be the relevant public and not all foreign tourists as argued by the applicant (Paras. 27 and 29). The GC also confirmed the meaning of the term "bateaux mouches" and his previous judgments on this point (see T-365/06, judgment of 10 December 2008 EU:T:2008:559 and T-553/12 judgment of 21 May 2014 EU:T:2014:264). The fact that the company is the first to have used the term "bateaux mouches" as a mark does not change this finding. As regards Article 7 (1) (c), the GC confirmed the conclusion that was reached by the BoA that one ground is enough to justify the refusal of the mark. On the application of Article 7 (3) the GC held that the BoA correctly assessed the

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existence of distinctiveness acquired by use and could refuse the evidence filed by the applicant as it did not demonstrate such acquired distinctiveness. The GC noted that most of the documents produced to show acquired distinctiveness were those filed by the applicant to demonstrate the acquired distinctiveness for the services of Class 39, 41 and 43 in the previous cases before the GC (Para. 70). The fact that the applicant succeeded to obtain registration on the basis of Article 7 (3) for services in Classes 39, 43 and 41 (CTM 010270321) for the verbal sign BATEAUX MOUCHES did not have an effect on the claim for services in Class 37 (Para. 78).

Case T-188/14; Grundig Multimedia AG v OHIM; Judgment of 21 January 2015; Language of the case: EN

RESULT: Action dismissed

KEYWORDS: Absolute grounds, Characteristics of the goods and services, Descriptive element, General principles of law, Principle of legality, Purpose of the goods and services, Quality of the goods and services, Relevant territory

FACTS: The applicant sought to register the word mark GentleCare as a CTM for goods and services within Class 7. The examiner refused to register the word as a CTM based on Article 7 (1) (b) and (c) CTMR with respect to part of the goods covered by the CTMA, namely "machines for manufacturing, treating, scotching, tentering or washing fabrics, sewing machines and industrial robots with the same function as the machines referred to above; washing machines (laundry/dishwashing machines); electrical machines for cleaning floors and carpets, vacuum cleaners and their parts". The Board of Appeal (BoA) dismissed applicant's appeal on the ground that the trade mark applied for was descriptive and devoid of any distinctive character. According to the BoA, the relevant public consisted of English speaking consumers in EU. The trade mark was composed of 2 words with clear meaning in English. The characteristics described by the expression 'gentle care' were desirable with respect to the goods at issue, since the primary functions of the machines it designates are enhanced by the fact that they are carried out in a gentle manner. The applicant filed an action before the General Court (GC).

CTMA
GentleCare

SUBSTANCE: In regards of the first plea in law alleging an infringement of Article 7 (1) (c) the GC notes that the BoA correctly identified the English-speaking public as the relevant public, since the two words of the trade mark applied for are English (Para. 22). The meaning of each of the words

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making up the expression "gentle care" is clear and the juxtaposition of those two words is not particularly surprising or unusual (Para. 23). Textiles, dishes, carpets and internal floors are, both at the stage of their manufacture and their maintenance, the subject of particular 'care' requiring a certain gentleness or attention. Thus, the public will expect the machines at issue to be capable of ensuring such care (Para. 25-26). A direct connection between the expression 'gentle care' and the goods at issue has been therefore established (Para. 30). Next, for application of Article 7(1) (c), it is irrelevant whether the characteristics of the goods or services which are capable of being described by a sign are commercially essential or ancillary (Para. 31). The expression 'gentle care' is not allusive but, on the contrary, contains direct information about the way the goods at issue operate (Para. 35). Further, contrary to the applicant's arguments, the Office is not obliged to prove that the sign for which registration as a CTM is sought is included in dictionaries. It is sufficient that the BoA applied the descriptiveness test, as interpreted by the Case-Law, in order to reach its decision and it was not obliged to justify its action by the production of evidence (Para. 41). Finally, the principles of equal treatment and sound administration must be consistent with respect for legality. For reasons of legal certainty and sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Since the examination of the sign at issue in the light of that provision could not, in itself, lead to a different conclusion, the applicant's claims of a failure to take into consideration the registration of identical trademarks cannot succeed (Paras. 41-44). Based on the foregoing, the sign at issue was found descriptive. Since the application of one of the absolute grounds for refusal suffices for the sign at issue not to be registrable, it was not necessary to examine the second plea in law – infringement of Article 7(1) (b) (Paras. 46-47).

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Decision of the Second Board of Appeal of 24 March 2015 in case R1536/2014-2 (EN)

Procedural issues – Article 29(1) CTMR, priority claim, lack of identity

The applicant sought to register the figurative mark

GranBio

for goods and services in Classes 1, 4, 35, 36, 39, 40 and 42 and claimed priority of several Brazilian trade marks all for the figurative mark

GranBio

The examiner refused the priority claim on the basis of the lack of identity between the signs in accordance with Article 29(1) CTMR.

The applicant appealed the examiner´s decision.

The Board found that it was true that there were differences in the black and greyscale in various components of the signs at issue. However, even if the examiner were correct that all the contrasted parts of the marks presented deviations that could not be attributed to printer settings or quality, these differences would only be perceived by a reasonably observant consumer upon a side by side examination of the marks. Therefore, the Board considered that these differences between the marks in the case at hand were insignificant. Consequently, the Board saw no reason to refuse the priority claim on the basis of the marks being different.

The Board upheld the appeal and annulled the contested decision.

Decision of the First Board of Appeal of 26 February 2015 in case R1649/2013-1 (FR)

Request for conversion – cancellation by national court

The applicant was granted the registration of its Community word mark 'EXCEL' for goods and services in Classes 6, 7 and 40.

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A declaration of invalidity against the CTM was filed before the High Court (Tribunal de grande instance) of Paris, as a counterclaim, in infringement proceedings pending before that court. The Court of Appeal (Cour d'appel) of Paris confirmed the judgment of the High Court of Paris, cancelling the CTM concerned.

The Registry of OHIM informed the applicant that the OHIM had registered the invalidity of the CTM on 17 January 2013.

On 26 February 2013, the applicant filed an application for conversion of its cancelled CTM into a national trade mark with the Office. On 10 April 2013, the Registry notified the applicant of certain deficiencies in the application that prevented the conversion request. The Registry, among others, claimed that the application for conversion had not been filed within the period of three months from the date on which the judgment of the Court of Appeal of Paris had acquired the authority of a final decision. Therefore, the request for conversion was refused.

The applicant filed a notice of appeal against the above decision.

The Board found that in the case of a conversion request, it was up to the party requesting conversion to assist in the determination of the relevant starting point (the decision had become final under national law) for the three-month deadline.

The Board dismissed the appeal.

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Decision of the Second Board of Appeal of 31 March 2015 in case R1726/2014-2 (EN)

Procedural issues – Article 112(6) CTMR

The word mark 'GIGI' was registered for goods in Class 3. On 30 July 2013, on the basis of a well-founded declaration of invalidity, the registration was declared invalid by the Cancellation Division. On 30 October 2013 the appellant was notified that the decision of the Cancellation Division had become final.

On 30 January 2014, the appellant filed a request for the conversion of its mark 'GIGI' with the Office.

The examiner refused the conversion request based on Rule 45(1) CTMIR claiming that the request was inadmissible as it had not been made within the relevant time-limit. This three-month period ran from the decision taken on 30 July 2013 terminating the Community trade mark and was calculated according to Rule 70(4) CTMIR.

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The applicant appealed the examiner´s decision claiming that under Article 112(6) CTMR the request for conversion had to be filed within three months after the date on which that decision acquired the authority of a final decision. As a result of the Office's letter of 30 October 2013, the deadline within which to file an application for conversion of the CTM to national trade marks was amended on the appellant's representative docketing system to 30 January 2014. The original docket date of 30 December 2013 was changed to 30 January 2014 only as a result of this letter from the Office.

The Board noted that the appellant argued that the decision as mentioned in Article 112(6) CTMR must have acquired the 'authority of finality' which was not the same as becoming final; a separate act was needed from the mere passing of the last day in which to file an appeal. The Board did not agree. Since Article 108(6) CTMR (now Article 112(6) CTMR) entered into force and in which the provisions concerning Office and Court decisions were joined, in the circumstances as in the case at hand, the period of three months for requesting a conversion started automatically once the decision had become final or acquired the authority of a final decision. From this date, 10 March 2004, no additional or separate act was needed from the mere passing of the last day in which to file an appeal. Therefore, it was from the day after the time-limit to file an appeal expired that the three-month period, as established in Article 112(6) CTMR, started to run. The conversion request was submitted on 30 January 2014, and thus, well outside the set time-limit of 2 January 2014, and therefore, had to be rejected.

The Board dismissed the appeal and ordered the reimbursement of the conversion fee to the appellant, if it had been paid.

Decision of the First Board of Appeal of 18 March 2015 in case R118/2014-1 (EN)

Absolute grounds for refusal – Article 7(1)(b) CTMR – well-known titles of books

The applicant sought to register the word mark 'THE JUNGLE BOOK' for goods and services in in Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 29, 30, 32 and 41.

Third-party observations were filed claiming that 'THE JUNGLE BOOK' was the title of a famous collection of fictional stories written by Rudyard Kipling (1865-1936) at the end of the 19th century and should not be registrable under Article 7(1)(b), (c) and (d) CTMR.

The examiner refused the registration of the mark based on Article 7(1)(b) CTMR stipulating that 'THE JUNGLE BOOK' belonged to the category of famous story or book titles. It was a story that was long established and well known and it had 'entered into the English language' as a reference to a story

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that was so universally known that this knowledge eclipsed any possible trade mark understanding of it.

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

The Board concluded that THE JUNGLE BOOK was primarily well-known as the title of a collection of stories by the English author Rudyard Kipling and also the title, as such or under different variations, of numerous adaptations in books, films and television series. The sign applied for lacked inherent distinctive character. The relevant public would instantly understand it as providing some kind of information relating to the goods or services which could have that story as their subject-matter (e.g. recording discs; cinematographic films, exposed films; audio discs; printer matter; baby books; books; entertainment services; amusement park and themed park services) or a claim indicating a genre which always related or adapted the life stories of young humans succeeding on their own in the wilderness, and not as indicating the commercial origin of those goods and services (see also R1856/2013-2 Pinocchio).

The Board dismissed the appeal.

Decision of the Second Board of Appeal of 15 April 2015 in case R1877/2014-2 (EN)

Absolute grounds for refusal – Article 7(1)(b), (c) and 7(2) CTMR – minimum degree of distinctiveness

The applicant sought to register the word mark 'YO. TV' for services in Classes 35, 38 and 41.

The application was refused pursuant to Article 7(1) (b), (c) and 7(2) CTMR.

The applicant appealed the decision.

The Board found that the abbreviation 'YO' in Finnish was commonly used to refer to the term 'ylioppilas'. However, the term 'ylioppilas' did not refer to students in general, but was rather a title that was achieved by a student in Finland by passing specific exams, that was, the so-called 'ylioppilaskoe' after finishing secondary education. In addition, the term 'ylioppilas' was used when referring to a student of a specific faculty, for example 'oikeustieteen ylioppilas' (student of the law faculty), but was not usually used on its own to refer to students in general. The word that was normally used for students in general was 'opiskelija'. While it was true that 'business services' could be provided to students, it was entirely unclear as to which characteristics of business services 'YO. TV' could describe. The argument that consumers would perceive 'YO.TV' as descriptive for 'business services' because there could be something within

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the nature of the business services relating to student television appeared far-fetched, especially as the word 'ylioppilas' was not usually used on its own to refer to students in general. In relation to the services for which registration was sought in Classes 38 and 41, namely, the provision of applications providing access to listings and guides about the ultimate television programmes being broadcast, it was difficult to see how descriptive content would be grasped immediately by consumers. The message that the mark might have transmitted was somewhat alien and strange, not exactly clear and the potential consumer would be puzzled in trying to make any sense out of it. Even if it were interpreted as 'ylioppilas televisio', the expression 'YO.TV', was fanciful and did not immediately inform the relevant public about the characteristics of the services applied for, but required at least certain mental steps, in order to render that expression meaningful. In the Board's opinion, it was just as possible, if not even probable, that the relevant public in Finland, who generally had a rather high level of knowledge of English, would associate the element 'YO' as the English slang word with the meaning 'hello', rather than think of a specific title that a student may have. In the case of 'YO.TV' there was no sufficiently direct and specific relationship between the sign and the services in issue to enable the public concerned immediately to perceive, without further thought, a description of the services in question or one of their characteristics. The Board considered that the mark 'YO.TV' as a whole had at least a minimum degree of distinctive character.

The Board upheld the appeal and annulled the contested decision.

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Decision of the Second Board of Appeal of 21 April 2015 in case R654/2014-2 (EN)

Relative grounds - Article 8(1)(b) CTMR – dissimilarity

The applicant sought to register the word mark 'McGYM' for goods and services in Classes 25, 28, 32 and 41.

The mark applied for was opposed pursuant to both Article 8(1)(b) and 8(5) CTMR on the basis of a number of earlier marks owned by McDonald's. The Opposition Division partly upheld the opposition under both provisions based on the earlier mark 'McDONALD'S' and rejected the CTM application for goods and services in Classes 25, 28, 32 and 41.

The applicant requested the annulment of the aforesaid Opposition Division's decision.

The Board recognised that 'McDONALD'S' was a famous brand name used on certain fast foods and fast-food outlets and cited various judgments and decisions of the Office to this effect. It also

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recognised the enhanced distinctiveness enjoyed by the prefix 'Mc' to a 'family of marks' in e.g. 'McFISH' (Classes 29 and 30), 'McTOAST' (Classes 29, 30 and 43), 'McMUFFIN' (Classes 29, 30 and 43), 'CHICKEN McNUGGETS'(Class 29), 'McCHICKEN' (Class 30) and 'McRIB (Classes 29 and 30), 'McFLURRY' (Class 29). Nevertheless, in analysing the marks in the context of Article 8(1)(b) CTMR, the Board stated that the enhanced distinctiveness of 'Mc' only operated in the field of fast-food products and services. However, that was not applicable in this instance, since these were not the goods at issue. The signs were also found to be visually, phonetically and conceptually dissimilar. Therefore, despite the identity and similarity of some of the conflicting goods, there could be no risk of confusion. The Board also dismissed the 'family of marks' argument, because 'McGYM' did not fit in with the family with regard to structure, because the second element 'GYM' was not a foodstuff or a characteristic of foodstuffs which characterized the earlier marks. Furthermore, the English words in question, such as 'fish', 'toast', 'muffin', 'chicken' etc. would be widely understood. Therefore, since 'GYM' was understood by parts of the relevant public, it would not be perceived as fitting into the 'family'. Hence the opposition under Article 8(1)(b) CTMR was rejected. Regarding the opposition under Article 8(5) CTMR, the Board stated that it too had to fail since the condition that the marks had to be 'identical or similar' was not fulfilled in this instance. Although the reputation of the name 'McDONALD'S' and the prefix 'Mc' were recognised, the conflicting marks were nevertheless dissimilar overall.

The Board annulled the contested decision insofar as it partly allowed the opposition under Article 8(1)(b) CTMR and rejected the CTM application for 'clothing, footwear, headgear in Class 25'; 'games and playthings; gymnastic and sporting articles not included in other classes' in Class 28; 'other non-alcoholic drinks; fruit drinks and fruit juices' in Class 32; 'education; providing of training; electronic desktop publishing; providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts' in Class 41. The Board annulled the contested decision insofar as it partly allowed the opposition under Article 8(5) CTMR and rejected the CTM application for 'novelties for parties, dances [party favours, favours]' in Class 28; 'beers; mineral and aerated waters; syrups and other preparations for making beverages' in Class 32; 'entertainment; sporting and cultural activities' in Class 41. The case was remitted to the Opposition Division for a new decision to be taken on the basis of the other earlier marks which had not been taken into account.

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Decision of the Fifth Board of Appeal of 26 March 2015 in case R1190/2014-5 (EN)

Relative grounds – Dissimilarity

The applicant sought to register the figurative mark

for goods and services in Classes 28 and 41.
The opponent filed a notice of opposition based on the earlier CTM

The Opposition Division rejected the opposition in its entirety stating that the evidence submitted by the opponent did not demonstrate that the earlier trade mark had acquired a high degree of distinctiveness through its use in relation to the goods in Class 28 and/or services in Class 41 covered by the marks on which opposition was based. Also, the contested sign contained other verbal elements which made the two signs dissimilar and the differentiating elements were sufficient to exclude any likelihood of confusion between the marks.

The opponent applicant filed an appeal against the contested decision.

Decision No B 2 188 327 of the Opposition Division was overturned. A likelihood of confusion was established, just as was found in parallel case No B 2 219 791. The central and most dominant elements of the marks in dispute were the letters D and M. Since they coincided, there was a likelihood of confusion, following case-law T-477/10, SE Sports Equipment. As regards the goods and services, 'gymnastic and sporting articles not included in other classes' in Class 28 these were found dissimilar, contrary to the contested decision, also following case-law T-514/11, Betwin. For those goods a likelihood of confusion was excluded.

The Board upheld the opposition and annulled the contested decision with respect to: 'games and playthings; ornaments for Christmas trees, except illumination articles and confectionery' in Class 28 and 'education; providing of training; entertainment; sporting and cultural activities' in Class 41. The Board dismissed the appeal and rejected the opposition for the remainder, namely: 'gymnastic and sporting articles not included in other classes' in Class 28.

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Decision of the Second Board of Appeal of 10 April 2015 in case R1422/2014-2 (EN)

Opposition – Figurative mark, likelihood of confusion - Alcoholic beverages (except beers)

The applicant sought to register the figurative mark

(with the word elements: 'AURÈLIA' and 'CASTELL D'AGE') for goods in Class 33, namely for alcoholic beverages (except beers) and for sparkling wines.

The opponent filed an opposition based on the earlier figurative CTM 'ORELIE', registered for alcoholic beverages (except beers) in the same Class 33.

The Opposition Division upheld the opposition.

The applicant filed an appeal against the decision.

The Board agreed with the contested decision that the declaration was drawn up by an independent third party, namely by a chartered accountant belonging to a group of chartered accountants. The simple fact that a chartered accountant was a service provider for, amongst others, the opponent, did not change the fact that it was an independent third party. Therefore, the Board saw no reason to question the credibility and veracity of the account given. Visually, the signs were similar to the extent that the earlier mark and the word 'AURÈLIA' in the contested sign coincided in the letters '*(*)RELI*'. On the other hand, they differed in their initial letters 'O'/'AU', in their final letters 'E'/'A' as well as in the accent on the letter 'E' of the contested sign. The signs differed further in the figurative elements of the contested sign and in its additional words 'CASTELL D'AGE' which appeared twice. The marks could not be found dissimilar on account of the element 'CASTELL D'AGE' written twice and the decorative features in the contested mark, because all these elements and components were of secondary importance in the overall impression of the marks. It was noted that the earlier mark's only element 'ORELIE' was aurally highly similar to 'AURÈLIA', which came in the initial place in the contested sign, which made the addition of 'CASTELL D'AGE' insufficient to preclude an aural similarity between the signs because of its weak distinctiveness and its secondary position. Hence, overall, the signs were aurally similar. The signs were conceptually similar to the extent that they would both be perceived by the relevant public as containing variations of the same name of Latin origin, 'AURELIA'. The Board considered that as the goods were identical, the signs similar and the earlier French trade mark had a normal degree of distinctive character, thus a likelihood of confusion existed.

The Board dismissed the appeal.

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Case law

The Registry also recommends

Decision of the Fourth Board of Appeal of 21 April 2015 in case R1583/2014-4 (EN)

International Registration — Not substantiated

The applicant sought to register the figurative mark

(with the word element 'PEARL SWAN') for goods in Classes 29 and 30.

The opponent filed an opposition based on earlier international registration

('PEER SWAN'), registered for goods in Classes 5, 29 and 30.

The Opposition Division asked the opponent to file facts, arguments and evidence in support of the opposition together with proof regarding the existence and the validity of the earlier trade mark. Within this time-limit, the opponent filed a brief which was limited to statements concerning the existence of a likelihood of confusion.

By decision of 22 April 2014, the Opposition Division rejected the opposition pursuant to Rule 20(1) CTMIR, as the opponent had failed to comply with Rule 19(2) and (3) CTMIR as it had not filed any evidence regarding the existence and validity of the earlier trade mark on which the opposition was based.

The opponent filed an appeal against the decision.

The Board observed that furnishing official documents as proof of the existence and validity of the earlier rights was a matter of the substantiation of the opposition, i.e. proof of whether the alleged earlier right actually existed and was in force. The OHIM was not obliged to point out to the opponent the deficiencies in its proof. This requirement was provided by Rule 19(2) CTMIR and also applied to international registrations designating the European Union. In addition, it was precisely the rationale of Rule 19(1) and (2) CTMIR that it was up to the opponent to substantiate the earlier mark and it was not the task of OHIM to 'assist', so to say, one of the two parties in the opposition proceedings. To sum up, nothing in Rule 19 CTMIR or in any Article of the CTMR relieved international registrations designating the European Union from the obligations set out in that same Rule 19 CTMIR regarding the requirement to file evidence of the existence and validity of the earlier trade mark on which the opposition was based.

Consequently the Board dismissed the appeal.

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