

International Cooperation and Legal Affairs Department  
Legal Practice Service

---

# OVERVIEW OF GC/CJ CASE-LAW 2014

STATUS: 31/12/14



The Legal Practice Service of the International Cooperation and Legal Affairs Department prepares a yearly overview of the case-law of the General Court and the Court of Justice of the European Union (GC/CJ) with regards to trade mark and design matters.

This overview is published for information purposes and includes abstracts of judgements, preliminary rulings and important orders rendered by the GC and the CJ, which are arranged in categories to be browsed more easily according to their content. Cases in which the GC or the CJ have decided differently from OHIM are indicated by the symbol  before the case number.

Preliminary Rulings are integrated alongside the judgments. References to the CTMR in the chapter headings should be read as extending to the equivalent rules in Directive 2008/95/EC (TMD), where existent.

Each reference to a case contains an abstract of the relevant issues together with the indication of the language of the proceedings.

More detailed information can be found in the GC/CJ Case Law Database on OHIM's website ([eSearch Case Law](#)) which contains keywords, relevant legal norms, facts in brief and headnotes of each judgment.

Please note that this overview is an unofficial summary only and does not reproduce the exact wording of the judgments, preliminary rulings or important orders. For full information, please consult the official website of the GC/CJ at [www.curia.europa.eu](http://www.curia.europa.eu) ([Curia website](#)).

Furthermore, the information on the basis of which this overview is compiled is obtained exclusively from the official website of the GC/CJ without any verification. The accuracy of this data is the sole responsibility of said EU institution. The Office is not liable for any damage caused by the disclosure of this data.



CTRL + click on the titles of the index to go directly to the text.



## INDEX

I. PROCEDURAL MATTERS .....	5
A. PROCEDURE BEFORE THE GC/CJ .....	5
1. Admissibility.....	5
2. Essential procedural requirements .....	13
3. General principles of Community Law .....	15
B. PROCEDURE BEFORE OHIM.....	17
1. Admissibility .....	17
2. Essential procedural requirements .....	25
3. General principles of Community Law .....	33
4. Other .....	35
II. ABSOLUTE GROUNDS FOR REFUSAL/INVALIDITY .....	37
A. Article 7(1)(a), 52(1)(a) CTMR – Sign of which a CTM may consist.....	37
B. Article 7(1)(b), (c) and (d), 52(1)(a) CTMR – Non-distinctive, descriptive, customary .....	37
C. Article 7(1)(e), 52(1)(a) CTMR – Shape .....	66
D. Article 7(1)(f), 52(1)(a) CTMR – Public policy/morality .....	66
E. Article 7(1)(g), 52(1)(a) CTMR – Deceptive .....	73
F. Article 7(1)(h) and (i), 52(1)(a) CTMR – Emblems etc .....	73
G. Article 7(1)(j) and (k), 52(1)(a) CTMR – Geographical indication for wines and spirits – agricultural products and foodstuffs.....	74
H. Article 7(3), 52(2) CTMR - Distinctiveness acquired through use.....	74
III. RELATIVE GROUNDS FOR REFUSAL/INVALIDITY .....	76
A. Article 8(1)(a), 53(1)(a) CTMR – Identical signs/g&s .....	76
B. Article 8(1)(b), 53(1)(a) CTMR – Likelihood of confusion .....	76
C. Article 8(3), 53 (1)(b) CTMR – TM filed by agent.....	163
D. Article 8(4), 53(1)(c) CTMR – Non registered marks/other signs used in the course of trade .....	164
E. Article 8(2)(c), 8(5), 53(1)(a) CTMR – Well-known marks/marks with a reputation.....	165
F. Other issues .....	175
IV. PROOF OF USE.....	177
V. OTHER CANCELLATION.....	185
A. Article 52(1)(a) CTMR .....	184



B. Article 52(1)(b) CTMR - Bad Faith .....	196
C.. Article 53(2) CTMR – Other relative grounds for invalidity .....	201
D. Article 54 CTMR – Acquiescence.....	206
VI. DESIGN MATTERS .....	207
A. Article 3(a), 9 CDR - Registration Proceedings .....	207
B. Article 25b CDR – Invalidation Proceedings .....	210
VII. ENFORCEMENT .....	214
VIII. OTHER.....	218
ANNEX 1: ALPHABETICAL LIST OF GC AND CJ JUDGMENTJUDGMENTS AND IMPORTANT ORDERS IN 2013 BY NICKNAME OF TRADE MARK (ICLAD CASE QUOTATION MANUAL).....	221



## I. PROCEDURAL MATTERS

### A. PROCEDURE BEFORE THE GC/CJ

#### 1. Admissibility

##### *1.1 Right to appeal, form, deadline*

◆ **C-422-12P; CLORALEX / CLOROX**, Order of 30 January 2014, *Industrias Alen SA de CV*. *Other parties: The Clorox Company and OHIM* – es. Upon appeal from the opponent, the General court (GC) annulled the BoA decision (T-135/11). The Office supported the appeal and raised new pleas, which amounted to a cross-appeal. As from 1 November 2012, Article 176(2) of the Rules of Procedure of the CJ requests that cross-appeals be filed in a separate document. The Office did not do it. The cross-appeal is manifestly inadmissible.

**C-490/13P; ALPHAREN / ALPHA 3**, Order of 17 July 2014, *Cytochroma Development Inc. v OHIM* - en. Ineos Healthcare Ltd (Cytochroma Development's predecessor in law) brought an appeal before the Office against that decision of the Opposition Division (OD). Cytochroma Development - filed a CTM application of the word sign ALPHAREN for goods in the pharmaceutical and veterinary fields. The opposition of Teva, the proprietor of the earlier word mark ALPHA D3, based on the ground that there was a likelihood of confusion, was upheld. The Second Board of Appeal (BoA) dismissed the appeal brought against the decision of the OD by the Cytochroma Development, concluding that there was a likelihood of confusion. Subsequent action for annulment brought by the Cytochroma Development before the General court (GC) was upheld in part, which resulted in annulment of the BoA decision in part. The case was remitted to the First BoA, which rendered that there was a likelihood of confusion between the marks at issue. Subsequently, Cytochroma Development raised an action for annulment against that decision, which resulted in its annulment by the GC on the ground that one of the members of the Second BoA that had adopted the previously annulled decision had also sat on the First BoA that had adopted the following contested decision. Although the judgment annulled the contested decision, the Cytochroma Development raised an appeal claiming that since its action was successful only in part, it has a genuine interest in bringing an appeal before the European court of justice (CJ) on the grounds of infringement of: (1) Article 65(6) of Regulation No 207/2009 and Article 1d(1) of Regulation No 216/96 regarding the measures to be taken in order to comply with the first judgment, stating that the GC should have held that the Office may carry out a new examination of a case only in exceptional circumstances and that such an examination was not justified in the present case, and 2) infringement of the principle of legal certainty and of Article 17 of the Charter of the Fundamental Rights of the European Union. The CJ stated that under Article 169(1) of the Rules of Procedure, an appeal is to seek to have set aside, in whole or in part, the operative part of the decision of the GC (Para. 29). If the GC annulled the contested decision in the operative part of the judgment under appeal, that annulment, which is unrestricted, therefore concerns the decision in its entirety (Para. 30). In accordance with Article 169(1) of the Rules of Procedure, an



appeal could therefore only seek to challenge the annulment of the contested decision and, accordingly, the very result sought by Cytochroma Development in bringing an action before the GC (Para. 32). The CJ held that it is clear from the analysis of the two grounds relied on by Cytochroma Development in support of its appeal that it actually seeks to challenge, not the operative part of the judgment under appeal, but certain reasons stated in that judgment, namely (i) those concerning the application of Article 65(6) of Regulation No 207/2009 and Article 1d(1) of Regulation No 216/96 and (ii) those concerning the principle of legal certainty and Article 17 of the Charter (Para. 33-34). Therefore, according to Article 181 of the Rules of Procedure, where the appeal is, in whole or in part, manifestly inadmissible or manifestly unfounded, the CJ may at any time, acting on a proposal from the Judge-Rapporteur and after hearing the Advocate General, decide by reasoned order to dismiss that appeal in whole or in part (Para. 26).

## 1.2 Claims

### 1.2.1 Claims to issue directions to OHIM

### 1.2.2 Claims to change an OHIM decision

◆ **T-383/12; Sun Park Holidays / Sunparks Holiday Parks**, Judgment of 16 January 2014, *Ferienhäuser zum See GmbH v OHIM* – en. The General court (GC) rejected the Office's plea of inadmissibility in relation to the applicant's claim for annulment of the decision of the OD. The GC pointed out that such an annulment falls within the measures which may be taken by the GC in the exercise of its power to alter decisions (Para. 19).

### 1.2.3 Claim by applicant to confirm decision

◆ **T-366/12; YOGHURT-GUMS**, Judgment of May 15<sup>th</sup> 2014, *Katjes Fassin GmbH & Co. KG v OHIM* - de. The Board of Appeal (BoA) confirmed the rejection of the trade mark applied for goods in Class 30 - confectionery. It considered that yoghurt-gums describes the characteristic of those goods, namely that they are gum candies made with yogurt. In the reasoning the BoA referred to a previous decision in which a CTM application filed by the same party for an identical trade mark and good covering those applied for was rejected. Contrary to the judgment in the case on T-157/08, 'Insulate for life' the GC did not dismiss the action as inadmissible against a confirmatory decision (rejection of a repetitive application for the same mark and goods).



#### 1.2.4 Claim in excess of what is appealable

[no entry]

#### 1.2.5 Clarification of claim by applicant

[no entry]

#### 1.2.6 Interpretation of claim by Court

**T-381/12; RON PALMA MULATA DE CUBA / PALMA MULATA**, Judgment of 12 March 2014, *Ana Borrajo Canelo et al vs. OHIM – es*. The GC clarified two procedural issues. First of all, it stated that the claim of the applicants to declare the contested decision as contrary to the CTMR has to be interpreted as claim to annul the contested decision. Consequently it is admissible (Para. 16 – 17). The claim of the Intervener asking the GC to confirm the contested decision is inadmissible. This is confirmed by the Case-Law (Para. 18).

#### 1.2.7 Claim that the case has become devoid of purpose

[no entry]

### 1.3 *Undisputed facts, arguments, grounds or evidence – examples*

[no entry]

### 1.4 *New facts, arguments, grounds or evidence*

**C-591/12P; BIMBO DOUGHNUTS / DONUT**, Judgment of 6 March 2014, *Bimbo S.A v. OHIM - en*. The opposition was upheld in its entirety by Opposition Division and Board of Appeal under Article 8(1) (b) CTMR. The General Court (GC) dismissed the action for annulment. The GC addressed the effect of the alleged market recognition of the element 'Bimbo' in the mark applied for. The argument that the reputation of 'BIMBO' would suffice to prevent a risk of confusion is new and therefore inadmissible (Para. 48).

**T-600/11; Carrera panamericana / CARRERA**, Judgment of 28 January 2014; *Schuhhaus Dielmann GmbH & Co. KG v OHIM – en*. The GC declared inadmissible certain documents (extracts from websites and a newspaper article which had been printed after the adoption of the contested decision and another newspaper article which appeared before the adoption of the contested decision, but was printed from that magazine's website after the adoption of that



decision) (Para. 13). Secondly, the GC declared inadmissible the applicant's argument alleging that the marks at issue had peacefully co-existed on the German market, on the ground that it was based on a fact which was submitted for the first time before the GC (Para. 16).

**C-337/12P; SHAPE OF A PRODUCT**, Judgment of 6 March 2014, (*Joined Cases C-337/12P to C-340/12P*); *Pi-Design and Others v Yoshida and OHIM (C-337/12P and C-339/12P) and OHIM v Yoshida (C-338/12P and C-340/12P)*. The European Court of Justice (CJ) referred in this respect to the Case-Law of the General court, in which it stated that the material which, although subsequent to the date of filing the application, enables conclusions to be drawn with regard to the situation as it was on that date, can be taken into consideration (Para. 60). In addition, the CJ noted that some of the evidence submitted by the invalidity applicant predated the filing date of the contested CTMs (Para. 63). However, since the GC did not apply the provision of Article 7(1) (e) (ii) CTMR correctly, there was no reason to examine further grounds of appeal (Para. 66).

**T-551/12; REBELLA / SEMBELLA**, Judgment of 23 January 2014, *Coppenrath-Verlag GmbH & Co KG v OHIM - de*. The decisions of the German DPMA (Deutsche Patent- und Markenamt) for the first time submitted by the applicant had been rendered before the appealed BoA decision and, therefore, have been submitted to the GC belatedly (inadmissible) (Para. 59).

**C-468/13P; MOL BLUE CARD / TARJETA BLUE BBVA et al**, Judgment of 17 July 2014, *MOL Magyar Olaj- cs Gazipari Nyrt. v. OHIM + Banco Bilbao Vizcaya Argentaria SA – en*. CJ dismissed the appeal pursuant to Article 181 RPCJ. On the infringement of Article 44 RPGC and Article 21 SCJ, the CTM applicant criticised the GC for declaring inadmissible the arguments raised before the Office and referred to in its appeal as long as it was a mere technical reference (Para. 27, Para. 28). The CJ, endorsing the Office's arguments, dismissed the ground of appeal, considering the GC's finding as correct and the CTM applicant's argument as an attempt in vain to reclassify the general reference (para. 31, para. 32). On the infringement of Article 65(2) CTMR and Article 135(4) RPGC, the CTM applicant criticised the GC for declaring inadmissible evidence annexed to the appeal in so far they were presented for the first time before the GC: facts and arguments were not new because they were included in written observations submitted before the Office (Para. 36). The CJ, endorsing the Office's arguments, held that the CTM applicant duly set out facts and arguments, but it did not provide the Office with evidence (Para. 40). The principle following which new documents are inadmissible when submitted for the first time before the GC is therefore reiterated.. The CJ, endorsing the Office's arguments, held that the ground of appeal must be rejected as manifestly inadmissible in so far as the CTM applicant seeks to obtain a re-examination by the CJ of the GC's findings (Para 51).

◆ **T-531/12; T / T**, Judgment of 7 October 2014, *Tifosi Optics, Inc. v. OHIM – en*. As to the admissibility issue, annexes A10 to A13 to the application were submitted for the first time before the General court (GC), and not during the proceedings before the Office. Since such evidence is contrary to Article 135(4) of the Rules of Procedure of the GC, these annexes were not found admissible (Para. 17 and 18). The applicant further submitted certificates showing that its representatives are members of the Bar, however, not translated to the language of the case. The GC found these certificates admissible, since they are not documents supporting written pleadings



and therefore do not need to be translated in accordance with the Article 135(3) of the Rules of Procedure. The GC must verify on its own motion if the parties are properly represented; for such purposes the translation into the language of the case is not necessary (Para. 22).

**T-498/13; NAMMU / NANU**, Judgment of 11 December 2014, *Nanu-Nana Joachim Hoepp GmbH & Co., v. OHIM* – en. The General Court (GC) finds that the third affidavit and the accompanying data, submitted for the first time before the GC, are not a confirmation of the first and second affidavit. They are thus inadmissible (Para. 37). Figures in the 1<sup>st</sup> and 2<sup>nd</sup> affidavits concern goods in Class 3 generally and do not make it possible to ascertain what use was in fact made of the earlier mark, particularly because they do not show the extent of use in Germany during the relevant periods.

**T-601/13; PIONEERING FOR YOU**, Judgment of 12 December 2014, *Wilco SE v. OHIM* – de. The applicant sought the registration of the CTM *Pioneering for You* for goods and services in Classes 7, 9, 11, 37 and 42. The First Instance held that the mark is devoid of distinctive character (Art. 7 (1) (b) CTMR). The Board of Appeal (BoA) upheld that decision. The General Court (GC) confirms the Case-Law that an appeal against a decision of the BoA has the aim of reviewing its legality. This means that the GC may only take into consideration the factual and legal situation as it has been present before the BoA. Consequently new facts and evidence submitted for the first time before the GC are inadmissible, with the only exception of well-known facts, which are to be considered on its own motion (para. 12).

### **1.5 Limitation, including restriction of goods and services**

**T-575/12; PYROX/PYROT**, Judgment of 8 May 2014, *Pyrox GmbH v OHIM*; de. The request of partial restriction ('for the purpose of ...') of the goods changes the subject-matter in dispute and is not admissible (Para. 22).

**C-31/14P; PREMENO / PRAMINO**, Judgment of 11 December 2014 *OHIM v Kessel medintim GmbH v OHIM and Janssen-Cilag GmbH* - de. An opposition against the CTMA *PREMENO* applied for "vaginal ovules" in class 5 was upheld on the basis of the earlier mark *PRAMINO*, registered in Germany for "prescription medicines". The use of the earlier mark was proven for "prescription medicines, namely hormonal contraceptives". The goods were considered identical, the marks similar, the likelihood of confusion was affirmed. In the appeal against this decision the CTM applicant requested a limitation of the goods applied for to "non-prescription vaginal ovules against vaginal dryness and vaginal infections" When dismissing the appeal, the Board of Appeal (BoA) considered the limitation inadmissible and upheld the finding of the likelihood of confusion. The General Court (GC) annulled (in T-536-10) the BoA decision due to an infringement of Article 43 (1) CTMR. The Case-Law has recognized that a therapeutic indication is a relevant criterion for restriction of goods in class 5. The limitation is admissible as far as it concerns "vaginal ovules against vaginal dryness and vaginal infections". It is not admissible as far as the goods applied for were restricted to "non-prescription" medicines. This criterion is not valid due to the lack of uniform rules on of the obligation to sell medicines under prescription within the EU. The inadmissibility of the limitation as far as it concerned the non-prescription medicines only, cannot lead to the



conclusion that it was entirely irrelevant. The BoA had to take into account the other part of the restriction which is based on the therapeutic indication. The Office filed an appeal claiming an infringement of Article 43 (1) CTMR in conjunction with Rule 2 (2) CTMIR and of Article 43 (2) CTMR in conjunction with the bounding effect of limitation request. The European court of justice (CJ) rejected both pleas. Pursuant to article 43 (2) CTMR in conjunction with Rule 2 (2) CTMIR the limitation of the goods has to indicate clearly the nature of goods concerned (para. 36). As decided by the GC, the limitation was admissible as far as it was based on the therapeutic indication. The fact that it also contained a reference to the prescription obligation did not necessary make it inadmissible (paras 39 and 40). The question if the limitation to “non-prescription medicines” is admissible is a question of fact. The GC did not need to examine this question. It decided merely that the limitation was rejected incorrectly despite the fact that it was based on the admissible criterion of a therapeutic indication (para. 43). The judgment of the GC cannot be read in the way that the GC decided that the Office had to accept the limitation partially and not to take into consideration the remaining part. It did not infringe the principle of the binding effect of the CTM application (para. 51).

### **1.6 Matters of fact appealed to CJ**

**C-177/13P; WALICHNOWY MARKO / MARKO**, Order of 13. February 2014; *Marek Marszałkowski v OHIM*, - pl. In Case T-159/11 the General Court (GC) confirmed the decision of the Board of Appeal (BoA) and refused the CTMA WALICHNOWY MARKO for goods in Class 29 on the basis of the earlier CTM MARKO registered in the same Class. The CTM applicant brought an appeal to the European Court of Justice (CJ) claiming an infringement of Article 8(1) (b) CTMR and Article 48 (2) RoP. The appeal was rejected as partly inadmissible and partly unfounded. The CTM applicant claimed an infringement of article 8(1) (b) CTMR by three mistakes in the overall assessment of the likelihood of confusion regarding the comparison of the trade marks, the overall assessment, the dominant character of the element “MARKO”, the relevant public, the importance of the reputation the CTMA has in Poland and the level of attention of the relevant public. The trademark comparison, the relevant public and its level of attention are questions of facts and cannot be reviewed by the CJ within the appeal procedure (Para. 40 et seq.). The same applies to the claimed reputation of the CTMA in Poland (Para. 64). Whereas the evaluation of all factors within the overall assessment of the likelihood of confusion is an issue of fact that cannot be reviewed by the CJ, failure to take all of those factors into account, on the other hand, constitutes an error of law (Para. 52). The related arguments of the CTM applicant are based, however, on a misunderstanding of the judgment under appeal (Para. 53).

**C-414/13 P; Wolfgang Amadeus Mozart PREMIUM / W. Amadeus Mozart**, Order of 20.05.2014, *Reber Holding GmbH & Co. KG v OHIM – de*. In the judgment T-530/10 the General Court (GC) confirmed a decision of the Board of Appeal (BoA) which rejected the proof of use as insufficient in opposition proceedings. The opponent filed an appeal to the European Court of Justice (CJ) claiming an infringement of Articles 43 (2) and (3) CTMR, 15 (1) CTMR and 15 (2) CTMR. The CJ dismissed the appeal as partially inadmissible and partially unfounded. The assessment of the probative weight to be given to the sworn statement conducted by the GC comes within the scope



of the facts of the case (Para. 32). Whereas the evaluation of the evidence is an issue of fact that cannot be reviewed within the appeal, failure to take all of that evidence into account, on the other hand, constitutes an error of law (Para. 33).

**C-448/13P; INNOVATION FOR THE REAL WORLD**, Order of 12 June 2014, *Delphi Technologies, Inc. v OHIM*, - en The General Court (GC) dismissed the appeal, as the sign INNOVATION FOR THE REAL WORLD is instantly apparent to the relevant English-speaking public as meaning that the goods covered by the mark applied for are innovations for the real world (Para. 30). The European Court of Justice (CJ) stated that the assessment of facts was out of the scope of the appeal. The GC did not fail to state reasons. The appellant is seeking a new assessment of the facts, which is precluded in an appeal.

**C-285/13P; Caffé KIMBO/BIMBO**, judgment of 12 June 2014, *Bimbo, SA v. OHIM – en*. The Opposition Division (OD) upheld the opposition in respect of part of the goods at issue, namely ‘flour and preparations made from cereals, bread, pastry and confectionery, ices; yeast, baking powder’ in Class 30. The Board of Appeal (BoA) annulled the OD decision in so far as it rejected the Community trade mark application in respect of ‘flour, confectionery, ices, yeast and baking powder’. The General Court (GC) dismissed the appeal of Bimbo in its entirety. The European court of justice (CJ) found that the alleged breach of Rule 19 of the Implementing Regulation put forward by Bimbo in support of its first ground of appeal and, in particular, the claim based on the assertion that Bimbo had proved the existence and validity of the earlier Spanish mark BIMBO registered under No 291655, in accordance with that rule, were never raised before the GC. The CJ stressed, in this regard, that Bimbo based its action before the GC solely on the earlier unregistered mark BIMBO, which is well known in Spain. Consequently, the first ground put forward by Bimbo in support of its appeal was rejected as being manifestly inadmissible (Para. 17 and 18). The CJ pointed out that the assessment of the comparison of the conflicting goods is factual in nature and is not, subject to review by the CJ (Para. 24). It considered that Bimbo was inviting the CJ to substitute its own assessment of the facts for that of the GC, with regard to the comparison of the goods at issue, without, moreover, either showing or even alleging that that assessment of the GC is based on a distortion of the facts or the evidence. Thus, the first part of the second ground of appeal was rejected as being manifestly inadmissible (Para. 25). As regards the second part of the second ground presented in support of the appeal, alleging breach, by the GC, of Article 8(4) of Regulation No 40/94, it sufficed to point out that Bimbo did not put forward that argument before either the GC or the BoA and it was therefore inadmissible (Para. 26). As to the third part of the second ground of appeal, the CJ pointed out that Bimbo never argued, before the GC, that the earlier mark BIMBO had a reputation in Spain (Para. 27). Moreover, Bimbo specifically based its action before the GC on the earlier unregistered mark alone. Consequently, the third part of the second ground of appeal was rejected as being manifestly inadmissible (Para. 28).

**C-608/12 P; STAR FOODS / STAR SNACKS**, Order of 8 May 2014, *Greinwald GmbH V OHIM – de*. The CJ found the appeal inadmissible, since the applicant, contrary to the requirements of Article 169 (2) of the Rules of Procedure of the CJ, criticized reasoning of the GC without precise identification of specific points in the grounds of the GC’s decision that were contested. (Paras. 27 and 33). In its single plea in law, the applicant had not provided any argument to explain why



under his opinion the GC had committed an error of law in application of Article 8 (1)(b) CTMR (Para. 30). In regards of applicant's requirement to annul the decision based on incorrect examination of the similarity between beers and other goods covered by Classes 29 and 30 the CJ stated that, in accordance with Article 256 (1) TFEU and Article 58, first paragraph, of the Statute of the CJ, the GC has an exclusive jurisdiction to find and examine the relevant facts and the evidence submitted to it. (Paras. 34 and 36).

### **1.7 Other, including general reference to previous statements**

**C-177/13P; WALICHNOWY MARKO / MARKO**, Order of 13. February 2014; *Marek Marszałkowski v OHIM*, - pl. The appeal was rejected as partly inadmissible and partly unfounded. The claimed infringement of Article 48(2) RoP was rejected as unfounded as contrary to previous submissions of the CTM applicant.

**T-486/12; METABOL / METABOL-MG**, Judgment of 11 June 2014, *Sofia Golam v OHIM* – en. The GC reiterated its settled Case-Law that an application is inadmissible insofar as it makes general reference to submissions in the course of the proceedings before the Office (Para. 15). It also held that the duty of the BoA to state reasons does not require them to follow exhaustively and one by one all lines of reasoning of the parties (Paras. 18-19); it thus confirmed the implicit rejection of the applicant's objections regarding abuse of the right to oppose, non-use of the right to file a CTM application and vagueness of the opponent's written pleadings (Paras. 21-23).

**T-575/12; PYROX/PYROT**, Judgment of 8 May 2014, *Pyrox GmbH v OHIM*; de. The request of the applicant that the Office bear the costs before the Opposition Division is not admissible being contrary to Art. 136 Para. 2 Rules of procedure (Para. 15).

**T-66/13; SHAPE OF A LIQUEUR BOTTLE**, Judgment of 16 July 2014, *Franz Wilhelm Langguth Erben GmbH & Co KG. vs OHIM* – de. The applicant argued that the response of the Office was not signed and should be disregarded. The GC indicated that Article 43(7) of the Rules of procedure constitutes the basis for a decision of the GC in 2011 to submit briefs electronically through e-Curia. E-Curia was used by the Office (Paras. 10-16). The GC confirms its ruling that a general reference to arguments presented in the administrative procedure cannot substitute the indication of the substantial legal arguments in the plaintiff's action brief (Paras. 17-20).

**C-521/13P; DESIGN OF RED SHOELACE TIPS**, Judgment of 11 September 2014, *Think Schuhwerk GmbH v OHIM*. It merely reproduces the pleas in law and arguments previously submitted to GC in order to obtain a re-examination (para. 30). (iii) On the infringement of Article 76 (1) CTMR. The CTM applicant criticised the CG for failing to sanction a breach of Article 76 (1) CTMR by the BoA. It would have not demonstrated the reasons why the mark had not distinctiveness (p. 31). According to the Office, the GC gave a ruling on the same ground of



appeal; anyway the applicant has the burden to prove distinctiveness (Para. 32). The CJ dismissed the ground of appeal as manifestly unfounded, relying on arguments and Case-Law set out with regard to the previous plea (Para. 33, Para. 34).

**T-173/11; CARRERA / CARRERA**, Judgment of 27 November 2014, *Kurt Hesse and Lutter & Partner GmbH v OHIM – de*. The applicant sought to register the word mark Carrera as a CTM for goods within Class 9. An opposition based on the earlier word marks CARRERA registered for goods in Class 12 was filed on the grounds of Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) upheld the opponent's appeal finding that the signs are identical and there exists likelihood of confusion in respect of part of the goods applied for (mobile navigation apparatus, in particular satellite-based mobile navigation apparatus). In regards of the remaining goods the BoA found that the mark applied for would take unfair advantage of the distinctive character of the earlier marks. The applicant filed an action before the General Court (GC). Subsequently, the application was partially transferred. The GC emphasised that, under Article 44 (1) (d) of the Rules of Procedure, all heads of claim must be accompanied by pleas and arguments enabling both the defendant and the GC to assess the merits. Since the subsidiary heads of claims are not accompanied by any plea or argument, they must be rejected as inadmissible (Paras. 26 – 27).

## 2. Essential procedural requirements

### 2.1 Right to be heard

**C-530/12; THE SHAPE OF A HAND**, Judgment of 27 March 2014, *appeal of the OHIM against the judgment of the General Court in case T-404/10 - en*. The Office filed an appeal to the European Court of Justice (CJ), raising three pleas in law and alleging (i) infringement of Article 76(1) CTMR and of Rule 37 CTMR; (ii) infringement of the right to be heard, insofar as OHIM's right to be heard regarding the judgment of 14 June 2007 was not observed; and (iii) manifest inconsistency and distortion of the facts which affect the reasoning followed and the conclusion reached by the General Court (GC). In particular, by its first plea, the Office submitted that the GC could not rely on an article of the Italian Civil Code and on the judgment of the Italian Supreme Court of Cassation, since those two factors had not been invoked by the parties and did not, therefore, fall within the subject-matter of the dispute brought before the Board (BoA). The Office argued that it read the judgment of the CJ in Case C-263/09 P *Edwin v OHIM* as confirming that it is for the party relying on national law to provide the Office not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law. The CJ held that it is not apparent from the judgment in *Edwin v OHIM* that a rule of national law, made applicable by a reference such as that in Article 52(2) CTMR, should be treated as a purely factual matter, the existence of which the Office and the CJ merely establish on the basis of the evidence before them (Para. 37). The review by the Office and by the GC must be conducted in the light of the requirement of ensuring the practical effect of the CTMR, which is to protect registered CTMs (Para. 40). The scope of the decision of the Officer is called to take in an invalidity scenario necessarily implies that the Office's role cannot be of mere validation of the national law as submitted by the invalidity applicant (Para. 43). The GC must be able to confirm, beyond the documents submitted, the content, the conditions



of application and the scope of the rules of law relied upon by the applicant for a declaration of invalidity (Para. 44). The GC did not err by holding that the Office must — of its own motion and by whatever means considered appropriate — obtain information about the national law of the Member State concerned, where such information is necessary for the purposes of assessing the applicability of a ground for invalidity relied on before it and, in particular, for the purposes of assessing the accuracy of the facts adduced or the probative value of the documents submitted (Para. 45). Since the parties before the GC were not given the opportunity to submit their observations on the above mentioned judgment of the Italian Supreme Court of Cassation, the GC infringed the Office's right to be heard (Paras. 57-60). The CJ therefore set aside the judgment of the GC and referred the case back to the lower instance for a ruling on the merits of the action.

**C-521/13P; DESIGN OF RED SHOELACE TIPS**, Judgment of 11 September 2014, *Think Schuhwerk GmbH v OHIM - it*. The CTM applicant sought to register the trade mark represented below. The examiner refused the application under Article 7 (1) (b) CMTR. The Board of Appeal (BoA) confirmed that the trade mark lacked distinctiveness to the extent that it would be perceived by the public as a variation in shoe design rather than as a badge of origin (para. 9). The CTM applicant filed before the General court (GC) an action grounded on 4 pleas in law: (i) lack of reasons within the meaning of Article 75 CTMR; (ii) infringement of Article 76 CTMR; (iii) incorrect application of Article 7(1) (b) CTMR; (iv) breach of the principle of equal treatment. The GC dismissed the action. The CTM applicant then filed before the European court of justice (CJ) an action based on 4 pleas in law: (i) infringement of the right to a fair hearing; (ii) breach of the duty to state reason; (iii) infringement of Article 76(1) CTMR; (iv) Infringement of Article 7(1) (b) CTMR. The CJ dismissed the appeal pursuant to Article 181 RPCJ (order). (i) On the infringement of the right to a fair hearing, pursuant to Article 122(1) RPGC, "If a defendant on whom an application initiating proceedings has been duly served fails to lodge a defence to the application in the proper form within the time prescribed, the applicant may apply to the General Court for judgment by default". (ii)



## 2.2 Adequate reasoning

**C-521/13P; DESIGN OF RED SHOELACE TIPS**, Judgment of 11 September 2014, *Think Schuhwerk GmbH v OHIM* - it On the breach of the duty to state reasons, the CTM applicant criticised the GC for failing to sanction a breach of the duty to state reasons by the BoA. It would have grounded the decision on generally known facts without describing such facts and explaining their impact on the distinctive character of the mark (para. 25). The CJ dismissed the ground of appeal as manifestly unfounded, relying on settled Case-Law (para. 27, para. 28, para. 29): (i) the appeal criticises the BoA's decision rather than the GC's Judgment, (ii) it does not indicate precisely the contested elements of the GC's Judgment

## 2.3 Ultra petita

[no entry]

## 2.4 Other

**T-160/12; MARINE BLEU / BLUMARINE**, Judgment of 14.05.2014, *Adler Modemärkte AG v OHIM* – de. The CTM applicant filed an action before the General court (GC) claiming an infringement of article 8 (1) (b) CTMR. The GC refused first the request of the other party that English be the language of proceedings and further dismissed the action of the CTM applicant. Pursuant to article 131 (2) (3) Rules of Procedures (RoP) of GC, the language of proceedings is the language of the application, notwithstanding the fact that pursuant to Article 119 (3) CTMR the applicant has to choose a second language, being one of the official languages of the Office (Paras. 18, 21). Since there are possibilities to use another language, providing later their translation pursuant to article 131 (3) RoP GC, the choice of German as a language of proceedings does not limit the defence rights of the other party (Para. 23).

## 3. General principles of Community Law

**C-301/13P ; CLUB GOURMET/ CLUB DEL GOURMET, EN... El Cortes Inglés**, Order of 6 of February 2014, *El Corte Ingles, S.A. v OHIM* – es. The applicant sought to register the word mark 'CLUB GOURMET' as a CTM for goods in Classes 16, 21, 29, 30, 32 and 33. An opposition was filed on the grounds of Article 8(1) (b) and Article 8(5) CTMR. It was based on the earlier Spanish figurative trademark for services in Class 35. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal which had been filed by the opponent. The General Court (GC) dismissed the appeal and upheld the decision of the BoA. It considered that the earlier right identified only one service of Class 35, without any reference to the products covered by other related trademarks. The GC also stated that the opponent had not alleged protection beyond the services of Class 35. Furthermore, it set out that the Office has the obligation to take into consideration the national law only if it previously had indications as regards such national law. Finally, the GC found that the description of the services covered by the earlier mark did not allow a comparison with the challenged goods. The opponent alleged (i) the infringement of the principle of legitimate expectations and of the principle of legal certainty; (ii) that the GC had made



an erroneous assessment of the facts; (iii) lack of reasoning; (i) the infringement of the right of defense. As regards the first plea, the European court of justice (CJ) considered that the opponent has made an erroneous interpretation of the GC's decision (Para. 30) and that the principles whose infringement is alleged cannot be applied in this case (Para. 32). Moreover, the CJ also set out that the opponent was not actually criticizing the GC's decision, but rather the decision of the Opposition Division. The second plea was refused as inadmissible since it refers to the assessment of the facts made by the GC, which is out of the scope of the appeal before the CJ (Para. 43). With respect to the third plea, the CJ considered that the GC had provided a sufficiently clear line of reasoning as regards the inapplicability of a particular Case-Law (Para.54), as well as regards the reasons to refuse the opponent's claim (Para. 58). Finally, the CJ endorsed the analysis made by the GC with respect to the assessment of the comparison of the goods. In the CJ's view, the GC took into account the opponent's arguments and duly refused them. Therefore, the infringement of the right of defense must be excluded (Para. 68). The CJ accordingly dismissed the opponent's appeal in its entirety (Para.69).

**C-448/13P; INNOVATION FOR THE REAL WORLD**, Order of 12 June 2014, *Delphi Technologies, Inc. v OHIM* - en. As to the claim of infringement of the principles of equal treatment and sound administration by rejecting the appeal against the decision of the Board of Appeal, even though the Office applied to this CTM application stricter criteria than those which allowed the registration of similar marks, the European Court of Justice ruled, that the appellant does not identify any error of law committed by the General court. The appeal is therefore dismissed in its entirety also on this ground as being in part manifestly inadmissible and in part manifestly unfounded.

**T-11/13, MEGO / TEGO et al** Judgment of 23. September 2014, *Tegometal International AG v OHIM* – de. An invalidity request pursuant to Article 52(1) (a) CTMR in conjunction with Article 8(1) (b) CTMR was filed against the CTM MEGO which was registered in classes 6 and 20. The request was based on several national and Community trademarks TEGO and TEGOMETAL. The Cancellation Division rejected the request finding the marks dissimilar. An appeal filed by the invalidity applicant was dismissed as inadmissible. The Board of Appeal (BoA) considered that since previously an opposition was filed against the same CTM mark and that opposition was based on the same ground and the same earlier trademarks as the invalidity request, and, furthermore, that the previous decision of the BoA confirmed the rejection of this opposition and this decision of the BoA had become final, the current proceedings were inadmissible. The invalidity applicant filed an action before the General court (GC) claiming an erroneous application of the *res judicata* principle, an infringement of Article 34 (2) CTMR and of Article 8(1) (b) CTMR. The first plea led to the annulment of the decision of the BoA. The GC decided that the principle of *res judicata* which prohibits a final decision being called in question, was not applicable so far as concerns the relationship between the final decision in an opposition proceedings and an application for the declaration of invalidity, given, *inter alia*, that proceedings before the Office are administrative not judicial and that the relevant provision of Article 53(4) CTMR and Article 100(2) CTMR lay down no rule to that effect (Para. 12 with a reference to further Judgments). The GC did not decide on the other pleas.



**T-601/13; PIONEERING FOR YOU**, Judgment of 12 December 2014, *Wilo SE v. OHIM* – de. As far as the applicant’s complaint on the infringement of equal treatment is concerned, because similar marks have been registered by the Office, the GC answered the following: First it made reference to the constant Case-Law which clearly states that decisions concerning registration of a sign as a Community trade mark which the BoA are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of BoA must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice of the BoA (para. 41). The GC further stresses that even if a similar or identical sign has been previously registered, the later applicant cannot rely on that unlawful decision. The principle of equal treatment has to respect the principle of legality (para. 42). Also the factual circumstances may vary from case to case. The claim that the Office should have adopted the same reasoning as in a specific previous case is unfounded, unless the applicant shows that the BoA has committed an error leading to the annulment of the contested decision (para. 43).

## B. PROCEDURE BEFORE OHIM

### 1. Admissibility

#### 1.1 *Right to appeal, form, deadline*

**T-61/13; NUEVA**, Judgment of 21 May 2014, *‘Melt Water’ UAB, v OHIM* – It. The applicant sought to register a figurative sign as a CTM for goods in Class 32, mineral water. The examiner refused the application on the basis of Article 7(1) (b) and (c), as well as Article 7(2) CTMR on the ground that the sign at issue was descriptive and devoid of any distinctive character. The applicant lodged an appeal against this decision. On 3 December 2012 the Board of Appeal (BoA) deemed the applicant’s appeal not to have been filed. An application for annulment was filed against this decision. In support of its action, the applicant alleged an infringement of Article 60 CTMR. It submitted that its appeal was filed before the BoA lawfully, on the ground that it paid the appeal fee within the period prescribed by the Lithuanian version of that article, which is authentic. The GC confirmed the consistent case law which held that drawing from Article 314 EC and Article 55 EU, all the language versions of a provision of European Union law must be regarded as being equally authentic and, in principle, recognised as having the same weight. However the GC noted that the Lithuanian version of this provision is not unambiguous and raises doubts as to its interpretation and its application (Para. 24). With regard to the versions of Article 60 CTMR set out in the other official languages of the European Union, in particular the five working languages of the Office, the GC stated that, in the French, English, German, Italian and Spanish versions, the terms *‘recours’*, *‘notice’*, *‘Beschwerde’*, *‘ricorso’* and *‘recurso’* used in the second sentence of that article refer clearly to the same term used in the first sentence to designate the notice of appeal to be filed with the Office within two months after the date of notification of the decision under appeal, and not to the different term used in the third sentence to refer to the written statement setting out the grounds of appeal which must be filed within four months (Para. 29). In relation with the



general purpose and scheme of the second sentence of Article 60 CTMR, that sentence should be regarded as seeking to prevent the lodging of merely formal appeals that are not followed by a written statement setting out the grounds of appeal, or indeed to discourage the lodging of unrealistic appeals (Para. 30). As a consequence, the uniform interpretation of this provision is for the GC that payment of the appeal fee is required in order for the appeal to be regarded as having been filed, with the result that that payment is linked to the filing of the notice of appeal and must be made, in the same way as that filing, within a period of two months following the date of notification of the decision under appeal. The period of four months following the date of notification of the decision applies solely to the lodging of the written statement setting out the grounds of appeal, and not to the payment of the appeal fee (Para. 31). Furthermore, the Board was right to note that this uniform interpretation is corroborated by Rule 49(3) of Regulation No 2868/95. That rule, the wording of which is clear and unambiguous both in Lithuanian and in the other languages provides that, if the fee for appeal has been paid after expiry of the period for the filing of the appeal provided for in Article 60 CTMR the appeal is to be deemed not to have been filed and the appeal fee is to be refunded to the appellant.. Compliance with procedural time-limits, particularly in relation to appeals, is a matter of public policy, and any interpretation other than that uniform interpretation is liable to undermine legal certainty (Para. 34). On the reproduction of the Lithuanian version of Article 60 by the examiner in its decision of refusal the GC stated that the fact that the examiner reproduced the ambiguity affecting the Lithuanian version of that article in respect of the time-limit for payment of the appeal fee, without drawing the applicant's attention to that ambiguity or to the discrepancy between that version and the other authentic language versions could not affect the principle of uniform interpretation. In particular the GC held that the applicant did not demonstrate the care and diligence required for the purposes of monitoring and complying with the time-limit prescribed for payment of the appeal fee. A normally careful and diligent applicant for a Community trade mark which, just like the applicant, has chosen English as the second language in its application for a Community trade mark ought at least to have been able to verify the wording of the English version of Article 60 CTMR as the wording in English clearly links the payment of the fee for appeal to the filing of the notice of appeal, which is subject to a period of two months, and not to the lodging of the statement setting out the grounds of appeal, which is subject to a period of four months (Para. 41). Even on the assumption that the applicant sought to argue that, although it had exercised all due care required by the circumstances, it had been unable to comply with the time-limit for payment of the appeal fee, it did have the possibility of bringing *restitutio in integrum* proceedings before the Office and could have submitted an application under Article 81 CTMR (Para. 43). Judging the circumstances of the case exceptional within the meaning of the first subparagraph of Article 87(3) of the Rules of Procedure, fairness requires that the Office OHIM should bear its own costs and pay those incurred by the applicant (Para. 48).

**T-495/11; PARA.METRICA / Para.meta**, Judgment of 30 January 2014, *Michael Streng v OHIM* – it. The applicant sought to register the word mark 'PARA.METRICA' for services in Classes 36 and 42 and an opposition was filed under Article 8(1)(b) CTMR on the basis of the allegedly earlier German word mark 'Para.meta', registered for services in Classes 35, 38, 41 and 42. English was the procedural language. In order to substantiate the opposition, the opponent had submitted, along with the notice of opposition, an extract from the trade mark register kept by the German Patent and Trademark Office and a copy of the registration certificate, both in German. Following an admissibility deficiency notice issued by the Office, the opponent filed an online extract from the



German trade mark register, worded in German and where only the services relied upon had been indicated both in German and in English. The Opposition Division (OD) upheld the opposition, considering that the opponent had substantiated the earlier mark. On appeal filed by the applicant, the Board of Appeal (BoA) annulled the decision of the OD and rejected the opposition, considering that the opponent had failed to provide, within the time limit, a separate translation meeting the requirements laid down by Rule 98(2) CTMIR and containing all the essential elements and reflecting the structure of the German certificate and extracts filed in support of the opposition. The General Court (GC) dismissed the opponent's appeal and confirmed the contested decision. The GC held, referring to previous Case-Law, that from the combined provisions of Rule 19(3) and 98(2) CTMIR it follows that an opponent must submit, within the prescribed time limit, a full translation in the procedural language of the original document/s relied upon, this requirement being aimed at allowing the applicant as well as the bodies of the Office to readily and fully appreciate the content of the translation and its conformity to the original document/s and verify the existence, validity and scope of protection of the allegedly earlier mark. Given that the three documents mentioned above were written in German and that only the services listed in the online extract (filed following the admissibility deficiency notice) had been translated into English, and that such a limited translation of the goods/services of the earlier mark, while sufficient for admissibility purposes, cannot be considered an acceptable translation (complete and reflecting the structure ) of the original document/s, it follows that the opponent failed to substantiate the existence, validity and scope of protection of the allegedly earlier German mark, with the result that the opposition must be rejected as unfounded under Rule 20(1) CTMIR. In this respect, the GC noted that the opponent had failed to provide, in particular, the English translation of essential elements of the earlier mark.

**T-386/12; ELITE BY MONDARIZ / ELITE**, Judgment of 9 April 2014, *Elite Licensing Company, S.A. v OHIM – es*. On the infringement of Rules 48(2), 49(1) and 96(1) CTMIR: The appeal was filed in ES (language of the proceedings EN). No translation was filed within the deadline. The Office notes that the official form was used, by ticking boxes and adding personal data which does not need to be translated. The General Court (GC) considered this a breach of Rule 48(2) CTMIR. The notice of appeal should have been filed in the language of the proceedings (EN) or translated into it. However, the judgment of 17/9/08 (T-218/06, *Neurim Pharmaceuticals*) is no longer a valid legal precedent, as the European Court of Justice (CJ) took a different view in its judgment of 19/1/12 (C-53/11P, *OHIM v. Nike*, R10). Rule 96(1) CTMIR applies only 'unless otherwise provided for in these Rules'. Rule 49(1) CTMIR 'provides otherwise', as it indicates that a deficiency can be remedied before the expiry of the deadline in Article 60 CTMR (two or four months). In its Judgment, the CJ established that the 4 months deadline should be taken into account in order to have a real possibility to remedy the deficiency. Since the grounds of appeal were submitted in the language of the proceedings within such deadline, this can remedy the deficiency, as it contains all the necessary data for the appeal. The GC dismissed the submission of the Office that a notice of appeal which is not filed in the language of the proceedings can be declared admissible when the appellant only needs to tick boxes in order to fill it (Paras. 28 to 31). On the infringement of Rule 95 CTMIR, the GC dismisses the practice of the Board of Appeal (BoA) according to which Rule 95 (b) CTMIR not only applies to registered CTMs, but also to CTMs applied for. Rule 96 constitutes *lex specialis* in relation to Rule 95. The BoA should have based its decision on the admissibility of the appeal on Rule 96, but this error does not lead to the annulment of the contested decision.



**T-480/13; YouView+ / You-View.tv**, Judgment of 1 July 2014; *You-View.tv v OHIM* - en. The applicant sought to register the word mark YouView+ as a CTM for goods and services in Classes 9, 16, 38, 41 and 42. An opposition based on an earlier figurative mark, registered for services in Classes 35, 38 and 41, 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 timely proven its entitlement as owner of the earlier mark. Whereas the notice of opposition was filed in the name of You-View.tv, the extract from the Benelux Trade Mark Office and its English translation filed by the opponent showed that the earlier Benelux mark was registered in the name of You-View.tv BVBA. The OD held that those were two different legal entities and that the opponent had not provided any evidence of a transfer of ownership of the earlier mark to its name, or filed any document demonstrating that it had been authorised by the proprietor of the earlier mark to file an opposition. 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. Finally, the GC pointed out that, in view of the BoA's discretion, the concept of a lack of legitimate interest in seeking to have the contested decision annulled (and which applies where the annulment of the contested decision can only give rise to another decision identical in substance to the decision annulled) cannot be invoked (Para. 32).

◆ **T-342/12; STAR / STAR**, Judgment of 8 October 2014, *Max Fuchs v.OHIM* - en. The applicant sought to register a star as a figurative mark in Classes 18, 24, 25 and 26. An opposition based on the CTM and French star figurative marks for goods in Classes 18, 24 and 25 (FR) was filed. On Article 8(1) (b) CTMR, the Opposition Division rejected the opposition for the goods in Class 24 and allowed the opposition in respect of all the other goods. The Board of Appeal (BoA) dismissed the appeal. After the adoption of the contested decision by the BoA, a final decision of the Cancellation Division revoked the earlier CTM as from 24 June 2013. The applicant claimed that the opposition should be considered devoid of purpose to the extent that it was based on the earlier CTM. On its own motion, the General court (GC) ruled on whether the applicant continues to have an interest in bringing the action, i.e. on whether the annulment of the contested decision, to the extent that it is based on the revoked CTM, is still capable of procuring an advantage to the applicant. The applicant's interest in bringing proceedings must, in the light of the purpose of the action, exist at the stage of lodging the action (failing which, the action is inadmissible). That purpose must continue, like the interest in bringing proceedings, until the final decision (failing which, there will be no need to adjudicate). If the applicant's interest in bringing proceedings disappears in the course of proceedings, a decision of the GC on the merits cannot bring him any benefit. However, the lapsing of the contested decision occurred after the lodging of the action, does not in itself place the GC under the obligation to declare that there is no need to adjudicate (Para. 23). A CTM revoked ex Article 55(1) CTMR is deemed not to have had the effects provided for under the CTM as from the date of the application for revocation (*ex nunc*). If those effects start after the adoption of a decision of the BoA allowing an opposition based on that mark (like in the case at hand), revocation does not constitute either a withdrawal or a repeal of that decision (Para. 24). Notwithstanding the intervention of a definitive decision revoking the earlier CTM on which the opposition was based, the applicant retains an interest in challenging the contested decision, including to the extent that that decision rules on the opposition based on that mark for the goods in Class 18 (Para. 29).



**T 232/12; ULTRA CHOCO / ultra choco**, Judgment of 21 January 2014, *Agroekola EOOD v OHIM* – en. In its appeal, the opponent failed to prove that payment of the appeal fee had been transferred in time. The Board of Appeal (BoA) found that the fee had been paid on the 11<sup>th</sup> and not on the 10<sup>th</sup> of January 2012, which was the deadline. In accordance with Article 60 CTMR, the appeal was deemed not to have been filed. Relying on an alleged infringement of Article 60 CTMR, the opponent requested the General Court (GC) to order the BoA to accept the appeal and follow normal procedure. New evidence proving that the bank transfer order was given on 10 January 2012 was presented before the GC. The evidence was inadmissible as it was not submitted to the BoA for examination and no explanation was given to why the information was not presented during the administrative procedure (Paras. 20-23). The opponent argued that the BoA should have assessed the documents at its disposal and deduced that the transfer order must have been given at least one day earlier than the transfer of the fee. It is however, up to the opponent to prove such orders are given before the deadline and not for the Office to make presumptions based on average transaction times. The opponent should have presented his transfer order to the Office (Paras. 25, 29-32). This approach promotes legal certainty and avoids discrimination as the same methods of calculating time-limits can be applied irrespective of the party's residence or nationality (Paras. 33-34). As to the argument that the Office had initially confirmed the regularity of the payment of the fees, the CG concludes that this does not breach the principle of the protection of legitimate expectations since the Office had not confirmed that the payment of the appeal fee had been made within the prescribed period, but merely acknowledged receipt of the opponent's observations and of the transfer order dated after the deadline (Paras 37-38).

**C-324/13 P; PATRIZIA ROCHA**, Order of 30 January 2014, *Fercal Consultoria e Servicos, Ld, v OHIM* – pt. The applicant sought to set aside the judgment of the General Court of 10 April 2013 in case *T-360/11 Fercal Consultoria e Servicos, Ld, v OHIM*, by which the General Court (GC) dismissed its action seeking the annulment of the decision of the Second Board of Appeal of 8 April 2011 declaring the appeal inadmissible as the statement of grounds was filed outside the applicable time limit. On the admissibility of the appeal, interpretation of Article 58 Rules of Procedure of the Court, the European court of justice (CJ) held that the appeal was, contrary to what the Office argued, admissible, although the appellant did not mention or quote any relevant extract of the judgment. In general it can be clearly extracted from the argumentations which are the elements under criticism allowing then the CJ to exercise its control of legality. On the substance, as to the interpretation of former Article 59 (now Article 60) CTMR, the first plea in law namely on the concept of filing and referring to the interpretation of Regulation 2868/95, the CJ confirmed the assessment of the GC at point 27 of the judgment when it held that following the spirit of the law and from the provisions themselves it is the date of reception of the statement of grounds by the Office which is relevant and not the date on which the statement was sent. This "reception theory approach" is confirmed by section 2B of the decision of the Presidium, applicable in virtue of Article 1 paragraph 6 of Regulation n° 216/96 as modified by Regulation 2082/2004. This text uses the expression to "communicate the appeal" and "to present the statement of grounds". Moreover Rule 62, paragraph 3 of Regulation n° 2868/95 provides that when the motivation is made by certified letter with or without receipt the notification is reputed done 10 days after the date of sending by post, so again the criteria is the reception date not the sending date. On the second plea in law related to the determination of the day when the delay started to count the CJ confirmed the interpretation of the GC Rule 70 paragraph 4, CTMIR that the time limit



started to count the day after the notification and expired on 27 January 2011. It is therefore not correct to argue, as the applicant did, that the time limit expired on 28 January 2011. The delay must be counted in months not in days. Finally on the means of communication of Rules 61 to 65 CTMIR which was the third plea in law, the appellant was wrong in its interpretation, even if the parties are free to choose the means of communication, the delays are not modified in accordance with these choices.

## 1.2 New facts, arguments, grounds or evidence

◆ **T-38/13; PEDRO / Pedro del Hierro**, Judgment of 8 May 2014, *Pedro Group Pte Ltd v OHIM – en*. The GC ruled that documents bearing a date after filing date cannot be deprived of evidential value if they enable conclusions to be drawn with regard to the situation as it was on the filing date.

**T-600/11; Carrera panamericana / CARRERA**, Judgment of 28 January 2014; *Schuhhaus Dielmann GmbH & Co. KG v OHIM – en*.

CTM applied for	Earlier Mark
Carrera panamericana	

In first place, the GC declared inadmissible certain documents (extracts from websites and a newspaper article which had been printed after the adoption of the contested decision and another newspaper article which appeared before the adoption of the contested decision, but was printed from that magazine’s website after the adoption of that decision) (Para. 13).] Secondly, the GC declared inadmissible the applicant’s argument alleging that the marks at issue had peacefully co-existed on the German market, on the ground that it was based on a fact which was submitted for the first time before the Court (Para. 16).

**T-249/13; DORATO / RESERVE IMPERIAL**, Judgment of April 9 2014, *MHCS v OHIM – en*. The applicant alleged that the Board (BoA) had infringed Rule 50(1) CTMIR and Article 76(2) CTMR firstly by rejecting the evidence filed for the first time at appeal stage and aimed at proving that the earlier marks had acquired enhanced distinctiveness and, secondly, by failing to state the reasons why it did not take that evidence into account. The General Court (GC) held that, since the opponent had not, during the opposition proceedings, claimed that the earlier marks had acquired enhanced distinctiveness or submitted any evidence in that respect, the BoA had correctly rejected as inadmissible the evidence filed for the first time at the appeal stage and had also provided sufficient reasons for doing so (Paras. 19-20). The GC also noted that the BoA, in the exercise of its broad discretion, had found that that belated evidence was in any case irrelevant to the decision, given that the figurative elements contained in the earlier marks were only weakly distinctive, and thus, even if they had been found to have acquired an additional degree of enhanced distinctiveness through use, their total distinctiveness would still not be high (Para. 34).



◆ T-480/13; **YouView+ / You-View.tv**, Judgment of 1 July 2014, *You-View.tv v OHIM* - en.

CTMA	Earlier mark
YouView+	

The applicant sought to register the word mark YouView+ as a CTM for goods and services in Classes 9, 16, 38, 41 and 42. An opposition based on an earlier figurative mark, registered for services in Classes 35, 38 and 41, 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 timely proven its entitlement as owner of the earlier mark: Whereas the notice of opposition was filed in the name of You-View.tv, the extract from the Benelux Trade Mark Office and its English translation filed by the opponent showed that the earlier Benelux mark was registered in the name of You-View.tv BVBA. The OD held that those were two different legal entities and that the opponent had not provided any evidence of a transfer of ownership of the earlier mark to its name, or filed any document demonstrating that it had been authorised by the proprietor of the earlier mark to file an opposition. 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. The General Court (GC) upheld the appeal and annulled the BoA decision. The GC noted that the European Court of Justice (CJ) has held, in Case C-120/12 *PROTI SNACK / PROTI*, that Rule 20(1) CTMIR does not preclude the BoA from using its discretion under Article 76(2) CTMR in order to take account of facts and evidence submitted or produced late (Para. 25). Thus, in applying Rule 20(1) CTMIR and in failing to exercise its discretion, the BoA infringed Article 76(2) CTMR (Para. 28). The GC dismissed the Office's argument that the BoA had acted correctly, since the opponent (i) had not made a serious initial attempt to prove its entitlement as owner of the earlier Benelux mark and (ii) it had been negligent in not taking the necessary steps in order to regularize the ownership in the official records kept by the Benelux Office, notwithstanding the fact that the Office had drawn its attention to the importance of the aspect concerning the entitlement of the earlier mark. The GC held that, even if it were assumed that that was the case, that circumstance would be irrelevant to the lawfulness of the BoA's decision, since that decision is not based on the lack of probative value of the evidence produced by the opponent before the BoA, but on the BoA's inability to take that evidence into account at the stage of the opposition proceedings at which it adopted that decision (Para. 30). For the same reason, the GC dismissed the Office's argument that, even assuming, in light of the above mentioned ruling of the CJ in *PROTI SNACK / PROTI*, that the BoA could have exercised its reasoned discretion under Article 76(2) CTMR, still the BoA would, with all likelihood, have adopted a restrictive approach and would have decided in the sense that the belatedly filed evidence could not be taken into consideration (Para. 31). Finally, the GC pointed out that, in view of the BoA's discretion, the concept of a lack of legitimate interest in seeking to have the contested decision annulled (and which applies where the annulment of the contested decision can only give rise to another decision identical in substance to the decision annulled) cannot be invoked (Para. 32).



◆ **T-453/11; LAGUIOLE / FORGE DE LAGUIOLE**, Judgment of 21 October 2014, *Gilbert Szajner v. OHIM* – fr. As regards the admissibility of a national judgment rendered after the contested decision and its impact on the review of legality, the CTM holder submitted, for the first time before the GC, a judgment of the French Supreme Court adopted after the Board's decision and which supported its view, as well a number of other documents. While the latter was considered inadmissible (para. 23), the former was considered admissible (para. 24). The principle following which the party who relies on 8(4) must submit the content of the national law (C-263/09 Fiorucci) does not exclude the possibility to control the legality of the Board's decision in the light of a national decision which has been adopted on a subsequent date (para. 24 and 45). This is all the more so where a judgment merely clarifies the Case-Law (para. 46). Interpretative judgments have a retroactive effect: the Case-Law in force on a given date does not lead to acquired rights (para. 48). Even if the French Supreme Court's judgment is, as such, a "new fact", it interprets the French law as the Board should have done on an earlier date and as the GC must now do (para. 50).

**T-490/12; GRAZIA / GRAZIA**, Judgment of 26 September 2014; *Arnoldo Mondadori Editore SpA, v OHIM* – en. The CTM applicant sought to register the word mark GRAZIA for services in Classes 35, and 36. The opponent based its opposition on Article 8 (1) (b) and 8 (5) CTMR using among others the earlier Italian mark shown below, registered for goods and services in Classes 3, 9, 16, 18, 25 and 38. The opposition was directed against all the services covered by the application. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal, finding that the goods and services to be compared are dissimilar for which reason no likelihood of confusion may occur. As for the other ground invoked, the BoA found that the opponent did not show the alleged reputation for the earlier marks nor did it show the necessary link between the confronted marks in order to apply Article 8 (5) CTMR. The opponent appealed to the General court (GC), arguing an infringement both of Article 8 (1) (b) and 8 (5) CTMR. The applicant referred in the application before the GC to documents, which were not produced before the Office, and additionally proposed to submit further evidence if needed. The GC refused those submissions and the proposal as inadmissible. It confirmed the Case-Law that, since it is held to review the legality of the contested decision of the BoA, it must not re-evaluate the facts in the light of evidence submitted for the first time before it. (Para. 42 – 44). The applicant's claim that the BoA should not have concluded that the earlier figurative mark is not well known as its reputation had not previously been called into question must be rejected as unfounded. Following Article 64 (1) CTMR the BoA is to decide on the appeal and, in doing so, it may 'exercise any power within the competence of the department which was responsible for the decision appealed', that is to say, in the present case, give a decision itself on the opposition. It therefore follows from that provision that the effect of any appeal brought before it is that the BoA is required to carry out a new, full examination of the merits of the opposition, in terms of both law and fact (Para 45).

◆ **T-543/12; BUGUI VA / BUGUI et al**, Judgment of 24 October 2014, *Xavier Grau Ferrer v OHIM*, - es. The applicant sought to register the figurative mark represented below as a CTM for goods and services within Classes 31, 35 and 39. An opposition based on the earlier figurative marks represented below, registered for goods in Class 31 (Spanish trade mark) and Classes 31, 32 and 39 (CTM), was filed on the grounds of Article 8 (1) (a) and (b) CTMR. The GC annuls the decision to the extent that: (1) The BoA erred when it did not exercise its discretionary power to decide on the admissibility of the 'complete' database printout (Sitadex) regarding the ES mark submitted



before it. The GC finds that a discretionary power existed in this case and leaves the decision on whether or not to take the 'complete' Sitadex into account to the BoA since no mention on that issue was in the contested decision (Paras 49-52). The GC (i) points out that the BoA decided not taking into account the belated document without examining whether it was 'new' or 'additional' (Para. 43); (ii) considers that the graphical representation was not 'completely' new (because the first 'incomplete' Sitadex identified the colours of the sign and because the B&W representation of the sign had been reproduced in the opponent's arguments for the opposition) (Para. 44); and (iii) as subsidiary in its reasoning, refers to PROTI judgments (Para. 45).

### **1.3 Limitation, including restriction of goods and services**

◆ **T-127/13 PRO OUTDOOR / OUTDOOR**, Judgment of 11 September 2014, *El Corte Inglés S.A. v. OHIM – es*. The applicant sought to register the word mark PRO OUTDOOR in Classes 9, 12, 14, 18, 22, 24, 25, 28 and 35. Opposition based on the CTM figurative mark reproduced below, for goods in Classes 12, 18, 22, 24, 25 and 28. As to Article 8(1) (b) CTMR, the Opposition Division partially upheld the opposition for the goods in Classes 9, 12, 18, 22, 24, 25 and 28. The Board of Appeal (BoA) dismissed the appeal. The BoA took the view that the applicant had limited its appeal to 'computers and data processing equipment' in Class 9. Before the General court (GC), the applicant claims that the appeal referred to all the products for which the opposition had been upheld. Although the drafting of the appeal before the BoA was not clear, the GC takes the view that, examined in its context, it is clear that the applicant did not intend to limit the appeal to the goods mentioned by the BoA. The contested decision is partially annulled. The BoA must examine the appeal in relation to all the remaining goods.

## **2. Essential procedural requirements**

### **2.1 Right to be heard**

**T-184/12, HEATSTRIP / HEATSTRIP**, Judgment of 9 July 2014, *Moonich Produktkonzepte & Realisierung GmbH v OHIM – de*. On article 75 second sentence CTMR in conjunction with the principle of equal treatment: The BoA was not obliged to invite the applicant to present further arguments or inform it about its preliminary assessment of the case. The right to be heard extends to all the factual and legal material which forms the basis of the decision, but not to the final position which the authority intends to adopt (para. 37 with a reference to further Case-Law). The applicant cannot rely on the principle of equal treatment and the fact that the BoA sent a communication requesting further explanations.

**T-66/13, SHAPE OF A LIQUEUR BOTTLE**, Judgment of 16 July 2014, *Franz Wilhelm Langguth Erben GmbH & Co KG. vs OHIM – de*. The GC confirmed the discretion conferred to the Office for the arrangement of an oral hearing (Paras. 85-91). The applicant did not indicate circumstances which can be considered under the concept of misuse of powers (Paras. 92-96).



**T-567/12; KAATSU**, Judgment of 7 November 2014; *Kaatsu Japan Co. Ltd. v OHIM* - en The applicant sought to register the word mark KAATSU for goods and services in Classes 9, 10, 16, 28, 41 and 44. The examiner rejected the application for registration because the mark applied for was caught by the ground for refusal set out in Article 7(1) (c) and Article 7(2) CTMR. On the appeal of the applicant the Board of Appeal (BoA) dismissed the appeal. It held that the mark applied for related to an exercise method or technique to build muscle quickly, and that the term 'kaatsu' referred to that method and informed the consumer directly and without the need for further reflection on his part about the goods and services in question. The BoA went on to say, that the mark applied for was neither merely suggestive nor allusive, but directly descriptive of certain characteristics of the goods and services offered by the applicant. The BoA also held that the applicant had failed to show that the mark applied for had acquired distinctiveness through use. On the breach of the rights of the defence, the BoA held that the evidence upon which the examiner had based his conclusion was sufficient to establish the descriptive nature of the mark applied for. In referring to the fact that other evidence of descriptiveness existed, the BoA did not state that it was taking that evidence into consideration, but merely pointed out that other evidence existed so that the evidence upon which the contested decision was based was not exhaustive. Therefore, the GC held that it cannot properly be inferred from that passage that other evidence, which was not made available to the applicant, was taken into consideration in the administrative proceedings.

**T-176/13; GENERIA / GENERALIA generacion renovable**, Judgment of 9 December 2014, *DTL Corporación, S.L. v. OHIM* – es. The applicant sought to register the word sign GENERIA for goods and services in Classes 9, 35, 37, 40, 41 and 42. Opposition pursuant to Article 8 (1) (b) CTMR, based on the figurative mark reproduced below, covering goods and services in Classes 7, 35 and 40. The Opposition Division (OD) partially upheld the opposition with regard to all the products and services, except for some of the services in Class 35. The Board of Appeal (BoA) dismissed the appeal. Before the General Court (GC), the applicant alleges an infringement of the right of defence and of Article 8 (1) (b) CTMR. The applicant alleges a breach of the right of defence and the right to be heard because the OD found that G&S applied for in Classes 9, 37 and 42 were similar to goods of the earlier mark in Class 7, but the BoA found them similar to services of the earlier mark in Class 40, without giving the applicant the opportunity to file observations. The GC stated that it follows from Article 64 (1) CTMR that the BoA is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact. Since the services in Class 40 were invoked in the notice of opposition, the applicant had the opportunity, both before the OD and the BoA, to file its observations with regard to the lack of similarity between all the goods and services at hand. Within the framework of such full examination, the BoA was entitled to compare the relevant goods and services of the CTMA with the services of the earlier mark in Class 40 (paragraph 31). The BoA is not under the obligation to ask the parties for their observations on the similarity of the goods and services that the OD did not take into account but which were validly invoked in support of the opposition (Para. 32).



## 2.2 Adequate reasoning

◆ **T-47/12; EQUITER / EQUINET**, Judgment of 27 March 2014, *Intesa Sanpaolo SpA v OHIM* - en. The GC pointed out that an absence of or inadequate statement of reasons constitutes an infringement of essential procedural requirements for the purposes of Article 263 TFEU and is a plea involving a matter of public policy which may, and even must, be raised by the European Union judicature of its own motion (Paras. 22-24). The BoA's decision is vitiated by a failure to state reasons in so far as, first, it is not possible to identify from it the services, among those in respect of which the earlier mark is registered and which are cited as justification for the opposition, in connection with which that mark was put to genuine use and, second, it does not state the grounds on which the BoA held that genuine use of the earlier mark had been demonstrated..

◆ **T-502/12; OCTASA / PENTASA**, Judgment of 9 April 2014, *Farmaceutisk Laboratorium Ferring A/S v OHIM* - en. The evidence relied upon by the Board of Appeal and which consists of extracts, in English, from two online encyclopaedias, namely Wikipedia and The Free Dictionary concern only the English-speaking end-users of medicines and not non-English-speaking end-users (Para. 49). It is settled Case-Law that an extract from Wikipedia lacks certainty as a source of information (Para. 50).

◆ **T-170/12; BEYOND VINTAGE / BEYOND RETRO**, Judgment of 30 April 2014, *Beyond Retro Limited v. OHIM* - en. Regarding the goods in Classes 18 and 25, the GC held that the BoA erred in its finding of no likelihood of confusion (LOC) due to a lack of reasoning: the global assessment was seen to be flawed. The BoA distinguished between English-speaking and non-English speaking public, yet drew its formal conclusion only with regards to the non-English-speaking public (Para. 86). Since the BoA had concluded that the respective signs had no conceptual similarity for the latter, as opposed to low conceptual similarity for the former, the GC held that it might have been possible for the BoA to have made different findings regarding LOC for the English-speaking public (Paras. 89 and 90). It was not enough to assume a finding of no LOC for this public based on the BoA's finding of a lower than average distinctiveness of the earlier mark for the English-speaking public. The GC partially annulled the BoA on this basis.

**T-600/11; Carrera panamericana / CARRERA**, Judgment of 28 January 2014, *Schuhhaus Dielmann GmbH & Co. KG v OHIM* – en. The GC rejected *inter alia* the applicant's argument that the BoA would have failed to comply with its obligation to state the reasons for the contested decision (Paras. 19-28).

**T-486/12; METABOL / METABOL-MG**, Judgment of 11 June 2014, *Sofia Golam v OHIM* – en. The GC reiterated its settled Case-Law that an application is inadmissible insofar as it makes general reference to submissions in the course of the proceedings before OHIM (Para. 15). It also held that the duty of the BoA to state reasons does not require them to follow exhaustively and one by one all lines of reasoning of the parties (Paras. 18-19); it thus confirmed the implicit rejection of



the applicant's objections regarding abuse of the right to oppose, non-use of the right to file a CTM application and vagueness of the opponent's written pleadings (Paras. 21-23).

◆ **T-686/13 and T-687/13; FOUR STARS / FIVE STARS**, Judgment of 3 September 2014, *Unibail Management v. OHIM*, Language of the case - fr. The Case-Law recognises the possibility for the Office to use only general reasoning for all of the goods and services concerned where the same ground of refusal is given for a category or group of goods or services. The General court (GC) however considers that this possibility is exclusively limited to the circumstance in which the G&S are homogeneous (Para. 15 and 26). This is not the case as far as G&S in Classes 16, 35, 36, 38, 41 and 42 are concerned (Para. 21). The Board of Appeal (BoA) erred in failing to provide an adequate statement of reasons in relation to the lack of distinctive character of the signs at issue for each homogeneous category of the goods and services, apart from those in Class 43 (Para. 23). According to the GC, the BoA violated the essential requirement for any decision to be subject to judicial review. In particular, the GC is not in a position to assess the reasons why the BoA found that the CTMAs would be perceived as a badge of compliance with a "four star" label in respect of printed matters, financial services, or the service of rental of access time to global computer networks. Without making a distinction between the different categories of G&S, it is impossible to assume that the perception of the signs would be the same. This is because the lack of distinctive character cannot be the object of presumptions (Para. 26). Finally, the GC rebuts the relevance of past judgments cited by the Office in which the GC suggested that global reasoning could be appropriate where the general message conveyed by the signs is susceptible to be perceived equally in respect of all G&S (Para. 27). The decision of the BoA is thus annulled insofar as G&S in Classes 16, 35, 36, 38, 41 and 42 is concerned. The refusal of the CTMA in respect of the services in Classes 39 and 43 has become final since it was not challenged before the GC.

**T-450/11; GALILEO / GALILEO**, Judgment of 11 September 2014; *Galileo International Technology LLC v OHIM* - en. Regarding the subject-matter of the proceedings, the GC emphasized that it is not for the GC to remedy the shortcomings of the application since that would deprive the other parties of the opportunity to defend their views. It thus ruled that the applicant could not rely on all of the earlier rights despite having based its arguments on only two of them 'for reasons of procedural economy' (Paras. 15-17). The GC reiterated its jurisprudence according to which the obligation to state reasons must be distinguished from the reasoning being well-founded and stressed that, since the BoA upheld the OD's decision in its entirety, the latter and its reasoning form part of the contested decision. It therefore rejected the applicant's claim that the contested decision's findings as regards similarity of goods were insufficiently reasoned (Paras. 31-32, 34-37).

**T-576/12; PROTEKT / PROTECTA**, Judgment of 15. July 2014, *Grzegorz Łaszkiwicz v OHIM* – pl. The applicant filed an action before the General court (GC), claiming the infringement of Article 8(1) (b) CTMR and articles 75 and 76 CTMR. There was no infringement of article 75 and 76 CTMR. The applicant did not substantiate its argument that the OHIM applied the rules of the factual assessment pursuant to Article 76(1) CTMR incorrectly, so this argument must be dismissed (Para. 71). As to the claimed breach of Article 75 CTMR the GC emphasized that BoAs cannot be required to take a position on any argument raised by the parties. The reasoning has to



present the facts and considerations that were substantial for the decision (Paras. 77 and 78 with the reference to further).

◆ **T-605/13; SOTTO IL SOLE / VIÑA SOL et al**, Judgment of 25 September 2014, *Alma-The Soul of Italian Wine LLLP v. OHIM* - en. The applicant sought to register a figurative mark for ‘wines’ in Class 33. Opposition based on the ES and CTM word mark VIÑA SOL, as well as the figurative ES mark reproduced below and the CTM word mark SOL, all for wines or alcoholic beverages (except beers). As regards Articles 8 (1) (b) and 8 (5) CTMR, the Opposition Division (OD) upheld the opposition on the basis of the word mark SOL, cf. Article 8 (1) (b). On appeal, the Board of Appeal (BoA) upheld the opposition and rejected the CTM application, but referred to 8 (5) and the CTM VIÑA SOL. Before the General court (GC), the applicant alleges an infringement of Articles 64, 8(1) (b), 8(5) and 75 and 76(1) CTMR. On the infringement of Article 75 and Article 76(1) CTMR the applicant claims that BoA did not take into account evidence intended to establish that consumers in the EU are used to marks for wine containing the words ‘sol’, ‘sole’, ‘soleil’ or ‘sun’ and/or images of the sun and to show that the word ‘sol’ and translations have a very weak distinctive character in the wine sector. The General court (GC) stated that the reasoning of the decision may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA’s decision and provides the GC with sufficient material to review legality (Para. 19). Neither OD nor BoA mentions the evidence provided by the applicant. It cannot be held that even implicitly the BoA analysed the evidence in order to respond to the applicant’s arguments (p. 21). The BoA acted in breach of its duty to provide a statement of reasons (Para. 23) and therefore the decision was annulled.

◆ **T-235/12; BOTTLE WITH A STRAND OF GRASS**, Judgment of 11 December 2014 - *CEDC International sp. z o.o. v OHIM* – de.

CTMA	Earlier Mark
	

The applicant sought to register a 3D mark represented above as a CTM for goods within Class 33. An opposition was filed. Based among others on the earlier French mark represented below protected for goods in Class 33 with the following description: ‘a bottle as represented above inside which a blade of grass is placed almost diagonally in the body of the bottle’. The Opposition Division (OD) considered the proof of use of the earlier mark insufficient and rejected the opposition pursuant to article 42(2) CTMR. With the appeal the opponent filed further documents. The Board of Appeal (BoA) dismissed the appeal confirming the finding that the proof of use was insufficient. It found that that the proof of use showed bottles in two different shapes but always with the same striking non-transparent ‘ZUBROWKA BISON VODKA’ label covering a large part of the bottles, and that the diagonal line was not affixed to the outside surface and did not appear on the label itself. It further found that, as a result of the presence of the label, it was impossible to see what was behind it on or in the bottles. The opponent filed an action before the General Court



(GC) claiming the (i) infringement of the principle of legality and the Manual of Trade Mark Practice of the Office; (ii) infringement of Article 15(1) CTMR and Rule 22(3) of Regulation CTMIR and of Article 8(1) (a) and Article 42(2) and (3) CTMR; and (iii) infringement of Article 75 and Article 76 (1) and (2) CTMR. The GC annulled the decision following the third plea alleging infringement of Article 75 and Article 76 (1) and (2) CTMR. The BoA failed to examine evidence adduced for the first time before it and to provide reasons in that regard (paras. 41, 54). Article 76 (2) CTMR grants the Office a wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take such information into account (Para. 45). In the present case, it is clear that the BoA did not exercise the discretion conferred on it to decide whether or not to take into account evidence of use produced for the first time before it and did not give any reasons for its decision in that regard (Para. 61). In addition to that obligation to give reasons, the Case-Law has laid down criteria for the exercise of the Office's discretion for the purposes of potentially taking into account evidence submitted out of time. Thus, taking such facts or evidence into account is particularly likely to be justified where the Office considers, first, that the material which has been produced late is, on the face of it, likely to be relevant to the outcome of the opposition brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (Para. 62). In the present case, the evidence produced out of time met the two requirements for being taken into account by the Office (Para. 63). The stage in the proceedings at which the late production of evidence arose and the circumstances surrounding it do not argue against such evidence being taken into account by the Office, since the applicant produced it together with its statement setting out the grounds of its action before the BoA, thereby allowing the BoA to exercise its discretion in an objective, reasoned manner to decide whether or not to take the evidence into account (Para. 67). In relation to the arguments brought by the Office before the GC that were not taken into account for the purposes of that decision, it must be pointed out that such additional reasons cannot be successfully relied on before GC in order to make perfect potentially inadequate reasoning in the contested decision (Para. 71). Following was also found wrong: Rule 22(2) CTMIR does not prevent the BoA from exercising the discretion conferred on it by Article 76(2) CTMR in order to take into account any supplementary evidence produced for the first time before it (Para. 86). The Case-Law does not require a material connection between the supplementary evidence and the earlier evidence. It requires only that evidence submitted after expiry of the time-limit set by the OD not be the first and only proof of use, but that it be 'complementary' or 'supplementary' to relevant evidence which was lodged within the time-limit set (Para. 89). The fact that the applicant did not explain how the evidence produced for the first time before the BoA was complementary to the evidence adduced previously, nor why it had not adduced it by the time-limit set, is irrelevant since such an explanation is not required by the Case-Law (Para. 92 and 93). It is not necessary that the party concerned be unable to submit evidence within the time-limit in order for additional evidence of use of the mark submitted after expiry of the time-limit referred to in Rule 22(2) CTMIR to be taken into account (Para. 95). The Case-Law relied on by the Office, to the effect that a lack of statement of reasons, does not *per se* lead to annulment of the contested decision where it has no bearing on the issue of whether the contested decision is well founded, is ultimately inapplicable to the present case precisely because that condition is not met (Para. 99)



**T- 539/11; LEISTUNG AUS LEIDENSCHAFT**, Judgment of 25 March 2014, *Deutsche Bank AG v OHIM - de*. The existence of identical or similar registration on national level does not constitute a ground for admitting the registration of the mark devoid of distinctive character (Para. 53). The applicant did not even specify the grounds based on which the national authorities decided to register the word signs to which it referred and which might have been taken into account in the application of Article 7 (1) (b) (Para. 54). The Principle of equality and sound administration must be assessed with respect to the legality. A person who applies for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act that was to the advantage of someone else (Para. 62). For reasons of legal certainty and sound administration, the examination of any application must be strict and complete in order to prevent trade marks from being improperly registered (Para. 63).

### 2.3 *Ultra petita*

**T-122/13, T-123/13 and T-77/13; DODIE / DODOT**, Judgments of 8 October 2014 *Laboratoires Polive v OHIM – en*. In joint cases T-122/13 and T-123/13, the applicant sought to register two figurative marks represented below as CTMs for goods within Classes 3, 5, 8, 10, 11, 16, 18, 21, 25 and 28. Oppositions, based on the earlier Spanish and Portuguese word marks DODOT covering goods in Class 3, 5, 10, 12, 16, 18, 20, 21, 24, 25, 28 and 44, were filed on the grounds of Article 8 (1)(b) and Article 8 (5) CTMR. The Opposition Division (OD) partially upheld the oppositions on the basis that there was a likelihood of confusion between the marks at issue in respect of some of the goods in Classes 3 and 18 and accepted the CTMA in respect of the rest of the goods. The Board of Appeal (BoA) annulled the decisions of the OD and partially upheld the oppositions on the basis that there was a likelihood of confusion between the marks at issue also as regards some of the goods. The applicant filed an action before General Court (GC) alleging infringement of Article 8 (1) (b) CTMR. In the Case T-77/13, the applicant sought registration of the word sign DODIE for goods within Classes 3, 5 and 10. The opposition was based *inter alia* on earlier Spanish word mark DODOT registered for the goods within Classes 3, 5, 10 and 16 and on earlier Community word mark DODOT registered for the goods within Classes 16, 24 and 25). The opposition was based on the same grounds as in the joint cases outlined above and the action alleged also infringement of Article 8 (1) (b) CTMR. The GC stated that its power to alter decisions pursuant to Article 65(3) CTMR does not have the effect of conferring on the GC the power to carry out an assessment on which the BoA has not yet adopted a position. Exercise of the power to alter decisions must, in principle, be limited to situations in which GC, after reviewing the assessment made by the BoA, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the BoA was required to take (Para. 62). As in the present case the BoA did not examine whether was a likelihood of confusion between the mark applied for and any of the other earlier rights relied on by the intervener, the conditions for the exercise of GC's power to alter decisions are not satisfied and applicant's claim was rejected (Paras. 62 and 63).



## 2.4 Other

**T-291/12; PASSION TO PERFORM**, Judgment of 25 March 2014, *Deutsche Bank AG v OHIM* – en. The applicant’s arguments were rejected concerning the earlier use and national registrations. The CTM regime is autonomous (Para. 59) and, in any case, the applicant gave no details regarding the grounds on which national authorities had made decisions (Para. 60). As to the claimed breach of the principle of equality, reference was made to the judgment in Case C-51/10 P *Agencja Wydawnicza Technopol* that obliges the Office to take into account CTM registration decisions in respect of similar applications and consider with special care whether to decide in the same way (Para. 65), but this cannot result in taking advantage of a possibly unlawful act (Para. 66) and here the Board of Appeal carried out a comprehensive and specific examination of the CTMA, and another finding was not possible (Para. 68).

◆ **T- 484/13; THE YOUTH EXPERTS**, Judgment of 18 November 2014, *Lumene Oy v OHIM* – en. The applicant obtained an international registration designating European Union for the wordmark THE YOUTH EXPERTS, registered for the goods and services within Classes 3 and 5. The examiner refused the sign protection in the EU in respect of some of the goods applied for (the “contested goods”) and accepted the CTM application for the remaining goods (the “non-contested goods”) on the ground that the trademark applied for was devoid of any distinctive character in respect of the contested goods. The Board of Appeal (BoA) dismissed applicant’s appeal finding that the trademark applied for was unsuitable as an indication of the commercial origin of all the goods in Classes 3 and 5. The applicant filed an action before the General Court (GC). The GC raised of its own motion a question whether the BoA had competence to re-examine the application for registration of the CTM in question in respect of all the goods covered by that application, when the examiner had allowed the registration in respect of some of the goods covered (Para. 19). Pursuant to the first sentence of Article 59 CTMR, the BoA was legitimately affected of the appeal only to the extent that the lower authority had rejected the applicant’s claims and exceeded the limits of its powers in so far as it re-opened of its own motion the examination of the application in the light of absolute grounds of refusal in respect of the non-contested goods covered by the application (Para. 23-24). The contested decision was therefore annulled to the extent that the trademark applied for was declared devoid of any distinctive character in relation to the non-contested goods (Para 25



### 3. General principles of Community Law

**T-68/13; CARE TO CARE**, Judgment of 23 January 2014, *Novartis AG v OHIM* - en. The GC dismissed both pleas on which the action was based, the alleged infringement of Article 7(1) (b) CTMR and the breach of the principle of equal treatment. Although, in the light of the principles of equal treatment and sound administration, the Office must take into account the decisions already taken in respect of similar applications and must consider with special care whether it should decide in the same way or not, the way in which those principles are applied must, however, be consistent with respect for the principle of legality. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Accordingly, such an examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (Para. 51).

◆ **C-450/13P; ULTRAFILTER INTERNATIONAL**, Judgment of 19 June 2014, *Donaldson Filtration Deutschland GmbH v. OHIM + Ultra Air GmbH* - it. The CTM applicant Donaldson Filtration (formerly Ultra Air) sought to register the word trade mark indicated below. The Examiner rejected the application, considering that the trade mark was descriptive and lacked distinctiveness. Donaldson Filtration filed an appeal and the Board of Appeal (BoA) annulled the decision, considering that the trade mark had acquired distinctiveness in consequence of the use. Afterwards, Ultra Air filed an action before the Office for invalidity of the registered CTM. The Cancellation Division (CD) declared invalid the registered TM. Donaldson Filtration filed an appeal and the BoA annulled the decision of the CD, considering that Ultra Air's action was inadmissible on the ground of abuse of rights. Ultra Air filed an action for the declaration of invalidity in order to use the same trade mark for similar goods in its business. Ultra Air filed before the General court (GC) an action grounded on 2 main pleas: (i) infringement of Article 52(1) (a) CTMR and (ii) infringement of Article 56 (1) (a) CTMR. The GC annulled the BoA's decision, considering (i) that neither an interest in bringing proceeding nor good faith are required to file an application for a declaration of invalidity based on an absolute ground for invalidity, (ii) that the Office breached its obligation to examine the validity of the trade mark during a proceeding for declaration of invalidity and (iii) the fact that Ultra Air had previously filed an application for the registration of the trade mark did not preclude a subsequent application for a declaration of invalidity (para. 14-25). The CTM applicant and the Office filed before the European court of justice (CJ) an action based on two pleas in law: (i) infringement of the general legal principle of abuse of rights and (ii) error of law by not considering the relevance of the unfair and inconsistent behaviour of Ultra Air. The CJ dismissed the appeal pursuant to Article 181 RPCJ (order). (i) On the infringement of the general legal principle of abuse of rights, the CTM applicant criticised the GC for disregarding its arguments on the breach of the general legal principle and failing to ascertain and sanction the abuse of rights by Ultra Air. The CJ dismissed the ground of appeal given that it was based on an incorrect reading of the Judgment under appeal. The BoA erred in dismissing the appeal as inadmissible, without providing an adequate evaluation of the validity of the trade mark. Defending the need to keep a sign free from IPR in order to use it in trade does not constitute an abuse of right: this is deduced from the spirit of Article 7 (1) (c) CTMR (Para. 37, Para. 43). (ii) On the error



of law by not considering the relevance of the unfair and inconsistent behaviour of Ultra Air, the CTM applicant, supported by the Office, criticised the GC for committing an error of law by not considering the relevance of the unfair and inconsistent behaviour of Ultra Air which had previously supported the registration of the trade mark (Paras. 51-56). The CJ dismissed the ground of appeal as manifestly unfounded. The GC took into account the behaviour of Ultra Air, considering that it could not preclude an application for a declaration of invalidity based on an absolute ground for invalidity: this is justified by the aim, the nature and the object of such proceedings (Paras. 65-69).

**T-131/13; FLOWER ELEMENT ON CLOTHES**, Judgment of 14 March 2014, *Lardini S.r.l. v OHIM* - en. The Board of Appeal correctly dismissed the argument of the applicant that the Office had accepted other similar trademarks, given that in those cases the signs concerned were sufficiently stylized and had at least a degree of inherent distinctiveness, contrary to the sign applied for, whose shape is not sufficiently defined (Para. 36).

**T-513/12; NORWEGIAN GETAWAY**, Judgment of 23 January 2014, *NCL Corporation Ltd. v OHIM* - de. The General court confirms the Case-Law according to which decisions from authorities outside the EU are not binding for the assessment of whether a sign may be registered as a CTM.

**T-600/11; Carrera panamericana / CARRERA**, Judgment of 28 January 2014; *Schuhhaus Dielmann GmbH & Co. KG v OHIM* - en. The General court dismissed the applicant's reference to a judgment of the *Bundespatentgericht* (German Federal Patents Court) which had excluded a likelihood of confusion between the same signs (Para. 63).

**T-228/13; EXACT**, Judgment of 22 May 2014; *NIT Insurance Technologies Ltd. v. OHIM* - de. The GC dismissed also the applicant's plea that the acceptance of certain marks and at the same time the refusal of similar marks would distort the free competition on the market and restricts the free movement of goods or services. On the contrary, the decision of a BoA, such as that given in the present case, which rightly concludes, in accordance with the provisions of Article 7(1) CTMR, that a sign cannot be registered as a Community trade mark, cannot be regarded as constituting an obstacle to free competition, or to the freedom to provide services. The role of the Office departments of verifying that a trade mark applied for complies with the legislation governing the registration of Community trademarks serves rather to guarantee undistorted competition than to restrict competition (Paras. 56 to 59).

**T-404/13; SUBSCRIBE**, Judgment of 14 July 2014, *NIT Insurance Technologies Ltd. v. OHIM* - de. The GC dismissed the applicant's plea that the acceptance of certain marks and at the same time the refusal of similar marks would distort the free competition on the market and restricts the free movement of goods or services. On the contrary, the decision of a Board of Appeal, such as that given in the present case, which rightly concludes, in accordance with the provisions of Article 7(1) CTMR, that a sign cannot be registered as a Community trade mark, cannot be regarded as constituting an obstacle to free competition, or to the freedom to provide services. The role of OHIM departments of



verifying that a trade mark applied for complies with the legislation governing the registration of Community trademarks serves rather to guarantee undistorted competition than to restrict competition (para. 57 to 58).

◆ **T-341/13; SO BIO ETIC / SO... ?**, Judgment of 23 September 2014; *Groupe Léa Nature SA v OHIM* – en. According to the first plea the BoA has erred in law in the choice of the legal basis of the contested decision and therefore has breached the principles of legal certainty, legitimate expectations and the right to fair hearing because the contested decision was based on the Regulation 207/2009 and not on the Regulation 40/94 which was in force when the CTMA was filed. This plea was rejected as Regulation No. 207/2009 only codified Regulation No 40/94 and the relevant provisions thereof did not undergo any amendment in the course of that codification (Para. 18). GC also excluded the application of the right to a fair ‘hearing’ in proceedings before the BoA of the Office, since proceedings before the BoA are administrative and not judicial in nature (T-273/02 *CALPICO*) (Para. 25).

#### 4. Other

◆ **T-356/12; SÔ: UNIC / SO... ? ONE, SO... ? CHIC, et al.** Judgment of 3 April 2014. *Debonair Trading Internacional Lda v OHIM*. In relation to Article 8(4) CTMR, the Board of Appeal (BoA) held that the opposition was not admissible according Rule 15(2) (b) (iii) CTMIR, since the applicant had indicated that the opposition was based on non-registered marks in the European Union, whereas such a category of intellectual property rights did not exist. Regarding the alleged infringement of Rule 15(2) (b) (iii) CTMIR, the General court (GC) firstly noted that it is not true that the opponent had not provided a representation of the earlier signs used in the course of trade. Since they are word signs, the reference to them in the corresponding pages of the notice of opposition must be considered to be a representation of those signs (Para. 43). Then the GC noted that in the letter attached to the notice of opposition the opponent claimed that “Leaving aside the registrations of the opponent’s marks, the opponent has the right to prevent use of the mark applied for in the UK and Ireland at least on the basis of the law of passing off and in other Community [S]tates on the basis of the law of unfair competition having regard to the extensive goodwill and reputation earned”. In light of the above, the GC held that the opponent incorrectly checked the box entitled ‘EM’. This fact, however, did not render entirely inadmissible its opposition based on Article 8(4) CTMR. The information provided in the notice of opposition and in the attached letter made it possible to understand that it was claiming protection for the non-registered marks in the United Kingdom and in Ireland under the rules on passing off (Para. 44 to 48). Therefore, the BoA erred in declaring inadmissible the opposition founded on Article 8(4) CTMR.

◆ **T-556/12, KAISERHOFF / KAISERHOFF**, Judgment of 25 November 2014, *Royalton Overseas Ltd v OHIM + S.C. Romarose Invest Srl* – en. The applicant filed an application for the figurative trade mark ‘KAISERHOFF’ for goods in Classes 1 and 8. The opponent relied on an earlier Romanian mark ‘KAISERHOFF’ for goods and services in Classes 11, 21 and 35. The Opposition Division (OD) partially upheld the opposition. The applicant filed an appeal against the OD’s



decision and requested the suspension of the proceeding since a cancellation proceeding against the earlier right was pending before the Romanian Tribunal. The Board of Appeal (BoA) refused the request for suspension (Para. 12) and dismissed the appeal (Para. 13). The applicant brought an action before the General Court (GC) based on two pleas in law (Para. 20).

CTMA	Earlier mark
	KAISERHOFF

The GC upheld the first plea in law and annulled the BoA decision. As regards the first plea, the BoA did not take into account the evidence produced by the applicant in support of its request for suspension. Under Rule 20 (7) CTMIR, the Office has a wide discretionary power when deciding or not to suspend the proceedings. When reviewing the legality of an administrative decision based on such an appraisal, the GC must not substitute its own assessment for that of the BoA. Consequently, judicial review in such matters must be limited to verifying that the measure in question is not vitiated by any manifest errors or misuse of powers. A refusal to suspend the appeal proceedings may not be vitiated by any manifest error even where the validity of the earlier mark is challenged before a national court. This is because the decision on the suspension must take into account the balance between the parties' respective interests, including the opponent or cancellation applicant's interest to obtain a decision within a reasonable period of time (Paras. 31-36). The GC examined whether the BoA had correctly balanced the parties' interests. It replied in the negative. First, the fact that the cancellation action against the earlier mark was lodged after lodging the appeal before the BoA is not a proper justification for refusing the suspension (Para. 42). The holder of the earlier mark has no interest in pursuing the opposition if its earlier mark is cancelled: even if the CTMA was refused, it could not oppose a fresh filing (Para. 41). The CTM applicant has no interest in delaying the adoption of a decision because it does not enjoy an effective protection until the CTMA is registered (Para. 47). As regards the second plea, the BoA did not take into account the evidence produced by the applicant as grounds for rejecting the opposition, the GC deemed being not necessary to appraise the second plea in law, considering that (i) the examination of the question whether to suspend the proceeding is preliminary to the analysis regarding the likelihood of confusion between the trademarks and (ii) the GC is unable to determine the "soundness of the analysis carried out by the BoA in the contested decision" (Paras. 52, 53).



---

## II. ABSOLUTE GROUNDS FOR REFUSAL/INVALIDITY

### A. Article 7(1) (a), 52(1)(a) CTMR – Sign of which a CTM may consist

**C-421/13, DESIGN OF A RETAIL STORE**, Preliminary Ruling in Judgment of 10 July 2014, *Apple Inc. v Deutsches Patent- und Markenamt* - de. Apple obtained from the United States Patent and Trademark Office the registration of a three-dimensional trade mark consisting of the representation, by a design in colour (in particular, metallic grey and light brown), of its flagship stores for services within the meaning of Class 35, namely for 'retail store services featuring computers, computer software, computer peripherals, mobile phones, consumer electronics and related accessories and demonstrations of products relating thereto'. Subsequently, Apple sought to extend this trade mark internationally under the Madrid Agreement. That extension was accepted in some States and refused in others. *Inter alia*, the *Deutsches Patent- und Markenamt* (German Patent and Trade Mark Office, 'the DPMA') refused the extension of that three-dimensional international trade mark to German territory on the ground that the depiction of the space devoted to the sale of the undertaking's products was nothing other than the representation of an essential aspect of that undertaking's business. The DPMA considered that while it is true that consumers may perceive the layout of such a retail space as an indication of the quality and price bracket of the products, they would not see it as an indication of their commercial origin. Besides, it considered that the retail store depicted in the case before it was not sufficiently distinguishable from the stores of other providers of electronic products. Apple appealed to the *Bundespategericht* court against the DPMA's refusal decision. Although that court considered that the layout depicted by the three-dimensional trade mark has features that distinguishes it from the usual layout of retail stores in that electronic sector, it decided to stay the proceedings and to refer the following 4 questions to the Court of Justice: 1-3) Whether Articles 2 and 3 of the Directive 2008/95 must be interpreted as meaning that the representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store may be registered as a trade mark for services which comprise various services aimed at inducing the consumer to purchase the products of the applicant for registration and, if so, whether such a 'presentation of the establishment in which a service is provided' may be treated in the same way as 'packaging'? 4) Is Article 2 of Directive 2008/95 to be interpreted as meaning that the scale of the protection afforded by a trade mark for retail services also extends to the goods produced by the retailer itself?' The answer to the first to third questions: Article 2 of Directive 2008/95 does not forbid a graphic representation, such as a design, which depicts the layout of a retail store by means of an integral collection of lines, curves and shapes, from constituting a trade mark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings (Paras. 18-20). With the exception of Article 3(1) (e) of the Directive, which exclusively covers signs for which registration is sought consisting of the shape of the goods and is thus irrelevant for the resolution of the dispute in the main proceedings, the provisions of Article 3(1) make no explicit



distinction between different categories of trade mark (Linde and Others, C-53/01, 2003 I-03161, paragraphs 42 and 43), (Para. 24). Therefore, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not only for the goods themselves but also for services falling within one of the Classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple's application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by means of seminars of the products that are displayed there, can themselves constitute remunerated services falling within the concept of 'service' (Para. 26). The answer to the fourth question: The scale of the protection granted by a trademark for retail services manifestly bears no relation to the subject-matter of the main proceedings, which are concerned exclusively with the refusal by the DPMA to register the given sign as a trade mark. Consequently, according to the established Case-Law, a request for a preliminary ruling from a national court must be rejected where it appears to be quite obvious that the interpretation of Union law sought bears no relation to the facts or purpose of the main proceedings (see, *inter alia*, Cipolla and Others, C-94/04, 2006 I-11421, paragraph 25, and Jakubowska, C-225/09, 2010 I-12329, paragraph 28), therefore, the fourth question must be declared inadmissible (Para. 29-30).

## B. Article 7(1)(b), (c) and (d), 52(1)(a) CTMR – Non-distinctive, descriptive, customary

### **Non-distinctive:**

[T-534/12](#), [T-535/12](#); **FleetDataServices / TruckDataServices**, Judgment of 26 March 2014, *Still GmbH v OHIM – de*.

T-534/12	T-535/12
<b>FleetData Services</b> 	<b>Truck Data Services</b> 

The applicant sought to register the complex marks 'Fleet Data Services' and 'Truck Data Services', shown above, as CTMs for goods and services within Classes 9, 12, 35, 36, 37 and 39. The examiner refused the signs on the basis of Article 7(1) (c) and (b) CTMR and was confirmed by the Board of Appeal (BoA). The applicant appealed to the General Court (GC). The General court (GC) focused its analysis on Article 7(1) (b) CTMR. It agreed that the signs lacked distinctive character. The goods and services (*inter alia*, industrial cargo vehicles, management of vehicle fleets using software etc.) are directed at a professional public (Para. 13, undisputed), including consumers in those Member States in which English is an official language as well as professionals in the area of vehicle fleet management in the entire EU (Para. 13, undisputed). The relevant public would not understand the signs as a reference to the commercial origin, but as



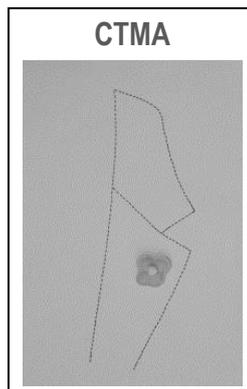
(advertising) indications in relation to the goods and services. They show that the goods and services serve the collection of data in relation to vehicle fleets and trucks and thereby allow an increase in efficiency of those vehicle fleets, an important characteristic of modern transport companies and fleets (Para. 16). The word element of the signs is easily understandable and has no originality in relation to the English language (Para. 23). The GC rejected the applicant's argument that the signs are distinctive through the addition of the figurative element. The figurative element has a direct connection to the meaning of the word elements (Para. 23) as it is made up of radio waves (Para. 22) and merely shows a network connection (Para. 25). The figurative element does not make the combination into more than the mere sum of its components. Since the signs lack distinctive character under Article 7(1) (b), it is not necessary to decide on Article 7(1) (c) CTMR (Para. 30). Finally, as regards the applicant's argument that the Board had breached its right to be heard by stating, for the first time in the Board of Appeal (BoA) decision, that the figurative element shows radio waves, the GC found that, as the applicant itself states that the figurative element shows radio waves, it could not have defended itself any better, if it had known before the BoA decision that the BoA would make this statement (Para. 35). The BoA statement that the figurative element, by itself, is not registrable is only supplementary and has no bearing on the decision to reject the complex signs for lack of distinctive character (Para. 36).

**T-291/12; PASSION TO PERFORM**, Judgment of 25 March 2014, *Deutsche Bank AG v OHIM* – en. The applicant sought to register the word sign PASSION TO PERFORM as a CTM for services in Class 35 (e.g. advertising), 36 (e.g. insurance, financial affairs), 38 (telecoms), 41 (e.g. education) and 42 (e.g. scientific and tech services). The examiner rejected the CTMA on the basis of Article 7(1) (b) CTMR. The Board of Appeal (BoA) dismissed the appeal, finding that the sign was devoid of distinctive character. The applicant appealed to the General court (GC), arguing an infringement of Article 7 (1) (b) CTMR. The BoA did not apply overly strict criteria for establishing the distinctive character of an advertising slogan, and it properly held that the CTMA would not be immediately perceived as an indication of commercial origin of the services in question, but would be perceived merely as a laudatory statement (Para. 22), conveying a clear message to the Anglophone public (Para. 41) that the applicant promised its clients that it would perform with passion (Para. 40). Each category of services was properly analysed (Para. 24). Nor did the Board err as to the assessment of the level of attention of relevant public, (Para. 29) the public at large including professionals, noting that the word combination was common parlance and not specialist terminology (Para. 30). Even if the level of attention of the relevant public can vary according to the goods or services claimed the GC held that the relevant public here had a low level of attention given the promotional nature of the mark at issue (Para. 33). Nor did the BoA err in finding no plausible various meanings of the word combination (Para. 42) Taken as a whole, and in light of the services, it could only have one meaning (Para. 55: the meaning is clear and precise in relation to the services). Further, with regard to the alleged 'resonance', neither the alleged alliteration (Para. 49), the 'emotional' content (Para. 53), the shortness of the phrase (Para. 52) nor its incomplete nature (Para. 52) were sufficient to imbue the word sign with distinctiveness, since such aspects were normal in promotional phrases and the phrases respect the semantic and grammatical rules of English (Para. 52). Additionally, the applicant's arguments were rejected concerning the earlier use and national registrations. The CTM regime is autonomous (Para. 59) and, in any case, the applicant gave no details regarding the grounds on which national authorities had made decisions (Para. 60). Breach of principle of equality: C-51/10 P *Agencja Wydawnicza Technopol* obliges the Office to take into account CTM registration



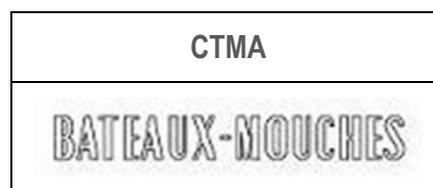
decisions in respect of similar applications and consider with special care whether to decide in the same way (Para. 65), but this cannot result in taking advantage of a possibly unlawful act (Para. 66) and here the BoA carried out a comprehensive and specific examination of the CTMA, and another finding was not possible (Para. 68).

**T-131/13; FLOWER ELEMENT ON CLOTHES**, Judgment of 14 March 2014, *Lardini S.r.l. v OHIM* - en.



The examiner refused the application under Article 7(1) (b) CTMR, considering that it would be perceived rather as an ornament than as a trademark. The Board of Appeal (BoA) dismissed the appeal, considering, on the one hand, that the sign was represented in too imprecise a manner for the relevant public to readily identify and memorize it and, on the other, that it represented an element commonly used to decorate the goods in question. The General Court (GC) dismissed the appeal and endorsed the BoA's findings. It held that the sign is very basic and does not present features that could identify it readily in the consumers' eyes as an indicator of origin. Even assuming it were perceived as a flower, given its position close to the buttonhole on the lapel of a clothing item, it is not sufficiently distinctive (Para. 23). The public are used to the presence of ornaments, including flowers, on the lapel of a jacket (Para. 24). The fact that the flower is not natural, but made of fabric does not change its likely perception as an ornament (Para. 30). The BoA correctly dismissed the argument of the applicant that the Office had accepted other similar trademarks, given that in those cases the signs concerned were sufficiently stylized and had at least a degree of inherent distinctiveness, contrary to the sign applied for, whose shape is not sufficiently defined (Para. 36).

**T-553/12; BATEAUX-MOUCHES**, Judgment of 21 May 2014, *Compagnie des Bateaux-Mouches v OHIM* – fr.





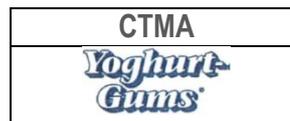
The applicant sought to register the figurative sign as a CTM for services within Classes 39, 41 and 43. The examiner refused the application for registration on the ground that the mark applied for was devoid of distinctive character for the purposes of Article 7(1) (b) and Article 7(1) (c) CTMR: The Board of Appeal (BoA) confirmed this decision. The applicant filed an action before the General Court (GC). The GC held that the targeted public by reference to which the existence of an absolute ground for refusal must be assessed is the average French speaker namely consumers from France, Belgium and Luxembourg, as the mark is composed of words of the French language (Para. 39). On the violation of Article 7(1) (b) CTMR The GC confirmed the analysis of the BoA in the definition of the expression BATEAUX MOUCHES and confirmed the reference to the *Dictionnaire de l'Académie française* which defines *bateaux mouches* as a type of boat used in the river Seine for the transportation of passengers for leisure purposes (Paras. 42 and 43). The GC referred to the judgment in a previous BATEAUX MOUCHES case (Judgment of 10 December 2008 in case T-365/06 for the verbal mark Bateaux Mouches) the fact that the applicant was the first user of the signs as trade mark in the 1950's does not exclude the fact that the term became generic (Para. 44). The evidence filed by the applicant showing its continuous efforts to protect the sign as a mark and to fight its use as a generic term does not prove the distinctive character of the mark (Paras. 45 and 46). On the violation of Article 7(1) (c) CTMR The GC confirms its case law that it is not necessary to examine this ground when the mark has already been refused on the basis of another absolute ground such as the 7(1) (b) (Para. 53). As regards the application of Article 7(3) CTMR, the GC confirmed the appreciation by the BoA that some of the evidence filed to demonstrate acquired distinctiveness refers to the verbal mark or to other figurative signs belonging to the applicant. Furthermore it confirmed that the campaign to fight against the term becoming generic does not constitute a direct evidence of the acquired distinctiveness, in the absence of a poll the BoA was correct when it just confirmed that the mark enjoys certain recognition in France. But this recognition of a certain reputation in France does not constitute proof of acquired distinctiveness in the meaning of Article 7(3) CTMR (Paras. 69 and 70). The fact that the figurative sign has been registered in France and in Switzerland does not constitute a factor in favour of acquired distinctiveness either (Para. 72). Nor constitute a factor the fact that the Office has on the 23 April 2012 registered the verbal sign BATEAUX MOUCHES for the same services under Article 7(3) CTMR (Para.73). The GC confirmed that the document filed by the applicant does not demonstrate acquired distinctiveness for the Belgian and Luxembourgish territories (Para. 75). The argument that the internet site of the applicant is available in 10 languages is not decisive either (Para. 76).

**T-570/11; La qualité est la meilleure des recettes**, Judgment of 15 February 2014, *Dr. August Oetker Nahrungsmittel KG v OHIM* – de. The applicant sought to register the word sign “La qualité est la meilleure des recettes” among others for goods in Classes 29, 30 and 32. The Grand Board of Appeal (BoA) confirmed the first instance decision. It found that the applied for sign lacks distinctive character as a banal laudatory message. The applicant did not show that the sign had acquired distinctiveness through use according to Article 7 (3) CTMR. The applicant appealed to the General court (GC), arguing an infringement of Article 7(1) (b) CTMR. The GC confirmed the finding of the BoA that the target public is the general public, which will not be very attentive, since the relevant goods are rather cheap and are consumed on a daily basis (Paras. 30-31). Since the applied for sign is composed of French words, the French speaking public is the target public for the assessment of the distinctive character (Para. 29). The GC further confirmed the assessment



of the meaning of the applied for sign which just conveys a laudatory message in the sense that the goods are quality products. The public will understand the sign as referring to methods of production of the goods that guarantee a quality. The sign is grammatically correct and does not bear any originality or other feature which would make it memorable (Para. 34). The contested decision therefore correctly concluded that the signs lacks any distinctiveness which prevents it from being registered (Para. 37). The applicant's argument that the sign consist of a play on words has been refused by the GC. The GC confirmed the Case-Law whereby the consumers will show a reduced attentiveness when they are confronted with laudatory messages. Consequently the public will not make big efforts to analyse the sign in depth (Para. 43). The applicant's view that the case at hand is to be compared with the Judgment in the case "Vorsprung durch Technik" (C-398/08) has been dismissed. The signs show differences in length and also the goods are different and the attentiveness of the public as well (Para. 58 – 60). Finally, the claim of the applicant that the applied for sign enjoys a reputation which would contribute to the distinctive character as it has been held in the case "Vorsprung durch Technik" (C-398/08) cannot succeed. The GC concluded that the applicant did not show the alleged reputation (Paras. 66 – 72).

**T-366/12; YOGHURT-GUMS**, Judgment of May 15<sup>th</sup> 2014, *Katjes Fassin GmbH & Co. KG v OHIM* - de.



The Board of Appeal (BoA) confirmed the rejection of the trade mark applied for goods in Class 30 - confectionery. It considered that yoghurt-gums describe the characteristic of those goods, namely that they are gum candies made with yogurt. In the reasoning the BoA referred to a previous decision in which a CTM application filed by the same party for an identical trade mark and good covering those applied for was rejected. The CTM applicant filed an action before the General Court (GC) claiming an infringement of article 7(1) (c) CTMR and 7(1) (b) CTMR. The GC dismissed the action. The trade mark must be refused pursuant to article 7(1)(c) CTMR, so there is no need to rule on article 7(1)(b) CTMR. The meaning of the word element is clear for the relevant English-speaking consumer, even if the word 'yogurt' is usually written without an 'h' (Para. 22). The combination of both words follows the grammar rules (Para. 24). The refusal of registration under article 7(1) (c) CTMR does not require that the word combination applied for is currently used in a descriptive manner (Para. 27). With regard to the figurative element in the context of descriptive character of a sign it is decisive if it can change the meaning of the word element (Para.30). The figurative elements of the sign are limited to the typeface, position, colour and the sign of an 'R' in a circle indicating a registered trade mark and cannot grant the trade mark any distinctive character (Para. 31-32).

**T-567/13; BIG PAD**, Order of 7 May 2014, *Sharp KK v OHIM* - en. The applicant filed an action before the General Court (GC). The GC agreed with the BoA that the relevant public was composed of average consumers and of professionals (Para. 19). The meaning of the sign in question had not been disputed by the applicant. This definition corresponds, in the GC's view, to the description of the goods concerned or their technical characteristics (Para. 21). Therefore, the applicant's claim that the sign is merely suggestive cannot be upheld (Para. 22). On the contrary, it



is a descriptive mark within the meaning of Article 7(1) (c) (Para. 24). These findings cannot be outweighed by the other applicant's arguments, namely that the expression 'big pad' is not used in common parlance (Para. 26), that the sign is a figurative one (Para. 27), or that there exist other previous decisions from the Office (Para. 32) or from the national offices (Para. 33). The GC therefore concluded that the applicant's action must be dismissed as being manifestly lacking any foundation in law (Para. 37).

**T-95/13; HIPERDRIVE**, Judgment of 22 May 2014, *Walcher Meßtechnik GmbH v OHIM – de*. The applicant applied for the word 'HIPERDRIVE' as a CTM (after limitation) for goods in Class 7 (essentially, position drives for the positioning of work pieces and tools). The examiner refused the CTMA under Article 7(1) (c) and (b) CTMR. The Board of Appeal upheld the examiner's decision. It considered that the English and German speaking professional public would understand HIPERDRIVE as HYPERDRIVE and, since the goods contain a motor, merely as a description of them containing a very strong/very good motor. The applicant appealed to the General court (GC), claiming an infringement of Articles 7(1) (c) and 7(1)(b) CTMR. The relevant consumers are English and German speaking professionals (the terms are known in Germany). German speaking consumers would pronounce 'HIPERDRIVE' in English as 'drive' and clearly as a word in English (not disputed) (Para. 25, 26). The GC rejected the applicant's argument that the element 'hiper' would not be understood as 'hyper'. Visually, there is only one different letter and consumers will perceive 'hiper' as a variation of writing 'hyper' (Para. 29). Phonetically, 'hiper', in English, will be pronounced identically to 'hyper' and due to the link with 'drive', it will likely be pronounced in English even by German consumers (Para. 30). Conceptually, 'hiper' and 'hyper' are identical. The consumer will understand the two the same way, even if one is misspelled (Para. 32). The GC also rejected the applicant's argument that 'HIPERDRIVE' was an artificial term that would not be understood as descriptive by the consumer and that, in any case, a motor was not the most important part of the goods in question. The professional consumer will clearly understand that the term refers to a very strong/very good motor and that the goods contain such a motor (Para. 39). From the perception of the relevant public, the characteristic of the component (motor) described by the sign could have a significant impact on the essential (not necessarily the 'most important') characteristics of the product itself (position drives) (Para. 41 et seq. with reference to T-625/11, *ecoDoor*). The registration, by the Office, of various CTMs containing the element 'hiper' (Paras. 46 to 52) and the registration of 'HIPERDRIVE' in the USA (Para. 53) do not change the assessment. As the sign is descriptive within the meaning of Article 7(1) (c) CTMR, it is not necessary to assess, whether it also lacks distinctiveness within the meaning of Article 7(1) (b) CTMR (Para. 55, 56).

**C-448/13P; INNOVATION FOR THE REAL WORLD**, Order of 12 June 2014, *Delphi Technologies, Inc. v OHIM*, - en. The applicant sought to register the word sign INNOVATION FOR THE REAL WORLD for goods in Classes 7, 9, 10 and 12, like motor vehicle products, GPS navigation systems, medical apparatus for vital signs monitoring, etc. The examiner refused registration pursuant to Article 7(1) (b) on the ground that the sign applied for was devoid of distinctive character. The Board of Appeal (BoA) confirmed this assessment. The General court (GC) dismissed the appeal, as the sign INNOVATION FOR THE REAL WORLD is instantly apparent to the relevant English-speaking public as meaning that the goods covered by the mark



applied for are innovations for the real world (Para. 30). The relevant public will perceive it, directly and without further consideration, as an allusion to innovative goods and not as an indication of the commercial origin of such goods (Para.32). Furthermore, the sign is not sufficiently original or resonant to require at least some interpretation, thought or analysis on the part of the relevant public, as that public is led to associate that sign immediately with goods which are capable of being marketed by any undertaking offering innovative products (Para. 37). As to the first ground of appeal, the appellant criticises the GC for not having correctly assessed neither the goods coming under Class 9 or the relevant public. In this regards the European Court of Justice (CJ) stated that the assessment of facts was out of the scope of the appeal. As to the second ground of appeal, infringement of Article 7(1) (b) by interpreting too strictly the criteria for assessing the distinctive character of the mark applied for, the CJ stated there was a misreading of the judgment under appeal and the Case-Law (Para. 35). The GC did not establish any hierarchy between the promotional and the commercial aspect of the perception of a mark consisting of a promotional slogan (Para. 37). The GC did not fail to state reasons. The appellant is seeking a new assessment of the facts, which is precluded in an appeal. As to the third ground of appeal, infringement of the principles of equal treatment and sound administration by rejecting its appeal against the decision of the BoA, even though the Office applied to this CTM application stricter criteria than those which allowed the registration of similar marks, the CJ ruled, that the appellant does not identify any error of law committed by the GC. The appeal is therefore dismissed in its entirety as being in part manifestly inadmissible and in part manifestly unfounded.

**T-68/13; CARE TO CARE**, Judgment of 23 January 2014, *Novartis AG v OHIM* - en. The applicant so ought to register the slogan “CARE TO CARE” for services in Classes 41 and 42. The Examination Division’s decision, rejecting the CTM application based on Article 7(1) (b) CTMR, was confirmed by the Boards of Appeal. The applicant appealed to the GC. The Court dismissed both pleas on which the action was based, the alleged infringement of Article 7(1) (b) CTMR and the breach of the principle of equal treatment. Marks that are also used as advertising slogans may be recognised as having distinctive character and the ability to indicate to the consumer the commercial origin of the goods or services in question where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public (Para. 16). According to Article 76(1) CTMR, examiners and the Boards of Appeal of OHIM are required to examine the facts of their own motion. Whilst it is in principle the task of the competent bodies to establish in their decisions the accuracy of such facts, such is not the case where they rely on facts which are well known. Facts shown by practical experience generally acquired and likely to be known to anyone, including the relevant public, are well known (Para. 22). The case at hand: The relevant public is made up of professionals and of the families of patients suffering from Alzheimer’s disease who are particularly well-informed as to the seriousness and effects of that disease (Para. 23). The facts concerning the need for a gradual adaptation and changes of care are *a fortiori* well-known to the relevant public, which is especially familiar with the effects of Alzheimer’s disease. In relying on well-known facts, the Board did not infringe the rules relating to apportionment of the burden of proof (Para. 24-25). In that specific context and in respect of the relevant English-speaking public, the expression ‘care to care’ will be perceived as a reference to the change from one type of care to another and, therefore, as a banal expression alluding to an inherent characteristic of educational and medical services relating to Alzheimer’s disease (Para. 37). The CTM applicant complained that the Board infringed the principles of equal



treatment not taking into account the decisions already taken in respect of similar applications. Although, in the light of the principles of equal treatment and sound administration, OHIM must take into account the decisions already taken in respect of similar applications and must consider with special care whether it should decide in the same way or not, the way in which those principles are applied must, however, be consistent with respect for the principle of legality. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Accordingly, such an examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (Para. 51).

**T-228/13; EXACT**, Judgment of 22 May 2014, *NIT Insurance Technologies Ltd. v. OHIM* – de. The applicant sought the registration of the CTM “EXACT” (word) for goods and services in Classes 9, 16 and 42. The examiner refused the application for most of the goods and all the services as being descriptive and without the necessary distinctive character (Art. 7 (1) (b) and (c) CTMR). The Board of Appeal (BoA) upheld that decision. The General Court (GC) confirms the descriptive meaning of the adjective “EXACT” with respect to the goods and services in Classes 9, 16 and 42. Those goods and services are intended to be accurate and the consumers would expect them to have that characteristic (Para. 28 to 31). The GC refuses the applicant’s argument that the characteristic of being “accurate” would be banal and intrinsic for the goods and services and therefore fanciful. On the contrary, the sign is descriptive since it just indicates a feature of the goods or services (Para. 32). It is irrelevant, if the sign could be considered as a slogan. Since it directly informs of specific characteristics of the goods or services it must be refused according to Article 7 (1) (c) CTMR (Para. 35 and 36). The applicant argued that the findings of the contested decision are in contradiction with the fact that the sign has been accepted for certain goods in Class 16. The GC confirmed the Case-Law referring to Article 59 CTMR, according to which a party may only file an appeal to the extent that it is adversely affected by the contested decision (see case T-236/12 “NEO”, Para. 23 and Case-Law cited therein). Consequently, even if there would be a contradiction between the refusal for certain goods and the acceptance of other similar goods, the Boards could not assess on that, since the accepted goods are not the subject matter of the proceedings before them nor before the GC (Para. 38 and 39). The applicant indicated some similar CTMs which have been registered and argues an infringement of equal treatment. The GC refuses that argument and referred to the constant Case-Law (Para. 41 to 48). Although, OHIM must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. The way in which those principles are applied must, however, be consistent with respect for the principle of legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Such an examination must therefore be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal. The GC dismissed also the applicant’s plea that the acceptance of certain marks and at the same time



the refusal of similar marks would distort the free competition on the market and restricts the free movement of goods or services. On the contrary, the decision of a BoA, such as that given in the present case, which rightly concludes, in accordance with the provisions of Article 7(1) CTMR, that a sign cannot be registered as a Community trade mark, cannot be regarded as constituting an obstacle to free competition, or to the freedom to provide services. The role of the Office departments of verifying that a trade mark applied for complies with the legislation governing the registration of Community trademarks serves rather to guarantee undistorted competition than to restrict competition (Para. 56 to 59).

**T-273/12; AB IN DEN URLAUB**, Judgment of 24 June 2014, *Unister GmbH vs OHIM* – de. The applicant sought to register the word mark “AB IN DEN URLAUB” as a CTM for services within Classes 35, 39, 41 and 43. The examiner explained the meaning of the CTM applied for as “[lets go] on holidays” and emphasized, that all services are related to travelling. The Board of Appeal (BoA) confirmed the refusal of the CTM application pursuant to article 7(1) (b) CTMR and considered the proof of acquired distinctiveness filed in the appeal proceedings as not sufficient. The CTM applicant filed an action before the General court (GC) claiming the infringement of articles 7(1) (b) and 7(3) CTMR. The GC rejected both claims: On article 7(1) (b) CTMR. The GC repeated the principles on the assessment of the distinctiveness of slogans (Para. 17-20). In the case on file the BoA correctly assessed that the CTM consisted of German words which would be understood in Germany, Austria, Luxemburg and parts of Belgium and Denmark and Italy (Para. 21). The BoA did not express a requirement that a slogan had to be fanciful, surprising or unexpected to be registered as a trade mark, but merely stated that the word combination applied for does not have these characteristics (Para. 22-23). As established in the Case-Law of the European court of justice (CJ), although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character (Para. 23). On article 7(3) CTMR, the BoA was correct when requiring the proof of the acquired distinctiveness in all German-speaking countries, which means Germany, Austria, Luxemburg and parts of Belgium and Denmark and Italy (Para. 39).

**T-404/13; SUBSCRIBE**, Judgment of 14 July 2014; *NIT Insurance Technologies Ltd. v. OHIM*; language of the case –de. The applicant sought the registration of the CTM SUBSCRIBE (word) for goods and services in Classes 9, 16 and 42. The First Instance refused the application for most of the goods and services as being devoid of distinctive character (Art. 7 (1) (b) CTMR). The Board of Appeal (BoA) upheld that decision. The General Court (GC) holds that the meaning of the English term “subscribe” as referring to payment for consecutive issues of goods or services as for example newspapers was undisputed (para. 23). Since the goods and services for which registration has been refused may be purchased via subscription, the consumers will consider the applied for sign as an indication on the possibility to subscribe to those goods or services (para. 30). Although, the sign does not give further information or details on the subscription, it may not be seen as an indicator of the origin for the affected goods and services (para. 31).. The BoA correctly concluded that the sign is devoid of distinctive character and consequently this finding may not be put in question because similar marks have been accepted (para. 47 to 49): Although, the Office must take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not. The way in which



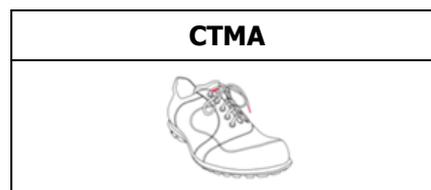
those principles are applied must, however, be consistent with respect for the principle of legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Such an examination must therefore be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal.

◆ **T-686/13 and T-687/13; FOUR STARS / FIVE STARS**, Judgment of 3 September 2014, *Unibail Management v. OHIM*, Language of the case – fr.

CTMA 1 (Classes 16, 35, 36, 38, 41 and 42)	CTMA 2 (Classes 16, 35, 36, 38, 41 and 42)
<p style="text-align: center;">————— ★ ★ ★ ★ —————</p>	<p style="text-align: center;">————— ★ ★ ★ ★ ★ —————</p>

The Board of Appeal (BoA) confirmed that the two CTMAs lacked distinctiveness to the extent that they would be perceived by the public at large and the professional public as a badge of guarantee that all G&S are of such a quality that they would comply with a “four star” label or the highest quality standards or have a high degree of prestige. Without making a distinction between the different categories of G&S, it is impossible to assume that the perception of the signs would be the same. This is because the lack of distinctive character cannot be the object of presumptions (Para. 26). Finally, the GC rebuts the relevance of past judgments cited by the Office in which the GC suggested that global reasoning could be appropriate where the general message conveyed by the signs is susceptible to be perceived equally in respect of all G&S (Para. 27). The decision of the BoA is thus annulled insofar as G&S in Classes 16, 35, 36, 38, 41 and 42 is concerned. The refusal of the CTMA in respect of the services in Classes 39 and 43 has become final since it was not challenged before the GC.

**C-521/13P; DESIGN OF RED SHOELACE TIPS**, Judgment of 11 September 2014, *Think Schuhwerk GmbH v OHIM*.



On the infringement of Article 7 (1) (b) CTMR, the applicant of the CTM criticised the GC for this infringement of Article 7 (1) (b) CTMR by not accepting that the Office infringed the aforesaid



provision (p. 35). The main sets of arguments (Paras. 36-40) were: Error of law by the GC. It would have incorrectly applied legal criteria and referred to wrong Case-Law; Criticism of the finding results from the factual assessment conducted by the GC. It would have not taken into account the level of attention of the relevant public and the diversity of the design of shoes and laces in relation to the market. The CJ dismissed the plea as being manifestly unfounded – referring to (a) - and manifestly inadmissible – referring to (b) (Para. 61): The GC validated the decision without committing an error of law. Since it had stated that the mark would be indistinguishable from the appearance of the product, correctly applied Case-Law developed and ascertained whether the sign departed significantly from the norms or customs of the sector (para. 50); The argument implies an assessment of the facts which is a matter reserved to the jurisdiction of the GC (Paras. 43, 44).

**T-171/12; SHAPE OF A TURNBUCKLE**, Judgment of 25. September 2014, *Peri GmbH v OHIM* - de.

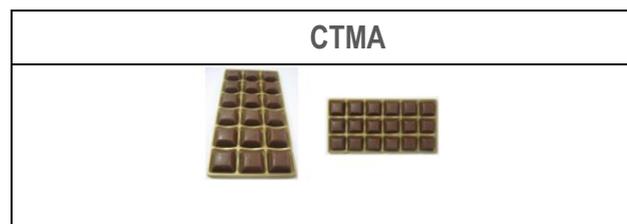


The BoA observed that the CTM application consist in a usual make variation of a turnbuckle which forms part of the goods covered by the application (“concrete formworks”). The CTM applicant filed an action before the General Court (GC), claiming an infringement of Articles 7 (1) (b) and 7 (1) (e) CTMR. During the GC procedure it requested a limitation of the goods applied for. On the subject of proceedings: The limitation of the goods initially applied for (“concrete formworks”) to “concrete formworks except turnbuckles” made during the GC proceedings exceeds the subject of the judicial control pursuant to article 65 (2) CTMR and would change the subject matter of the dispute against article 135 § 4 Rules of Procedure. It cannot be taken into consideration (para. 13 et seq. with reference to previous Case-Law). On the claimed infringement of Article 7 (1) (b) CTMR: The goods applied for are directed to specialised public with an enhanced level of attention (para.38). The Case-Law according to which a three dimensional trade mark consisting of a shape of the goods applied for must depart significantly from the norm or customs of the sector is applicable when the relevant public is the professional one (para. 42). The CTM applied for shows differences to the shapes of turnbuckles analysed in the contested decision of the BoA, but these differences are not significant enough to make the mark distinctive. The mark appears rather as a possible make variation of the goods covered by the application (para.44). On the claimed infringement of Article 7(1) (e) CTMR: The contested decision was not based on Article 7 (1) (e) CTMR but on Article 7 (1) (b) CTMR. For this reason the claim of an infringement of this provision is ill-founded.



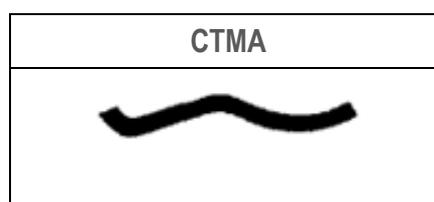
**T-712/13, REHABILITATE**, Judgment of 11 December 2014; *Monster Energy Company v. OHIM* - en. The examiner refused registration of the word sign REHABILITATE for goods in Classes 5, 30 and 32, on the basis of Article 7 (1) (b) and (c) and Article 7 (2) CTMR, as it would immediately inform consumers, without further reflection, that the goods were nutritional supplements and drinks which helped restore consumers to health. The Board of Appeal dismissed the appeal. The General Court notes that one of the meanings of the word REHABILITATE is to bring a person back to a good state of health or to enable him to return to a good physical condition, which is something that nutritional supplements in Class 5 and drinks in Classes 30 and 32 are supposed to help to do. The fact that this word may have other meanings does not rule out its descriptive character. In particular for the part of the relevant public engaged in intense physical exertion, the word REHABILITATE contains obvious and direct information on the purpose of the relevant goods. The application is dismissed.

**T-440/13; CHOCOLATE BOXES**, Judgment of 11. December 2013, *Zakład Wyrobów Cukierniczych „Millano” Krzysztof Kotas v OHIM* – pl.



The applicant sought to register the 3D mark represented above for goods in Class 30 (“chocolate boxes”). The Board of Appeal (BoA) confirmed the refusal of the CTM application by the examiner pursuant to Article 7 (1) (b) CTMR with the reasoning that the mark consists of the usual shape of the product. The applicant filed an action before the General court (GC) claiming the infringement of Article 7 (1) (b) CTMR. The head of claim requesting the registration of the CTM by the GC is inadmissible. The GC has no competence to give instructions to the Office (Para. 11). This request does not fall into the GC competence to alter the decision as the BoA was not competent to register the mark (Para. 12). There is no infringement of article 7 (1) (b) CTMR. The GC recalled its Case-Law related to the assessment of the distinctive character of the signs consisting of the shape of the product (paras. 18-20) and decided that the CTM applied for does not depart significantly from the usual shapes of the products on the market (Para. 24 *et seq.*) Even if the applicant was, as it claimed, the only producer using this shape of the product, it would not mean that the shape has the required distinctive character (Para. 28).

**T-53/13; DEVICE OF A WAVY LINE**, Judgment of 6 November 2014, *Vans, Inc. v OHIM* - en.



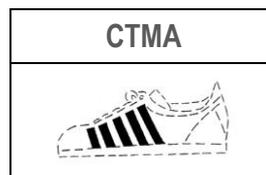


The applicant sought to register a community mark represented for goods within classes 18 and 25. The mark applied for was the figurative sign represented above. The application was rejected in its entirety based on article 7 (1) b) CTMR. The sign at issue was considered devoid of distinctive character and the fact that the mark applied for had already been registered in some Member States was considered to be irrelevant. Lastly, it was rejected on the basis of Article 7 (3) CTMR finding that the mark applied for had not acquired distinctive character through use. An appeal was filed to the Fifth Board of Appeal (BoA) which was dismissed on the basis that the trade mark applied for was devoid of any distinctive character within the meaning of article 7 (1) (b). In this regard, the relevant public of the mark applied for would only recall the concept of a wavy line, which is too vague to identify the goods as coming from a certain producer and that the graphic lines and stripes are commonly used in the Classes applied. Furthermore, the sign would lead the relevant public to perceive it as having a merely ornamental function. Lastly, the BoA found that the applicant did not provide enough evidence to prove that the relevant public would identify the goods covered by that mark and that it had acquired any distinctive character through use in the European Union as a whole for the purposes of Article 7 (3) CTMR. The applicant filed an action before the General Court (GC) relying on three pleas of law. The first plea alleging the infringement of Article 76 (1) was rejected as unfounded. In this regard, the applicant argued firstly, that the BoA refused to take into account all of its arguments and the evidence provided. The GC found that this fact cannot constitute an infringement of Article 76 CTMR but could only give rise to an infringement of a substantive provision, which the GC only assessed under the plea regarding Article 7 (3) (para. 22). Also, with regard to the substantiation of lack of distinctive character of the mark applied for, the applicant argued that the BoA failed to examine the distinctive character of the mark in relation to each of the sub-categories of goods concerned. The GC pointed out that the findings of the BoA concerning these arguments constituted sufficient statement of reasons, namely why the mark applied for was devoid of distinctive character in respect of the goods in classes 18 and 25 (paras. 37 to 39). The second plea alleging the infringement of Article 7 (1) b) was also rejected as unfounded. The applicant stated that the BoA erred in finding that the mark applied for was devoid of any distinctive character, namely that the consumers, who are accustomed to the use of single graphic lines and stripes on sports shoes as an indication of commercial origin, would not perceive the mark applied for not as decoration but as an indication of origin (para 42). The GC confirmed the BoA's assessment with regard to the lack of distinctive character of the mark in the sense that the relevant public would perceive the mark applied for as a simple line which combines slants and curves and therefore would not make it possible to individualise any of the goods in relation to other goods in competition (para. 75). Lastly, the third plea put forward by the applicant was also rejected as unfounded. The applicant mainly argued that the BoA erred in finding that the mark applied for had not acquired distinctive character through use for the purposes of Article 7 (3) CTMR (para. 90). The applicant argued that the evidence provided was sufficient to prove the acquisition of distinctive character acquired through use and that it was possible to establish the renown both of the undertaking as well as of its trade marks (para. 91). In this regard, the GC dismissed the applicant's arguments namely, by indicating that it is apparent that proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising material (para. 100). Also the mere fact that the sign had been used in the territory of the European Union for a certain time is not sufficient to show that the target public for the goods in question would perceive it as an indication of origin



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

**T-85/13, SHOE WITH FIVE STRIPES**, Judgment of 13 June 2014, *K-Swiss, Inc. v OHIM* – en.



The trade mark reproduced above was registered for the products ‘footwear’ in Class 25. An application for a declaration of invalidity was filed against the mark on the basis of Article 52(1) (a) and Article 7(1) (b). The Cancellation Division (CD) granted the application for a declaration of invalidity. The Board of Appeal (BoA) found that the sign does not possess the required minimum degree of distinctive character and confirmed the decision of the CD. The CTM proprietor filed an action before the General court (GC). The GC set out, first of all, that the mark must be considered to be indistinguishable from the appearance of the products (Para. 21) and that the Case-Law developed in respect of those cases is also applicable to the case at hand (Para. 33), namely that those signs are distinctive only if they depart significantly from the norms or customs of the sector (Para. 16). In that regard, the GC dismissed in particular the CTM proprietor’s arguments that, in the relevant sector, consumers are accustomed to making assumptions as to the commercial origin of products based on simple signs, composed of lines or stripes placed on the products or that the application of parallel stripes on the side of shoes is a long-standing practice used by itself. In the view of the GC, such arguments could not outweigh the BoA findings that the mark at issue is indistinguishable from the appearance of the product (Para. 31). The GC went on to assess in particular the BoA’s analysis of the distinctive character of the sign. In that respect, it stated that it had not been proven that the mark in question departs significantly from the customs of the sector (Para. 36). The GC set out that while the fact that a sign composed of a design applied to the surface of a product departs significantly from the customs of the sector concerned is a necessary condition for finding that that sign is distinctive, it is not a sufficient condition for such a finding. The sign at issue must also be independent of the appearance of the product it designates in order, in particular, not to be perceived by the relevant public merely as a decorative element (Para. 40). In the case at hand, however, the GC was of the opinion that the CTM proprietor had not proven that the five parallel stripes, applied to the external surface of shoes, could be apprehended without the intrinsic characteristics of those shoes being simultaneously perceived. It had not therefore proven that those five stripes could be easily and instantly recalled by the relevant public as a distinctive sign (Para. 42). That conclusion is not called into question, in the GC view, by the other CTM proprietor’s arguments, such as, among others, the existence of other registrations or the burden of proof borne by the applicant (Para. 44). The GC therefore concluded that the CTM proprietor’s action must be dismissed (Para. 58).

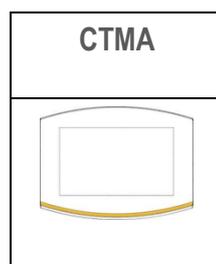


**T- 539/11; LEISTUNG AUS LEIDENSCHAFT**, Judgment of 25 March 2014, *Deutsche Bank AG v OHIM - de*. The applicant obtained an international registration designating European Union for the word sign *Leistung aus Leidenschaft* (in English: “Performance from Passion”), registered for the goods and services within Classes 35, 36 and 38. The examiner refused the sign protection in the EU on the ground that the trademark applied for was devoid of any distinctive character. The Board of Appeal dismissed applicant’s appeal finding that the mark applied for was a promotional slogan; hence a higher level of attention of part of the relevant public is required. It found that the mark was a statement that might be applied to all services covered by the trade mark and to all providers of these services. The mark conveyed to consumers the idea that the services offered by the applicant were of a very high quality because they were supplied by a particular provider; however, it did not contain any elements that the relevant public could keep in its memory as an indication of a specific commercial origin. The applicant filed an action before the General Court. In regards of the alleged failure to state reasons, the competent authority may use a general reasoning for all the goods or services concerned where the same ground of refusal relates to one category or group of goods or services (Para. 14). Sufficiently direct and specific link between the goods and products is required in order to form a category or group of goods or services of sufficient homogeneity for which the Office is allowed to provide general reasoning. The fact that the goods or services are within the same class under the Nice Agreement is not sufficient for this purpose (Para. 15). All services concerned may be supplied with a particular commitment, be it advertising, insurance services, financial services or telecommunications. Given the very general meaning of the mark at issue, there was no need to provide more detailed reasons for each category of services concerned (Para. 16). The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The competent authority should therefore consider overall impression of the mark when assessing whether the mark is or is not devoid of distinctive character. However, this does not preclude the competent authority from, at first, examining different elements of the mark applied for which may be even useful in the overall assessment (Para. 36). The mark appears to be a promotional slogan transmitting to the relevant public laudatory message that the applicant offers services with a particular commitment and is dedicated to their providing also with a particular devotion (Para. 45). The identity of the beginnings of the two usual names of which the mark is composed is quite usual in German and is solely the result of the juxtaposition of two simple terms from basic German vocabulary. The rhythm of the pronunciation of the combination of the words is also usual (Para. 47). The existence of identical or similar registration on national level does not constitute a ground for admitting the registration of the mark devoid of distinctive character (Para. 53). The applicant did not even specify the grounds based on which the national authorities decided to register the word signs to which it referred and which might have been taken into account in the application of Article 7 (1) (b) (Para. 54). The Principle of equality and sound administration must be assessed with respect to the legality. A person who applies for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act that was to the advantage of someone else (Para. 62). For reasons of legal certainty and sound administration, the examination of any application must be strict and complete in order to prevent trade marks from being improperly registered (Para. 63).



**T 484/13; THE YOUTH EXPERTS**, Judgment of 18 November 2014, *Lumene Oy v OHIM* – en. The applicant obtained an international registration designating European Union for the word mark THE YOUTH EXPERTS, registered for the goods and services within Classes 3 and 5. The examiner refused the sign protection in the EU in respect of some of the goods applied for (the “contested goods”) and accepted the CTM application for the remaining goods (the “non-contested goods”) on the ground that the trademark applied for was devoid of any distinctive character in respect of the contested goods. The Board of Appeal (BoA) dismissed applicant’s appeal finding that the trademark applied for was unsuitable as an indication of the commercial origin of all the goods in Classes 3 and 5. The applicant filed an action before the General Court (GC). In regards of the alleged infringement of Article 7 (1) (b) CTMR in relation to the contested goods the GC stated that the relevant public, confronted with the trade mark applied for, would not be led to perceive it as an indication of commercial origin, but as purely promotional information promising expertise in a particular field (Para. 45). Having concluded that the sign at issue was devoid of any distinctive character for the purposes of Article 7 (1) (b) CTMR, the BoA did not have to examine whether the sign might also be caught by the absolute ground for refusal of registration referred to in Article 7(1)(c) CTMR (Para 48). As regards the arguments alleging failure to follow the decision-making practice of the Office, the Office must take into consideration the decisions taken in respect of similar applications and consider with special care whether it should decide in the same way or not. A person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act that was to the advantage of someone else (Para. 56). Since the legality of the contested decision regarding the non-registrability of the sign THE YOUTH EXPERTS as a CTM in respect of the contested goods is established directly on the basis of Article 7 (1) (b) CTMR, the contested decision cannot be called in question merely because the BoA did not follow the decision-making practice of the Office (Para. 58). The CTM regime is an autonomous system with its own set of objectives and rules peculiar to it, which applies independently of any national system. Accordingly, the Office and, as the case may be, the judicature of the European Union are not bound by a decision given in a Member State, or indeed a non-member country, to the effect that the sign in question is registrable as a national mark (Para. 59). The single plea in law was rejected as unfounded as regards the contested goods (Para. 62).

**T-331/12; SHAPE OF AN ELECTRONIC SCREEN**, Judgment of 26 February 2014, *Sartorius Lab Instruments GmbH & Co. KG v. OHIM* - de.





The Board of Appeal (BoA) confirmed that the mark represented above lacked distinctiveness, considering that: all goods in cl. 7, 9, 10 and 11 are equipped with similar decorated electronic screen and the mark would be perceived by the professional public as an ornament/decorative element rather than as a badge of origin. The CTM applicant filed an action before the General Court (GC). The GC dismissed the action and endorsed the BoA's findings. The CG set out, first of all, that «a position mark» can be registered as CTM if all the CTMR requirements, mainly distinctiveness, are fulfilled (pp. 13, 15). Secondly, it affirmed that the mark must be considered to be indistinguishable from the appearance of the products and that the Case-Law developed in respect of those cases is also applicable to the case at hand, namely that those signs are distinctive only if they depart significantly from the norms or customs of the sector (p. 23). The GC dismissed in particular the CTM applicant's argument that the BoA did not take into account the higher level of attention of the relevant public to details (p. 30). In this regard, the GC was of the opinion that, the CTM applicant had not proven the aforesaid higher level of attention (p. 32). The CTM applicant provided pictures of similar products, but he did not explain how such documents can prove a higher level of attention by the professional public to details. The BoA's evaluation was correctly based on facts which are well known or which may be learnt from generally accessible sources (p. 31). Electronic screens of medical devices are usually characterized by simple, coloured and decorative elements on the borders. They are perceived by the professional public as an ornament rather than a badge of origin (p. 38). The contested mark does not depart significantly from the norms or customs of the sector: it is not unique, original or unusual in the sector (p. 39, p. 40). Moreover, the CTM applicant had not proven acquired distinctiveness in consequence of the use of the simple trade mark (p. 41).

**T-5/12; WASH & COFFEE**, Judgment of 14 July 2014, *BSH Bosch und Siemens Hausgeräte GmbH v OHIM – de*. The applicant sought to register the word mark Wash & Coffee as a CTM for goods and services within Classes 25, 37 and 43. The examiner refused to register the word as a CTM in respect of some of the services (Classes 37 and 43) on the ground that in relation to the services at issue the mark was devoid of distinctive character. The Board of Appeal (BoA) dismissed the applicant's appeal finding that the terms used are basic English words and will be therefore easily understandable to English speaking part of the relevant public, the services are addressed to large public and the sign with respect to the services at issue indicates that these two kinds of services will be offered together. The applicant filed an action before the General Court (GC). On the plea on violation of Article 7 (1) (b) CTMR, the GC rejected the argument of the applicant that the Board of Appeal should have examined only the services covered by the mark applied for and not their specific combination. The BoA proceeded correctly when it firstly examined separately the words which constitute the sign and the services covered by it and then examined the mark as a whole in relation to those services (Para. 36). Contrary to the applicant's argument that, if the concept of service is unusual, a slogan that conveys information about this concept should be unusual too, the GC held that the BoA could properly establish that it resulted from the unambiguous reading of the words "wash" and "coffee" that they had a clear conceptual content which easily appeared in the combination of these two terms constituting the mark (Para. 37). The fact that the relevant public has probably never been presented the combination of the services at issue does not prevent it from immediate understanding of the promotional message of the slogan Wash & Coffee (Para. 39). As regards the plea on violation of Article 76(1) CTMR, whilst it is Office's task to establish in its decisions the accuracy of facts that have not been raised by the applicant, such is not the case where it alleges facts which are well-known (Para. 46 and 47). The BoA upon its assessment held that it was a well-known fact that the message conveyed



by the combination of the terms used for trade mark would be perceived by target consumers as an offer of the combination of services at issue (Para. 51). Since the applicant failed to demonstrate that the assessment of the BoA was incorrect, his plea on violation of Article 76 (1) CTMR was rejected (Para. 52).

**T-601/13; PIONEERING FOR YOU**, Judgment of 12 December 2014, *Wilo SE v. OHIM* – de. The applicant sought the registration of this CTM for goods and services in Classes 7, 9, 11, 37 and 42. The First Instance held that the mark is devoid of distinctive character (Art. 7 (1) (b) CTMR). The Board of Appeal (BOA) upheld that decision. The GC ascertains that the applicant itself agrees with the findings of the BoA with regard to the meaning of the applied for sign. It would be understood as “innovative for you” (para. 27). The applicant does not criticise the BoA’s assessment that the applied for sign would be perceived as a laudatory message stressing the positive characteristics of the goods and services. (Para. 28). However, the applicant contends that the sign is not exclusively laudatory and that the public would have at least for some of the goods a higher attentiveness. It further puts forward that the sign might be seen as a word play, which requires some mental effort to grasp its meaning (para. 29 and 33). The GC disagrees with the applicant. It states that the uppercase used for the letter “Y” in the word “You” is not uncommon and would in any event have no impact, also following the Case-Law according to which a different spelling which may not be pronounced would not have any impact on the semantic meaning of the sign (see case T-640/11 [RELY-ABLE]) (para. 35). The GC further states that the meaning of the sign is clear and does not leave any doubts. The structure of the sign is grammatically correct and does not trigger any mental process in order to find out its meaning. It is, as a whole, a simple message which would fit to any producers or service providers with the natural consequence that it may not indicate the origin of the goods or services (para. 36). Concerning the attentiveness of the public, the GC referred to the constant Case-Law according to which the attentiveness in cases of slogans tends to be low, even for a specialized public. It further adds that even for a higher attentive public the applied for sign would still convey a laudatory message without any distinctive character (para. 38). As far as the applicant’s complaint on the infringement of equal treatment is concerned, because similar marks have been registered by the Office, the GC answered the following: First it made reference to the constant Case-Law which clearly states that decisions concerning registration of a sign as a Community trade mark which the BoA are called on to take under Regulation No 40/94 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of BoA must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice of the BoA (para. 41). The GC further stresses that even if a similar or identical sign has been previously registered, the later applicant cannot rely on that unlawful decision. The principle of equal treatment has to respect the principle of legality (para. 42). Also the factual circumstances may vary from case to case. The claim that the Office should have adopted the same reasoning as in a specific previous case is unfounded, unless the applicant shows that the BoA has committed an error leading to the annulment of the contested decision (para. 43).



T-344/14; **DELUXE**, Judgment of 17 December 2014, *Lidl Stiftung v. OHIM* – de.



The applicant sought the registration of the figurative mark **Deluxe** as shown above for goods in Classes 29, 30, 31, 32 and 33. The First Instance held that the mark is devoid of distinctive character (Art. 7 (1) (b) CTMR). The Board of Appeal (BoA) upheld that decision. As to the procedure, the the General Court (GC) confirms the Case-Law that an appeal against a decision of the BoA has the aim of reviewing its legality. This means that the GC may only take into consideration the factual and legal situation as it has been present before the BoA. Consequently new facts and evidence submitted for the first time before the GC are inadmissible, with the only exception of well-known facts, which are to be considered on its own motion (para. 9 -11). With reference to the word element “Deluxe” the GC states that the word element “Deluxe” is purely laudatory and promotional intended to inform on the positive qualities of the goods. At least the English and German speaking consumers will immediately grasp this meaning (para. 24). The expression does not require any mental effort or interpretation nor is it original or resonant (para. 25). The typeface of the sign together with the figurative elements and the colour silver merely underline the message of elegance and quality of the expression “Deluxe” and do not add any distinctiveness to the overall impression (para. 26 and 27). The BoA correctly concluded that taken as a whole the applied for sign is devoid of distinctive character (para. 28). As far as the applicant’s complaint on the infringement of equal treatment is concerned, because similar marks have been registered by the Office, the GC answered the following: First it made reference to the constant Case-Law which clearly states that decisions concerning registration of a sign as a Community trade mark which the BoA are called on to take under the CTMR are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of BoA must be assessed solely on the basis of that regulation, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice of those boards (para. 38).The GC further stresses that even if a similar or identical sign has been previously registered, the later applicant cannot rely on that unlawful decision. The principle of equal treatment has to respect the principle of legality (para. 40 and 41).

**Descriptive:**

T-207/13; **THE SPIRIT OF CUBA**, Judgment of 24 June 2014, *1872 Holdings of & Havana Club International SA v OHIM* – en. The applicant was granted registration of the word mark THE SPIRIT OF CUBA as a CTM for Classes 33, 35 and 42. The intervener, Havana Club International SA, filed an invalidity request based on the fact that the mark THE SPIRIT OF CUBA was invalid pursuant to Article 52(1) (a) on the grounds that that mark had been registered in breach of Article 7(1) (b), (c) and (g) CTMR. The Cancellation Division (CD) granted the declaration. On the appeal



of the applicant the Board of Appeal (BoA) dismissed the appeal. It held that the expression ‘the spirit of Cuba’ described the nature and content of the goods and services at issue, namely, that the particular beverage that might be in question was an alcoholic spirit from Cuba or that the services provided related to an alcoholic spirit from Cuba or to a beverage that is normally mixed with, or consumed with, an alcoholic spirit from Cuba. It concluded that the CD had acted correctly in cancelling the registration of the mark THE SPIRIT OF CUBA on the grounds of Article 7(1)(c) of Regulation No 207/2009, read in conjunction with Article 52(1)(a) thereof. The GC dismissed the action. On the relevant public the findings of the BoA were challenged by the applicant, but the GC confirmed that the goods covered by the contested mark in Class 33 and the services of ‘retailing of alcoholic drinks’ in Class 35 were directed at the public at large and that the other services covered by the contested mark in Classes 35 and 42 were primarily of interest to businesses operating in the beverages sector. In addition, it took the view that, as the words composing the contested mark are basic words of the English language, the relevant public was made up of English speaking consumers within the European Union (point 15). On the descriptive character in the expression ‘the spirit of Cuba’ the word ‘Cuba’ designates the island State of that name in the Caribbean, the word ‘spirit’ designates, inter alia, a liquid obtained by distillation, specifically one which is of an alcoholic nature (alcoholic spirit), a category which includes rum. The GC confirmed the observation made by the BoA that it was not disputed that Cuba is well known historically for its rum industry. The BoA took the view that the use of the definite article ‘the’ had no impact on the perception of the contested mark and that the expression ‘the spirit of Cuba’ was grammatically correct and did not constitute an expression that was unusual or surprising in the English language so far as the goods and services at issue were concerned, that is to say, alcoholic beverages or services rendered in connection with alcoholic beverages or other beverages mixed with or consumed alongside alcoholic beverages. The GC then confirmed that the expression ‘the spirit of Cuba’ described the nature and content of the goods and services at issue, namely, that the particular beverage in question was an alcoholic spirit from Cuba or that the services rendered concerned an alcoholic spirit from Cuba or a beverage that is normally mixed with, or consumed with, an alcoholic spirit from Cuba. The GC confirmed the finding that under at least one of its meanings the word ‘spirit’ means ‘alcoholic spirit, alcoholic beverage’ and therefore is sufficient for it to be held that the BoA acted correctly in taking the view that the expression ‘the spirit of Cuba’ would be understood, by the relevant public, as a reference to the alcoholic spirit of Cuba or to the alcoholic beverage of Cuba (point 26) and as a consequence the BoA was right to conclude that the contested mark was descriptive for the purposes of Article 7(1)(c) of Regulation No 207/2009.

**T-513/12; NORWEGIAN GETAWAY**, Judgment of 23 January 2014, *NCL Corporation Ltd. v OHIM* – de. The applicant sought the registration of the CTM for services in Class 39. The examiner held that the mark is descriptive and lacks distinctive character (Article 7 (1) (b) and (c) CTMR). The Board of Appeal (BoA) upheld that decision. The General Court (GC) confirms that the target public of services as “arranging of cruises” and “Cruise ship services” in Class 39 is composed, inter alia, of the average attentive public. The argument of the applicant, that cruises are very expensive and, therefore, the attentiveness of the public would be very high, has been refused. These kind of cruise travels may not be considered, compared to other ways of travelling, as that expensive. The applicant puts forward that the term “Norwegian” would refer to the applicant itself, since it has a series of marks containing that word and the public would recognize it as referring to the applicant’s travel undertaking. The GC stated that the applicant did not invoke Article 7 (3) CTMR which, following the systematic of Article 7 CTMR, is the only provision on



which the use of a sign may be relied on for the purpose of that Article (Paras. 35 and 36). The alleged infringement of Article 7 (1)(c) CTMR by not investigating, on its own motion, if the expression “Norwegian” would be seen as a reference to the applicant has been rejected by the GC. The reputation of the applicant is not relevant for the application of that ground for refusal and the BoA rightly concluded that the term “Norwegian” is purely descriptive. The GC also concluded that the sign as a whole merely refers to a short holidays (“Getaway”) together with a territorial reference to Norway (“Norwegian”). The GC confirms the Case-Law according to which decisions from authorities outside the EU are not binding for the assessment of whether a sign may be registered as a CTM.

**T-514/12; NORWEGIAN BREAKAWAY**, Judgment of 23 January 2014, *NCL Corporation Ltd. v OHIM – de*. The applicant sought the registration of the CTM for services in Class 39. The examiner held that the mark is descriptive and lacks distinctive character (Article 7 (1) (b) and (c) CTMR). The Board of Appeal (BoA) upheld that decision. The General Court (GC) confirms that the target public of services as “arranging of cruises” and “Cruise ship services” in Class 39 is composed, inter alia, of the average attentive public. The argument of the applicant, that cruises are very expensive and, therefore, the attentiveness of the public would be very high, has been refused. These kind of cruise travels may not be considered, compared to other ways of travelling, as that expensive. The applicant puts forward that the term “Norwegian” would refer to the applicant itself, since it has a series of marks containing that word and the public would recognize it as referring to the applicant’s travel undertaking. The GC stated that the applicant did not invoke Article 7 (3) CTMR which, following the systematic of Article 7 CTMR, is the only provision on which the use of a sign may be relied on for the purpose of that Article. The alleged infringement of Article 7 (1)(c) CTMR by not investigating, on its own motion, if the expression “Norwegian” would be seen as a reference to the applicant has been rejected by the GC. The reputation of the applicant is not relevant for the application of that ground for refusal and the BoA rightly concluded that the term “Norwegian” is purely descriptive. The GC also concluded that the sign as a whole merely refers to a short holidays (“Breakaway”) together with a territorial reference to Norway (“Norwegian”). The GC confirms the Case-Law according to which decisions from authorities outside the EU are not binding for the assessment of whether a sign may be registered as a CTM.

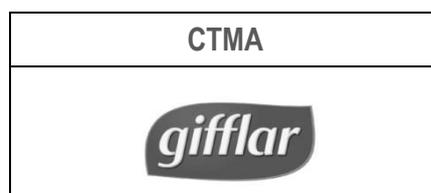
**T-102/11, T-369/12, T-370/12, T-371/12; IP ZONE et al**, Judgment of 12 March 2014; *American Express v. OHIM - en*. The examiner refused registration of the word signs IP ZONE, EUROPE IP ZONE, IP ZONE EUROPE and EUROPEAN IP ZONE for ‘hosting an on-line portal for disclosing, selling, buying, licensing and general transactions for intellectual property’, on the basis of Article 7(1) (b) and (c) and Article 7(2) CTMR. The Board of Appeal dismissed the appeals. The services at issue are aimed at professionals in the field of intellectual property. The absolute ground of refusal has to be assessed in relation to the English-speaking public. The General Court (GC) confirms that, from the point of view of the relevant public, there is a sufficiently direct and specific relationship between the signs and the services in respect of which registration is sought. The GC confirms that the possible meaning of the acronym IP should not be examined in the abstract, but in relation to the services covered by the marks applied for and to the consumers for whom they are intended (Para. 30). The signs at issue, taken as a whole, will be unequivocally understood by the relevant public as describing an area devoted to intellectual property. Even if this definition is



not particularly precise, it clearly includes the services at issue, namely ‘hosting an on-line portal for disclosing, selling, buying, licensing and general transactions for intellectual property’ (Para. 34). Since the signs are not capable of registration pursuant to Art. 7(1) (c) CTMR, it is not necessary to rule on the alleged infringement of Article 7(1) (b) CTMR.

**C-126/13, ecoDOOR**, Judgment of 10. July 2014, *BSH Bosch und Siemens Hausgeräte GmbH v OHIM – de*. The General court (GC) confirmed (T-625/11), the refusal of the mark ecoDoor for goods in Classes 7, 9 and 11. According to the GC, a sign that is descriptive of a characteristic of a component incorporated in a product can also be descriptive of the product itself. That is the case where, from the perception of the relevant public, the characteristic of the component described by the sign could have a “significant impact on the essential characteristics of the product itself”. Thus the sign ecoDoor, which describes the ecological qualities of doors, is descriptive in respect of products equipped with doors, such as dishwashers, washing machines, vending machines, apparatus for cooking etc. The CTM applicant claimed an infringement of article 7(1) (c) CTMR. The European court of justice (CJ) dismisses the appeal. It held that a characteristic of a part of the product is susceptible to fall within Article 7(1) (c) CTMR, if it is “the specificity of an equipment of a product which constitutes a significant property of this product” (para. 24). In this case, the GC had observed that the quality of doors have a “decisive importance” for the goods for which the CTM application was rejected (Para. 25). The GC did therefore not make any error in law when holding that the sign is descriptive since it is descriptive of an equipment, which in the perception of the public, is likely to have “a significant impact on an essential characteristic of the product itself” (Para. 27).

**T-520/12, GIFFLAR** Judgment of 9 July 2014, *Pågen Trademark AB v OHIM – sv*.



The trade mark reproduced above was applied for in relation to, amongst others, ‘Bread, biscuits, rusks, cakes, baked goods, pastries and confectionaries’ in Class 30. The examiner refused the trade mark in relation to the above mentioned goods on the basis of Article 7(1)(b) and (c) and 7(2) CTMR in relation to the Swedish speaking consumers in the EU. In its appeal, the applicant raised the claim of acquired distinctiveness through use, Article 7(3) CTMR. The Board of Appeal (BoA) rejected the appeal as unfounded and confirmed that the sign is descriptive and without the necessary distinctive character. In addition, the BoA found that the trade mark had not acquired distinctiveness through use. The applicant filed an action before the General court (GC). The GC starts off by confirming that the relevant public consists of both Swedish and Finnish consumers since even Finnish consumers know Swedish (para. 20). Furthermore, it is undisputed that the Swedish word ‘gifflar’ is plural for a type of croissant made from a wheat dough, and that this word is descriptive for the relevant goods. In addition, the GC refuses the applicant’s arguments that the sign as a whole, in its figurative form, is not descriptive and instead distinctive. The GC cites Case-Law where it is stated that when a composite mark consists of descriptive and non-descriptive elements, the trade mark can nevertheless be considered descriptive if the non-descriptive



elements do not divert the attention of the relevant public from the descriptive message the descriptive elements convey (para. 24). The GC also dismisses the applicant's arguments that the trade mark 'giffjar' is not descriptive for the actual product sold, which is not a croissant but instead a cinnamon roll tipped on its side. In this regards, the GC states that even if the trade mark is not descriptive for the actual product, it can still be used in relation to all goods covered by the application for which it is descriptive (para. 29). Therefore the BoA was correct in refusing the mark under Article 7(1) (c) CTMR and there is no need to assess the case under 7(1)(b) CTMR. In relation to the claim of acquired distinctiveness the GC notes that it is undisputed that all evidence consists of the applied sign 'giffjar' is used in combination with the trade mark 'Pågen' (para 41). From the evidence, it is apparent that the word 'giffjar' is used as a designation for a type of small breads. This word is, in all the product packages submitted by the applicant, used in combination with a word describing the flavour of said breads, for example cinnamon ('giffjar kanel'), vanilla ('giffjar vanilj') and chocolate ('giffjar choko'). The evidence further shows that the word 'giffjar' is used in a descriptive way by the competitors of the applicant (para. 44). In addition, the fact that the word 'giffjar' is always used in combination with the applicant's trade mark 'Pågen', differs in its stylisation from 'Pågen', and has a prominent position on the packages, does not mean that the relevant consumers understand the word 'giffjar' as the commercial origin of the goods. The fact that the word 'Pågen' is the company name of the applicant means that this trade mark, and not the sign 'giffjar', designates the commercial origin of the goods (para. 45). The applicant's arguments were therefore dismissed and the claim was rejected.

**T-484/12; SMILECARD**, Judgment of 25 September 2014; *CEWE Stiftung & Co. KGaA v OHIM*; Language of the case – de. The applicant sought to register the sign SMILECARD (word) as a Community trade mark. Protection was claimed for goods and services in classes 9, 16 and 40. The sign was refused under Article 7(1) (c) and (b) CTMR. The appeal filed by the applicant was rejected. The General court (GC) confirms the reasoning of the Board of Appeal (BoA) as to the merely descriptive character of the sign under Article 7 (1) (c) CTMR. The goods and services covered by the application are directed to the general public. The reasonably well informed, circumspect and attentive consumer is to be taken into account when evaluating the registrability of the sign at issue (Para. 20). Moreover, the English-speaking public has to be considered in this context since the sign consists of two English words. According to Article 7(2) CTMR, it is sufficient if the absolute ground for refusal exists only in a part of the European Union (Para. 21). The words "smile" and "card" belong to basics in English vocabulary. The relevant public will immediately understand the meaning of the combined term "SMILECARD" as referring to a card (postcard, greeting card) that makes its addressee smile (Para. 23). The combination "SMILECARD" follows the syntax and grammar rules of the English language and its structure is not unusual (Para. 25). The sign "SMILECARD" is purely descriptive in relation to all goods and services covered by the application: The goods in Class 16 include postcards or greeting cards or material of which those cards are made of like paper, cardboard or photographs. Being confronted with the word "SMILECARD" for those goods, the relevant public will immediately assume that the goods are postcards which make their addressee smile or serve to create those kinds of greeting cards (Para. 27). The computer software in Class 9 may also serve to create electronic postcards or greeting cards (Para. 28). Likewise, the services in Class 40 of the application may have the purpose of designing and producing such kinds of postcards (Para. 31). As regards the previous Community trade mark registered by the applicant, it is true that the Office has to consider

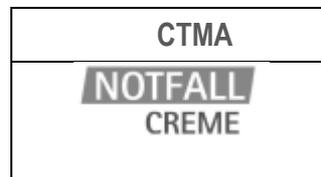


previous comparable marks pursuant to the principle of equal treatment (Para. 35). However, the principle of equal treatment must be consistent with respect for legality. For reasons of legal certainty and of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered (Para. 36). In those circumstances, the BoA was entitled to find that registration of the sign “SMILECARD” as a mark in respect of the goods and services referred to in the application was incompatible with Article 7(1) (c) CTMR (Para. 37 and 39).

**T-567/12; KAATSU**, Judgment of 7 November 2014; *Kaatsu Japan Co. Ltd. v OHIM* - en. The applicant sought to register the word mark KAATSU for goods and services in Classes 9, 10, 16, 28, 41 and 44. The examiner rejected the application for registration because the mark applied for was caught by the ground for refusal set out in Article 7(1) (c) and Article 7(2) CTMR. On the appeal of the applicant the Board of Appeal (BoA) dismissed the appeal. It held that the mark applied for related to an exercise method or technique to build muscle quickly, and that the term ‘kaatsu’ referred to that method and informed the consumer directly and without the need for further reflection on his part about the goods and services in question. The BoA went on to say, that the mark applied for was neither merely suggestive nor allusive, but directly descriptive of certain characteristics of the goods and services offered by the applicant. The BoA also held that the applicant had failed to show that the mark applied for had acquired distinctiveness through use. As regards the relevant public, the General Court (GC) held that as is clear from point 18 of the contested decision, which has not been challenged by the applicant, the goods and services referred to are intended not only for the general public, but also for a specialist public, which is represented, in particular, by professionals and companies specialised or operating in the medical field, trainers and fitness centres for personal training and body-building. Furthermore, the BoA’s finding that the relevant public was that of the European Union because the mark applied for was capable of being understood in any Member State of the Union was confirmed. On the descriptive character, the fact that the mark applied for was created by the applicant’s chairman, namely Professor S., in order to designate a particular exercise method (constituting an invented word for the EU public) does not mean that the mark in question must automatically benefit from Community registration. Pursuant to the Case-Law the mark applied for must, in order to be able to benefit from Community registration, enable the relevant public immediately to perceive the mark as an indication of goods or services offered by the holder of that mark and thus to distinguish them from the same goods and services that have a different commercial origin. The GC held that, since the sign KAATSU is presented as a particular exercise method and not as an indicator of goods and services offered by the applicant, it follows that the BoA was correct to refuse registration of the mark applied for on the basis of Article 7(1) (c) CTMR. The mark applied for will be understood as containing direct information as to the nature and subject-matter of the goods and services referred to, namely goods or services whose purpose is to build muscle quickly. Since the term KAATSU can be used to designate a particular method or technique of physical exercise and to inform the consumer, directly and without the need for further reflection on his part, that the goods or services in question concern that method or technique of physical exercise, that term must, having regard to the public interest that underlies Article 7(1) (c) CTMR, remain available for public use and not become the subject of a monopoly, even if the term is not yet commonly used.



**T-504/12; NOTFALL CREME** Judgments of 12 November 2014, *Murnauer Markenvertrieb GmbH v OHIM* - de.



The applicant sought to register the figurative mark 'NOTFALL CREME', represented above as CTM for goods within Classes 3 (in essence beauty products) and 5 (herbal products). The application was rejected. The applicant filed an action before the General Court (GC), claiming the infringement of Article 7(1) (c), 7 (1) (b) and 83 CTMR. The relevant consumer is the average German speaking consumer. The GC confirmed the view of the Board of Appeal that 'Notfall' (emergency) also referred to situations in which something is urgently needed, not just, as argued by the applicant, to life or limb threatening situations (Para. 21). In the context of the sign in issue, the term is descriptive for products that are useful or necessary to prevent or solve an urgent beauty care problem either because the goods are specifically tailored towards such problems in their composition or effects or because they can cover a situation in which the usual products are not available (Para. 23). Moreover, such products can have the function of protecting, calming or regenerating the body, in particular skin and mucus membranes, against irritants as well as internal and external attacks (Para. 24). 'CREME' describes that the products are either creams or contain cream additions. The combination of 'NOTFALL' and 'CREME' is in no way unusual in the structure of the German language (Para. 28). The CTM applied for is descriptive. The figurative element is banal and does not make the sign distinctive. Hence, the sign also lacks distinctive character. As regards an infringement of Article 83 CTMR, the GC found that there had been no breach of the principle of equal treatment through the registration of other CTMs that the applicant considered similar (Para. 43).

**T-188/13; NOTFALL**, Judgments of 12 November 2014, *Murnauer Markenvertrieb GmbH v OHIM* - de. The CTM owner had registered the verbal mark 'NOTFALL' for various goods within Classes 3, 5 and 30. Upon request, the CTM was declared invalid for the goods in Class 5 (dietetic products, medicinal product, herbal products etc.). The CTM owner filed an action before the General Court (GC), claiming the infringement of Article 7 (1) (c), 7 (1) (b) and 83 CTMR. The relevant consumer is the average German speaking consumer as well as the medical and care professional. The General Court (GC) confirmed the view of the Board of Appeal that 'Notfall' (emergency) also referred to situations in which something is urgently needed, not just, as argued by the CTM owner, to life or limb threatening situations (Para. 24). In the context of the sign in issue, the term is descriptive for products that are useful or necessary to prevent or solve an urgent dietary, care or health problem either because the goods are specifically tailored towards such problems in their composition or effects or because they can cover a situation in which the usual products are not available (Para. 26). The CTM is descriptive and lacks distinctive character in relation to the relevant goods. As regards an infringement of Article 83 CTMR, the GC found that there had been no breach of the principle of equal treatment through the registration (continued existence) of other CTMs that the CTM owner considered similar (Para. 42).



**T-43/14; THE LEADERSHIP COMPANY**, Judgment of 12 December 2014, *Heidrick & Struggles International Inc. v OHIM* – en. The Board of Appeal (BoA) had confirmed the refusal, on the basis of Article 7 (1) (c) (and therefore on Article 7 (1) (b) too, of the CTMA for the sign THE LEADERSHIP COMPANY for services in Classes 35 and 44, namely: Class 35: ‘Executive recruitment services; recruitment, business management and business administration consultation services’ – Class 44: ‘Psychological consultation services; including assisting individuals, organizations and communities identify goals and develop strategies for working towards and accomplishing those goals’. The BoA had considered that the appeal was directed against only ‘executive recruitment services’ and ‘recruitment consultation services’ in Class 35. The applicant lodged an appeal to the General Court (GC), asserting that the relationship between the sign and the services was not direct and specific, and could not be established without further consideration. The services applied-for are not leadership services. Moreover, recruitment can concern many low-level employees who are not considered leaders. It argued that no direct link exists in the relevant public’s mind. The GC rejected all these arguments, recalling that a sign can be refused registration on the basis of Article 7(1) (c) of Regulation No 207/2009 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (Judgment in *C-51/10P Agencja Wydawnicza Technopol v OHIM*). For the relevant English-speaking public, with a high degree of attention, THE LEADERSHIP COMPANY is, from the relevant public’s point of view, descriptive of ‘executive recruitment services’ and ‘recruitment consultation services’. It is irrelevant if leadership is equally important in many other services. Moreover, the existence of weaker or lower-level candidates does not negate the existence and value of top-level ones. The application was dismissed and the applicant ordered to pay costs.

**T-458/13 and T-459/13; GRAPHENE**, Judgment of 16 October 2014, *Joseba Larrañaga Otaño y Mikel Larrañaga Otaño v OHIM* – es. The applicants sought to register a community mark represented for goods within classes 13, 23 and 25 (Case T-458/13) and classes 2, 6, 10 and 22 (Case T-459/13). The mark applied for was the word mark GRAPHENE. The application was rejected in its entirety based on article 7 (1) b) and c) CTMR. An appeal was filed to the Second BoA of Appeal (BoA) which was dismissed on the basis that the trade mark applied for was descriptive and lacked distinctive character within the meaning of Article 7 (1) b) and c) CTMR. In this regard, the BoA found that relevant public would be both the general public as well as the specialized one, namely the professionals of textiles. In this light, the BoA considered that the trade mark designates a term that refers to a specific composition of the product itself (graphene) and therefore concluded it was descriptive for the English-speaking relevant public. In addition, the BoA found that the trade mark applied for lacked distinctive character since the relevant public would associate it as the characteristics of the product and not to its commercial origin. The applicants filed an action before the General GC (GC) relying on three pleas of law. The first plea alleging the infringement of Article 7 (1) c) was rejected as unfounded. In this regard, the applicant argued firstly, that it is possible to register a trade mark with a specific meaning as long as it does not refer to the products covered by the trademark (para. 13). The GC found that that the BoA did a correct assessment of Article 7 (1) c) since the trademark applied for would be understood by the relevant public as descriptive of a characteristic of the product itself and also for its composition (para. 24). Secondly, the GC found that it is enough for the BoA to provide a global motivation with regard to the descriptive character for a category or group of goods and/or services insofar as they have a direct and sufficient link between them (para 26). By the second plea, the applicant alleged



the infringement of article 7 (1) b). Concerning this plea, the applicant mainly argues that 'graphene' is not the usual denomination used to describe the products covered and does not give the relevant public the information about its characteristics (para 31). However, the GC recalled that there are no grounds to examine the substance of this plea as long as one of the paragraphs of article 7 (1) is fulfilled and therefore prevents the trademark to be registered. Since the BoA analysed the pleas in law of the applicant regarding Article 7 (1) c) there is no reason to further analyse the infringement of Article 7 (1) b) (paras. 31-32). Lastly, the third plea concerning the infringement of the principle of no discrimination was also dismissed by the GC. The applicants argued that the principle of no discrimination, and in addition the principles of equality and sound administration were disregarded by the BoA (para. 34). In this light, the applicants argued that the registered trademark 'Grafeno' for the classes 3, 7, 9 and 12 and the registered trademark 'Graphene' for the classes 4, 5, 8, 11, 14 to 21, 24 and 26 to 34, did not have any objection to registry with regard to lack of distinctive character for the products in question and that it lead to the violation of the aforementioned principles (para. 35). The GC rejected such argument referring to well established Case-Law, regarding the fact that the GC is only bound by the 207/2009 Regulation and not by any decisions taken by the Office (para 35). Furthermore, the GC points out that one who applies to register a trademark cannot claim in his/her favour a possible illegal action in order to obtain an identical result (para 36). Also, the GC states that each registration must be assessed on a case-by-case basis depending on specific criteria and factual circumstances in order to verify if there are any grounds to refuse the registration of a trade mark (para 36). Lastly, the GC found that the BoA had applied the aforementioned article properly and therefore it was justified to refuse the registration based on the absolute grounds stated in Article 7 (1) c) (paras. 37-39).

**T-50/13 VOODOO**, Judgment of 18 November 2014, *Think Schuhwerk GmbH v. OHIM* – de. The applicant sought the declaration of invalidity of the CTM VOODOO (word) registered for several goods in Class 25 based on Article 52 (1) (a) in conjunction with Article 7 (1) (b) and (c) CTMR and on Article 52 (1) (b) CTMR. The First Instance rejected the request for declaration of invalidity. The Board of Appeal (BoA) upheld that decision. As regards descriptiveness and lack of distinctive character, the applicant contends that the term "VOODOO" in connection with goods in Class 25 would describe a specific style of clothing or footwear which is used in the Voodoo-religion. Consumers would immediately understand this relation and consider the registered mark as descriptive. The General Court (GC) confirms the conclusions in the contested decision that the evidence submitted by the applicant does not show that it is reasonable to believe that it will actually be recognised by the relevant public as a description of one of the characteristics of the goods (Para. 32). The applicant could not show that the BoA was wrong in concluding that the mark will be seen as a fantasy term which only has a vague reference to something occult or cultic (Para. 33). Consequently, the mark may not be considered as directly descriptive term nor does it constitute a laudatory message or an abstract indication of quality of the goods (Para. 51). In respect of the burden to show the applicability of the invoked absolute grounds, the applicant claimed that the BoA infringed Article 76 CTMR by saying that the applicant would have to show the applicability of the invoked absolute grounds for refusal. The GC interpreted this plea in the sense that the BoA had not taken into consideration some of the evidence put forward by the applicant and that it did not undertake some further investigation (Para. 39). The GC concludes that the BoA did take into account all the evidence submitted during the administrative procedure as well as the information which may be generally accessed (Para. 41). Consequently, there is no



infringement of Article 76 CTMR (Para. 42). On the bad faith issue, cf. (Article 52 (1) (b) CTMR), the first argument put forward by the applicant was that the CTM proprietor knew that the applied for mark would lack distinctive character, because the German Trademark Office (DPMA) refused registration of the same mark has been rejected by the GC. The refusal decision from the German Trademark Office has been notified after the relevant date for the assessment of bad faith, which is the date of filing (Para. 58). The applicant further contends that the intervener was in bad faith because it claimed also a priority based on the German mark which has been found not distinctive by the German Trademark Office. The GC refused that argument because a priority may be lawfully claimed from an application being the subsequent outcome of that application irrelevant (see Article 29 (3) CTMR) (Para. 59). Finally, the applicant inferred bad faith from the fact that the Intervener tried to circumvent the obligation of use of its prior CTM registration “VOODOO” for Class 25 (No. 1 911 742). It is interesting that the GC upheld in this respect the argument of the Office that there would be no bad faith, since the earlier CTM is registered for the Class headings whereas the later CTM has been registered for specific goods in Class 25. Therefore the Intervener applied for the second mark for the sake of clearness and preciseness of the scope of protection of its “VOODOO” mark and not in a fraudulent way (Para. 60).

[T-494/13](#) and [T-495/13](#), **WATT**, Judgment of 4 December 2014, *Sales & Solutions GmbH v OHIM* - de.



The applicant registered (i) the word mark **WATT** (case T-495/13) and (ii) the figurative mark represented above (case T-494/13) as a CTM for services within Classes 35, 39 and 42. An application for invalidity was filed based on Article 7 (1) (b), (c) and (d) CTMR. The Cancellation Division upheld the application for invalidity on the ground of Article 7(1) (b) and (c) CTMR. The Board of Appeal dismissed CTM proprietor’s appeal finding that the contested marks were descriptive and devoid of distinctive character in relation to the services concerned. The CTM proprietor filed an action before the General Court (GC). The fact that the term “watt” is not related exclusively to electricity but allows, more generally, quantifying the power of an energy system does not contradict that this term is commonly used in electricity (Para. 28). Further, it is not correct conclusion that the difference between watt (W) and for example watt-hour (Wh) or kilowatt-hour (kWh) is such that these concepts cannot be mixed up (Para. 30). The services at issue are addressed to private households as well as to professionals. The focus should be more on practical perception of the term “watt” in everyday life than on precise scientific definition (Para. 33). The term “watt” can be perceived by the relevant public as a direct reference to unit of measurement used in the field of energy and, in particular, electricity (Para. 34). To assume that a term is descriptive, it is sufficient that, in at least one of its possible meanings, the sign at issue designates a characteristic of the goods or services covered by it (Para. 36). The services at issue in Class 35 fall within the services of an energy and water supply company which allows referring to the meaning of “watt” (Para. 40). The graphic elements of the figurative mark are not of the nature to confer on the mark a distinctive character (Para. 43). The decisions taken in one EU



member state are a factor (without being decisive) that can only be taken into account for the purposes of registration of the CTM, however, nothing in the CTMR requires the Office or the GC to achieve similar results to those achieved by the national authorities in similar situation (Para. 45).

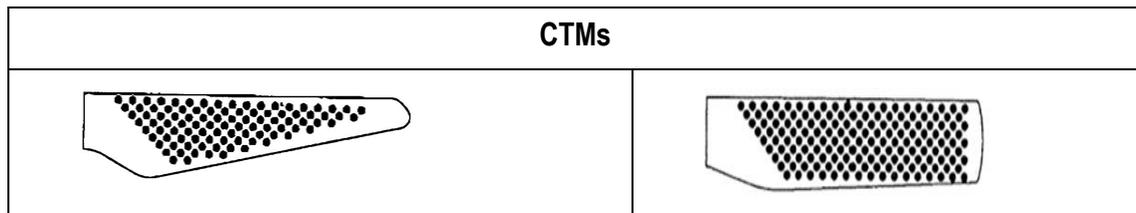
**T-556/13; ORIGINAL EAU DE COLOGNE**, Judgment of 25. November 2014, *Verband der Kölnisch-Wasser Hersteller e. V. v OHIM* -de. The applicant sought to register a word mark Original Eau de Cologne for perfumed water in Class 3. The Board of Appeal (BoA) confirmed the rejection of the trade mark by the examiner pursuant to Article 7 (1) (b) and 7 (1) (c) and 7 (1) (d) CTMR with the reasoning that the mark is a French description of the products “perfumed water” combined with the laudatory word “original”. The applicant filed an action before the Court claiming the infringement of Articles 7 (1) (c) in conjunction with Article 66 (2) CTMR, as well as of Articles 7 (1) (b) and 7 (1) (c) CTMR. The General Court (GC) confirmed the rejection of the CTM application pursuant to Article 7 (1) (c) in conjunction with article 66 (2) CTMR. The GC recalled its Case-Law regarding the descriptive character of a trade mark pursuant to Article 7 (1) (c) CTMR (paras. 11 et seq.) and emphasized that article 66 (2) CTMR makes an exception for a designation of geographical origin, which is not a ground of refusal in case of a collective trade mark (para. 15). The CTM applied for consists, however, of a designation of a nature and purpose of the goods applied for (para. 16). Its element “Eau de Cologne” describes a kind of perfume (para. 20). The element “original” will be understood in the sense that the goods are originals and not copies (para. 21). The argument of the applicant, that the addition of the element “original” to the element “eau de Cologne” renders it inherently distinctive in a way of “re-localisation” and give the sign a meaning of a geographical indication (“water from Cologne, a German city”) was rejected by the GC (para. 26 et seq.)

**T-352/12; FLEXI**, Judgment of 13 June 2014, *Grupo Flexi de León, SA de CV v OHIM* – es. The applicant sought to register the word sign “**FLEXI**” for goods in Classes 18 and 25. The Board of Appeal (BoA) confirmed the first instance decision. It found that the applied for sign is an abbreviation in EN and ES of the adjective ‘flexible’ and is an exclusively descriptive indication that informs of one of the characteristics of the relevant goods. The applicant appealed to the General Court (GC), arguing an infringement of Article 7(1)(c) and (b) CTMR. The GC confirmed the finding of the BoA that the target public is the general public of ES or EN language. FLEXI is an abbreviation of FLEXIBLE in several languages, namely in ES and EN. It will be directly understood by the relevant public as a reference to ‘flexible’, ‘flexibility’, or as an abbreviation of them, thereby informing the public of a characteristic of the products. The fact that it does not appear in dictionaries is not relevant, as abbreviations do not usually appear in them (Paras. 22-23). Nor is it relevant that the examiner did not back the objections with searches in the Internet showing that FLEXI is an abbreviation of ‘flexible’ (Para. 25). It is enough that the BoA applied the descriptiveness test, as interpreted by the Case-Law, without being under an obligation to provide evidence in support of its finding (Para. 26).



### C. Article 7(1) (e), 52(1) (a) CTMR – Shape

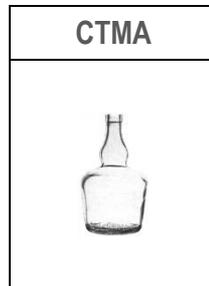
**C-337/12P; SHAPE OF A PRODUCT**, Judgment of 6 March 2014, (*Joined Cases C-337/12P to C-340/12P*); *Pi-Design and Others v Yoshida and OHIM (C-337/12P and C-339/12P)* and *OHIM v Yoshida (C-338/12P and C-340/12P)*;



When the CTM owner registered the figurative marks represented above as CTMs for goods within Classes 8 and 21, the Cancellation Division rejected the applications for a declaration of invalidity. On appeal, the Board of Appeal (BoA) declared the registrations invalid based on Article 7(1) (e) (ii) CTMR. The CTM owner appealed to the General Court (GC). The GC upheld the appeal. In particular, the GC found that “the concave character of the black dots is not part of the contested trade mark as filed and registered. There is nothing in the graphic representation of the contested mark to suggest that the black dots in question represent dents rather than a figurative pattern. Likewise, the registration of the contested mark was not accompanied by any description to that effect. Therefore, in concluding that the dots were concave in character, the BoA did not refer to the sign as filed, but to representations of the goods actually marketed by the applicant’. The GC considered that no account could be taken of the proof of current use of the signs at issue given that ‘only the shape as reproduced in the registration application may be the subject-matter of the examination of the trade mark’. The invalidity applicant and OHIM appealed to the European court of justice (CJ), alleging, inter alia, a breach of Article 7(1) (e) (ii) CTMR. Article 7(1) (e) (ii) CTMR: It is necessary to assess the essential characteristics of the signs at issue and their technical function (Para. 68). The possibility afforded in *Lego Juris v OHIM* to the competent authority when examining a three-dimensional sign can be extended to the examination of any sign constituted by the shape of goods within the meaning of Article 7(1) (e) (ii) CTMR (Para. 55). However, the requirements which must be satisfied by the graphic representation in order to fulfil its function cannot restrict the competent authority’s examination under Article 7(1) (e) (ii) CTMR in such a way as might undermine the public interest underlying that provision (Para. 58). When determining the essential characteristics of a sign, account can be taken of the actual use made of the trade mark following its registration (Para. 61). The CJ referred in this respect to the case law of the GC, in which it stated that the material which, although subsequent to the date of filing the application, enables conclusions to be drawn with regard to the situation as it was on that date can be taken into consideration (Para. 60). In addition, the CJ noted that some of the evidence submitted by the invalidity applicant predated the filing date of the contested CTMs (Para. 63). Since the GC did not apply the provision of Article 7(1) (e) (ii) CTMR correctly, there was no reason to examine further grounds of appeal (Para. 66).

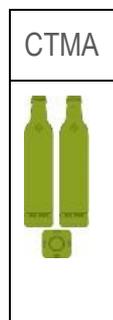


**T-66/13, SHAPE OF A LIQUEUR BOTTLE**, Judgment of 16 July 2014, *Franz Wilhelm Langguth Erben GmbH & Co KG. vs OHIM – de.*



The applicant applied for a ‘figurative mark’ as seen above for goods in Class 33 – ‘alcoholic beverages (except beers), blackberry liqueur’. On the bottom of the bottle it is indicated “*Echte Kroatzbeere*’ (real blackberry liqueur). The application was rejected on the ground of non-distinctive character, Article 7(1) (b) CTMR. After appeal the Board of Appeal (BoA) confirmed the rejection. The applicant filed an action before the General court (GC). The applicant applied for a ‘figurative mark’. It follows however from the three-dimensional shape of the mark and the arguments put forward in regard to a bottle as a shape or packaging for the goods that a three-dimensional mark has been applied for (Paras. 21-24). The GC confirmed settled Case-Law that three dimensional marks which consist of the shape of the product itself are not necessarily perceived in the same way as marks which are independent from the shape of the product (Para. 37). In particular, in the case of a shape of a bottle distinctiveness can be conferred only if the shape departs from others available on the market (Paras. 38, 39). The shape of the bottle applied for is banal and does not depart significantly from other bottles available on the marketplace. The expression ‘*Echte Kroatzbeere*’ (real blackberry) at the bottom of the bottle is, if noticed, perceived by the German consumers only as descriptive indication of the content of the bottle, i.e. that it is made of real berries (Paras. 42–44). Also the combination of both, the bottle and the expression ‘*Echte Kroatzbeere*’, does not confer distinctiveness (Para. 51

**T-209/13; SHAPE OF AN OLIVE OIL BOTTLE**, Judgment of 11/04/2014, *Olive Line International, S.L. v. OHIM – es.*



The applicant sought to register this figurative mark a CTM for ‘olive oil for food’ within Class 29. The examiner refused to register it as a CTM on the ground that it was devoid of any distinctive character under Article 7(1) (b). The Board of Appeal (BoA) dismissed the appeal. The General court (GC) recalled, first of all, that the case law settled in respect of three-dimensional trademarks



consisting of the shape of the product is also valid in respect of figurative signs consisting of a bi-dimensional representation of the product (Para. 23). Moreover, in the case at hand, being the products sold in a liquid form, the shape of the container (bottle) can be equated to the shape of the product (Para. 25). As regards the products, the GC underlined that the assessment of the distinctive character has to be made in respect of the list of goods as applied for, and not in respect of the particular goods which are actually sold by the applicant (Paras. 26-27). The GC endorsed the reasoning followed by the BoA, which analysed, first, the different constituent elements of the trademark (the shape of the bottle, the colour, and the verbal and the decorative elements) before concluding that the global impression produced by the sign did not differ from other similar bottles (Para. 31-32). In that regard, the contested decision was sufficiently grounded (Para. 33). According to the GC, the shape in question (as well as its colour) is relatively banal and does not have any characteristic which makes it different from other bottles for olive oil (Para. 43-44). As regards the descriptive character of the word element 'olive line', the fact that other registered figurative marks also include those words does not demonstrate that such element, considered on its own, is not descriptive (Para. 48). Finally, the GC stated that the public does not consider an element which is descriptive as being distinctive and dominant in the overall image conveyed by the sign (Para. 51).

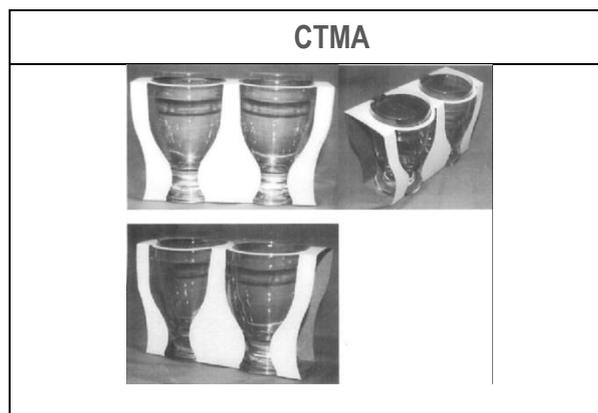
◆ **C-97/12P; SHAPE OF CLASP LOCK**, Judgment of 6 March 2014, *Louis Vuitton Malletier v. OHIM* – en.



The Cancellation Division and the Board of Appeal (BoA) considered that the CTM as depicted here was to be annulled on account of its lack of distinctive character. The General court (GC) partially annulled the BoA decision in respect of goods which were, in normal circumstances, not equipped with locking devices. The European Court of Justice (CJ) dismissed the appeal as well as the cross-appeal lodged by the Office, and held as follows: The GC did not err in applying the Case-Law relating to 3D marks to a figurative mark constituted by part of the shape of the product which it designates, even if that part is not 'essential'. The 2D shape is not independent of the appearance of the product it designates in so far as the relevant public perceives it as a representation of a particularly interesting or attractive detail of the product in question rather than as an indication of its commercial origin (Paras. 55-56). The GC did not distort the facts and its conclusions on whether parts of the goods are normally equipped with locking devices is of factual nature, hence not susceptible to be reviewed by the CJ (Paras. 62-63). On the cross-appeal, the CJ held that the Office's arguments were based on a misinterpretation of the BoA decision and that the GC did not make any error in failing to address a reason which the BoA did in fact not rely on (Paras. 87-88).



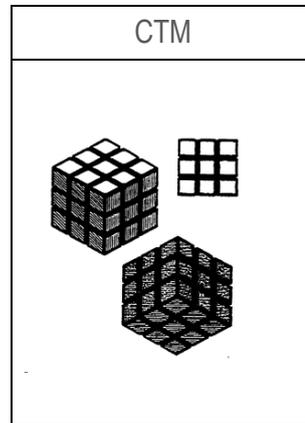
**T-474/12; SHAPE OF CUPS**, Judgment of 25 September 2014; *Giorgio Giorgis v OHIM* - en. The Board of Appeal (BoA) had upheld a cancellation action against the applicant's three-dimensional CTM, for certain Class 30 goods, namely 'Ice, flavoured ices, mixed sorbets, ice sorbets, ice creams, ice-cream drinks, ice-cream goods, ice-cream desserts, semi-frozen desserts, desserts, frozen yoghurt, pastry'. The applicant appealed, alleging errors regarding the findings of level of attention and the test for distinctiveness, as well as alleging the wrongful rejection of evidence of acquired distinctiveness in 8 EU Member States. The General court (GC) dismissed the action.



As to the 1<sup>st</sup> plea – Article 7(1) (b) CTMR, in rejecting applicant's argument that the relevant public for ice-creams had a high attention level due to the large number of flavours, the GC held that these are inexpensive everyday consumer food products, regardless of taste preferences there is no pre-purchase "lengthy period of reflection." (Para. 17) With regards to distinctive character, the BoA had correctly considered the individual features and overall impression, finding that the shape does not depart substantially for the norms in packaging of the sector, which is used to convey a certain image (handmade and quality). It did not unduly restrict the norm and customs (Para. 30) in finding the features normal or ornamental, and the presence of other shapes of packaging is not relevant – it is not necessary for a shape to be the most common form in order to be normal in the sector (Para. 40). The BoA's mention of 'differ substantially' was in reply to an argument of the applicant, after it had already made a finding on the basis of the correct "departs significantly" test (Paras. 45 and 46). As to the 2<sup>nd</sup> plea – Article 7(3) CTMR, the evidence for acquired distinctiveness had been rejected by the BoA since it only showed 8 Member States and moreover the 3D packaging was always used with the sign *LA GELATERIA DI PIAZZA NAVONA* printed on that packaging. The GC held that the applicant had no proven perception of the 3D packaging alone as a trade mark. Although it may be possible for a 3D mark used with a word or fig mark may acquire distinctive character (Para. 55), the public must first be familiarised with this and not every use of the mark necessarily amounts to trade mark use (Para. 56). Here, it would have been at least necessary for the applicant to show that the shape of the packaging was particularly retained by the relevant public as an indication of origin, which it did not (Para. 57). The merits of the argument that 8 Member States were a substantial portion of the EU were not examined, since the applicant failed on the first test, to show use as a trade mark of the shape alone (Para. 58).



T-450/09; **CUBES**, Judgment of 25 November 2014, *Simba Toys GmbH & Co. KG v OHIM* – en.  
The 3D sign reproduced below was registered for goods in Class 28 (three-dimensional puzzles).



A request for a declaration of invalidity pursuant to Article 52(1)(a) CTMR in conjunction with Article 7(1)(a) to (c) and (e) CTMR was filed. The Cancellation Division rejected the application for a declaration of invalidity in its entirety. The Board of Appeal (BoA) dismissed the appeal against the decision of the Cancellation Division as unfounded finding that (i) the contested mark was adequately graphically represented; (ii) there were no manifest reasons to consider the cubical grid structure not distinctive; (iii) the invalidity applicant had not adduced significant evidence that a cubic grid structure constitutes a “norm” in the sector of 3D puzzles; (iv) ‘the cubic grid structure’ gives no indication as to its function, it is impossible to conclude that it may impart some technical advantage or effect in the domain of 3D puzzles and it cannot be considered that the shape results from the nature of the goods themselves; and (v) a mere cubic grid as depicted in this case cannot be deemed to possess a shape which gives substantial value to the goods. The invalidity applicant filed an action before the General Court (GC) relying on eight pleas in law. The first plea alleging the infringement of the First sentence of Article 76(1) CTMR was rejected as unfounded. Firstly, although the invalidity applicant alleged a procedural violation, it seeks more to call in question the merits of the substantive assessment by the BoA (para. 19). Secondly, in invalidity proceedings, even when they relate to absolute grounds, the BoA is not required to examine of its own motion the facts. Even though the BoA cannot be prevented, if it considers it necessary, from taking into account of its own motion any matter relevant to its analysis, there was no such necessity in this case (Para. 25). By the second plea the invalidity applicant alleged infringement of Article 7(1)(e)(ii) CTMR. In this regard, the GC recalled that the examining authority must first of all identify the essential characteristics (i.e. the most important elements) of the sign. This identification may be either carried out by means of a simple visual analysis of the sign or based on a detailed examination in which relevant criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned (para. 38 and 40). Further, the GC reiterated that Article 7(1)(e)(ii) cannot be applicable where the trade mark application relates to a shape of goods in which a non-functional element, such as a decorative or imaginative element, plays an important role (para. 41). The grounds for invalidating a 3D trade mark pursuant to Article 7(1)(e)(ii) must be founded only on the examination of the representation of the mark as filed and not on any alleged or supposed invisible features (Para. 49). It is necessary to establish in order to apply the Article 7(1)(e)(ii) that



the essential characteristics of the mark at issue themselves perform the technical function of the goods at issue and have been chosen to perform that function (i.e. the shape of the goods is technically causal of the intended technical result), and not that those characteristics are the result of that function (Para. 53). The cube in question, contrary to invalidity applicant's claim, will not necessarily be perceived as having elements capable of being moved in the alleged way (Para. 57). The invalidity applicant's line of argument is based on knowledge of the rotating capability of the vertical and horizontal lattices of the Rubik's Cube. However, it is clear that that capability cannot result from the black lines in themselves or, generally, from the grid structure which appears on each surface of the cube in question, but at most from a mechanism internal to that cube, which is invisible on the graphic representations of the contested mark and which cannot constitute an essential characteristic of that mark (Para. 58). Accordingly, although the BoA cannot be prevented from drawing inferences for the purpose of its analysis of the functionality of the essential characteristics of the contested mark, it is still necessary that those inferences be drawn as objectively as possible from the shape in question, as represented graphically, and that they not be purely speculative, but sufficiently certain (Para. 59). It was not the intention of the legislature that a shape of goods would be refused registration as a trade mark solely on the ground that it has functional characteristics since any shape of goods is, to a certain extent, functional (Para. 60). The contested mark may not be relied on by its proprietor in order to prohibit third parties from marketing 3D puzzles that have a rotating capability. The registration of that mark protects solely the shape of a cube the surfaces of which bear a grid structure, which gives it the appearance of a 'black cage' (Para. 64). The graphic representations of the contested mark do not make it possible to determine whether the shape in question involves any technical function or, if so, what that technical function might be (Para. 72). Finally, it is irrelevant, as regards the examination of the functionality of the essential characteristics of a shape, whether or not there are other shapes which could achieve the same technical result (Para. 75). The third plea on infringement of Article 7(1)(e)(i) was rejected, since the nature of 3D puzzles (the goods concerned) in no way requires that they have the shape of a cube with surfaces that have a grid structure (Para. 82). The fourth plea alleging infringement of Article 7(1)(e)(iii) was rejected, since the invalidity applicant based its argument on the idea that substantial value is conferred on the goods concerned by certain functional features that the shape in question allegedly possesses without demonstrating or at least claiming that such substantial value flows from the aesthetic aspect of the shape (Para. 88). In respect of the fifth plea alleging infringement of Article 7(1)(b) the GC stated that the relevant public's perception is not necessarily the same in the case of a 3D mark, which consists of the appearance of the goods themselves, as it is in the case of a word or figurative mark (para. 97). Since a registered CTM is presumed to be valid, it is for the invalidity (or revocation) applicant to adduce evidence in support of its application (Para. 103). Article 7(1)(b) cannot be interpreted as meaning that if a 3D mark resembles the product in question, it is 'implied by fact' that customers will not perceive that mark as an indication of origin unless it departs significantly from the norm or customs of the sector (Para. 104). The mere fact that there exists on the market a puzzle which resembles the CTM proprietor's one does not suffice to demonstrate that the shape of the contested mark is the norm in the sector of 3D puzzles (Para. 106). Even if the shape in question were perceived by consumers as representing a 3D puzzle, it would still only be associated with the specific product marketed by the CTM proprietor, namely the Rubik's Cube, and not with a generic sub-section of 3D puzzles (Para. 109). Under the sixth plea alleging infringement of Article 7(1)(c) the invalidity applicant claimed that the contested mark is merely descriptive of a 3D puzzle in the shape of a 3x3x3 cube (Para. 114). For a sign to fall under the prohibition laid down by that provision, there must be a sufficiently direct and specific link between the sign and the goods and



services in question to enable the relevant public immediately to perceive, without further thought, a description of those goods or services or of one of their characteristics which is not the case at issue. The relevant public will not spontaneously perceive, in particular, without prior knowledge of the Rubik's Cube, unambiguously and without at least some reflection or analysis, the characteristics of the contested mark which are relied on by the applicant (Para. 119 and 123). The seventh plea alleging Article 7(3) was rejected as unfounded, since the contested mark was inherently distinctive (Para. 131). The eighth plea alleging insufficient reasoning of the BoA was rejected. The reasoning may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA's decision and provides the competent Court with sufficient material for it to exercise its power of review (Para. 137).

#### **D. Article 7(1)(f), 52(1)(a) CTMR – Public policy/morality**

[T-266/13](#); **CURVE**, Judgment of 26 September, *Brainlab AG v OHIM* – de. The applicant sought to register the word mark Curve as a CTM for goods and services within Classes 9, 10, 35, 38, 41, 42, 44 and 45. The examiner refused to register the word as a CTM on the ground that the word is a plural of Romanian word *curvă*, meaning in English “prostitute” or “whore”, which is of a vulgar content and will be perceived by the relevant public as an insulting and obscene statement. The Board of Appeal dismissed applicant's appeal. The General Court held that the relevant public in respect of which the existence of the absolute ground of refusal under Article 7 (1) (f) should be examined is the Romanian-speaking public (Para. 15). The relevant public is not limited only to the public to which the goods and services covered by the mark are directly addressed. It must be taken into account that signs covered by the ground under Article 7 (1) (f) offend equally other persons who are confronted with such sign accidentally without being interested in these products and services (Para. 19). Given the offensive meaning of the mark in Romanian, there is a reason to suppose that the sign will immediately attract the attention of anyone who will face it (Para. 23). The applicant did not provide any evidence on that, in the absence of any foreign language element accompanying the sign in question, the general Romanian-speaking public will perceive the sign as a foreign word. The fact that applicant's web sites are exclusively in English is irrelevant for determination of the public perception of that sign, appearing alone, usually in written form, and affixed directly to the products in question or used in connection with the services in question (para. 24). Use of German equivalent of the Romanian word as a name for the association of prostitutes or for their international day is of no consequence in the assessment of shocking and offensive nature of the mark applied for, insofar as the use of the word in the society in question does not minimize its inherently offensive and obscene character (Para. 31). It is the mark itself, i.e. the sign in relation to goods or services covered by the application that must be examined for the purpose of the assessment whether it contradicts the public order or morality (Para. 34).

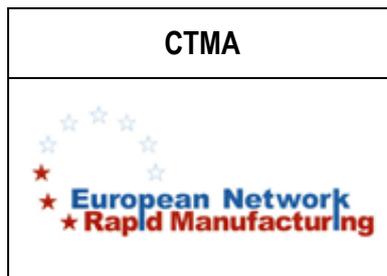
#### **E. Article 7(1) (g), 52(1) (a) CTMR – Deceptive**

[no entry]



## F. Article 7(1) (h) and (i), 52(1) (a) CTMR – Emblems etc.

T-430/12; **European Network Rapid Manufacturing**, Judgment of 13 March 2014, *Heinrich Beteiligungs GmbH v OHIM - de*.



The Board confirmed the rejection of the CTM application for this mark, for goods in Classes 6, 7, 12, 17 and 42 pursuant to article 7(1)(h) CTMR in conjunction with article 6ter Paris Convention. It decided that the CTM application contained a heraldic imitation of the European emblem and that the use of the latter may suggest a connection between the CTM applicant and the European Union. The CTM applicant filed an action to the General court (GC). The GC confirmed the decision. The European Emblem is protected as an emblem of an international organisation against the use of a heraldic imitation hereof in a trade mark under the condition that this use can suggest to the public that a connection exists between the European Union and the user, article 6ter section 1 c Paris Convention (Para. 21). The comparison has to be based on the heraldic description of the emblem (Para. 36). The assessment if the trade mark contains a heraldic imitation of an emblem has to be made from the perspective of the relevant public that may not notice every difference that would be noticed by a professional from the field of heraldic (Para. 38 with a reference to previous case law). Different artistic interpretations of an emblem with the same heraldic descriptions are possible (Para. 39). Use of a part of an emblem in the trade mark can be a heraldic imitation (Para. 40). The CTMA contains an imitation from the heraldic point of view of the European emblem, as it takes over its only motive – the circle of stars (mulletts) which ends do not touch each other (Para. 44). Even if only nine stars are presented in the trade mark, the public will realise that the other three are covered by the word element (Para. 45). The public will perceive the circle of stars (mulletts) as the European emblem even if some of them are red and some white with blue contours (Para. 48). It is sufficient that a trade mark contains an element which description could be confused with the description of an emblem to conclude, it contains a heraldic imitation of that emblem (Para. 51). The protection of the emblem of an international organisation applies first, when its use in the trade mark in connection with the relevant goods and services could mislead the public to think that those goods and services come from the international organisation. It applies however also in situations, when the public could believe that the goods and services are offered under a guarantee of the international organisation or that there is other kind of connection (Para. 62). In order to conclude if the public may be misled about a connection between the trade mark owner and the international organisation an overall assessment of the trade mark is necessary (Para. 63). In the case at hand the mark contains a



figurative element (a heraldic imitation of the emblem) and a word element “European” and that let the public think about the European Union (Paras. 65-67). The relevant goods and services fall within the scope of the competences of the European Union (Para. 68).

**G. Article 7(1) (j) and (k), 52(1) (a) CTMR – Geographical indication for wines and spirits – agricultural products and foodstuffs**

[no entry]

**H. Article 7(3), 52(2) CTMR - Distinctiveness acquired through use**

[no entry]



## II. RELATIVE GROUNDS FOR REFUSAL/INVALIDITY

### A. Article 8(1) (a), 53(1) (a) CTMR – Identical signs/g&s

[no entry]

### B. Article 8(1) (b), 53(1) (a) CTMR – Likelihood of confusion

#### *Likelihood of confusion (LOC)*

[T-568/12](#); **FOCUS/FOCUS**, Judgment of 4 April 2014: *Sofia Golam v. OHIM* – en.

CTMA	Earlier mark: DE (word)
	<b>FOCUS</b>

The applicant sought to register the figurative mark reproduced above for goods in Class 25. An opposition based on German word mark FOCUS, which covers identical goods in Class 25 was filed according to Article 8(1) (b) CTMR. The Opposition Division upheld the opposition. On appeal, the Board of Appeal dismissed the appeal. Before the General court (GC), the applicant alleges an infringement of Article 8(1) (b) CTMR, unlawful exercise of the right to opposition and infringement of Article 8 (5) CTMR. It is not contested that the relevant public is the general public in Germany. The goods are identical. The signs are visually similar to a degree above average and phonetically and conceptually similar to an average degree. There is likelihood of confusion. The GC declares that the applicant cannot claim that the opposition filed by intervener was abusive, brought in bad faith and contrary to ‘business ethics’ (Para. 54). The plea alleging infringement of Article 8(5) CTMR is also rejected. **LOC**

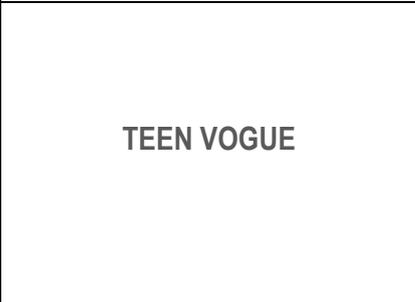


◆ **T-386/12; ELITE BY MONDARIZ / ELITE**, Judgment of 9 April 2014, *Elite Licensing Company, S.A. v OHIM* – es.

CTMA	Earlier marks: CTMA, International mark
	

The applicant sought to register the figurative mark reproduced above for goods in Class 32 and services in Classes 38 and 39. The opposition was based on the International mark and on the figurative CTM application reproduced below, which covers goods and services in a number of Classes and is well-known in ES, FR and the Benelux for services in Classes 35 and 41. On Article 8 (1) (b) and Article 8 (5), the Opposition Division upheld the opposition in its entirety. On appeal, the Board of Appeal (BoA) dismissed the opposition in its entirety. On the infringement of Article 8 (1) (b) CTMR the General court (GC) ruled that the relevant public is the average EU consumer and there is partial identity and partial similarity of the goods and services. MONDARIZ is the dominant element of the contested CTM. There is low – or very low - visual similarity and average aural similarity. The GC does not uphold the BoA’s finding of a low conceptual similarity. The GC finds a high – or very high - conceptual similarity because of the common element ELITE (Paras. 92 to 99). The aural and conceptual similarity counteracts the visual dissimilarities. The signs are similar overall. ELITE is not descriptive, but evokes a positive connotation. Its distinctive character is slightly below average. **LOC**

**T-37/12; TEEN VOGUE/VOGUE moda en lluvia**, Judgment of 27 February 2014, *Advance Magazine Publishers v OHIM* – en.

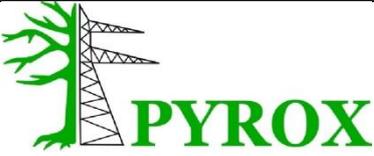
CTM	Earlier Spanish Marks
	

The applicant sought to register the word mark represented above as a CTM for various goods in Class 18. An opposition was based on the above earlier word mark and figurative mark on the grounds of Article 8(1) (b) CTMR. Upon the request from the applicant, the opponent provided documents in order to show that the earlier marks had been put to genuine use. The examiner upheld the opposition in part. The Board of Appeal (BoA) dismissed the appeal, confirming the



reasoning of the first instance. The applicant alleged that the BoA had infringed *Article 8(1) (b) CTMR* by (1) erring in its comparison of the overall impression given by the marks at issue by not giving consideration, or giving inadequate consideration, to the element ‘teen’ and (2) failure to identify, in the contested decision, the relevant average consumer, which is relatively highly aware and able to perceive the differences between the marks at issue, thus avoiding any likelihood of confusion. The GC rejected the second plea in law on the grounds that: (1) the presence of the element ‘teen’ in the mark applied for does not introduce such a dissimilarity between the signs at issue as would lead to erasing their visual and phonetic similarities (Para. 78); (2) the BoA rightly held that, when it comes to everyday consumer goods, frequently bought and used, the level of attention of the relevant public is not, contrary to what argued by the applicant, above average (Para. 62). (3) In light of the visual and phonetic similarities of the signs at issue and having regard to the fact that the goods designated by the earlier Spanish word mark VOGUE, on the one hand, and part of those covered by the mark applied for, on the other, are identical, the BoA did not make an error of assessment in finding that there was a likelihood of confusion between those marks (Para. 78). **LOC**

[T-575/12](#); **PYROX/PYROT**, Judgment of 8 May 2014; *Pyrox GmbH v OHIM* – de.

CTMA	Earlier German and Austrian CTM
	<p>PYROT</p>

The applicant requested proof of use of the earlier mark. The Opposition Division (OD) allowed the opposition partially and dismissed it for the remainder. The Board of Appeal (BoA) dismissed the applicant’s appeal and allowed the opponent’s appeal. Thus, the mark applied for was rejected in total. The applicant filed an action before the General Court (GC). The GC dismissed the appeal and made the following findings. The relevant public is made up of the general public and professionals. It dismissed the argument of the applicant that certain goods have a specific purpose as an entrepreneurial intention which is irrelevant for the assessment of the public (Para. 37). The public has an enhanced degree of attentiveness concerning the goods in Classes 7 and 11 and an average degree for the goods in Class 4 (Para. 47). The goods were considered similar to a different degree. The GC reiterates that an entrepreneurial decision on how the goods were to be used is irrelevant, the assessment being limited to the goods as they are on register (Para. 59). As to the comparison of the signs, the figurative element of the contested sign has, contrary to the assessment of the BoA, not a mere ornamental character (Para. 83). It is placed at the beginning and is bigger than the word element. The GC confirms that the word element ‘PYRO’, even if recognised as equivalent to ‘fire’, is not descriptive (Para. 86). The coinciding letter sequence makes that the signs are visually similar and aurally highly similar. The conceptual comparison is neutral. As to the likelihood of confusion the earlier mark has an average degree of distinctiveness; the high degree of attentiveness is not sufficient to outweigh the similarity of the signs. **LOC**



◆ **T-170/12; BEYOND VINTAGE / BEYOND RETRO**, Judgment of 30 April 2014, *Beyond Retro Limited v. OHIM*, - en. The applicant sought to oppose the registration of the word mark BEYOND VINTAGE, for goods in Classes 14, 18 and 25, on the basis of its earlier CTM for the work mark BEYOND RETRO registered for, inter alia, clothing in Class 25, cf. Article 8(1) (b) CTMR. The Opposition Division (OD) upheld the opposition for Classes 18 and 25, and rejected it for Class 14. The Board of Appeal (BoA) upheld the appeal of the CTM applicant, finding no likelihood of confusion (LOC) for any of the claimed goods in Classes 14, 18 and 25, and dismissed the opponent's appeal that LOC should have also been found in Class 14. Before the General Court (GC), the applicant alleges an infringement of Article 8(1) (b) CTMR. Regarding the goods in Classes 18 and 25, however, the GC held that the BoA erred in its finding of no LOC due to a lack of reasoning: the global assessment was seen to be flawed. The BoA distinguished between English-speaking and non-English speaking public, yet drew its formal conclusion only with regards to the non-English-speaking public (Para. 86). Since the BoA had concluded that the respective signs had no conceptual similarity for the latter, as opposed to low conceptual similarity for the former, the GC held that it might have been possible for the BoA to have made different findings regarding LOC for the English-speaking public (Paras. 89 and 90). It was not enough to assume a finding of no LOC for this public based on the BoA's finding of a lower than average distinctiveness of the earlier mark for the English-speaking public, since the obligation is to take into account not only distinctiveness, but all the various relevant factors regarding similarity of signs, goods and their interdependence (Para. 91). The GC partially annulled the BoA on this basis. However, it also held that it erred in finding that there was no conceptual similarity between the signs for the non-English-speaking public (Paras. 65 – 70). It also found that the BoA erred in finding that the degree of visual and phonetic similarity between the marks was low, since the first words of each mark are more likely to catch the public's attention (Paras. 53 -58). **LOC**

**T-160/12; MARINE BLEU / BLUMARINE**, Judgment of 14.05.2014, *Adler Modemärkte AG v OHIM* – de. The Board of Appeal (BoA) affirmed the likelihood of confusion for the following marks and goods in Classes 18 and 25, which it considered similar or identical. The CTM applicant filed an action before the (GC) claiming an infringement of Article 8 (1) (b) CTMR. The GC confirmed its Case-Law, that although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a verbal sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (Para. 45). It is not decisive if the elements are distinctive or dominant (Para. 46). The word “blumarine” as such does not exist in German (the language of the application), nor had the applicant proven that it belongs to any other language (Para. 47). The public is rather familiar with the word “marine” and “blue”, “bleu” or “blau” (Para.48) and will perceive the earlier mark as a combination of related elements. The marks are visually highly and phonetically similar. The mere inversion of elements of a mark cannot exclude this finding (Para. 50, 51). Conceptually, the part “marine” will be understood by the part of the public as a reference to the sea and “blu” or “bleu” can be easily associated with colour “blue”. Both trademarks will be associated with the colour “navy blue” (in German “marinenblau”, in French “bleu marine”), especially since the sequence of the particular words in these expression differs (Para. 54). They are conceptually similar or even identical (Para. 58). The BoA took into consideration that the earlier mark has a limited distinctiveness (Para. 64), but was right in the result that this does not exclude the likelihood of confusion given the similarity of the marks and goods (Para. 67). **LOC**



**C-591/12P; BIMBO DOUGHNUTS / DONUT**, Judgment of 6 March 2014, *Bimbo S.A v. OHIM* - en. The opposition was upheld in its entirety by Opposition Division and Board of Appeal (BoA) under Article 8(1) (b) CTMR. The General Court (GC) dismissed the action for annulment. The GC addressed the effect of the alleged market recognition of the element ‘Bimbo’ in the mark applied for. The GC noted that ‘the fact that an element of a composite trade mark is in itself a trade mark with a reputation may play a part in the appraisal of the relative weight of the various components of the composite mark. Thus if one element of a composite mark is itself a mark with a reputation, it may, by the same token, play a more important role in the composite mark’ (Para. 77). On the facts of the case, such a circumstance was however not susceptible to render the second component ‘Doughnuts’ negligible in the mark applied for. Regarding the global assessment of the likelihood of confusion, the GC found that the earlier mark ‘Donut’ will be regarded, like the word ‘doughnuts’, as a fanciful or foreign term, which is as such normally distinctive. The GC concluded that ‘the “doughnuts” element, which is almost identical to the earlier trade mark, has an independent distinctive role in the mark applied for. Indeed, contrary to what is claimed by the applicant, that element is not devoid of distinctive character but on the contrary has average distinctive character for the part of the relevant public which is not familiar with English. Furthermore, since the “doughnuts” element is wholly meaningless for that consumer, the mark applied for, BIMBO DOUGHNUTS, does not form a unitary whole or a logical unit on its own in which the “doughnuts” element would be merged (Para. 97). The European Court of Justice (CJ) dismissed the appeal and held as follows: The GC did not conclude that there was a likelihood of confusion merely from the finding that, in the trade mark applied for, the ‘doughnuts’ element has an independent distinctive role, but based its conclusion in that regard on a global assessment (Para. 29) The GC has exclusive competence to assess whether, in the CTMA, the ‘DOUGHNUTS’ element retains an independent distinctive role. The expressions ‘unitary whole’ and ‘logical unit’, used by the GC (Para.97) clearly correspond to the expression ‘unit having a different meaning’, used by the CJ in the Case-Law (Para. 37) The GC did not automatically infer that there was a likelihood of confusion between the signs at issue from the fact that the ‘doughnuts’ element has an independent distinctive role in the trade mark for which registration was sought. The GC carried out a global assessment (Para. 46). The argument that the reputation of ‘BIMBO’ would suffice to prevent a risk of confusion is new and therefore inadmissible (Para. 48). **LOC**

**T-247/12; ARIS / ARISA**, Judgment of 20 May 2014, *Argo Group International Holdings Ltd v OHIM* – en.

CTMA	Earlier CTM
	

The applicant sought to register the figurative mark represented above as a CTM for insurance services et al in Class 36. An opposition was based on the earlier figurative mark represented



above, registered for insurance and reinsurance in Class 36. The opposition was filed on the grounds of Article 8(1) (b) CTMR. The Opposition Division (OD) upheld the opposition for all the contested services. The Board of Appeal (BoA) confirmed the decision of the OD. The applicant filed an action before the General court (GC) arguing, an infringement of Article 8(1) (b) CTMR. The GC dismissed the appeal. The GC firstly confirmed the finding of the BoA that the services covered by the marks at issue are intended for the same relevant public, which comprises both the general public and art professionals. In relation to the signs the GC upheld the finding of the BoA, that the dominant components of the marks at issue are the word elements 'aris' in the mark applied for and 'arisa' in the earlier mark (Para. 33). Contrary to the applicant's arguments, the BoA took into account all the elements of the marks in comparison. While it is true that, when assessing the aural similarities between the signs at issue, the BoA compared only the elements 'aris' and 'arisa', it cannot be inferred from this that the BoA did not carry out an overall assessment of those signs, since it took account of the only other element that could be pronounced — 'assurances s.a.' — and found that the relevant public would not pronounce it, owing to its lack of distinctiveness (Paras. 44-46). The applicant argued that a finding of a low degree of visual and aural similarity between the signs cannot lead to a likelihood of confusion. However, this finding had been made by the OD, and not by the BoA (which found the signs overall similar). Thus, since the GC has to review the legality of decisions of the BoA within the meaning of Article 65 CTMR and not to obtain a review of the legality of decisions of OD, the applicant's argument must be rejected as ineffective *ab initio*. (Para. 51) As far as the claim of coexistence of the marks at issue on the market is concerned, the evidence produced in order to establish the applicant's use of the Community word mark ARIS cannot be taken into account, as that mark is different from the marks at issue, which are both figurative. Secondly, the evidence concerns only the sign applied for and does not indicate the presence of that sign on the EU market (Para. 58). **LOC**

[T-528/11](#); **FOREVER / 4 EVER**, Judgment of 16 January 2014, *Aloe Vera of America, Inc. v OHIM* – en.

CTMA	Earlier CTM
	

The applicant sought to register the figurative sign FOREVER, shown above, as a CTM, inter alia for goods in Class 32 (juices, bottled fresh water). The opponent based an opposition on Article 8(1)(a) and 8(1)(b) CTMR using the earlier figurative CTM, 4EVER, shown below, registered for goods in Class 32 (juices). The Opposition Division upheld the opposition and rejected the application for registration of the CTM. The Board of Appeal (BoA) dismissed the appeal, finding that the earlier trade mark had been put to genuine use in the course of relevant period five years and that the goods were in part identical and in part similar. The phonetic identity, conceptual identity and low level of visual similarity between the signs were also found. In the light of those facts, the BoA stated that there was a likelihood of confusion. Concerning the Article 8(1)(b) CTMR



the GC further stated that the attentiveness of relevant public was average and the concerned goods were in part identical and in part similar (Paras. 51-52). A low degree of visual similarity between the marks was concluded too, because the visual differences were not to be so significant to cancel out their slight visual similarity. Moreover, the applicant acknowledged that there are visually similar elements between those marks (Paras. 58-62). It is also clear that the part of relevant public, which has some knowledge of the English language, pronounces both marks identically. These marks will be phonetically similar for the part of relevant public with no knowledge of the English language, because they contain the same ending “ever” (Paras. 70-71). Likewise, the marks were found conceptually similar for the part of relevant public, which has some knowledge of the English language, however conceptually neutral for the part of relevant public with no knowledge of the English language. (Paras. 76-77). In the light of those facts, the GC considered that there was a likelihood of confusion (Para. 84). There is no infringement of Article (8) (1) (b) CTMR. **LOC**

**T-551/12; REBELLA / SEMBELLA**, Judgment of 23 January 2014; *Coppenrath-Verlag GmbH & Co KG v OHIM* - de.

CTMA	Earlier CTM	Forms in which earlier CTM was used
Rebella	SEMBELLA	 

The applicant sought to register the word sign Rebella as a CTM, inter alia for goods in Classes 20 (furniture etc.) and 24 (textiles, blankets etc.). The opponent based an opposition on Article 8(1)(b) CTMR using the earlier word CTM, SEMBELLA, registered for goods in Classes 17, 20 and 22. The opponent had to prove use of his CTM. The Opposition Division partially allowed the opposition. The applicant as well as the opponent appealed to the Board of Appeal (BoA). The BoA found that the opponent had proved use through use in two forms differing from the CTM as registered. It found visual and phonetic similarity and conceptual neutrality between the signs and an enhanced level of distinctive character of the opposing right in Austria for “slatted frames” and “mattresses”. It concluded that there was likelihood of confusion for identical and similar goods. The GC confirmed that the signs are visually similar, even though their first letters are different (Para. 57). They are also phonetically similar (strong similarity in the rhythm of pronunciation and intonation) (Para. 58). **LOC**

◆ **C-422-12P; CLORALEX / CLOROX**, Order of 30 January 2014, *Industrias Alen SA de CV*. *Other parties: The Clorox Company and OHIM* – es. The CTM applicant sought to register the word mark **CLORALEX** for goods in Classes 3 and 5 (inter alia bleaching products and disinfectants). The opponent based its opposition on word marks **CLOROX**, covering identical products. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) annulled the OD decision and dismissed the opposition, considering that the signs were not similar



enough for a likelihood of confusion to exist. Upon appeal from the opponent, the General Court (GC) annulled the BoA decision (T-135/11). It noted that Greek consumers will understand that the element CLOR- refers to chlorine and indicates a frequently used component of cleaning and disinfection products. The GC found that the common element CLOR- determines to a large extent the global impression that the two signs produce. The BoA erred in not taking into account the element CLOR- when comparing the conflicting signs. The GC found that, due to a low visual and aural similarity and a high conceptual similarity between the signs, there is a likelihood of confusion. It annulled the contested decision. The CTM applicant alleged an infringement of Article 8(1)(b) CTMR because the GC took into account the descriptive element CLOR in the comparison of goods, even though it is perceived by the public as a reference to chlorine and not to a trade mark. It also contested the visual, aural and conceptual comparison of the signs, as well as the assessment of likelihood of confusion. The European Court of Justice (CJ) found part of the appellant's arguments manifestly inadmissible and the remaining ones manifestly unfounded. **LOC**

◆ [T-380/12; DEMON / DEMON](#), Judgment of 13/02/14, *Demon International LC v OHIM* – it.

CTMR	Earlier Mark
	<p style="text-align: center;"><b>DEMON</b></p>

An application for invalidity of the CTMR, registered for goods in Class 9 including sunglasses; sports glasses; safety goggles; protective masks for sporting activities, except those adapted for a specific sport; ski masks; snowboard goggles was filed on the basis of the earlier international word mark registered, among other goods, for snowboards in Class 28. The Cancellation Division (CD) declared invalid the CTMR for sports glasses; safety goggles; protective masks for sporting activities, except those adapted for a specific sport; ski masks; snowboard goggles. The Board of Appeal (BoA) annulled the CD decision since it found no risk of confusion between the marks at hand. The cancellation applicant filed an action before the General Court (GC). The GC annulled the BoA's decision to the extent that it excluded a likelihood of confusion in relation to the contested ski masks; snowboard goggles. The GC found that the latter goods are similar to an average degree to snowboards and not to a low degree only as stated in the contested decision. In particular, they are complementary because the contested goods are important for the use of the goods covered by the earlier mark. In order to find a complementarity between goods, it is not needed that the use of some goods is essential for the use of others. The GC confirmed that the signs are conceptually and phonetically identical but that they are visually similar to a high (not average) degree. To reach this conclusion, the GC argued that the word element is the dominant one in the visual impression of the contested sign since the figurative element merely represents the concept of the word element. **LOC**



T-216/11; **IMPERIA / IMPERIAL**, Judgment of 28 January 2014, *Progust, SL & Sopralex & Vosmarques SA v OHIM* – es.

CTM applied for	Earlier Mark/Sign
	

The applicant sought to register the figurative mark represented above as a CTM for Classes 29, 30, 31 and 32. An opposition based on the earlier community trade mark below, registered for goods in Class 29 was filed on the grounds of Articles 8(1) (b) CTMR. The opposition was directed against *fish* in Class 29 of the CTM. The Opposition Division (OD) upheld the opposition and refused the registration of the mark for *fish* products in Class 29. The Board of Appeal (BoA) confirmed the decision of the OD and rejected entirely the appeal. On the relevant public, the General Court (GC) held that the BoA as correct when it concluded that the products were targeted to average general consumers and concerned the public of the European Union. On the comparison of products the GC confirmed also that the BoA was right when it held that the products were identical. On the comparison of signs the GC held that the BoA was right when it concluded that visually the signs had some similarity due to the fact that both have a unique verbal element very similar only differing in the final letter. Moreover the GC confirmed that both figurative signs had the representation of a bird an element that added to the similarity of the signs. The signs have little and minor differences only. On the aural comparison the General Court confirmed the assessment of the BoA when it held that both signs have a high degree of aural similarity having only one final letter difference. On the conceptual comparison the GC confirmed the conclusion of the BoA when it held that the conceptual comparison was not relevant as the verbal element of the signs had no meaning in some parts of the European Union. Concluding on the overall assessment of the likelihood of confusion the GC held that the verbal element of both signs was the dominant one and that this element being very similar the conclusion of risk of confusion was right. The GC confirmed also that the distinctiveness of the earlier mark was normal and not weak as claimed by the applicant. **LOC**

◆ [C-193/13 P](#); **nfon / fon** et al, Order of January 16<sup>th</sup>. 2014, *nfon AG v OHIM* – de. In the case T-283/11 the General court (GC) overturned a decision of the Board of Appeal (BoA) and refused the CTMA “nfon” for goods in services in Classes 9 and 38 on the basis of the earlier CTM “fon” (figurative) and UK mark “fon” registered in the same Classes. The CTM applicant brought an appeal to the European Court of Justice (CJ) which was supported by the Office. The CTM applicant claimed an infringement of Article 8(1)(b) CTMR by three mistakes in the overall assessment of the likelihood of confusion: the assessment of the distinctive elements of the signs, a wrong application of the interdependence theory and not taking into consideration the low distinctiveness of the common element “fon” and the enhanced degree of the attentiveness. In the first part of its claim the CTM applicant agreed with the judgment under appeal that the element “fon” as a short form of “telephone” is descriptive for concerned products. It submitted, however, that as such it is devoid of a distinctive character and the coincidence in this element cannot cause the likelihood of confusion. The CJ recalled that the question what are the dominant elements of the marks as well as what is their impact on the overall impression, are questions of facts (Para.



28). With the second part of the claim the CTM applicant challenged the judgment under appeal as far as it stated that in a case of an identity or high similarity between the products, the distance between the marks has to be significant in order to exclude the likelihood of confusion. The CJ took the position that no such a general rule was pronounced in the judgment under appeal (Para. 41). The third part of the claim regards the lack of consideration of the level of the distinctiveness of the common element, as well as the level of attention of the public in the overall assessment in the judgment under appeal. The CJ recalled that whereas the assessment of all factors within the global assessment of the likelihood of confusion is a question of fact, the failure of taking one of them into consideration is an error in law (Para. 52). It took, however, the position, that the GC implicitly considered all relevant factors (Para. 54 and 56). **LOC**

◆ **T-383/12; Sun Park Holidays / Sunparks Holiday Parks**, Judgment of 16 January 2014, *Ferienhäuser zum See GmbH v OHIM* – en.

CTM applied for	Earlier CTM
	

The applicant sought to register the figurative mark “Sun Park Holidays” as a CTM for services in Classes 39 and 43. The opponent lodged an opposition against the application on the basis of its registered CTM “Sunparks Holiday Parks” (fig.) for services in Classes 39, 41 and 43. The Opposition Division (OD) upheld the opposition in respect of all the services covered by the CTMA on the basis of Article 8(1) (b) CTMR. The appeal filed by the applicant was dismissed. The General court (GC) first rejected the Office’s plea of inadmissibility in relation to the applicant’s claim for annulment of the OD. The GC pointed out that such an annulment falls within the measures which may be taken by the GC in the exercise of its power to alter decisions (Para. 19). The GC confirmed the reasoning of the Board of Appeal as to the existence of a likelihood of confusion between the marks in a part of the EU, namely in Germany. The services in Classes 39 and 43 are directed to the general public (Para. 33). The degree of attention is normal. The evidence submitted by the applicant for the first time before the GC to show an enhanced degree of attention was rejected by the GC as belated (Para. 36). The services covered by the marks are identical (Para. 39). As regards the similarity between the signs the word element “sunparks” is the dominant element of the earlier mark, taking into account the smaller size and lower position of the words “Holiday Parks” and the negligible nature of the figurative element (Para. 58). The dominant elements of the mark applied for are the words “Sun Park Holidays” in the centre of the sign (Para. 59). The signs are visually highly similar due to the similarity of the dominant elements “Sunparks” and “Sun Park Holidays” (Para. 62). Phonetically, the signs are similar to an average degree (Para. 63). Conceptually, the signs will be understood without difficulty by the relevant German-speaking public as referring to the ideas of sunny holidays and of leisure or holiday parks. The signs are therefore highly similar from a conceptual point of view (Para. 70). In view of, first, the high degree of conceptual and visual similarity and the average degree of phonetic similarity between the signs at issue and, secondly, the identity of the services at issue, the GC confirmed that there was a likelihood of confusion between the marks within the meaning of Article 8(1)(b)



CTMR. The finding of a weak distinctive character for the earlier trade mark does not prevent that finding. Even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Para. 76). **LOC**

**T-600/11; Carrera panamericana / CARRERA**, Judgment of 28 January 2014; *Schuhhaus Dielmann GmbH & Co. KG v OHIM* – en.

CTM applied for	Earlier Mark
Carrera panamericana	

The applicant sought, by means of an International registration designating the EU, to register the word mark represented above as a CTM for goods in Classes 18 and 25. An opposition based on the earlier CTM below, registered for goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division (OD) partially upheld the opposition and refused the registration of the applied for mark for all the goods in Class 25 and part of those in Class 18. The Board of Appeal (BoA) confirmed the decision of the OD and rejected entirely the appeal, holding the goods to be partly identical and partly similar and the signs to be overall similar. The GC - having noted that the BoA findings on the relevant public and the identity/similarity of the goods had not been disputed - turned to the comparison of the signs and endorsed the BoA finding that the element 'carrera' constitutes the dominant element of the earlier mark both visually and phonetically, given that it is emphasised in white letters on a black background and that the figurative element of the earlier mark serves primarily as a background to highlight that word (Paras. 43-44). The GC further confirmed that the BoA was right to find that the marks at issue exhibit a high degree of conceptual similarity for Spanish-speaking consumers, given that the word 'carrera' means 'race' in Spanish, whereas, for the non-Spanish-speaking public, that word is purely fanciful (Paras. 55-59). Finally, the GC confirmed the existence of a likelihood of confusion on part of the relevant public (Paras. 61-62) and dismissed the applicant's reference to a judgment of the *Bundespatentgericht* (German Federal Patents Court) which had excluded a likelihood of confusion between the same signs (Para. 63). **LOC**

◆ **T-486/12; METABOL / METABOL-MG**, Judgment of 11 June 2014, *Sofia Golam v OHIM* – en. The applicant sought to register the word mark METABOL as a CTM for goods and services within Classes 5, 16 and 30. An opposition based on the earlier word mark METABOL-MG, registered for goods in Class 5, was filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition in respect of all goods in Class 5, with the exception of 'herbicides'. The Board of Appeal (BoA) partly annulled the OD decision and partly dismissed the applicant's appeal. It excluded the existence of likelihood of confusion also for 'food for babies; preparations for destroying vermin; fungicides'. The applicant filed an action before the General Court (GC). The GC reiterated its settled Case-Law that an application is inadmissible insofar as it makes general reference to submissions in the course of the proceedings before OHIM (Para. 15). It thus



confirmed the implicit rejection of the applicant's objections regarding abuse of the right to oppose, non-use of the right to file a CTM application and vagueness of the opponent's written pleadings (Paras. 21-23). The applicant's claim that the goods she markets under the contested mark are dietary supplements which have no connection with the opponent's pharmaceuticals did not prosper. The GC pointed out that the application was not made in respect of dietary supplements, but in respect of, *inter alia*, the goods included in the heading of Class 5 (Para. 33). The applicant's claim that she was obliged to refer to goods in Class 5 was deemed irrelevant, since pursuant to Rule 2(4) CTMIR the Classification of goods is to serve exclusively administrative purposes and therefore no direct conclusion concerning the similarity between the goods at issue can be deduced from that Classification (Para. 36). Furthermore, the GC reminded that it remained open to the applicant, if that was her intention, to state with precision that her trade mark application was made in respect of dietary supplements, but she did not make use of the possibility to restrict the list of goods provided by Article 43(1) CTMR (Paras. 36-37). The goods at issue were found to be similar or identical (Para. 41). With respect to the comparison of signs, the GC stressed the existence of the common element "metabol" and the minor part the element "mg" plays in the overall impression created by the marks. It found them visually/phonetically highly similar and conceptually identical (Paras. 46-47). The fact that the opponent in the past did not oppose the registration of other marks containing the element "metabol" cannot preclude it from exercising its rights under 8(1)(b) and 8(2)(a)(ii) CTMR (Para. 49). The GC rejected the applicant's argument that the weak word element "metabol" should not be reserved solely to the proprietor of the earlier mark on the ground that it is immediately understood as a reference to "metabolism": in opposition proceedings the validity of national trade marks may not be questioned (Paras. 53-55). In view of the similarity/identity of goods and similarity of signs, likelihood of confusion was deemed to exist despite the weak distinctive character of the earlier mark (Paras. 51, 54). **LOC**

**T-62/13; METABIOMAX / BIOMAX**, Judgment of 11 June 2014, *Sofia Golam v OHIM* – el. The applicant sought to register the word mark METABIOMAX as a CTM for goods and services within Classes 5, 16 and 30. An opposition based on the earlier word mark BIOMAX, registered for goods in Classes 5, 30 and 32, was filed on the grounds of 8(1)(b) CTMR. The Opposition Division (OD) partially upheld the opposition. The Board of Appeal (BoA) allowed the applicant's appeal in part and annulled the decision of the OD to the extent that it allowed the opposition in respect of 'coffee, coffee substitutes; flour' in Class 30. The applicant filed an action before the General Court (GC). The GC reiterated its settled Case-Law that an application is inadmissible insofar as it makes general reference to submissions in the course of the proceedings before the Office (Para. 17). It rejected the applicant's objection regarding the alleged lack of standing of the intervener, given that the Office was duly notified that the earlier mark had been transferred (Paras. 21-22). It thus confirmed the implicit rejection of the applicant's objections regarding abuse of the right to oppose and vagueness of the opponent's written pleadings (Paras. 26-28). The applicant's claim that the goods she markets under the contested mark have no connection with the opponent's pharmaceuticals did not prosper. Her claim that she was obliged to refer to goods in Class 5 was deemed irrelevant, since pursuant to Rule 2(4) CTMIR the Classification of goods is to serve exclusively administrative purposes and therefore no direct conclusion concerning the similarity between the goods at issue can be deduced from that Classification (Para. 46). Furthermore, the GC reminded that pursuant to Rule 2(2) CTMIR the list of goods and services is to be worded in such a way as to indicate clearly the nature of the goods and services and that pursuant to Article 43(1) CTMR the applicant may at any time restrict the list of goods or services (Para. 39). On the



basis of the above considerations the GC concluded that the applicant's argumentation regarding the true nature of the products she markets under the mark applied for is ineffective, because what matters is only the description provided in the application for registration (Para. 41). The goods at issue were found to be similar or identical (Para. 45). With respect to the comparison of signs, the GC pointed out that the conflicting marks were visually and phonetically similar. Despite its initial position, the element "meta" does not offset the said similarity because it is a rather common prefix unable to attract the consumers' attention more than the shared element "biomax" (Paras. 51-53). The BoA conclusion that the marks are conceptually similar due to the fact that they both allude to 'biology' and 'maximum' was confirmed (Para. 54). The fact that the opponent in the past did not oppose the registration of other marks containing the element "biomax" cannot preclude it from exercising its rights under 8(1)(b) and 8(2)(a)(ii) CTMR (Para. 56). In view of the similarity/identity of goods and similarity of signs, likelihood of confusion was deemed to exist without there being any need to assess whether the distinctive character of the earlier mark is average or weak in relation to the goods at issue (Para. 60). **LOC**

**T-281/13; METABIOMAX / metabiarex**, *Sofia Golam v OHIM, Judgment of 11 June 2014 - el*. The applicant sought to register the word mark METABIOMAX as a CTM for goods and services within Classes 5, 16 and 30. An opposition based on the earlier word mark metabiarex, registered for goods in Class 5, was filed on the grounds of 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition for all goods in Class 5, with the exception of 'herbicides'. The Board of Appeal (BoA) partially annulled the decision of the OD. The applicant filed an action before the General Court (GC). The GC reiterated its settled Case-Law that an application is inadmissible insofar as it makes general reference to submissions in the course of the proceedings before the Office (Para. 15). (Paras. 18-19). It thus confirmed the implicit rejection of the applicant's objections regarding abuse of the right to oppose, non-use of the right to file a CTM application and vagueness of the opponent's written pleadings (Paras. 21-23). The GC found that the BoA had erred in defining the German term "Arzneimittel" as including only medicines for human purposes (Para. 34). It, however, confirmed the contested decision's finding that 'pharmaceutical preparations' and 'veterinary preparations' are identical to, while 'sanitary preparations' and 'disinfectants' are highly similar to the opponent's 'drugs' (Paras. 35-37). The fact that the earlier mark appears in lower-case letters, whereas the contested sign is written in upper-case, was deemed not to amount to a visual difference (Para. 41). The conflicting marks coincide in the first five letters and in the ending, they are identical in their two first syllables and the pronunciation of the sequence "bia" is similar to the pronunciation of the sequence "bio" for German-speaking consumers. The contested mark is laudatory and allusive to "biology" and "maximum", whereas the earlier mark has no conceptual content. The GC therefore concluded that the marks are lowly similar (Paras. 47-48, 52 and 54). The fact that the opponent in the past did not oppose the registration of other marks containing the elements "meta", "bi" and the letter "x" cannot preclude it from exercising its rights under 8(1)(b) and 8(2)(a)(ii) CTMR (Para. 55). In view of the average distinctiveness of the earlier mark and under the circumstances of the case, the high degree of similarity and identity of the goods suffice to offset the low degree of similarity of the marks (Paras. 58-59). The existence of likelihood of confusion for 'pharmaceutical and veterinary preparations', 'sanitary preparations' and 'disinfectants' was confirmed (Para. 60). **LOC**



**T-330/12; THE HUT / LA HUTTE**, Judgment of 24 June 2014, *The Hut.com Ltd & Intersport France v OHIM* – en. The applicant sought to register the verbal sign THE HUT for inter alia Class 35 services: “Procurement of goods on behalf of others; retail services in connection with the sale of electronic products, cosmetics products, perfumes, clothing, footwear, headgear, toys, games, foodstuffs, drinks; advice and consultancy services in connection with all the aforesaid services; provision of the aforementioned services by a customer care unit’. An opposition based on the earlier French verbal mark LA HUTTE registered for goods, in Classes 3,5,18,22,25 and 28 was filed on the basis of Article 8(1)(b) CTMR. The Opposition Division (OD) rejected the opposition in its entirety. The Board of Appeal (BoA) annulled in part the OD decision in so far as it had rejected the opposition in respect of ‘retail services in connection with the sale of cosmetics products, perfumes, clothing, footwear, headgear, toys, games, advice and consultancy services in connection with all the aforesaid services; provision of the aforementioned services by a customer care unit’ in Class 35. As to the substance, the General court (GC) pointed out that the relevant public in the case is the French consumer and that consumer’s level of attention is average. On the comparison of goods and services the findings of the BoA were confirmed: “the ‘retail’ and ‘advice and consultancy’ services or the services of ‘provision of the aforementioned services by a customer care unit’, in respect of which registration of the mark THE HUT is sought, relate to goods which are identical to those covered by the earlier mark, namely ‘perfumes, essential oils, cosmetics’ (Class 3), ‘clothing, footwear, headgear’ (Class 25) and ‘games and playthings’ (Class 28) (para 25 of the judgment). As a consequence the GC confirmed that the relationship between those services and goods is close in the sense that the goods are indispensable to or, at the very least, important for the provision of the services covered by the mark applied for, which are specifically provided when those goods are sold. The services and goods covered by the signs at issue are consequently complementary, as the BoA correctly pointed out in paragraphs 26 and 27 of the contested decision (Para. 26). Such degree of similarity is, contrary to what the applicant argued, not low. On the comparison of signs the visual difference existing between the signs (The mark applied for consists of two words of three letters each and the earlier mark consists of one word of two letters followed by a word of five letters. Secondly, the initial elements of the signs at issue, namely ‘the’ in the mark applied for and ‘la’ in the earlier mark, consist of different letters. Lastly, the second element of the earlier mark contains the letters ‘t’ and ‘e’ added to the syllable ‘hut’, which is the second word in the mark applied for) are not sufficient to rule out any visual similarity between the signs at issue. So the GC confirmed the finding of the contested decision of the BoA that as a whole, the signs at issue are visually similar, albeit to a low degree. Phonetically given the relevant public’s imperfect knowledge and command of English, in particular of words, such as those at issue in the present case, which are not part of the basic vocabulary, a not insignificant part of that public may pronounce the English word ‘hut’, of which the second element of the mark applied for consists, in the same way as the French word ‘hutte’ in the earlier mark (see, by analogy, Case T 57/03 SPAG v OHIM — Dann and Backer (HOOLIGAN) [2005] ECR II 287, paragraph 58) the signs are phonetically similar. In relation with conceptual similarity the GC confirmed the BoA finding that in relation with the article THE, that definite article is used in everyday language by the relevant French public to highlight, sometimes humorously or emphatically, the common noun which follows it. Consequently, the relevant public will, in the present case, attach particular importance to the beginning of the second element ‘hut’, which is common to the signs at issue (Para. 44). In relation with the word HUT it has no meaning in French. However, the average French consumer will recognise the element ‘the’ in the mark applied for as the English definite article and will understand that it precedes a noun in view of its grammatical function. Consequently, a not insignificant part of the relevant public, not knowing the



meaning of the English word 'hut' in the mark applied for, will be able to attribute a meaning to that word on the basis of the French rules of pronunciation. As the pronunciation of the word 'hut' is similar to that of the word 'hutte', the relevant public will from that be able to deduce the correct translation in French, namely 'la hutte'. This meaning proves to be the only one possible and is identical to that of the earlier mark (Para. 46). The GC reminded that it is not dispute that the 'hut' is the English translation of 'la hutte' and refers to a shelter or a shack. The signs are overall similar therefore the GC confirmed the global assessment of the contested decision and held that there is a certain degree of similarity between the services in respect of which registration of the mark is sought and the goods covered by the earlier mark. Secondly, the signs at issue are similar. In those circumstances, it must be held, that there is a likelihood of confusion between those signs when assessed globally. **LOC**

**T-401/12; JUNGBORN / BORN**, Judgment of June 11<sup>th</sup> 2014, *Robert Klingel OHG v OHIM – de*. The Board of Appeal (BoA) confirmed the refusal of the extension of the protection of the international registration (IR) represented below to the EU territory due to the likelihood of confusion. The earlier trade mark was registered in Germany for similar and identical goods as in Classes 29, 30 and 32. The IR owner filed an action before the General court (GC) contesting the similarity of the mark and the assessment of the likelihood of confusion. The GC rejected the only plea – the infringement of Article 8(1) (b) CTMR in conjunction with Article 156 CTMR. The trademarks are similar visually and phonetically to an average degree. The fact that a mark consists exclusively of the earlier mark, to which another word has been added, is an indication that the two trademarks are similar (Para. 27 with a reference to further Case-Law). That similarity is not, contrary to what the applicant claims, diminished by the fact that the part common to those two marks, only constitutes the second syllable in the IR although it is settled Case-Law that consumers normally attach more importance to the beginning of signs. This rule has exceptions. In the case at hand the part "jung" is easily understandable for German public with the meaning "young" whereas the coinciding part "born" is less common and will attract and retain the attention of the relevant consumer (Para. 30 with a reference to further Case-Law). The conceptual comparison cannot be made, since the word "jungborn" has no meaning in German (Para. 33). Even if the consumer perceives the marks as a whole, they will break a verbal sign down into elements which, for them, suggest a concrete meaning or which resemble known words (Para. 35 with a reference to further Case-Law). Given that the goods are identical or similar, which finding was not contested by the parties and on the basis of the average level of attention of the relevant public, the BoA correctly found that the similarity between the marks leads to the likelihood of confusion (Para. 36) **LOC**

◆ **T-502/12; OCTASA / PENTASA**, Judgment of 9 April 2014; *Farmaceutisk Laboratorium Ferring A/S v OHIM - en*. The applicant sought to register the word mark OCTASA as a CTM for 'preparations and substances for preventing and treating diseases and disorders of the gastrointestinal tract' in Class 5. An opposition based on a number of earlier trademarks for the words PENTASA and OCTOSTIM and registered for 'pharmaceutical preparations' in Class 5 was filed on the grounds of Articles 8(1) (b) and 8(5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) dismissed the appeal. As far as the opposition was based on the earlier marks PENTASA, it held that the opponent had shown genuine use of the earlier Benelux trademark PENTASA in respect of a certain pharmaceutical product. The General court



(GC), following the BoA approach, began its assessment by analysing whether there was a likelihood of confusion between the Benelux word mark PENTASA and the mark OCTASA applied for. As to the relevant public and their level of attention, the General court (GC) held that all of the earlier trade marks (save one of them) cover pharmaceuticals in general and therefore also 'preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract' which are the specific goods covered by the mark applied for. The relevant public consists of medical professionals and consumers of the above specific products, the level of attention of consumers purchasing medicines to treat such diseases being higher than the average (Paras. 30-38). Addressing the issue of the alleged descriptive nature of the suffix 'ASA', the GC stated that the BoA failed to establish the descriptive character of the suffix 'asa' from the perspective of the end-users of the goods (Paras. 47-48). The evidence relied upon by the BoA and which consists of extracts, in English, from two online encyclopaedias, namely Wikipedia and The Free Dictionary concern only the English-speaking end-users of medicines and not non-English-speaking end-users (Para. 49). It is settled Case-Law that an extract from Wikipedia lacks certainty as a source of information (Para. 50). There is no reason for concluding that the medical publications submitted by the CTM applicant and taken into account by the BoA are read by the relevant end-users (Para. 51). There is no reason to conclude that those end-users will immediately interpret, without further thought, the suffix 'asa' as a description of that active ingredient. Rather, it is necessary to follow a complex line of reasoning which involves a number of stages in order to interpret the suffix 'asa' as a reference to *mesalazine* (Para. 53). Coming to the comparison of the signs, the GC stated that the principle that first component of word marks may be more likely to catch the consumer's attention than the following components cannot apply in all cases, what matters being the overall impression produced by the signs. The marks at issue display a certain degree of visual and phonetic similarity, given that they are of a similar length and have three syllables (Paras. 58-62). Conceptually, from the perspective of the end-users of the goods in question who do not understand that the suffix 'asa' is a reference to *mesalazine*, neither of the signs at issue, taken as a whole, have any meaning. For those end-users who are also unaware that the beginnings of the signs at issue, namely 'penta' and 'octa', refer to Greek numbers, the conceptual comparison is neutral. From the perspective of that part of the relevant public, neither of the signs refers to any concept whatsoever. However, some of the end-users will recognise that the beginnings of the signs at issue refer to Greek numbers. For those end-users, the signs at issue are conceptually similar in that they both refer to Greek numbers. None the less, given that the signs at issue refer to different Greek numbers, that conceptual similarity must be held to be weak (Paras. 63-68). The GC concluded that the BoA erred by finding that the signs OCTASA and PENTASA were dissimilar and by holding that, as a result, one of the necessary conditions for finding that there is a likelihood of confusion had not been met. The GC therefore upheld the first plea in law and annulled the contested decision, stating that there was no need to examine the other arguments and pleas in law raised by the opponent (Para. 71). However, the GC stated that the findings that the BoA had not established the descriptive character of the suffix 'asa' from the perspective of the end-users of the goods in question and that there is a certain degree of visual and phonetic similarity between the signs at issue also apply to the relevant publics of the other Member States concerned (Para. 72). **LOC**



**T-170/12; BEYOND VINTAGE / BEYOND RETRO**, Judgment of 30 April 2014, *Beyond Retro Limited v. OHIM* - en. The opponent sought to oppose the registration of the word mark BEYOND VINTAGE, for goods in Classes 14, 18 and 25, on the basis of its earlier CTM for the work mark BEYOND RETRO registered for, inter alia, clothing in Class 25, cf. Article 8(1) (b) CTMR. The Opposition Division (OD) upheld the opposition for Classes 18 and 25, and rejected it for Class 14. The Board of Appeal (BoA) upheld the appeal of the CTM applicant, finding no likelihood of confusion (NO LOC) for any of the claimed goods in Classes 14, 18 and 25, and dismissed the opponent's appeal that LOC should have also been found in Class 14. Before the General Court (GC), the opponent alleges an infringement of Article 8(1) (b) CTMR. Regarding the goods in Classes 18 and 25, however, the GC held that the BoA erred in its finding of no LOC due to the global assessment was seen to be flawed. The BoA distinguished between English-speaking and non-English speaking public, yet drew its formal conclusion only with regards to the non-English-speaking public (Para. 86). **LOC**

**T-1/13; GLAMOUR / TUDOR GLAMOUR**, Judgment of 4 July 2014, *Advance Magazine Publishers, Inc. v. OHIM* – de. The CTM applicant sought to register the word mark “GLAMOUR” for goods in Classes 12, 14 and 18. The opponent based its opposition on Article 8(1) (b) CTMR using the earlier International word mark with effect in the EU, registered for goods in Class 14. The opposition was directed against the goods in Class 14. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the appeal, finding that there was likelihood of confusion, taking into account, the identity of the goods and the similarity of the signs. The CTM applicant appealed to the General court (GC), arguing an infringement of Article 8(1) (b) CTMR. The applicant claimed incidentally an infringement of Article 7 (1) (b) CTMR. The GC found that the applicant did not explain how this article would be applicable and said that in any case in an opposition procedure such a claim, even if it was held to be admissible, would be ineffective (Para. 15 and 16). The GC confirmed the BoA concerning the finding of identical goods in class 14. It confirmed also the practice that the goods in class 14 are targeted at the average consumers who are in view of the nature of the goods highly attentive (Para. 23-25). As far as the signs are concerned, the GC stated that both word elements of the earlier mark are equally relevant and that on account of the second word which coincides with the contested mark there is a visual and phonetic similarity which is not ruled out by the first different word in the earlier mark (Para. 31). Conceptually the GC upheld the BoA finding that for a part of the public there is no conceptual meaning (Para. 35). In a global assessment, the GC confirmed the contested decision to the extent that taking into account the identity between the goods and the visual and aural similarities between the signs which for part of the public are not affected by any conceptual difference, there is likelihood of confusion. Under the given circumstances the GC did not consider it necessary to enter the question if the criteria in the MEDION Judgment (Thomson Life) were applicable or not (Para. 44). Finally the GC stated that the academic writings and the Case-Law of the German supreme courts have no binding effect (Para. 45-46) and the cases on which the applicant relied were not comparable to the case at hand (Para. 47 - 49). **LOC**



T-324/13; **FEMIVIA / femibion**, Judgment of 16 July 2014, *Endoceutics, Inc. v OHIM*, Language of the case - en.

CTMA	Earlier IR
FEMIVIA	<i>femibion</i>

The applicant sought to register the word mark FEMIVIA as a CTM for “pharmaceutical preparations for the prevention and treatment of medical conditions related to the menopause” within Class 5. An opposition based, *inter alia*, on the earlier international registration of the figurative mark represented above, registered for “pharmaceutical preparations” and other goods in Classes 5, 29 and 30, was filed on the grounds of 8(1)(b) CTMR. The Opposition Division rejected the opposition in its entirety due to lack of likelihood of confusion (LOC), insofar as the similarity of the signs was based on the prefix “femi” which is weak for the goods at issue. The Board of Appeal (BoA) upheld the opponent’s appeal. The applicant filed an action before the General court (GC). The GC rejected the applicant’s complaint that the opponent should have proven use of the earlier CTM, reminding that the BoA based its examination of LOC on the earlier international registration (IR) of a figurative mark, which was not under obligation of use (Para. 17). The applicant’s criticism regarding the relevant public did not prosper; the GC pointed out that since the marks cover all EU Member States, examination should not be limited to the English-speaking public. It also reiterated that the principle according to which registration of a mark can be refused if an absolute ground for refusal exists only in part of the EU also applies by analogy to relative grounds. The BoA was therefore entitled to restrict assessment to the Spanish-speaking portion of the public for reasons of procedural economy (Paras. 26-27). The GC found that, in the context of the goods covered by the mark applied for, the prefix “fem” will be understood by the relevant public as an abbreviation of “femenino”, which describes the intended purpose of the goods in question. The prefix thus has a weak distinctive character for those goods; however, such elements may hold an autonomous position in the overall impression created by a mark and therefore account should be taken of the conflicting signs as a whole (Paras. 33, 35-36). The BoA’s conclusions regarding the average degree of visual similarity and the high degree of phonetic similarity between the signs were confirmed by the GC (Paras. 39 and 41). However, the finding that the conceptual comparison is neutral was not upheld: the GC ruled that because of the element “fem” (which evokes the words “femenino” and “femina”) and the elements “ivia” and “ibion” which lack meaning for the relevant public, the signs should be regarded as conceptually similar to a certain degree (Para. 43). In view of the identity of the goods, the similarity of the signs on all levels of comparison and the normal inherent distinctive character of the earlier IR, the GC confirmed LOC (Paras 46 et seq.). Finally, the GC pointed out that the fact the relevant public will be more attentive to the identity of the producer or provider of the goods it wishes to acquire does not mean, however, that it will examine the mark before it in the slightest detail or compare it in great detail to another mark (Para. 48). **LOC**



T-425/12; E / E, Judgment of 11 July 2014, *Sport Eybl & Sports Experts GmbH v OHIM*, – de.

CTMA	Earlier Mark
	

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 9, 12, 18, 22, 25, 28 and 42. The opposition based on the earlier CTM represented below, which is protected among others for goods in classes 9, 12, 18, 25 and 28 was rejected. The Opposition Division excluded the likelihood of confusion without the entire examination on the basis of the assumption of the identity of products with the reasoning that even for such products the signs are sufficiently apart from each other and that the protection of a single letter sign is limited to its graphical representation. The Board of Appeal (BoA) partially annulled the decision and rejected the CTM application. It found a likelihood of confusion for identical goods (those in classes 9, 12, 25, 18 and 28) and for those found similar (Class 22). It found the services in Class 42 dissimilar to the products protected by the earlier CTM and rejected the opposition to that extent. The CTM applicant filed an action to the General court (GC). The action was directed against the decision as far as it rejected the opposition and based on article 8 (1) (b) CTMR. The GC confirmed the finding of likelihood of confusion. Within the claim of infringement of Article 8(1) (b) CTMR the applicant challenged the similarity of goods in Class 22, the similarity of the signs and the assessment of the likelihood of confusion (Para. 16). The GC confirmed the BoA's decision in all these points: The goods applied for "tents and climbing ropes" in Class 22 are similar to the "sporting articles" in Class 28. The classification in different classes is not an argument against the similarity since the Nice Classification has administrative purposes only, Rule 2 section 4 CTMIR (Para. 28 with a reference to further Case-Law). The fact that the goods are sold in the same shops is a valid criterion according to Canon-Judgment (C-39/97) (Para. 29 with a reference to further Case-Law). Also, goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Para. 30 with a reference to further Case-Law). It cannot be excluded that the goods applied for are complementary to those protected since climbing robes as well as tents can be used together with various sport articles (Para. 30). The signs are visually similar. The graphical presentation cannot detract from the same impression made by the letter "e" in both signs (Para.37). They are phonetically identical (Para. 38). They have no meaning making the conceptual comparison impossible (Para. 40). Even if the applicant was right claiming that the earlier mark has a limited distinctiveness, the likelihood of confusion could not be excluded (par. 47). **LOC**



T-195/12; **NUNA / NANA et al.**; Judgment of 23 September 2014; Nuna International BV, Nanu-Nana Joachim Hoepp GmbH & Co. KG, v. OHIM - en.

CTMA	Earlier marks
	NANA, NANU-NANA

The applicant sought to register the figurative sign represented above as a CTM for classes 12, 18, 20, 21, 25 and 28. An opposition based on CTM's registrations for goods in classes 18, 20, 21, 25 and 28 33 was filed on the grounds of Article 8(1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division rejected the opposition on the ground that there was no likelihood of confusion. The Board of Appeal (BoA) upheld the appeal. It concluded that there was a likelihood of confusion between the sign applied for and the earlier marks with respect to all the goods covered by that sign. In the global assessment of the likelihood of confusion done, the BoA was right to find that there is a likelihood of confusion between the marks at issue as regards the goods in classes 18, 21, 25 and 28 and the 'cribs; high chairs; bouncing seats; baby rocking chairs and carry cots' in Class 20 covered by the mark applied for (Para. 105).

**LOC**

T-218/12; **DELTA / DELTA PORTUGAL**, Judgment of 10 September 2014, *Micrus Endovascular LLC v. OHIM* – en.

CTMA	Earlier mark
DELTA	

The applicant sought to register the word mark DELTA for 'Medical and surgical devices, namely, microcoils used for endovascular surgery for the treatment of aneurysms' in Class 10. An opposition was filed based, *inter alia*, on the Portuguese trademark reproduced above, which covers pharmaceuticals and other products in Class 5, cf. Articles 8(1) (b) and 8(4) CTMR. The Opposition Division (OD) upheld the opposition. On appeal, the Board of Appeal (BoA) upheld the opposition and rejected the CTM application. Before the General court (GC), the applicant alleges an infringement of Article 8(1) (b) CTMR. The BoA was right to define the relevant public as composed of 'professionals in endovascular surgery', without narrowing that category further to encompass 'brain surgeons' only. As the Office claimed, endovascular surgery is not limited to the brain, but is also used to treat abdominal aortic aneurysms (Paras. 42-43) These highly specialised professionals use the 'pharmaceutical products' of the earlier mark, namely if they have to administer those medicines to a



patient before, during or after a surgical operation (Para. 48) It is common knowledge that large hospitals usually centralise orders for medicines, equipment and specialised work tools (Para. 62). However, this does not mean that the distribution channels are identical or that administrators in the central purchasing department are the relevant public (Para. 63). Professionals in endovascular surgery ultimately decide which products must be ordered (Para. 64). The goods are complementary because of their common intended purpose (use in the performance of endovascular surgical operations and in the context of pre-operative or postoperative care, or in preventive medicine). Furthermore, they are co-manufactured namely by pharmaceutical conglomerates (Para. 68). The signs are identical or highly similar and thus a likelihood of confusion. **LOC**

**T-536/12; AAROA / ARO**, Judgment of 11 September 2014, Aroa Bodegas, S.L & Bodegas Muga v.OHIM - es.

CTMA	Earlier marks
	

The applicant sought to register the verbal sign represented above as a CTM for class 32 (beers, mineral water and non-alcoholic beverages and Class 33 (wines, alcoholic beverages with the exception of beers). An opposition based on a Spanish earlier trade mark Registration for goods in Class 33 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division (OD) upheld the opposition refusing registration of the mark applied for in relation to all the goods concerned. The Board of Appeal (BoA) partially annulled the decision of the opposition division and rejected the opposition for non-alcoholic beverages, fruits juices and drinks made of fruits as these goods were not similar to the earlier mark goods. For the rest of the goods it found that the OD had correctly upheld the opposition since a likelihood of confusion could not be excluded due to the identity or similarity of the goods covered by the mark applied for, namely, wines, alcoholic drinks and beers, protected by the earlier Spanish figurative mark and the similarity of the signs at issue. The General court (GC) took note of the fact that the applicant does not challenge the findings of the BoA concerning the definition of the relevant public, composed of the average public in Spain (Para. 22). On the visual comparison of signs the GC held that the BoA was correct in concluding that the signs are visually similar to a low degree. Both signs are mainly composed of verbal elements and the elements “Aroa” and “Aro” are the most distinctive ones (Paragraph 39) as the figurative elements and the colours are frequent in marks in the wine sector (Paras. 35 and 36). On the aural comparison the GC confirmed the assessment of the BoA when it held that the signs to be compared which are “aro” and “aroa” present an average similarity, as they share the sounds “a, r and o” and they only differ in the “a” sound of the beginning of the contested sign (Paragraph 46). In relation to the conceptual comparison the GC held that the BoA was correct when it declared that both signs have different conceptual meanings. The word “aro” in Spanish language has a clear meaning



whether “aroa” even if it was used as a female name has no meaning (Para. 48). In the global assessment of the likelihood of confusion done, the BoA did not infringe Article 8(1) (b) CTMR as the goods are either identical or similar. The earlier mark has an average degree of distinctiveness, the word ARO in Spanish means “ring” and therefore has no connection with the goods (Paras. 51 and 52). In relation with the signs they have some similarity in particular because of their phonetic similarity. For these kind of products that are ordered in a noisy environment the phonetic similarity has a certain importance (Para. 53). The different sound of the final letter A of the contested mark could not be perceived clearly in these surroundings. Therefore the BoA was correct to hold that the phonetic similarity in this case was of more importance (Para. 56) and a risk of confusion is not to be excluded. Finally on the argument of a supposed peaceful coexistence between the contested sign and the mark AROA LAKET the GC held that the mark invoked is not similar to the marks at stake (Para. 62), moreover the opponent did not bring any evidence of this peaceful coexistence and this argument was correctly rejected. **LOC**

**T-576/12; PROTEKT / PROTECTA**, Judgment of 15. July 2014, *Grzegorz Łaszkiwicz v OHIM* – pl.

CTMA	Earlier Mark
	<b>PROTECTA</b>

The applicant sought to register the figurative mark represented above as a CTM for goods within classes 6 and 9. The application was entirely rejected upon an opposition based on the earlier Community word mark represented below, registered for goods in Class 9. The Board of Appeal (BoA) confirmed the decision. The applicant filed an action before the General court (GC), claiming the infringement of Article 8(1) (b) CTMR and articles 75 and 76 CTMR. The GC rejected the documents which were not presented in the administrative proceedings as inadmissible (Para. 15 et seq.) There was no infringement of Article 8(1) (b) CTMR. The similarity or identity of the goods is not under dispute (Para. 36) The signs are visually similar sharing characters “P-R-O-T-E—T-“ in the same sequence. The graphical elements are minor, therefore that emphasizes that the verbal elements are generally more distinctive than the figurative ones applies (Paras. 38 and 40). They are phonetically highly similar, differing only in the sound “a” since the letters “c” and “k” are pronounced identically (Para. 42). Both signs refer to the English basic word “protect” and are conceptually similar (Para. 48). A likelihood of confusion exists if the similarity of the products and the similarity of the signs are together sufficiently high, as in the case at hand (Para. 46 et seq.) The BoA enhanced level of attention corresponding to the fact that goods in question are meant to protect workers was considered by the BoA (Para. 49). The argument of the applicant that the earlier mark has a descriptive character referring to the concept of “protection” and does not enjoy any protection is not valid. Even if the earlier mark was registered incorrectly, the possible breach of article 7 CTMR cannot be taken into account in the opposition proceedings (Para. 55 with a reference to further). The earlier national mark always has [is deemed to have] some level of distinctive character (Para. 56 with a reference to C-196/11 P “Formula One Licencing”). Even if the earlier mark had a limited distinctiveness, it is only one of the factors taken into account when assessing the likelihood of confusion and cannot exclude it (Para. 59 with a reference to further).

**LOC**



T-18/13; **PROTEKT / PROTEK**, Judgment of 15. July 2014, *Grzegorz Łaszkiewicz v OHIM* - pl..

CTMA	Earlier Mark
	PROTEK

The applicant sought to register the figurative mark represented above as a CTM for goods within classes 6 and 9. The application was entirely rejected upon an opposition based on the earlier Spanish word mark represented below, registered for goods in class 9. The Board of Appeal (BoA) confirmed the decision. The applicant filed an action before the General court (GC), claiming the infringement of Article 8(1) (b) CTMR and articles 75 and 76 CTMR. There was no infringement of Article 8(1) (b) CTMR. The goods are similar, having the same character, method of use and purpose and being complementary (Paras. 35 and 40). The signs are visually similar sharing 6 characters in the same sequence. The graphical elements are minor, thus the Case-Law that emphasizes that the verbal elements are generally more distinctive than the figurative ones applies (Paras. 43 and 45). They are phonetically highly similar (Para. 47). Both signs refer to Spanish word “proteger” and are conceptually similar (Para. 48). The BoA considered an enhanced level of attention corresponding to the fact that goods in question are meant to protect workers (Para. 53). The argument of the applicant that the earlier mark has a descriptive character referring to the concept of “protection” and does not enjoy any protection is not valid. Even if the earlier Spanish mark was registered incorrectly, the possible breach of Article 7 CTMR cannot be taken into account in the opposition proceedings (Para. 56 with a reference to further Case-Law). The earlier national mark always has [is deemed to have] some level of distinctive character (Para. 57 with a reference to C-196/11 P “Formula One Licencing”). Even if the earlier mark had a limited distinctiveness, it is only one of the factors taken into account when assessing the likelihood of confusion and cannot exclude it (Para. 60 with a reference to further Case-Law). **LOC**

T-199/13; **STAR / STAR LODI**, Judgment of 10<sup>th</sup> September 2014, *DTM Ricambi Srl vs. OHIM* – it.

CTMA	Earlier IR
	



The applicant sought to register the figurative mark represented above as CTM for goods in classes 7, 9 and 12. The contested goods in Class 12 include, *inter alia*, motors and engines for land, air and water vehicles, machine coupling and transmission components for said vehicles. An opposition was filed on the grounds of Article 8(1) (b) CTMR. It was based on the earlier International figurative mark below registered for goods in classes 12, 38, 39 e 42. The Board of Appeal (BoA) found identity between the contested goods and the goods of the earlier mark in Class 12 and a high degree of similarity between the contested goods in classes 7 and 9 and engines for vehicles in Class 12 the earlier marks. The General court (GC) noted that, according to the explicatory notes of the Nice Classification, the contested air and water vehicles, machine coupling and transmission components for said vehicles in Class 12 do not fall in this class but in Class 7. Therefore, constitutive parts of boats and airplanes, protected by the earlier mark in Class 12, do not cover engines for air and water vehicles, machine coupling and transmission components for said vehicles. Therefore there cannot be identity between the above goods (Paras. 34-37). On the other hand, since Nice Classification serves administrative purposes only, it has to be found that the above goods in comparison are similar to a high degree even if belonging to different classes. Indeed, the goods engines for air and water vehicles, machine coupling and transmission components for said vehicles of the mark applied for, erroneously included in Class 12, are as the goods constitutive parts of boats and airplanes protected by the earlier mark, all components of air and water vehicles and these goods belong to the same industrial sector and are targeted to the same public, There is a high degree of similarity also in relation to the contested goods in classes 7 and 9, which are all parts or accessories of engines, and the goods of the earlier mark since as far as their nature, purpose and method use are concerned and they also are complementary. Therefore, the BoA failed in finding that there was identity between the above goods (which belong to different classes) instead of a high degree of similarity (Paras. 41 and 42). The GC confirmed that “STAR” is visually the dominant element of the earlier mark, due to its size and its central position, even when considered as having a low distinctive character (Paras. 49 and 50). The same conclusion is valid in relation to the contested mark since “STAR” is the only word element and it is the bigger element of the mark. Therefore, the marks are similar but to a low degree only due to the presence of different figurative and word elements which are secondary but not negligible in the overall impression of the signs (Para. 53). Phonetically, the marks are similar but not to a high degree, as found in the contested decision. The word “LODI” would not be omitted by the consumers in the pronunciation of the earlier mark (Para. 58). The BoA correctly found that there is identity from a conceptual point of view due the coincidence of the element “STAR” which will be understood by the EU consumers, including those of not English-speaking territories. Indeed a part of the public would find no meaning in the word “LODI” (Para. 61). As far as the distinctive character of the earlier mark is concerned, the GC found that “STAR” will be perceived as a laudatory element following the Case-Law of the GC. Therefore, the distinctive character of the earlier mark is weak at least for a significant part of the public (Para. 68). The distinctive character of the earlier mark is however only one of the factors to be taken into account in the assessment of the likelihood of confusion. Therefore, taking into account the identity and the high degree of similarity between the goods, and the degree of similarity between the signs, there is a likelihood of confusion, notwithstanding the low distinctiveness of the earlier mark and the attention of the relevant professional public. Therefore, the errors in relation to the identity of some of the goods and to the phonetic comparison of the signs in the contested decision do not lead to an annulment of the decision at issue (Para. 76). **LOC**



T-185/13; **CONTINENTAL WIND PARTNERS / CONTINENTAL**, Judgment of 11 September 2014, *Continental Wind Partners LLC v OHIM* - de.

CTMA	Earlier mark
	

The applicant sought to register the figurative mark CONTINENTAL WIND PARTNERS as a CTM for goods and services in classes 7, 9, 11, 35, 39 and 40. The opponent lodged an opposition against the application on the basis of the EU designation of its international registration Continental (fig.) for goods and services in classes 7, 9, 35 and 40. The Opposition Division (OD) upheld the opposition partly on the basis of Article 8(1) (b) CTMR. The appeal filed by the applicant was dismissed. The General court (GC) considered the application lodged before the GC partly inadmissible, namely insofar as the applicant simply referred to previous briefs filed in the administrative proceedings before the Office without bringing forward any arguments (Paras. 16-19). As to the existence of a likelihood of confusion between the marks, the goods and services are directed to a specialised public with specific knowledge in the area of renewable energies. The degree of attention is high (Para. 25). As regards the comparison of the goods and services, the Board of Appeal (BoA) had confined itself to referring to the arguments of the OD. The GC confirmed the comparison of the goods undertaken by the OD as far as that evaluation was contested by the applicant (Paras. 37-39). Since the applicant did not explain – before the BoA or before the GC – why the assessment of the comparison of goods was not correct (Para. 40) the BoA did not commit any error by referring to the arguments of the OD (Para. 41). The conflicting signs are visually similar to a low degree and phonetically similar to a medium degree (Paras. 49-51). Conceptually, the contested decision erroneously stated that the signs were identical from the perspective of those consumers who did not understand the meaning of the elements “Wind” and “Partners” (Para. 55). Since the goods and services are directed to a specialised public one can assume that those terms are understood by those specialists throughout the EU (Para. 56). The signs are conceptually similar to a low or medium degree (Para. 71). However, the error committed by the BoA would only lead to the annulment of the contested decision if it had an impact on the outcome (Para. 70) which is not the case. The argument of the applicant that the term “Continental” was not apt for registration due to its alleged descriptiveness was rejected by the GC. According to the GC, the validity of the earlier mark must not be questioned (judgment C-196/11 P of 24 May 2012, *Formula One Licensing/OHIM*, applied by analogy). Consequently, one has to concede a minimum degree of distinctiveness to the earlier mark (Paras. 59-64). The opposing mark even enjoys at least an average degree of distinctiveness (Para. 68). In view of the visual, phonetic and conceptual similarity between the signs and the identity or similarity of the goods and services at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1)(b) CTMR (Paras. 71-73). **LOC**



**T-127/13 PRO OUTDOOR / OUTDOOR**, Judgment of 11 September 2014, *El Corte Inglés S.A. v. OHIM* – es.

CTMA	Earlier mark
<p style="text-align: center;"><b>PRO OUTDOOR</b></p>	

The applicant sought to register the word mark PRO OUTDOOR in Classes 9, 12, 14, 18, 22, 24, 25, 28 and 35. Opposition based on the CTM figurative mark reproduced above, for goods in Classes 12, 18, 22, 24, 25 and 28. As to Article 8(1) (b) CTMR, the Opposition Division partially upheld the opposition for the goods in Classes 9, 12, 18, 22, 24, 25 and 28. The Board of Appeal (BoA) dismissed the appeal. The contested decision is partially annulled. The BoA must examine the appeal in relation to all the remaining goods (in another Paragraph). For the rest, the GC confirms that data processing equipment have a similar nature to games and toys, which include toy computers and interactive games that use software. These products may be addressed to the same public, may share the same distribution channels and they often have the same intended purpose, so that they can substitute each other. The relevant public includes EU professional and private consumers, whose degree of attention is higher than the average (Para. 43). The signs are visually and aurally similar, as they share the common element OUTDOOR. Conceptually, the signs are similar for the English speaking public. However, for the part of the relevant public who don't understand the term OUTDOOR the marks are conceptually different, as they will understand the meaning of the terms PRO, CAMPING, BARBECUE AND GARDEN. There was a likelihood of confusion for the whole of the relevant public, even more important for the English speaking public, for which the signs are also conceptually similar. **LOC**

**C-468/13P; MOL BLUE CARD / TARJETA BLUE BBVA et al**, Judgment of 17 July 2014, *MOL Magyar Olaj- cs Gazipari Nyrt. v. OHIM + Banco Bilbao Vizcaya Argentaria SA* – en. The CTM applicant sought to register this word trade mark. Banco Bilbao – the owner of the earlier CTM BLUE for the same services - filed an opposition based on the likelihood of confusion (Article 8 (1) (b) CTMR). The Opposition Division (OD) rejected the opposition. The opponent filed an appeal against the OD's decision. The Board of Appeal (BoA) upheld the appeal and rejected the CTM application. The CTM applicant filed before the General court (GC) an action for annulment of the BoA's decision. The GC dismissed the actions as unfounded, considering (i) that the general reference made by the CTM applicant to the arguments already raised before the Office was inadmissible, (ii) that evidence annexed to the application and presented for the first time before the GC (the existence of a family of "MOL" marks) was inadmissible, (iii) that the findings concerning the factual assessment conducted by the BoA (similar services, similar marks, LOC) were correct. The CTM applicant filed before the European court of justice (CJ) an action grounded on 3 pleas in law: (i) infringement of Article 44 of RPGC and Article 21 of SCJ, (ii) infringement of Article 65 (2) CTMR and Article 135(4) RPGC (iii) infringement of Article 8 (1) (b) CTMR. The CJ dismissed the appeal pursuant to Article 181 RPCJ. On the infringement of Article 44 RPGC and Article 21 SCJ, the CTM applicant criticised the GC for declaring inadmissible the arguments raised before the Office and referred to in its appeal as long as it was a mere technical



reference (Para. 27, Para. 28). The CJ, endorsing the Office's arguments, dismissed the ground of appeal, considering the GC's finding as correct and the CTM applicant's argument as an attempt in vain to reclassify the general reference (para. 31, para. 32). On the infringement of Article 65(2) CTMR and Article 135(4) RPGC, the CTM applicant criticised the GC for declaring inadmissible evidence annexed to the appeal in so far as they were presented for the first time before the GC: facts and arguments were not new because they were included in written observations submitted before the Office (Para. 36). The CJ, endorsing the Office's arguments, held that the CTM applicant duly set out facts and arguments, but it did not provide the Office with evidence (Para. 40). The principle following which new documents are inadmissible when submitted for the first time before the GC is therefore reiterated. On the infringement of Article 8 (1) (b) CTMR, The CTM applicant criticised the finding results from the factual assessment conducted by the GC, noting that it failed to consider (i) the high level of attention of the relevant public, (ii) the partial dissimilarity between the services referred to the earlier trade mark and the ones referred to the contested trade mark, (iii) the weak distinctive character of the element "blue". The CJ, endorsing the Office's arguments, held that the ground of appeal must be rejected as manifestly inadmissible in so far as the CTM applicant seeks to obtain a re-examination by the CJ of the GC's findings (Para 51). **LOC**

**T-342/12 STAR / STAR**, Judgment of 8 October 2014; *Max Fuchs v. OHIM* – en.

CTMA	Earlier CTM and FR marks
	

The applicant sought to register the figurative mark reproduced above in Classes 18, 24, 25 and 26. Opposition based on the CTM and French figurative marks reproduced below, for goods in Classes 18, 24 and 25 (FR). On Article 8(1) (b) CTMR, the Opposition Division rejected the opposition for the goods in Class 24 and allowed the opposition in respect of all the other goods. The Board of Appeal (BoA) dismissed the appeal. On the merits, the goods are identical or similar and the signs are visually similar and conceptually identical. A likelihood of confusion was therefore found, despite the weak distinctive character of the earlier mark. **LOC**

**T-263/13; HOLZMICHEL / MICHEL**, Judgment of 1 October 2014, *Lausitzer Fruchteverarbeitung GmbH v OHIM* – de.

CTMA	Earlier IR
	



The applicant sought to register the figurative mark seen above as a CTM for goods in Classes 32 and 33. The opponent lodged an opposition against the application on the basis of, *inter alia*, the designation in BLX, DE, ES, FR, IT and AT of its international registration for goods in Classes 32 and 33. The Opposition Division (OD) dismissed the opposition in its entirety. The appeal filed by the applicant was granted: The Board of Appeal (BoA) annulled the decision of the OD and granted the opposition on the basis of Article 8(1) (b) CTMR. The General court confirmed the existence of likelihood of confusion between the conflicting marks. The goods in Classes 32 and 33 are directed to the general public. The degree of attention is average (Para. 21). The beverages covered by the marks are identical or similar (Para. 22). The conflicting signs are visually and phonetically similar to a medium degree (Para. 49 and 58). The fact that the marks coincide in the element “Michel” is an indication of their visual and phonetic similarity (Para. 33 and 53). It is not unusual to use an antique font as shown in the contested sign in relation to beverages. The font of the mark applied for will therefore not be perceived as being capable of distinguishing the signs (Para. 37). Moreover, although it is true that consumers tend to pay particular attention to the beginning of a mark, the common element “Michel” will also be noticed and remembered by the public (Para. 39-41 and 55). Conceptually, the relevant German speaking public will associate the term “Michel” with a male first name. To that extent, the signs are conceptually similar (Para. 65 and 69). The word “Holz” means “wood” in German. The combined term “Holzmichel” will be understood - at least by a part of the German speaking consumer – as a reference to a person named Michel who is somehow connected with “wood” (Para. 66). The earlier mark enjoys a normal degree of inherent distinctiveness for beverages (Para. 76). Although the first element “Holz” of the contested sign is also distinctive the mark is not dominated by that term. The word “Michel” plays an independent distinctive role in the mark applied for (Para. 88). In view of the visual, phonetic and conceptual similarity between the signs and the identity or similarity of the goods at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1) (b) CTMR (Para. 89-91). **LOC**

**T-262/13; SKYSOFT / SKY**, Judgment of 15 October 2014; *Skysoft Computersysteme GmbH v. OHIM* – en. The applicant sought to register the word sign ‘SKYSOFT’ for goods and services in Classes 9, 35, 37, 38 and 42, including ‘maintenance and repair of data processing equipment and computer installations’ in Class 37. The opponent filed an opposition based on the earlier Community word mark ‘SKY’, covering goods and services falling within Classes 9, 16, 18, 25, 28, 35, 38, 41 and 42, including ‘data processing equipment and computers’ in Class 9. The Opposition Division upheld the opposition under Article 8(1) (b) in respect of all the contested goods and services. The Board of Appeal (BoA) dismissed the appeal. The General court (GC) confirmed the decision of the BoA. In first place, it stated that the BoA had correctly defined the relevant public as consisting of both the general public and the professional public in all the Member States of the European Union, in particular the English-speaking public residing in the United Kingdom with average or above average level of attentiveness (Para. 21). The GC then noted that the BoA’s finding as to the identity of the goods and services falling under Classes 9, 35, 38 and 42 was not disputed by the applicant. The GC went on to confirm the BoA’s finding that ‘maintenance and repair of data processing equipment and computer installations (including equipment for access to networks and computer databases)’, as covered by the mark applied for, and ‘data processing equipment and computers (including data storage apparatus and instruments, software and data storage software, and software for video-conferencing)’, as covered by the earlier mark, are complementary, since those services refer specifically to the



above goods and ensure their proper functioning. The GC added that those goods and services often share the same distribution channels and are offered in the same sales outlets specialising in IT (Paras. 24-25). As to the comparison of the signs, the GC endorsed the opponent’s argument that the relevant English-speaking public would perceive the element ‘soft’ as an abbreviation of the word ‘software’, being therefore descriptive of some of those goods — including software — and services, which further diminishes its importance compared to the element ‘sky’, which does not have such a descriptive character. Already on a visual comparison, the relevant public may perceive the latter sign as being derived from the first sign (Para. 30). The signs present an average phonetic similarity of the signs at issue by reason of the identical pronunciation by the relevant English-speaking public of the common syllable ‘sky’ (Para. 31). The signs are also similar to an average degree from a conceptual point of view, due to their common element ‘sky’ (Para. 33). The GC dismissed the applicant’s argument that Office is not entitled to take into account decisions of national authorities as factors relevant to its assessment, as the BoA did in the present case by referring to two decisions of the UKIPO (Para. 39) and also dismissed as vague and ineffective the applicant’s argument that the distinctiveness of the earlier mark would be ‘diluted’ by the approximately 600 entries containing the word ‘sky’ in the UKIPO’s register. The GC then confirmed the BoA’s assessment that the earlier trade mark ‘SKY’ had a substantial reputation in the United Kingdom for some of the goods and services in question (Para. 40). The GC therefore confirmed the BoA’s finding that, in the mind of the relevant English-speaking public residing in the United Kingdom, and even taking into account a greater level of attentiveness than average on its part, there was a likelihood of confusion. **LOC**

[T-297/13](#); **UNITED AUTOGLAS / AUTOGLASS**, Judgment of 16 October 2014; *United Autoglas Deutschland GmbH & Co. KG v OHIM* - en.

CTMA	Earlier Mark
United Autoglas	

The applicant sought to register the word mark United Autoglas as a CTM for goods and services, *inter alia*, in Classes 12 and 37. An opposition based, *inter alia*, on the earlier Polish figurative mark seen below registered for goods and services in Classes 12, 21 and 37, 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. The General court confirmed the existence of likelihood of confusion between the conflicting marks. The goods and services covered by the marks are directed mainly at the general public in Poland (Para. 22) and are identical and similar (Para. 24). The Polish equivalent of the German word “Glas” (“glass” in English) is “szkło”. Although many consumers in the European Union know basic English vocabulary (such as the English terms ‘star’, ‘snack’ and ‘food’), the term ‘glass’ does not form part of such basic vocabulary (Para. 32). The term “autoglas” cannot be considered to be descriptive for the part of the Polish consumers who do not have a certain level of English or German. Since the term “glas” has no meaning for the part of the relevant public, the term “autoglas” is of medium distinctive character (Para. 35-36). The English word ‘united’ is not elementary English vocabulary either. Even though the average Polish



consumer might recognise the term ‘united’ knowing companies such as ‘United Airlines’ or the name ‘the United States of America’, there is nothing to suggest that he also understands its meaning (Para. 42-43). CTMA does not contain any element which might be considered to be manifestly more distinctive or dominant in comparison with the other elements (Para. 45). Having regard to the high similarity between the second element of the CTMA and the only word element of the earlier mark, but also to the differences between them in the remaining elements, including figurative, there is a low degree of visual similarity (Para. 51-53). Given the identical pronunciation of the term “autoglas(s)” in both marks, there is a medium phonetic similarity (Para. 56). Although the term “autoglas(s)” will not be associated with glass for automobiles by those of the average Polish consumers who do not have a certain level of English or German, both marks contain the term ‘auto’ and will therefore evoke, from the point of view of the relevant public, either automobiles or automatic devices. Even if, as the applicant asserts, the average Polish consumer associates the term “auto” only with automobiles, the fact remains that the marks at issue are conceptually similar in this respect (Para. 58). The presence of the element ‘united’ in the CTMA does not rule out the possibility that the consumer might consider the trade mark sought to constitute a mere variant of the earlier mark on account of the presence of the element “autoglas”, which is almost identical to the sole word element in the earlier mark (Para. 64). Even a high level of attention on the part of the relevant public would not call into question a risk that a consumer may think that the trade mark sought is a variant of the earlier mark (Para. 66). **LOC**

[T-531/12](#); T / T, Judgment of 7 October 2014, *Tifosi Optics, Inc. v OHIM* – en.

CTMA	Earlier mark
	

The registration of Community trademark was sought by Tifosi Optics, Inc. (the “applicant”) for a figurative sign reproduced above, for the following goods: - Class 9: ‘Optical apparatus and instruments; spectacles; sunglasses; frames; cases; hinges; arms and lenses for spectacles and sunglasses, parts and fittings therefor; visors; binoculars; ski masks; protective helmets and goggles, parts and fittings therefor; contact lenses and containers therefor’; – Class 25: ‘Clothing, footwear, headgear’. Tom Tailor GmbH (the “opponent”) filed a notice of opposition, pursuant to Article 41 CTMR, to registration of the mark applied for in respect of all the goods based on the earlier Community figurative mark reproduced below, for the following goods: – Class 9: ‘Optical apparatus and instruments; eyewear; eyeglasses; sunglasses; lenses; eyeglass cases and sunglass cases; parts and fittings for all the aforesaid goods’; – Class 25: ‘Men’s and women’s clothing; t-shirts, shirts, jeans, pants, shorts, leather pants, chaps, sweaters, jackets, vests, skirts, dresses and footwear; articles of outerclothing’. The opposition relied on the grounds set out in Article 8(1) (a) and (b) CTMR. The opposition was rejected by the Opposition Division (OD). Afterwards, based on an appeal of the opponent, the Board of Appeal (BoA) annulled the OD’s decision and refused the Community trademark application for all the goods concerned. The BoA appeal stated that the goods covered by the earlier trademark were either identical or similar and the marks were visually similar and aurally and conceptually identical. The applicant brought an action alleging infringement of Article 8(1) (b) CTMR and challenging the conclusion of the BoA,



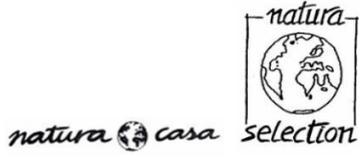
initially, that the goods in question were similar or identical; subsequently, that the signs at issue were visually, aurally and conceptually similar; and, lastly, that there was a likelihood of confusion between the marks at issue. The relevant public in the present case consists of both professionals and the general public. The relevant public's degree of attention is higher than average for some of the goods in Class 9. The GC found the goods in Class 25 of the contested trademark to be identical with the goods covered by the earlier mark. In regards of the goods in Class 9, GC found the majority of the goods identical to goods covered by the earlier mark. In respect of "protective ... goggles" The GC did not agree with the argument of the BoA stating that these goods are identical to the "optical apparatus and instruments" covered by the earlier trade mark: the latter category, according to the GC, covers goods which are far more technically complex than spectacles, such as microscope. By contrast, the "protective ... goggles" covered by the mark applied for appear to be similar goods to the "sunglasses" covered by the earlier trade mark in view, inter alia, of the method of use and intended purpose of both categories of goods (Para. 48). The GC found that the BoA was right to conclude that the "visors; ... ski masks; protective helmets ..., parts and fittings therefor" in Class 9 covered by the mark applied for were similar to the "articles of outer clothing" in Class 25 covered by the earlier trade mark. The GC highlighted that the classification of goods and services under the Nice Agreement is intended to serve exclusively for administrative purposes. Goods may not therefore be regarded as being different from each other solely on the ground that they appear in different classes: the benchmark is whether, from the relevant public's perspective, the goods in question may have a common commercial origin (*PiraÑAM diseño original Juan Bolaños*, T-443/05). Furthermore, these two categories of articles are closely connected because of their producers, points of sale and purpose. The GC concluded that the majority of the goods covered by the marks at issue are identical and the rest are similar (Paras. 51 to 53). When comparing the signs, the GC found the signs, despite some slight differences between them, visually similar. The overall impression is determined, according to the GC, by the capital letter 'T' and the oval which surrounds it. On the contrary, the graphic stylisation of the signs is clearly secondary and requires a detailed examination on the part of consumers which is unlikely considering that the mark, when placed on goods at issue, is usually relatively small and that the marks concerned are single-letter signs (Para. 62 and 63). GC found, in line with the Board of Appeal, that the marks are orally identical and rejected the applicant's argument that consumers will inevitably make the connection between the sign and the name of the company which owns the brand since such a factor has no bearing on the aural impression conveyed by the marks as filed (Para. 72). In regards of conceptual similarity, GC stated that it is not possible to compare the signs at issue conceptually, since it was not established that the capital letter 'T' had a particular meaning in one of the languages of the European Union; nor it was indicated what concept would be conveyed by the capital letter 'T' in the present case (Para. 81). The question whether an individual letter of the alphabet may convey a concept in general has, however, still not been unambiguously answered. The GC concluded that the signs are highly similar for the relevant public (Para. 84). Finally, the GC found that the BoA was right to find that the impression of the marks at issue likely to be retained by the relevant public would be largely determined by their memory of a capital letter 'T' inside an oval (Para. 90). Further, the degree of similarity between the signs and the degree of identity or similarity between the goods concerned are such that there is a likelihood of confusion even in the event that the relevant public has a high level of attention (Para. 92). Lastly, even if it is accepted that the earlier trade mark has a weak distinctive character, the degree of identity and similarity between the goods and the degree of similarity between the marks are, considered cumulatively, high enough to warrant the conclusion that there is a likelihood of confusion (Para. 96). **LOC**



[T-303/06 RENV](#) and [T-337/06 RENV](#), **UNIWEB et al / UNIFONDS et al**, (remitted to the General Court (GC) by the European Court of Justice (CJ) in Case C-0317-10P), Judgment of 25 November 2014, *UniCredit SpA v OHIM* – it. The applicant sought to register the word marks represented below as CTMs for services within Class 36 (these being ‘banking business; financial affairs; monetary affairs; insurance; real-estate affairs; financial and insurance consultancy and information; credit/debit card services; banking and financial services via the Internet’ for UNIWEB and ‘banking business; financial affairs; monetary affairs; assurance; real-estate affairs; financial information’ for UniCredit Wealth Management). The opponent filed two oppositions based on the three earlier German word marks represented below and registered for ‘placement of funds’ in Class 36. The opponent also invoked the existence of a family of marks in Germany, all characterized by the initial element ‘UNI’ and all used to distinguish ‘placement of funds’. The ground invoked was based on Article 8 (1) (b) CTMR. The Opposition Division upheld the oppositions in respect of all of the contested services with the exception of ‘real estate affairs’, which were considered to be dissimilar to ‘placement of funds’. The Board of Appeal (BoA) dismissed the appeals filed by the opponent and the applicant, respectively. The applicant filed two actions before the General court (GC). By a first judgment, the GC annulled the BoA’s decisions, holding that the latter had erred by not properly assessed the issue of the family of marks and by finding that, given its lack of distinctive character, the common element ‘UNI’ could not trigger in the consumers’ minds an association between the contested applications and the opponent’s family of marks. Following an action lodged by the opponent (and supported by the Office with a cross appeal), the European court of justice (CJ) annulled the GC’s judgments, holding that the latter had erred in law in the application of Article 8 (1) (b) CTMR. The CJ remitted the cases to the GC for a new assessment (C-0317/10P). The GC dismissed the actions filed by the applicant and confirmed the BoA’s decisions to the extent that it upheld the oppositions for all of the contested services with the exception of ‘real estate affairs’. The relevant public consists of the German consumer of financial services, whose level of attention is above average (Para. 48). The services (with the exception of ‘real estate affairs’) are similar and this has not been disputed by the applicant. The signs are also similar to a certain degree, to the extent that they all consist of the initial element ‘UNI’ followed by descriptive or non-distinctive terms such as RAK, FONDS and ZIN (all meaningful in German when it comes to the opponent’s services ‘placement of funds’) or ‘Wealth’, ‘Management’ and ‘Web’, the use of English being widespread in the financial sector (Para. 53). The signs present a certain similarity also on a conceptual level, given their highly similar structure (Para. 54). Turning to the issue of the family of marks, the GC recalled the established Case-Law, in particular the judgment in *Bainbridge* (C-234/06), and held that the opponent had proven the use of a family of marks on the German market of ‘placement of funds’. Contrary to what had been argued by the applicant, the opponent was not required to prove that the German consumers would perceive the earlier marks as forming a family of marks (Paras. 65-66). Although the three earlier marks on which the opponent expressly relied are limited in number, they are sufficient to consider that they form a family of marks (Para. 74). The fact that the conflicting signs have a common structure and that the common element ‘UNI’ is placed at the beginning is sufficient to trigger a link in the consumers’ minds between the contested applications and the opponent’s family of marks (Paras. 80-81), also considering that the common element ‘UNI’ has a certain degree of inherent distinctiveness when it comes to financial services, as it does not refer to specific characteristics of the latter (Paras. 84-87). **LOC**



◆ T 549/10; **NATUR / NATURA SELECTION et al**, Judgment of 13 November 2014, *Natura Selection SL v. OHIM* – en.

CTMA	Earlier marks
<p><b>natur</b></p>	

The applicant sought to register the word mark ‘natur’ as a CTM for goods and services within Class 24 corresponding to the following description of goods: Textiles and textile goods, not included in other classes; bed and table covers. An opposition was based on the earlier figurative CTMs represented above. The CTMs were registered for goods in Class 20 and the following services in Class 35: Commercial retailing and via worldwide telematic networks; import and export services; advertising services; all the above relating to *inter alia* textiles and textile goods, not included in other classes; bed and table covers; clothing, footwear, headgear. The opposition was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition in respect of some of the disputed goods and rejected the opposition in respect of table covers in Class 24. The Board of Appeal (BoA) dismissed the opponent’s appeal finding that the goods ‘table covers’ in Class 24 covered by the mark applied for were lowly similar to services of ‘commercial retailing..... relating to ... table covers’ in Class 35, covered by earlier marks. The opponent filed an appeal before the General Court (GC). There is a similarity between goods and retail services which relate to those goods (Para. 33). The services in Class 35 covered by the earlier application for the mark ‘natura’ relate to the goods in Class 24 covered by the mark applied for. Consequently, there is a similarity between the commercial retailing and via worldwide telematic networks of table covers covered by the earlier application for the mark ‘natura’ and the table covers covered by the mark applied for (Para. 34). Moreover, the services covered by the earlier application for the mark ‘natura’ constitute one of the possible distribution channels for the goods covered by the mark applied for. That fact thus accentuates their similarity (Para. 35). The GC thus found that the BoA erred in finding there was a low degree of similarity between the disputed goods and services and, consequently, it erred in concluding there was no likelihood of confusion (Paras. 36 and 37). The single plea of the opponent was upheld. **LOC**



T-153/11 and T-154/11, ZENATO RIPASSA / RIPASSO, Judgments of 27 November 2014, *Cantine Broglie 1 Srl v OHIM* – it.

CTMAs	Earlier Mark
<p>ZENATO RIPASSA</p> <p>(case T-153/11)</p>  <p>(case T-154/11)</p>	<p>RIPASSO</p>

The applicant sought to register the marks represented above as CTMs for ‘alcoholic beverages (except beers)’ in Class 33. Oppositions were filed based on the earlier Italian word mark RIPASSO, registered for ‘wines, spirits and liqueurs’ in Class 33. The ground invoked was based on Article 8 (1) (b) CTMR. The Opposition Division, having found that the earlier mark had been genuinely used only for ‘wines’, dismissed the oppositions, finding the signs to be overall dissimilar. The Board of Appeal (BoA) upheld the appeals and the oppositions, finding likelihood of confusion. The applicant filed two actions before the General Court (GC). The GC dismissed the actions and confirmed the BoA’s findings. The goods concerned, wines, are mass consumer goods, which are purchased not only in wine shops and specialist establishments but also in supermarkets, grocery shops, etc. and which target the average consumer of large consumption goods (Para. 22). Therefore, the relevant public’s level of attention will not be particularly high (Para. 24). As for the applicant’s claim that the wine in question coming from Valpolicella are particularly costly, it is enough to note that this circumstance is not evident from the specification of the earlier mark (Para. 23). The GC dismissed the applicant’s argument that there could be no likelihood of confusion, given the very limited distinctiveness, if any, of the earlier mark ‘RIPASSO’, which years back had been refused by the Office on the grounds that it was descriptive of a re-fermenting method, used in the *Valpolicella* area (in the Veneto region). The GC noted that, since the earlier ‘RIPASSO’ trade mark is validly registered in Italy and is assisted by a presumption of validity, it must be considered to have at least a certain degree of inherent distinctiveness (Paras. 32-36). The GC confirmed the BOA’s reasoning that the above-mentioned technical meaning of the term ‘RIPASSO’ in relation to the wine sector would not be known to the majority of the Italian public, consisting particularly of less-knowledgeable end consumers not from the Veneto region. Consequently, for such end consumers the term ‘RIPASSO’ does not have any relationship with the goods in question. The GC also found that there is no contradiction between the decision of the Office, at the time, to refuse the CTM application ‘RIPASSO’ on the ground of its descriptive nature and the later decisions to uphold two oppositions based on an earlier registered national mark ‘RIPASSO’ (Para. 39). In this respect, the GC noted that for ‘RIPASSO’ to be considered



descriptive under Article 7 (1) (c) CTMR, it is sufficient if the interested circles, consisting of wine professionals, connoisseurs having a higher degree of awareness and consumers from the Veneto region, are likely to perceive it as referring to a method for re-fermenting wine (meaning that it is sufficient if the descriptive nature of the trademark is perceived by a part of the relevant public). On the other hand, in the context of Article 8(1)(b) CTMR, upholding the oppositions is justified since the above technical meaning of 'RIPASSO' would not be known to the majority of the Italian public, not originating from the Veneto region and consisting of average consumers with a normal level of attention (Para. 41). The conflicting signs 'RIPASSO' and 'ZENATO RIPASSA' have a low degree of visual and aural similarity and are conceptually similar to the extent that they both make reference to the same concept, 'ripasso' being a noun meaning 'the act of passing again; revision' and 'ripassa' being a verbal form having the same root and meaning '(he/she) passes again; (he/she) revises' (Paras. 49-57). Finally, the GC held that, even assuming the earlier mark 'RIPASSO' was inherently weak, still there is a likelihood of confusion on account of the identity between the goods and the degree of similarity between the signs (Para. 66). **LOC**

**T-445/12; KW SURGICAL INSTRUMENTS / Ka We**, Judgment of 26 September 2014, *Koscher + Würtz GmbH, v OHIM – de*.

Contested IR	Earlier German mark
	<p style="text-align: center;">Ka We</p>

The applicant designated the EU for its International Registration "KW Surgical" for goods in Class 10. The intervener filed an opposition based on Article 8 (1) (b) CTMR using the earlier German mark "Ka We", registered for goods in Class 10. The Opposition Division rejected the opposition because the similarity of the signs was held to be insufficient. For reasons of procedural economy the evidence intended to show the proof of use of the earlier mark has not been examined. The Board of Appeal (BoA) upheld the appeal of the intervener, finding that there was likelihood of confusion, taking into account, the identity of the goods and the similarity of the signs. The BoA did not examine the evidence intended to show the proof of use of the earlier mark. The applicant appealed to the General Court (GC), arguing an infringement of Article 8 (1) (b) CTMR. As regards the plea for alteration of the contested decision in the sense that there is no likelihood of confusion The GC proceeded to examine the comparison of the signs in the contested decision. It agrees with the BoA that the signs are visually similar in a low degree because of the coincidence of the letters "K" and "W" contained in both marks (Para 55). From a phonetic point of view the GC coincides with the contested decision and states that there is a high degree of aural similarity or even an aural identity, in case that the public would not pronounce the terms "surgical instruments" of the younger mark (Para. 61 and 63). From a conceptual point of view the terms "surgical instruments" will be understood at least by the English speaking consumers with specific knowledge in the medical field. The GC proceeds with the analysis if this conceptual meaning of "surgical instruments" together with the graphical features contained in the younger sign are enough to exclude any likelihood of confusion (Para 66). The GC finally reaches the conclusion that the differences between the signs would not be sufficient in order to safely set aside any likelihood of confusion. The meaning of "surgical instruments" may not neutralize and counteract



the visual and in particular aural similarities between the signs (Para. 73). The BoA did not commit any mistake when it concluded that there would be a likelihood of confusion between the signs (Para 75). The plea for alteration has been rejected (Para. 82). The Office has to examine the evidence intended to show the proof of use of the earlier sign and then assess if there is likelihood of confusion between the marks (Para. 83). **LOC**

**T-463/12; MB / MB&P**, Judgment of 6. November 2014, *Eugen Popp and Stefan M. Zech v OHIM* – de.

CTMA	Earlier CTM
MB	<b>MB&amp;P</b>

The applicant sought to register the word mark represented above as a CTM for “services of a patent attorney’s office” within Class 45. An opposition pursuant to article 8 (1) (b) CTMR was filed on the basis of an earlier CTM represented below and protected for services in class 35 and 42. The CTM applicant requested proof of use. The Opposition Division rejected the opposition due to the differences between the marks. The Board of Appeal (BoA) allowed the opposition in its entirety. It considered that the proof of use was sufficient for “services of a patent attorney” in Germany and found the likelihood of confusion. The applicant filed an action before the Court claiming infringements of Article 42 (2) CTMR and Article 8 (1) (b) CTMR. As far as the applicant contests the probative value of the affidavit provided as proof of use for the first time in the reply, it is not a new plea in the meaning of Article 48(2) of the Rules of Procedure, but an extension of its plea based on Article 42(2) CTMR which was raised in the application. It is admissible. On Article 8 (1) (b) CTMR, there is an identity between the “patent attorney’s services” in Class 42 and the “services of a patent attorney office” in Class 45. The classification has only administrative purposes pursuant to rule 2 (4) CTMIR (Para. 75). The earlier mark has a normal distinctiveness (para. 88). According to the Case-Law, the assessment of the likelihood of confusion in the case of marks consisting of short sequences of letters follows the general rules, even if the sequence is not pronounceable (Para. 90). The fact that the earlier mark is contained in the CTM application leads to a similarity. The Case-Law does not support the applicant’s assumption that the similarity is excluded already by small differences if the signs are short. Even for short signs the differences have to be sufficient (Para. 97). There is a likelihood of confusion even taking into consideration the enhanced level of attention that the public will show in the case of patent attorney’s services. The public will perceive the CTM application as a variation of the earlier one (Para. 148) **LOC**

**T-308/13; ELECTROLINERA / ELECTROLINERA**, Judgment of 18 November 2014; *Repsol, S.A. & Josep Maria Adell Argiles v. OHIM* - es. The applicant sought to register the verbal sign ELECTROLINERA as a CTM in Classes 4, 37 and 39. An opposition based on a Spanish earlier mark ELECTROLINERA for goods in Classes 12 and 9 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division (OD) partially upheld the opposition. The Board of Appeal (BoA) partially annulled the decision of the



OD. For industrial oils, greases, lubricants and fuels in Class 4 it held that there was a weak but non negligible similarity with vehicles in Class 12 of the earlier mark. It held that there is a certain similarity between electricity in Class 4 and the apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity in Class 9 of the earlier mark. For gas stations services in Class 37 it held that there is a certain degree of similarity with apparatus in Class 9 of the earlier mark. Finally the services of providing, distributing and stocking energy for vehicles in Class 39 of the contested mark were found to be similar to vehicles of Class 12 and to apparatus of Class 9 of the earlier marks. The signs being identical, likelihood of confusion was found with regard to the similar products and services. The relevant public is composed of the average public and the professional public in Spain (Para. 27). On electricity in Class 4 and apparatus in Class 9, the BoA was correct to establish that the products were similar (Para. 52). In relation to the services of Class 37 and the apparatus of Class 9, the BoA was correct to conclude to a certain degree of similarity (Para. 61). On the services of Class 39 and the apparatus of Class 9, the BoA was correct to find a certain similarity (Para. 74). In the global assessment of the likelihood of confusion, although the GC criticises (Para. 69) the similarity found by the BoA in relation with services of Class 39 and vehicles of Class 12, in Para. 84 the GC held that the mistake pointed out in this respect was without consequences in the legality of the BoA decision. **LOC**

**T-595/13; compressor technology / KOMPRESSOR PLUS et al**, Judgment of 4 December 2014 of, *J BSH Bosch und Siemens Hausgeräte GmbH v OHIM* Language of the case – de.

CTMA	Earlier Marks
	<ol style="list-style-type: none"> <li>1.) <b>KOMPRESSOR PLUS (CTM)</b></li> <li>2.) <b>KOMPRESSOR (FR)</b></li> <li>3.) <b>KOMPRESSOR (ES)</b></li> <li>4.) <b>KOMPRESSOR (UK)</b></li> </ol>

The CTM applicant sought to register the mark represented above for goods and in Class 7, 9 and 11. An opposition based on the earlier mark represented below, registered for similar and identical goods in Class 7, 9 and 11, was filed on the grounds of Article 8 (1)(b) CTMR. The Opposition Division (OD) upheld the opposition for the goods found to be similar and identical. The Board of Appeal (BoA) dismissed the applicant's appeal and rejected the CTM application for further goods, which were found similar contrary to the OD's opinion. The applicant filed an action before the General Court (GC). The goods at issue are partly identical, partly similar (not disputed). The CTM applicant argued that the distinctiveness of the element KOMPRESSOR, at least for goods that can contain a compressor (such as e.g. vacuum cleaners/air condition apparatus) is only minimal. Therefore, for these goods, even the slightest differences will prevent a likelihood of confusion. The GC emphasized that, first, a certain degree of distinctiveness has to be attributed to national marks (Para. 26), and second that the distinctiveness of the earlier mark(s) is just one element of the assessment of likelihood of confusion (Para. 27). The CTM applicant's approach would lead to



the result of the distinctiveness of the earlier mark neutralizing the similarity of signs and, thus, giving undue weight to the distinctiveness in the overall assessment (Para. 31). The BoA has seen and included the differences between the marks in its global assessment, but in light of the decorative figurative element and the secondary position of the element “technology” within the CTMA was right in its assessment that the difference in the first letters “C/K” are not sufficient to compensate for the similarity of the word elements “KOMPRESSOR”/“compressor” (Para. 34). Even if the aural similarity was considered secondary in the present case, the visual and conceptual similarities suffice to come to the conclusion of a likelihood of confusion (Para. 35). Based on the foregoing, the action was dismissed. **LOC**

**T-176/13 GENERIA / GENERALIA generacion renovable**, Judgment of 9 December 2014, *DTL Corporación, S.L. v. OHIM – es.*

CTMA	Earlier marks: CTMs and IT
GENERIA	

The applicant sought to register the word sign GENERIA for goods and services in Classes 9, 35, 37, 40, 41 and 42. Opposition pursuant to Article 8 (1) (b) CTMR, based on the figurative mark reproduced above, covering goods and services in Classes 7, 35 and 40. The Opposition Division (OD) partially upheld the opposition with regard to all the products and services, except for some of the services in Class 35. The Board of Appeal (BoA) dismissed the appeal. Before the General Court (GC), the applicant alleges an infringement of the right of defence and of Article 8 (1) (b) CTMR. The GC confirms the comparison of the goods and services and of the goods, with some nuances. There is a likelihood of confusion (LOC). The application is dismissed. **LOC**

◆ **T-605/11, BIOCERT / BIOCEF**, Judgment of 10 December 2014, *Novartis AG v. OHIM + Dr Organic Ltd – en.* The CTM applicant filed an application for the word mark BIOCERT for goods in Class 5. The opponent relied on an earlier Austrian mark BIOCEF for goods in Class 5. The Opposition Division (OD) dismissed the opposition. The opponent filed an appeal against the OD’s decision. The Board of Appeal (BoA) dismissed the appeal. The CTM applicant brought an action before the General Court (GC) based on two pleas in law. On the infringement of Article 8 (1) (b) CTMR, the GC endorsed the BoA’s finding that the average consumer shows a heightened level of attention when choosing pharmaceutical products (Paras. 20-24). The GC reversed the BoA’s finding with regard to the comparison of the signs and, given the identical or similar nature of the products, it found likelihood of confusion between the marks (Para. 60). In particular, the GC held that the signs have an average degree of visual (Paras. 33-40) and phonetic similarity (Paras. 41-46) and also a certain degree of conceptual similarity (Paras. 47-51). The GC held that the BoA erred in not considering the relevance of the element “BIO” (Para. 34). Even though it is descriptive in respect of the goods covered by the marks at issue, it can still attract the public’s attention due to its position at the beginning of the signs. Moreover, the GC pointed out that the



common element is constituted by “BIOCE” which is longer than “BIO” and, thus, more likely to catch the public’s attention (Paras. 36-38). On the infringement of Article 76 (1) CTMR, the GC deemed it not necessary to appraise that plea in law considering that the other plea must be upheld and the contested decision must be annulled (Para. 61). **LOC**

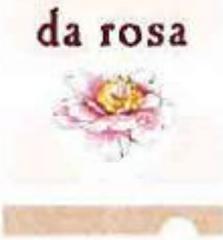
**T-12/13 ARTI / ARTITUDE**, Judgment of 11 December 2014, *Sherwin-Williams Sweden AB v. OHIM*; – en.

CTMA	Earlier marks: Benelux and IR (ES, FR)
	

The applicant sought to register the figurative mark reproduced above for goods in Class 2. An opposition based on the Benelux and International registration (with effect in ES and FR) of the word mark ARTITUDE, which cover goods in Class 2 was filed. As regards Article 8 (1) (b) CTMR, the Opposition Division (OD) upheld the opposition on the ground that there was likelihood of confusion (LOC) in the Benelux. The Board of Appeal (BoA) dismissed the appeal and found also LOC in France. Before the General Court (GC), the applicant alleges an infringement of Article 8 (1) (b) CTMR. The GC notes that the level of attention of the relevant public is a legal parameter that has to be examined by the BoA even if the applicant does not raise it. Therefore, the applicant can raise it before the GC and is not required to adduce evidence in that regard, as the fact that the average consumer does not regularly buy goods such as paints, varnishes, lacquers etc. is a matter of common knowledge (Para. 37). The GC refers to the Case-Law according to which the fact that a type of product is not purchased regularly by the average consumer suggests that that consumer’s level of attention will be fairly high. The BoA incorrectly found that the relevant public had an average level of attention. The goods are in part identical and in part highly similar. Not disputed by the applicant. Since the BoA held that the figurative elements of the CTMA are as important as the word element, the argument according to which nothing prevents the representation of the earlier word marks from being of the same colour and in the same typeface as the CTMA cannot be applied. Such premise is only relevant where the word element of the figurative mark is considered the dominant element and the figurative elements are secondary (Para. 61). There is a weak visual similarity, an average aural similarity and a weak conceptual similarity between the signs and thus there is a likelihood of confusion. **LOC**



T-405/13; **DA ROSA / AROSA**, Judgment of 12 December 2014, *Le Comptoir d'Épicerie, A-Rosa Akademie GmbH v. OHIM* – fr.

CTMA	Earlier marks
	  AROSA

The applicant sought to register the figurative sign represented above as a CTM for Classes 29, 30 and 43. An opposition based on CTM and national registrations for goods in Classes (i.e.) 30 and 43 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division partially upheld the opposition on the ground that there was likelihood of confusion. The Board of Appeal (BoA) confirmed the opposition decision. It concluded that there was a likelihood of confusion between the sign applied for and the earlier marks with respect to the identical or similar goods and services. On the argument about the coexistence of trademarks, the General Court (GC) held that the arguments of the applicant did not fulfil the criteria of Article 44, Rules of Procedure (ROP) of the General court (GC), and they were therefore declared inadmissible and un-founded. On the proof of use issue, the GC considered that the request of proof of use as filed for the first time before the BoA was belated and therefore could not be considered admissible. (Para. 54) On the obligation to motivate, the GC held that the argument of the applicant that the BoA could not base its decision on judgments not published was not founded. Judgments are indeed published some minutes after they are pronounced in the web site of the European Court of Justice (CJ). Moreover the BoA's decision was well motivated and complied with the obligation provided in Article 75 CTMR. On the violation of Article 6 of the European Human Rights Convention (right to a fair trial), the GC confirmed that this provision is not applicable to the procedures before the BoA of the Office. On the relevant public and the level of attention, the assessment of the BoA was confirmed. The relevant public is the average consumer as the goods in question are daily consumption products. In regard to the comparison of goods in Classes 29 with services of Class 43, the GC held that the BoA did not make an error of assessment in finding that the goods in Class 29 are complementary with the services of Class 43 (Para. 96) in spite of their different nature, their different destination and their different utilisation. On the comparison between milk and milk products of Class 29 and cacao of Class 30, the BoA correctly concluded that there was a certain degree of similarity (Para. 99). On the comparison between jellies, jams and compotes of Class 29 and honey of the earlier CTM, the GC confirmed the BoA's approach that although these goods are different they can be used for the same purpose in pastry so there is a possible competition and interexchange between both and therefore a certain similarity (Paras. 100 and 102). On the comparison between vinegar in Class 29 and wine in Class 33, the GC confirmed the BoA's assessment that there is a low degree of



similarity between these goods although one derives from the other and both can be used in cooking (Para. 105). On the comparison between treacle and honey in Class 30, the BoA's conclusion that both products have some degree of similarity was confirmed (Para. 107). On the visual comparison of signs, only the verbal earlier CTM **AROSA** was considered. Both signs share five letters in an identical order the last four being the word ROSA so this will attract the attention of the public. The signs are therefore partially identical (Para. 118). The rose in the contested CTM will be perceived as a decoration. In relation with the aural comparison, the assessment of the BoA that the signs share some phonetic similarity was confirmed (Para. 126). In relation to the conceptual comparison, the GC held that the BoA did not err in finding, in the contested decision, that the signs share a partial degree of conceptual similarity both signs having a connexion with the female name ROSA or the flower rose (Para. 128). Finally, in the global assessment of the likelihood of confusion done, the BoA was right to find that there is a likelihood of confusion between the marks at issue (Para. 134). **LOC**

**T-519/13; VALDASAAR / Val d'Azur**, Judgment of 9 December 2014, Leder & Schuh International AG v. OHIM – de. The applicant sought to register the word mark VALDASAAR as a CTM for goods and services in Classes 18, 25 and 35. The opponent lodged an opposition against the application on the basis of its earlier Community trade mark Val d'Azur for goods in Class 25. The Opposition Division (OD) granted the opposition partially in relation to the contested goods and services in Classes 25 and 35. The appeal filed by the applicant was partially successful: The Board of Appeal annulled the decision of the OD and refused the opposition in relation to the services in Class 35. On the other hand, the appeal was dismissed and a likelihood of confusion was confirmed as regards the goods in Class 25 of the mark applied for. The applicant filed an application before the General Court (GC) as far as the opposition was granted against the contested goods in Class 25. In its application before the GC, the applicant limited itself to claiming that the contested decision 'infringed the Community Trade Mark Regulation'. However, contrary to the argument brought forward by Office, the application is still admissible: It follows from the context of the application that the applicant relied on an infringement of Article 8(1) (b) CTMR. Besides, it is clear when reading the Office's response that it was in a position to understand the claims made by the applicant. Consequently, the application was admissible (Para. 14-18). As to the substance, the GC confirmed the existence of a likelihood of confusion between the conflicting marks. The goods in Class 25 are directed to the general public. The degree of attention is average (Para. 28). The goods covered by the marks are identical (Para. 29). Visually, the signs have a similar length and share the first five letters. The fact that the earlier mark consists of small and capital letters whereas the contested sign is made up exclusively of capital letters is irrelevant as both marks are word marks. The conflicting signs are visually similar to a certain degree (Para. 31). From a phonetic point of view, the beginnings of the marks are pronounced identically. The consumers normally pay particular attention to the first element of a trade mark when being confronted with it (Para. 36). Consequently, the signs are phonetically similar to a medium degree (Para. 37). A conceptual comparison is not possible as the contested sign will be perceived as a phantasy term without any meaning (Para. 40). The earlier mark enjoys a normal degree of inherent distinctiveness for the goods in Class 25 (Para. 45). In view of the visual and phonetic similarity between the signs and the identity of the goods at issue, there is a likelihood of confusion between the marks within the meaning of Article 8 (1) (b) CTMR (Para. 50). **LOC**



**T-105/13; TrinkFix / DrinkFit**, Judgment of 12 December 2014, *Ludwig Schokolade GmbH & Co. KG v. OHIM - de*. The applicant sought to register the word mark TrinkFix as a CTM for goods in Classes 29, 30 and 32. The opponent lodged an opposition against the application on the basis of its earlier German and Community trade mark Drinkfit (word) for goods in Classes 29 and 32. Upon request by the applicant, the opponent submitted evidence of use relating to both earlier rights. The Opposition Division (OD) granted the opposition partially in relation to some of the contested goods in Classes 29, 30 and 32. The appeal filed by the applicant was refused. The applicant claimed an infringement of a) Article 42 (2) (3) CTMR in connection with Article 15 CTMR and b) Article 8 (1) (b) CTMR. As regards the first claim (proof of use), the GC confirmed that the evidence submitted by the opponent was sufficient to show genuine use of the earlier marks for milk, milk beverages and yogurt beverages in Class 29 ('the earlier goods'). It is irrelevant that the sign 'Drinkfit' was not depicted on the products themselves according to some of the submitted evidence. The function of a trade mark does not require the trade mark to be physically placed on the goods (Para. 28-38). Moreover, the use of the trade mark as a label does not alter the distinctiveness character of the registered form and therefore constitutes valid use of the registered word mark 'Drinkfit' (Para. 43-53). Overall, the catalogues and product packaging, the invoices and the affidavit are sufficient to prove use of the earlier marks (Para. 54). Concerning the second claim, the GC confirmed the existence of a likelihood of confusion between the conflicting marks. The goods are directed to the general public and to specialists. The degree of attention of the general public is average (Para. 60). The contested goods powders and powder mixes for making mixed milk beverages and milk powder in Class 29 are highly similar to the earlier goods (Para. 67). There is also an average degree of similarity between the earlier goods and coffee whitener in Class 29 (Para. 67). Moreover, there is a certain degree of similarity between the earlier goods and cocoa, cocoa drinks and cocoa powder, chocolates, drinking chocolate, coffee and artificial coffee, tea, fruit teas, iced tea and non-medicinal herbal teas, beverage powders containing chocolate, coffee and tea based beverages, cappuccino beverages and beverage powders in Class 30 of the contested mark (Para. 75). Finally, the earlier goods and the contested non-alcoholic beverages and powders making those beverages are also similar to a certain degree (Para. 92). The signs are visually similar (Para. 105-109). Phonetically, the signs are similar to a high degree (Para. 112-114). Moreover, the signs are conceptually similar from the perspective of the German-speaking consumers. For other consumers, the signs are conceptually not similar or a conceptual comparison cannot be made (Para. 138). In view of the visual and, more importantly, strong phonetic similarity (Para. 141-142) between the signs and the similarity of the goods at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1)(b) CTMR despite the fact that the inherent distinctiveness of the earlier marks is rather low for a part of the relevant public (Para. 144-145). **LOC**



T-374/12 and T-375/12; **KASTEEL / CASTEL BEER**, Judgment of 25 November 2014, *Brouwerij Van Honsebrouck v OHIM* – fr.

International Application	Earlier Mark
	<p>CASTEL BEER</p>

The applicant obtained the international registration with the designation of European Community for the word mark KASTEEL (T-375/12) and figurative mark (T-374/12) represented above, registered for the goods and services within Class 32, namely beers, ales. An opposition based on the earlier French word mark CASTEL BEER, registered for goods in Class 32, beers, was filed on the grounds of Article 8 (1) b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal finding that (i) the opponent proved the genuine use of the earlier mark, (ii) the goods are identical and (iii) the marks are visually similar in the way that the more distinctive part of the earlier mark "CASTEL" coincides with the sole word element of the application. Further, the figurative element of the application has only a decorative function. The marks are not conceptually similar, except for a part of relevant public that will perceive the meaning of both terms "KASTEEL" and "CASTEL" as "castle". The applicant filed an action before the General Court (GC). The applicant claims the violation of Article 76 (1) CTMR in so far that the BoA examined a claim related to the coexistence of the marks in France, although the applicant revoked this claim preserving his right to invoke it later (Para. 26 and 28). The BoA dealt with applicant's claim on coexistence only for the clarity purposes and the examination of this claim was just superabundant (Para. 29). The first claim of the applicant cannot cause annulment of the contested decision and therefore was dismissed by the GC (Para. 31). The applicant claims that the BoA did not assess correctly the existence of the risk of likelihood of confusion. The applicant alleges that since the beers marketed under the earlier mark are of Cameroon origin, they are aimed at a specific public (Para. 71). The trademark rights cover each category of goods or services for which the trademark is protected or registration is sought. The commercial choices made, or that may be made, by the trademark holders are factors that have to be distinguished from the rights derived from the marks and, insofar as they depend on the will of the holders of those marks, are likely to change. Therefore, unless the list of the goods covered by the marks in conflict has changed, such factors may not have any impact on the relevant public to be taken into account within the assessment of the existence of likelihood of confusion (Para. 72). In respect of the comparison of goods, objective circumstances of commercialisation of the goods covered by the marks should be taken into account when assessing the likelihood of confusion, not particular circumstances which may vary over time and according to the will of the marks holders, such as their commercial intentions (Para. 80). In respect of the comparison of signs, the elements of resemblance between the earlier mark and the mark applied for, i.e. six common letters placed in the same order, outweigh the dissimilarities between the marks, i.e. the first letters of the word elements "Kasteel" and "Castel", the figurative element of the mark applied for and the repetition of letter "e" in the mark applied for. The figurative element of the mark applied for is only of a decorative nature and the word element "beer" contained in the earlier mark is descriptive for the goods in question. According to an overall visual assessment, the signs have a certain degree of similarity (Para. 95-98). The marks are also phonetically similar (Para. 103). From the conceptual



point of view, the meaning of terms "castel" and "kasteel" of the signs will not be easily understood by a significant part of the relevant public because of the infrequent use of the term "castel" in French (Para. 106). Therefore, the marks will not be conceptually similar for French consumers, except for those who are capable to perceive the words "castel" and "kasteel" as evoking both the concept of "castle" (Para. 109). Based on the aforementioned, the risk of confusion of the marks in conflict was found (Para. 114). Contrary to the applicant's conclusions, where the products are likewise to be ordered orally, certain importance must be ascribed to the phonetic aspect of the comparison of the signs (Para. 115). The action was dismissed. **LOC**

**T-221/12; SUN FRESH / SUNNY FRESH et al**, Judgment of 23 January 2014, *The Sunrider Corporation v OHIM* – en. The trade mark for which registration was sought is the word sign 'SUN FRESH' in respect of 'beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages' in Class 32. An opposition was lodged under Article 8(1)(b) CTMR on the basis of several 'SUNNY FRESH' figurative trade marks, in particular an earlier CTM covering 'herbal nutritional supplements' in Class 5 and earlier UK, Irish and Benelux trademarks covering 'herbal beverages; herbal teas; preparations, powders and essences for making beverages; non-alcoholic beverages; syrups for beverages' in Class 32. The applicant requested proof of genuine use and the opponent filed evidence in reply. The Opposition Division upheld the opposition for all the contested goods and rejected the application for registration in its entirety. On appeal, the Board of Appeal annulled the decision of the Opposition Division and rejected the opposition. The Board found that the earlier mark 'SUNNY FRESH' had been used in several Member States but only for a dietary supplement based on a herbal concentrate falling within Class 5, so that only the earlier CTM could be taken into account for the purpose of the opposition. On the substance, the Board considered that 'nutritional dietary supplements' in Class 5 and the contested beverages in Class 32 are dissimilar and therefore excluded a likelihood of confusion. The GC confirmed the decision of the Board. It found that the category of goods 'herbal nutritional supplements' in Class 5 had to be distinguished from the categories of goods 'herbal beverages; herbal teas; preparations and essences for making beverages; syrups for beverages' in Class 32, taking into account the main purpose of these goods, their liquid and edible nature not being the distinguishing criterion (Paras. 30-31). The GC - in reply to the opponent's argument that its 'SUNNY FRESH' nutritional supplement was not a product for medical use and that the Board should have examined whether it could also be classified as a beverage in Class 32 - underlined that the title of Class 5 and the list of goods which it includes (such as 'food for babies' and 'herbal teas for medicinal purposes' in the English version) make it apparent that the medical or veterinary use which it refers to must be understood broadly, meaning that what is decisive is the fact that the opponent's nutritional supplement is primarily meant to prevent or remedy medical problems in the broad sense of the term or to balance nutritional deficiencies (Para. 35). In view of the fact that the opponent's products are presented and marketed with warnings about the recommended dosage and potential hazards of the product for young children, the GC confirmed the Board's finding that the main purpose of the goods was not to quench thirst or to ensure standard human nutrition, as had been argued by the opponent (Para. 47). Furthermore, given the nature of the goods at issue, the relevant public is reasonably well informed and reasonably observant and circumspect as regards the contested beverages in Class 32, whereas regarding nutritional supplements for medical use in the broad sense of the term included in Class 5, the relevant public displays a relatively high level of



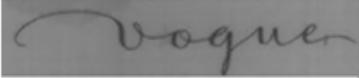
attention, insofar as those goods affect their health (Para. 64). Thus, 'herbal nutritional supplements' in Class 5 cannot be regarded as similar to 'beverages' or to 'preparations for making beverages' in Class 32, even though some of these nutritional supplements are sold as liquids or liquid concentrates that can be mixed with water. The Court dismissed the argument of the opponent that these goods are in competition, holding that the average consumer does not consume nutritional supplements as ordinary food or to quench its thirst (Paras. 71-72). The GC also confirmed the Board's finding that the goods in question are usually sold in different outlets (or in different aisles of large supermarkets and the like) and that it was clear that the Board had relied, in order to come to that conclusion, on the well-known fact that nutritional supplements are generally offered for sale in pharmacies, drugstores or specialised departments (Para. 77). The GC further dismissed the opponent's argument that the goods are complementary, holding that 'herbal nutritional supplements' in Class 5 are not indispensable or important for the use of 'beverages' or 'preparations for making beverages' in Class 32. It specified that any combined consumption of those products is merely ancillary (Para. 84). The GC held that the opponent's reference to a previous judgment where similarity had been found between 'strengthening and refreshing health care products, namely vitamin preparations, mineral preparations, tonics' in Class 5 on the one hand and 'beverages' and 'preparations for making beverages' in Class 32 on the other was not conclusive, since there is no equivalence between the above goods and the 'herbal nutritional supplement' involved in this case (Para. 87). Finally, in reply to the opponent's argument that there are some manufacturers who produce both nutritional supplements and beverages, the GC found that a likelihood of confusion can exist only if a large part of the producers or distributors of the products in question are the same, and that it is only in such a case that the relevant public will perceive the goods or services as having a common commercial source. The mere fact that some manufacturers (including the opponent) produce both categories of goods is not sufficient to demonstrate that a large part of the manufacturers or distributors of the goods at issue are the same, which should be taken into account when assessing the likelihood of confusion (Paras. 90-91). Thus, having regard to the different purposes of the goods at issue, the differences in their marketing and lack of substitutability or complementarity, the GC considered that a partial identity of the manufacturers of the contested goods is not sufficient to create a likelihood of confusion between those goods (Para. 92). **LOC**

**T-292/12; MAGNEXT / MAGNET 4**, Judgment of 28 January 2014, *Mega Brands International & Diset, SA v OHIM* – en. The applicant sought to register the word mark "MAGNEXT" as a CTM for Class 28. An opposition based on the earlier Spanish word mark "MAGNET 4", registered for goods in Class 28, was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 28 of the CTMA. The Opposition Division upheld the opposition. The Board of Appeal confirmed the decision of the OD and rejected the applicant's appeal in its entirety. The GC took note of the fact that the applicant does not challenge the findings of the Board of Appeal concerning the definition of the relevant public, composed of average Spanish-speaking consumers who are reasonably observant and circumspect, and the partial identity of the products covered by the marks at issue (Para. 19). On the comparison of signs, the GC held that that the CTMA differs from the dominant element 'magnet' of the earlier mark only by the capital letter 'X', it must be held that it has an average degree of visual and phonetic similarity to the earlier mark (Para. 25). As regards the conceptual point of view, the assessment set out in paragraph 19 of the contested decisions must be confirmed, that the existence in the Spanish



language of the adjective 'magnético', commonly used by the relevant public to designate an article with magnetic properties, has the consequence that that public will associate the earlier mark with objects having such properties. In that context, the Board of Appeal rightly concluded that there was no conceptual similarity between the CTMA and the earlier mark, since the word 'magnext', which does not exist in Spanish and is not otherwise connected to any current concept, will be perceived as being fanciful. Furthermore, the mark MAGNET 4 does not contain any element that may be associated with the English word 'next' (Para. 27). It follows that, conceptually, the conflicting marks are different (Para. 28). On the assessment that the earlier mark has an average distinctive character, the GC held (Paras. 32 and 33) that, as the Board of Appeal stated in paragraph 19 of the contested decision, the relevant public will associate the earlier mark with objects with magnetic properties. The GC referred to documents produced by the applicant before the Opposition Division and before the Board of Appeal. That evidence consists, in particular, of results of internet searches showing that the promotion of the magnetic properties of games and toys is a common practice among operators active in the sector, including the owner of the earlier mark, while the Commission adopted Decision 2008/329/EC of 21 April 2008 requesting Member States to ensure that magnetic toys placed or made available on the market display a warning about the health and safety risks they pose (OJ 2008 L 114, p. 90). According to recital 7 in the preamble thereto, magnets had already been used in toys for a long time. The GC concludes that in those circumstances, it must be held that the earlier mark MAGNET 4 sends a message that may be connected, in the mind of the relevant public, to the characteristics of the products for which they have been registered and which are identical to those covered by the CTMA, so that contrary to the finding made by the Board of Appeal, its distinctive character is not medium, but weak. Concluding on the overall assessment of the likelihood of confusion the General Court confirmed however the assessment of the Board and held that taking account of the average degree of similarity between the CTMA and the earlier mark, the fact that the products covered by the marks are partly identical and in spite of the weak distinctive character of the earlier mark there is likelihood of confusion between them within the meaning of Article 8(1) (b) (Para. 35). **LOC**

**T-509/12; TEEN VOGUE / VOGUE**, Judgment of 27 February 2014, *Advance Magazine Publishers & Nanso Group Oy v OHIM* - en.

CTMA	Earlier Swedish and Finnish marks
<p><b>TEEN VOGUE.</b></p>	<p><b>VOGUE</b></p>  <p><b>VO Gue.</b></p>



The applicant sought to register the verbal signs represented above as a CTM for Class 25 (Clothing; footwear; headgear; parts and fittings for all the aforesaid goods). An opposition based on several Swedish and Finish earlier marks, registered for goods in Class 25 was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 25 of the CTM. It was requested that the opponent furnished proof of use for the two Swedish earlier marks. The Opposition Division upheld the opposition refusing registration of the mark applied for in relation to all the goods concerned. The Board of Appeal confirmed the decision of the OD and rejected the applicant's appeal in its entirety. It found that the Opposition Division had correctly upheld the opposition since a likelihood of confusion could not be excluded due to the identity or similarity of the goods covered by the mark applied for, namely, *clothing, footwear and headgear*, and of those protected by the earlier Swedish word mark VOGUE - the use of which it considered had been sufficiently proved but only for hosiery - and the average similarity of the signs at issue. The GC took note of the fact that the applicant does not challenge the findings of the Board of Appeal concerning the definition of the relevant public, composed of the general public in Sweden (Para. 25). On the comparison of signs, the General Court held that the Board of Appeal was correct to conclude that the signs are visually similar to an average degree, due to the presence of the element 'vogue', common to those signs. Contrary to what was claimed by the applicant, the General Court found that the presence of the element 'teen' in the mark applied for undoubtedly contributes to differentiating the two marks at issue phonetically, nevertheless, it cannot be accepted that the element 'teen', in view of its shortness, outweighs, in that respect, the element 'vogue', common to both signs. Therefore, a certain phonetic similarity can be found between the two signs taken as a whole (Para. 43). In relation to the conceptual comparison, the General Court held that it was for the Board of Appeal to ascertain whether the general public in Sweden, many of whom speak English, was able to discern the meaning of those two elements, which it did not do. The arguments provided by the Office in its response cannot compensate for the Board of Appeal's lack of analysis concerning the Swedish general public's knowledge of the English language. For the General Court it is necessary to verify whether that incomplete examination by the Board of Appeal, which does not amount to a failure to provide reasons because it clearly stated the grounds on which it found that it was not possible to compare the signs conceptually, but to a partially erroneous assessment of the relevant public's abilities, affects the legality of the contested decision (Para. 44). For the part of that general public which has a command of the English language, the word 'vogue' would be understood as a word relating to fashion, the word 'teen' clearly indicating adolescents the expression 'teen vogue' would be perceived as a mere variation of 'vogue', since the concept of 'what is fashionable for adolescents' naturally comes from 'what is fashionable'. That clear conceptual similarity could therefore only bear out the Board of Appeal's conclusion in relation to, first, the similarity of the signs at issue and, next, the likelihood of confusion. As a result, that error regarding the knowledge of the relevant public does not affect the legality of the contested decision, it being borne in mind that, for the relevant non-English-speaking public, the Board of Appeal's conclusion regarding the lack of influence of the conceptual comparison on the assessment of the similarity of the signs remains true (Para. 45). On the comparison of products, the General Court held that notwithstanding the fact that "hosiery, footwear and items of headgear" are comprised of different textiles and materials and that they are sometimes sold in different retail outlets, the Board of Appeal was correct to find that they are similar within the meaning of Article 8(1)(b) CTMR (Para. 34). In relation to "hosiery and clothing", the General Court held (para. 26) that hosiery, consisted of clothing and was therefore identical to 'clothing' covered by the mark applied for. Finally, in the global assessment of the likelihood of



confusion, the General Court concluded that in the light of the visual and phonetic similarities of the signs at issue and having regard to the fact that the goods designated by the earlier Swedish word mark VOGUE, on the one hand, and the mark applied for, on the other, are in part identical and in part similar, the Board of Appeal did not make an error of assessment in finding that there was a likelihood of confusion between those marks and, thus, it did not err in confirming the Opposition Division's decision refusing registration of the mark applied for as regards 'clothing; footwear; headgear; parts and fittings for all the aforesaid goods' in Class 25 (Para. 49). **LOC**

**T-229/12; VOGUE / VOGUE**, Judgment of 27 February 2014, *Advance Magazine Publishers & Eduardo Lopez Cabré v OHIM* – en.

CTMA	Earlier CTM and Spanish Mark
	

The applicant sought to register the figurative sign represented above as a CTM for Class 18. An opposition based on a CTM and the earlier Spanish marks below, registered for goods in Class 18, was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 18 of the CTM. The Opposition Division upheld the opposition in part, refusing registration of the mark applied for in relation to the goods 'umbrellas, parasols, accessories' in Class 18, on the ground that there was, in relation to those goods, a likelihood of confusion with the earlier CTM VOGUE. It rejected the opposition for the remaining goods. The Board of Appeal confirmed the decision of the OD and rejected the opponent's appeal in its entirety. The GC took note of the fact that the opponent does not challenge the findings of the Board of Appeal concerning the definition of the relevant public, composed of the average consumer of the goods at issue in the European Union. The average consumer must be deemed to be reasonably well informed and reasonably observant and circumspect (Para. 27). On the comparison of signs, the General Court held that, notwithstanding the specific presentation of the word in the mark applied for, the signs at issue are visually highly similar (Para. 45) and that the Board of Appeal was correct to conclude that the signs are phonetically identical (Para. 46). On the comparison of products, the finding of the Board was correct when it held that umbrellas, in Class 18, protected by the earlier Community word mark VOGUE, and the umbrellas, parasols and accessories covered by the mark applied for are 'identical or similar'. There is no doubt that the goods at issue are identical as regards umbrellas (Para. 28). In relation to umbrellas protected by the earlier CTM and the parasols, the General Court held, contrary to the Board, that although umbrellas and parasols function according to the same type of mechanism, their end-users are not the same and the distribution channels frequently differ. The Board of Appeal was, entitled to find that umbrellas and parasols are similar but should have emphasised the low degree of that similarity, which it did not (Para. 32). **LOC**



**T-25/13; 4711 Aqua Mirabilis / AQUA ADMIRABILIS**, Judgment of 27 February 2014, *Mäurer & Wirtz GmbH & Co. KG v OHIM – de*. The applicant sought to register the word mark “4711 Aqua Mirabilis” as a CTM for goods in Class 3. The opponent lodged an opposition against the application on the basis of its registered CTM “AQUA ADMIRABILIS” (word) for goods in Class 3. The Opposition Division upheld the opposition partly in respect of the goods “soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices” covered by the CTMA on the basis of Article 8(1) (b) CTMR. The appeal filed by the applicant was dismissed. The General Court (GC) confirmed the reasoning of the Board of Appeal as to the existence of a likelihood of confusion between the marks in at least a part of the EU. The goods in Class 3 are directed to the general public. The degree of attention is normal. The goods covered by the marks are identical or similar (Para. 17). The conflicting signs are visually and phonetically similar due to the highly similar word elements “AQUA MIRABILIS” and “AQUA ADMIRABILIS”. The additional element “4711” is not sufficient to render the signs overall different despite its position at the beginning of the contested CTMA (Para. 27). Conceptually, the signs are similar for those consumers who understand the meaning of the Latin terms “aqua” and “admirabilis”/“mirabilis”. On the other hand, the conceptual comparison is neutral for those customers in the EU who do not understand the words (Para. 31). The argument of the applicant that the earlier mark enjoyed only a low degree of inherent distinctiveness does not necessarily exclude a risk of confusion between the marks. The distinctiveness of the earlier mark is only one of various factors to be considered when assessing a likelihood of confusion. Even in cases where the distinctiveness of the earlier mark is low, a likelihood of confusion may exist due to the similarity between the marks and the goods or services (Para. 38). In view of the visual and phonetic similarity between the signs and the identity or similarity of the goods at issue, there is a likelihood of confusion between the marks within the meaning of Article 8(1) (b) CTMR (Para. 39). **LOC**

**T-602/11; QUINTA S. JOSÉ DE PERAMANCA / PÈRA MANCA et al**, Judgment of 27 February 2014; *Pêra-Grave S.A.U. v. OHIM - en*.

CTMA	Earlier marks: PT
	

The applicant sought to register the figurative mark reproduced above for alcoholic beverages (except beers) in Class 33. The opponent opposed the registration on the basis of the three Portuguese figurative marks reproduced below, which cover wines or alcoholic beverages (except beers) in Class 33. Grounds: Article 8(1) (b) and 8(5) CTMR. OD dismissed the opposition and found that reputation of the earlier marks had not been substantiated, as the evidence had been submitted late. On appeal, the Board upheld the opposition pursuant to Article 8(1) (b) and rejected the CTM application for all the goods covered. Before the General Court, the applicant alleges an infringement of Article 8(1) (b) CTMR. The Court examined LoC with the third earlier



mark, which *prima facie* has the greatest similarity with the CTM applied for. The relevant public is the average Portuguese consumer of the relevant goods in Class 33. The goods are identical. The GC confirmed a low degree of phonetic similarity and some conceptual overlap, as well as a very low degree of visual similarity. Notwithstanding the differences due to the figurative elements and other word elements, PÊRA-MANCA or PERAMANCA is the most distinctive element in the overall impression of the signs. Besides, the figurative elements and the mention 'Qta' allude to the goods covered and have a weak distinctive character (Paras. 36-37). It is not inconceivable that certain elements (i.e. PERAMANCA) of a meaningful sequence of words ('Qta S. José de Peramanca') will attract more attention than the others (Para. 47). The allegedly enhanced distinctive character of the term QUINTA was not submitted to the BoA; therefore it is inadmissible before the GC. The GC points out an inconsistency in the applicant's arguments. It submitted that PERAMANCA refers to a Portuguese region well-known for the quality of the wine produced there, but it also stated that such word is devoid of any meaning, contrary to Article 21 Statute of CJ and 44(1) Rules of Procedure (Para. 52). Consumers usually describe and recognise wine and alcoholic beverages by reference to the word element which identifies them. These goods are also sold in cafés, bars and restaurants, where the consumer's choice is made through a menu, on which only the word element of the marks is reproduced. LoC is thus increased because the differences deriving from the presence of figurative elements cannot help the consumer to distinguish between those marks (Para. 58). In view of the identity of the goods, the very low degree of visual similarity and low degree of phonetic similarity, Loc cannot be ruled out. **LOC**

[T-226/12; LIDL / LIDL MUSIC](#), Judgment of 27<sup>th</sup> February 2014, *Lidl Stiftung & Co. KG v OHIM*, - en.

CTMA	Earlier Cz marks and the way it is used
	 

The applicant sought to register the figurative mark represented above as CTM for “musical instruments” in Class 15 (among other goods). An opposition was filed on the grounds of Article 8(1) (b) CTMR. It was based on the earlier Czech figurative mark registered for “musical instruments” in Class 15. The Opposition Division upheld the opposition for all the contested goods. The OD deemed that genuine use was proven for “flutes” and “harmonicas” in Class 15 and that there was a likelihood of confusion between the marks at issue. The Board of Appeal confirmed the decision of. In particular, the Board considered that, even if the earlier mark was used in a different form than as it was registered, the distinctive character was not altered according to Article 15(1) (a) CTMR. The applicant filed an action before the General Court arguing, in particular, an infringement of Articles 42(2)(3) in combination with 15(1)(a) and 8(1) (b)



CTMR. The General Court dismissed the appeal. In relation to Articles 42(2)(3) CTMR, the GC argued that the invoices and photographs, considered together, showed genuine use of the earlier mark for musical instruments. Since these goods are not everyday consumer goods, there is no need to show evidence of large-scale commercial use. In relation to Article 15(1)(a) CTMR, the GC upheld OHIM's argument that the figurative elements of the earlier mark, as registered, are limited to the stylistic presentation of the two word elements. Those decorative elements do not play any significant role in the overall impression of the sign and have no inherent semantic content of their own which would lend the mark distinctive character or designate the goods concerned. Therefore, the GC concluded that the form in which the mark was used did not alter the distinctive character of the registered mark (Paras. 52, 53). The GC further added that this conclusion is not undermined by the fact that, in two decisions between the same parties, the OD held that genuine use had not been established by the opponent regarding musical instruments. The GC noted that the lawfulness of the decisions of the Board must be assessed solely on the basis of the regulation, as interpreted by the European Union judicature and not on the basis of a previous decision-making practice. OHIM must however take into account the decisions already taken in respect of similar cases and consider with especial care whether it should decide in the same way or not. The way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. To this respect, the GC argued that, since the evidence provided by the opponent was not the same as in the present case, the principle of equal treatment was not infringed (Paras. 54-57). In relation to Article 8(1)(b) CTMR, the GC confirmed that, under the case law, the attention of the relevant public at the time of purchasing musical instruments must be taken to be higher than usual (Para. 67). The GC further argued that, the elements 'music' in the earlier mark and 'express' in the contested one have only a weak distinctive character, since they simply designated the purpose or use of the goods on the one hand, and speed on the other. The common element "lidl" is highly distinctive since it bears no reference to the goods at hand and it is placed at the beginning of the signs. The figurative elements of the mark applied for and of the earlier mark will be perceived as decorative components. Therefore, the signs are visually similar. From an aural point of view, the marks are similar in so far as their distinctive element is the same. As regards the conceptual comparison, a comparison could not be made, since the word 'lidl' had no meaning for a Czech-speaking consumer. The meaning of the elements 'music' and 'express' is not of great relevance since consumers will not pay much attention to them (Paras. 74-81). Therefore, since the goods are identical and the marks are similar, the Board of Appeal was entitled to conclude that there was a likelihood of confusion. **LOC**

T-520/11, **GE / GE et al**, Judgment of 28 February 2014, *Genebre S.A. v. OHIM* – es.

CTMA	Earlier marks: UK, CTM
	

The applicant sought to register the figurative mark reproduced above for goods in Classes 6, 7, 9, 11 and 17. The opponent opposed the registration on the basis of the UK and CTM word and



figurative marks reproduced below, which cover inter alia goods in Classes 6, 7, 9, 11 and 17. The grounds were those laid down in Article 8(1) (b) and 8(5) CTMR. The Opposition Division dismissed the opposition. On appeal, the Board of Appeal (BoA) upheld the opposition on the basis of the UK word mark GE and rejected the CTM application for all the goods covered. Before the General Court, the applicant alleges an infringement of Article 8(1) (b) CTMR. The relevant public is the average UK consumer of goods in Classes 6, 7, 9, 11 and 17, whose level of attention varies between average and high. The goods are identical or similar. The GC dismissed the applicant's claim that the earlier mark will be perceived as a fancy figurative element rather than as a stylised representation of the letters GE. It also confirmed the BoA finding of an average degree of visual similarity between the signs. Taking into account that the products are identical and that the signs are aurally identical and visually similar to an average degree, there is a likelihood of confusion even for the public whose level of attention is higher. **LOC**

[T-599/11](#); **ENI / EMI**, Judgment of 21 May 2014; *SpA v OHIM* – en.

CTM applied for	Earlier CTM
ENI	

The relevant contested goods of the CTM application (for the word mark represented below) are 'Clothing, footwear, headgear' in Class 25. An opposition based, *inter alia*, on the figurative CTM above, registered for services 'The bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothing, footwear and headgear' in Class 35, was filed on the grounds of Articles 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition by refusing registration of the mark applied for in respect of the goods concerned in Class 25 on the ground that there was, in relation to those goods, a likelihood of confusion with the earlier CTM. The Board of Appeal (BoA) confirmed the decision of the OD and dismissed the appeal. It found that the OD had been right to uphold the opposition, owing to the existence of a likelihood of confusion as a result of the similarity of the goods covered by the mark applied for, namely the clothing, footwear and headgear, and the service protected by the earlier Community figurative mark, that is to say the retail service in respect of the goods at issue, and owing to the visual and phonetic similarity of the signs at issue. The GC rejected the first plea, alleging a failure to state reasons. The BoA fully complied with the obligation to state reasons, although concisely, as it based its analysis that the clothing, footwear and headgear, on the one hand, and the retail service in respect of those goods, on the other, were similar on the Case-Law resulting from the *O STORE* judgment, which concerned the same goods and services as in the present case (paragraphs 31-32). The GC rejected all the applicant's arguments relating to the existence of an error of assessment in the comparison of the goods and the services at issue. First, the BoA did not overlook the finding in *O STORE* according to which the goods and services in question differed by their nature, purpose and method of use (Para. 36). Second, contrary to the applicant's claim, the BoA did not refer to a 'strong similarity' instead of 'a certain degree of similarity' as in *O STORE* (Para. 37). Third, it is incorrect to claim that the BoA carried out an abstract analysis of the comparison of the goods and the service at issue (Para. 39). Fourth, it is incorrect to state that, in



O STORE, the GC based its analysis 'only' on the alleged complementarity between the goods and services in question and on the fact that they 'are generally sold in the same sales outlets': in fact, in that judgment the GC stated that the goods were identical to those to which the retail services related and that such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods, which also applies to the present case, irrespective of the fact that the applicant and the intervener carry out their respective core business activities in very distinct sectors - namely the marketing of energy and automotive products, on the one hand, and the publishing and offering for sale of audio-visual contents on the other - (Paras. 40-41). Fifth, the applicant errs in invoking an infringement of the Guidelines of the Office, which state, in essence, first, that the risk of confusion is unlikely between retail services and particular goods except in very particular circumstances, such as when the respective trademarks are identical or almost so and well established in the market and, secondly, that each case that arises will be dealt with on its own merits (Paras. 42-44). Sixth, the applicant's plea must also be rejected according to which the BoA's interpretation and application of *Praktiker Bau- und Heimwerkermärkte* failed to have regard for the wording of that judgment and, more broadly, could render irrelevant, in their entirety, the Nice Agreement and the legal framework governing the Community trade mark (Paras. 46-54). In those contexts, the GC recalled the role and value of the Guidelines of the Office (Para. 43) and of the President of the Office's Communications (Para. 53). Lastly, in view of the foregoing finding, the applicant cannot reasonably rely on the previous decisions of the Office (Para. 57). The GC confirmed the BoA's assessment with regard to the relevant public, which consists of the general public and of professionals, with the consequence that, the relevant public being heterogeneous, it is necessary to take into consideration the part of that public with the lowest level of attention, that is to say, in the present case, the general public (Para. 70). On the comparison of signs, the GC took note of the fact that the applicant ultimately concurs with the BoA assessment concerning the visual and phonetic similarity of the signs at issue, which is, in that regard, well founded (Para. 63). The applicant disputes, in actual fact, only the BoA assessment relating to the impossibility of making a conceptual comparison on account of the fact that the signs at issue had no meaning in any of the relevant languages. The applicant disputes the BoA assessment, taking the view that the mark applied for and the earlier mark have each developed their own identity in the market and that, as their 'personality' sufficiently differentiates one from the other, they will be perceived by consumers as containing conceptual differences, irrespective of the original meaning of the three-letter sequences 'e', 'n', 'i' and 'e', 'm', 'i'. The applicant refers, in that regard, to the concept of a well-known fact, which is distinct from that of a well-known mark. The CG rejected the applicant's argument by stating that it cannot reasonably be claimed that, for the general public of the European Union, the terms 'eni' and 'emi' are well known, as the painter Pablo Picasso or the comic strip character Obelix (Para. 71). As regards the global assessment of the likelihood of confusion, the GC first rejected as unsubstantiated (and partly contradictory) the applicant's argument alleging that the mark applied for and the earlier mark are well known on account of the applicant's entrepreneurial history, on the one hand, and that of the intervener, on the other, and that those marks are at the head of the sectors in which the applicant and the intervener carry out their main business activities (Para. 75). Finally, the GC stated that, in view of the visual and phonetic similarities between the signs at issue and having regard to the fact that the services covered by the earlier mark, on the one hand, and the goods covered by the mark applied for, on the other, are also similar, the Board of Appeal did not err in finding that there was a likelihood of confusion between them (Para. 77). **LOC**



T-382/12; **NOBEL / NOBEL**, Judgment of 19 June 2014, *Kampol sp. z o.o. v OHIM* – en.

CTMA	Earlier Mark
	<p style="text-align: center;"><b>NOBEL</b></p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 10 and 24. An opposition based on the earlier Portuguese word mark NOBEL, registered for ‘mattresses’ in Class 20, was filed on the grounds of 8(1)(a) and (b) CTMR. The Opposition Division upheld the opposition as far as it was based on 8(1) (b) CTMR. The Board of Appeal (BoA) dismissed the applicant’s appeal. The applicant filed an action before the General court (GC). The GC held that the proprietor of an earlier mark registered in a Member State may not rely on the seniority of that mark outside the territory in respect of which it is protected: claiming seniority of a national mark does not mean that the CTM application enjoys a better priority right. It thus rejected the allegation of the applicant that the opposing mark is not an “earlier mark” within the meaning of 8(2) (a) CTMR (Paras. 24-26). The BoA’s finding that the relevant public was the general public in Portugal was deemed to be correct, on the grounds that the earlier mark was a Portuguese mark (Para. 30), that bedding and mattresses in Classes 20 and 24 are purchased by everyone and that the contested goods in Class 10 are not exclusively purchased by people with health problems, but also by consumers who seek additional comfort when sitting or sleeping (Paras. 32-34). The GC found that cushions, blankets, quilts, bed covers and duvets are basic equipment which enables a mattress to be used as a bed, and that they are not available only in specialist sales outlets, even when they are destined for ‘medical purposes’ (Paras. 41 and 44-45). The GC rejected the ‘economic’ definition of complementarity suggested by the applicant, whilst stating that a restrictive interpretation of complementary was equally unacceptable (Paras. 50-53). It reminded, on the one hand, that the Office is allowed to rely on well-known facts not put forward by the parties (Para. 57) and, on the other hand, that the Office may only take account of the list of goods as it appears in the trade mark application. The applicant’s arguments as regards the luxurious character of its goods and their channels of distribution were rejected as irrelevant (Paras. 60-63). The GC finally confirmed that the contested goods are closely connected, complementary and similar to an average degree (Paras. 43, 48 and 64). The GC found that the BoA had erred in categorizing the degree of visual similarity as high: the figurative elements have an impact on the overall impression and render the marks visually similar to an average degree only (Paras. 72 and 76-78). It then confirmed that the signs are phonetically identical and that the conceptual comparison is neutral (Paras. 79 et seq.). As regards the global assessment, the GC pointed out that even a high level of attention would not eliminate the likelihood that the consumer will perceive the contested mark as a variant of the earlier mark, because the signs have the same single word element ‘nobel’ (Para. 105). The error committed by the BoA in the assessment of the degree of visual similarity cannot lead to the annulment of the contested decision, because likelihood of confusion may be established even on the basis of an average degree of visual similarity (Para. 110). **LOC**



**T-510/12; EUROSKY / SKY**, Judgment of 18 November 2014, *Conrad Electronic SE v OHIM – de*. The applicant sought to register the word mark EuroSky as a CTM for goods in class 9. The opponent lodged an opposition against the application on the basis of, inter alia, the earlier Community trade mark SKY (word) for goods in class 9. The Opposition Division held that a likelihood of confusion between the marks existed for identical goods and granted the opposition in its entirety. The appeal filed by the applicant was dismissed. The General Court confirmed the existence of likelihood of confusion between the conflicting marks. The goods in class 9 are directed to the general public and to specialists. The degree of attention varies from average to high (Para. 33). The goods covered by the marks are identical (Para. 35). The conflicting signs are visually and phonetically similar to a medium degree (Para. 40-42). It is true that the beginnings of the signs are different. However, this is outweighed by the fact that the first element of the mark applied for ‘Euro’ describes the origin of the goods. The consumers will therefore pay less attention to this element (Para. 40). Conceptually, the common element “Sky” is also weak: The public will associate the concept of ‘Sky’ with the place where the satellites necessary for the functioning of the goods at issue are placed. The term therefore describes a possible use of the goods, namely apparatus which function on the basis of satellite communication (Para. 46). Overall, the marks are also conceptually similar to an average degree (Para. 47). The earlier mark ‘SKY’ enjoys an enhanced distinctiveness due to its extensive use for class 9 goods on the British market as shown by the opponent. The set-top-boxes depicted in the documents also bear the trade mark of the producer. Thus the public will know that the opponent is not the producer of the goods. However, the consumers will still believe that the products marketed under the trademarks ‘Sky digibox’, ‘SKY+’ and ‘SKY’ derive from the opponent (Para 64-65). Moreover, although the relevant moment for proving the enhanced distinctiveness is the filing date of the contested mark (13 July 2005), documents relating to the period between 1998 and 2003 also serve to prove the enhanced distinctiveness of the ‘SKY’ mark (Para. 67-68). Overall, bearing in mind the identity of the goods, the average degree of similarity between the signs and the enhanced distinctiveness of the earlier mark ‘SKY’, the Board of Appeal was correct to conclude *that there existed a likelihood of confusion between the marks* (Para 71).

**T-473/11; MENOCHRON / MENODORON**, Judgment of 28 April 2014, *Longevity Health Products, Inc. v OHIM –de*. The applicant sought to register the word mark MENOCHRON as a CTM for goods within Classes 3 and 5. An opposition based on the earlier word mark MENODORON, registered for goods in Classes 3 and 5, was filed on the grounds of Article 8 (1) (b) and 8 (5) CTMR. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant’s appeal finding that based on the average distinctive character of the earlier mark, identity of the goods and high visual and average phonetic similarity of the signs the likelihood of confusion cannot be excluded even if the increased degree of attention of the relevant public is taken into account. The applicant filed an action before the General Court (GC). The GC rejects applicant’s argument on sufficient knowledge of the relevant public of Latin and Greek on one hand and in-depth knowledge in the medical field on the other hand allowing it to understand the individual elements of which the marks at issue consist (Para. 39). Therefore, the comparison of the signs at issue must be based on all of the syllables of the signs (Para. 40). From the visual point, the only difference is limited to the fifth and sixth letters of the marks at issue (Para. 41). In



regards of the phonetic comparison, the marks differ in the length and rhythm of pronunciation because they are composed of different number of syllables (Para. 42). The GC concludes that marks have an enhanced degree of visual similarity and average degree of phonetic similarity (Para. 44). The GC emphasises that the covered goods are identical. As a result of this identity the extent of differences between the marks at issue is reduced (Para. 46). Such an argument which essentially amounts to consider that the phonetic aspect of a brand is always decisive in assessing the likelihood of confusion has no basis in Case-Law. Certainly, as part of the overall assessment of likelihood of confusion the visual, phonetic or conceptual aspects of the signs are not always of the same weight and it is then to examine the objective conditions in which the marks may be presented on the market (Para. 48). **LOC**

**T-173/13; SELOGYN / SELESYN**, Judgment of 12. December 2014, *Selo Medical GmbH v OHIM - de*. The applicant sought to register the word mark represented below as a CTM for goods within Class 5. An opposition based on the earlier German word mark represented below, registered for goods in Class 5. The Board of Appeal (BoA) confirmed the decision of the Opposition Division that there was likelihood of confusion. The CTM applicant filed an action before the General Court (GC) claiming an infringement of article 8 (1) (b) CTMR. The GC dismissed the action. It rejected the argument that the perception of the professional public is of more relevance and recalled the Case-Law stating that the public of pharmaceutical preparation consists of both, professionals and patients (para. 24). The goods are similar or identical (para. 38). The signs coincide in the beginning and the end and are therefore visually similar (para. 46). They cannot be seen as short signs (para. 48). For the same reasons, they are also phonetically similar (para. 48). Conceptually none of the marks has a meaning (para. 53). A significant part of the public will not associate the letters “SELE” with “Selen”, as a substance contained in the goods concerned, because in German another words exist beginning with “SELE”, like “Selektion” (para. 57 and 58). For this part of the public the distinctiveness of the earlier mark is therefore average. For the remaining part of the public the earlier mark is still not purely descriptive (paras. 65 and 66). There is a likelihood of confusion. **LOC**

**T-239/12; ZIECON / CERCON**, Judgment of 1 July 2014, *Jyoti Ceramic Industries PVT. Ltd v OHIM – de*.

CTMA	Earlier Mark
	<p style="text-align: center;"><b>CERCON</b></p>

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



signs are identical or at least similar and there is visual and phonetic similarity of the signs. The applicant filed an action before the General Court. The relevant public in relation to which the likelihood of confusion must be analysed consists in respect of the goods in Classes 5 and 10 of specialists trained in dentistry and for the services in Class 40 of both, general final consumer and specialists trained in dentistry, and the attention of the relevant public is considered to be increased, since the goods and services covered are related to health (Para. 28 and 30). Nothing precludes finding of the existence of visual similarity between a verbal and a figurative mark, since both types have a graphical form capable of creating a visual impression (Para. 43). If the relevant public is not aware of the fact that ceramic products get their own characteristics due to their cooking at a high temperature, the representation of simple curved blue and orange shapes symbolising two flames can be considered rather banal and unimaginative, and is thus negligible in the overall impression of the mark. The graphical element of the CTMA may be perceived by the relevant public as a simple decorative element and not as an element indicating the commercial origin of the goods (Para. 45). Nothing rules out that the second syllable “con” which is identical in both signs will retain as much attention of the relevant public as the first syllables of the signs at issue (Para. 47). The principle that the consumer pays particular importance to the beginning of the mark applied for should not be assessed independently on the circumstances of this case, particularly on the specific characteristics of the signs at issue (Para. 48). Phonetically, the signs are composed of two syllables of the same length and are pronounced very similarly in English as well as in German (Para. 58 and 59). Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even where an earlier mark is of weak distinctive character, there may be a risk of confusion, particularly because of the similarity of the signs and goods or services covered (Para. 78). **LOC**

**T-173/11; CARRERA / CARRERA**, Judgment of 27 November 2014, *Kurt Hesse and Lutter & Partner GmbH v OHIM – de*. The applicant sought to register the word mark Carrera as a CTM for goods within Class 9. An opposition based on the earlier word marks CARRERA registered for goods in Class 12 was filed on the grounds of Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) upheld the opponent’s appeal finding that the signs are identical and there exists likelihood of confusion in respect of part of the goods applied for (mobile navigation apparatus, in particular satellite-based mobile navigation apparatus). In regards of the remaining goods the BoA found that the mark applied for would take unfair advantage of the distinctive character of the earlier marks. The applicant filed an action before the General Court (GC). Subsequently, the application was partially transferred. As to the plea on violation of Article 8 (1) (b) CTMR, the GC stated that the application does not exclude the mobile navigation devices that are intended to be used or that might be used in motor vehicles (Para. 44). When a consumer uses a mobile navigation device in a motor vehicle, in particular the device intended to be used in such vehicles it must be considered that a close relationship exists between them. In this case, motor vehicles are in fact essential for correct use of these mobile navigation devices, given in particular that the elements present on the screen of these devices or navigation instructions are obviously intended for the driver of a motor vehicle driving on public roads. In these circumstances, it cannot be denied that the mobile navigation devices are for the same public as vehicles and a functional complementarity between them exists, so consumers may think that the responsibility for production of all these goods lies with the same company (Para. 45). **LOC**



T-149/12; MICRO / MICRO, Judgment of 16 January 2014, *Investrónica, SA v OHIM* – en.

CTMA	Earlier Mark
	

The applicant sought to register the figurative mark represented above as a CTM for goods within Class 9. An opposition based on the earlier figurative mark represented below, registered for goods in Class 9, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) upheld the applicant's appeal finding that the identity of the goods was offset by the dissimilarity of the signs at issue. Although the word element 'micro' was common to the signs at issue, because of its descriptiveness it could not be perceived by the relevant public from a visual or conceptual point of view as the distinctive and dominant element of a composite mark. The opponent filed an action before the General Court (GC). The GC emphasizes that the comparison of the signs must be made by examining each of the marks in question as a whole which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (Para. 30). There is no need to examine the absolute grounds for refusal referred to in Article 7 CTMR in the context of opposition proceedings (para. 35). The fact that a national mark has been registered means that that mark has a minimum of inherent distinctiveness, since the harmonization Directive precludes registration of a mark which is devoid of distinctive character (Para. 36). The inherent distinctive character of the registered national mark can be challenged only in cancellation proceedings brought in the Member State concerned (Para. 37). As regards the mark applied for, the fanciful element preceding the word element is negligible; the word element 'micro' therefore constitutes the dominant element of the sign (Para. 48). That conclusion is not called into question by the argument that the word element is not only devoid of distinctive character, but is descriptive (Para. 49). Certain circumstances may justify that a descriptive element has a dominant character (Para. 51). The design of the mark applied for covers a quarter of the surface, while the other three quarters are occupied by the word element. In that specific context, the public eye is necessarily attracted, not by the colours used or the design, but by the word element, the position of which is predominant. It can therefore only be considered as dominant even assuming that it is descriptive (Para. 52). Also in case of the earlier mark the attention will be drawn primarily to the word and not to the particular combination of colours and letters that constitute it. It follows that the word element "micro" must be regarded as the dominant element of the earlier national figurative mark (Para. 53). In so far as the word element 'micro' is the dominant visual element of the mark applied for, it is clear that, notwithstanding the descriptiveness of the word element there is a large degree of conceptual similarity between the signs at issue (Para. 60). **LOC**



### No likelihood of confusion (NO LOC)

**T-356/12; SÔ: UNIC / SO... ? ONE, SO... ? CHIC, et al**, Judgment of 3 April 2014, *Debonair Trading Internacional Ldª v OHIM*; - en. An opposition was filed an opposition against CTMA “SÔ: UNIC” on the grounds of Articles 8(1) (b) and 8(4) CTMR. It was based on 24 earlier national or Community marks, all containing the word element “so... ?”, including “SO... ? ONE”, “SO... ? CHIC” and a number of non-registered word marks, protected in the European Union. The Opposition Division dismissed the opposition. The Board of Appeal dismissed the opponent’s appeal, as far as Art. 8(1) (b) CTMR was concerned, because there was no likelihood of confusion between the signs. The opponent filed an action before the General Court. The General Court partly dismissed the appeal. It found that the Board did not err in finding that the element ‘so... ?’, common to the earlier marks, was not reproduced identically in the mark applied for and, in particular, the element ‘unic’ in the mark applied for was not an English expression like those of the earlier marks. Therefore, the Board correctly found that the family of marks argument raised by the applicant was to be dismissed and that a risk of confusion was to be excluded (Paras.-20-31). **NO LOC**

**T-554/12; AAVA MOBILE/JAVA**, Judgment of 27 March 2014, *Oracle America, Inc. v OHIM* - en. The applicant sought to register the word mark AAVA MOBILE as a CTM for goods and services within Classes 9, 38 and 42. The signs, considered as a whole, were neither visually similar, nor phonetically similar. The signs at issue are conceptually different, having each a different meaning, since the mark applied for AAVA MOBILE will evoke, for the Finnish-speaking part of the relevant public, the words ‘open’, ‘expansive’ or ‘wide’ and telecommunications and mobile device hardware or services and, for the non-Finish-speaking part of the relevant public, only the latter services and hardware. Moreover, the earlier mark, in all Union languages, will refer to the island of Java. Thus, even if the goods and services covered by the signs in question are identical and the earlier mark JAVA has a massive reputation, given the absence of similarity between the signs in question, there is no likelihood of confusion between them. **NO LOC**

**T-249/13; DORATO/RESERVE IMPERIAL**, Judgment of 9 April 2014; *MHCS v OHIM* – en.

CTMA	Earlier CTM and French Marks
	



The applicant sought to register the figurative mark represented above as a CTM for goods in Class 33. An opposition based on the earlier figurative marks represented above, registered for goods in Class 33, was filed on the grounds of Article 8(1) (b) CTMR. The Opposition Division (OD) dismissed the opposition and the Board of Appeal (BoA) dismissed the appeal, considering the signs to be overall dissimilar. As to the alleged breach of Article 8(1) (b) CTMR, the GC confirmed the findings of the BoA and made the following remarks. The opponent had not denied that affixing to a bottle of alcoholic beverage a label consisting of two bands intersecting at an angle with a circular element where the bands cross, is a practice which exists in the sector in question and that it was apparent from the administrative file that labels with that shape are not uncommon on bottles containing alcoholic beverages (Paras. 51-58). Coming to the comparison of the signs, the figurative elements contained in the mark applied for cannot constitute the dominant element. By contrast, on account, in particular, of its position, its size, the fact that it appears twice in the mark applied for and the contrast between its black letters and the white background on which it appears, the word element 'dorato' constitutes the dominant element of that mark (Para. 66). The signs are visually dissimilar overall, since the only element of similarity between them is that they have figurative elements representing a label for affixing to the neck of a bottle and that those elements are only weakly distinctive. Moreover, the signs have different structures and contain many differences (Paras. 71-72). The signs are phonetically dissimilar (Paras.- 74-75). The mark applied for is dominated by the word element 'dorato', meaning 'gold' in Italian, whereas none of the word elements in the earlier marks conveys that concept. For non-Italian speaking consumers, the mark applied for has no meaning, whereas the earlier marks contain laudatory elements, such as 'brut', 'réserve' or 'impérial'. On the other hand, consumers will not therefore attribute any specific conceptual meaning to the presence of the label in the shape of a tie. It follows that the signs are conceptually different (Paras. 76-82). As to the overall assessment, given that there is no visual, phonetic or conceptual similarity between the signs, one of the conditions for the application of Article 8(1) (b) CTMR has not been satisfied in the present case. The GC added that, even if the signs were held to be conceptually similar, that would have no bearing on the above finding of no likelihood of confusion since, on account of the circumstance that the earlier marks do not have a particularly distinctive character and consist of an image with little imaginative content, the mere fact that the marks might be held to be conceptually similar would not be sufficient to give rise to a likelihood of confusion (Paras. 86-87). **NO LOC**

[T-288/12](#); **ZYTeL/ ZYTEL**, Judgment of 9 April, 2014, *El du Pont de Nemours and Company v OHIM* – en.

CTM	Earlier marks
	<p>ZYTEL</p>

The figurative sign represented above was registered as CTM for goods within Classes 9, 12 and 37. The opposition based on the earlier trademarks CTM ZYTEL and well known mark ZYTEL was



rejected. The Board of Appeal (BoA) dismissed the appeal on the grounds that the goods and services covered by the signs at issue were dissimilar and the opponent failed to demonstrate an unfair advantage to the reputation of the earlier trademarks. The appeal was raised before the GC on the grounds of infringement of Article 8(1) (b) and (5) CTMR. The General Court (GC) held that the earlier mark's goods in Classes 1 and 17 were dissimilar to the contested mark's goods in Classes 9 and 12 because of the different nature (Para. 35), intended purposes (Para. 36), methods of use (Para. 37) lack of complementarity (Paras. 38 and 39). Furthermore, the publics and the distribution channels are different (Paras. 41 and 42). The applicant's argument that the goods consisting of raw material may enter into the composition of the finished products was not accepted. The GC has reiterated the Case-Law findings according to which the raw materials subject to transformation process are essentially different from the finished products which incorporate, or are covered by, those raw materials, both by their nature and by their aim and intended purpose (Para. 43). For the same reasons the GC has found dissimilar opponent's goods with the services in Class 37. As one of the necessary conditions - the similarity of the goods and services at issue - was not satisfied by the opposition based on the Article 8(1) (b) it was rejected (Para. 49). The GC concluded that in the present case a link between the signs at issue could not have been established due to the fact that the goods covered by the earlier marks were directed at moulders and converters, whereas the goods covered by the mark applied for were directed at the general public or at the specialised public in the field of renewable energies or in the automotive sector (Paras. 71-73), the goods and services at issue had different distribution channels, and finally, that the specialised public displays a high level of attention (Para. 74). **NO LOC**

**T-647/11; ASOS / ASSOS**, Judgment of 29 April 2014, *Asos plc v OHIM* – en. The applicant sought to register the word mark ASOS for goods and services within, *inter alia*, Classes 3, 18, 25 and 35. The opposition was partially upheld for all the goods and services in Classes 3, 25, 35 and some of the goods in Class 18. In the appeal proceedings the Board of Appeal (BoA) upheld partially the appeal, annulling the decision of the Opposition Division with regard to goods in Class 18. The BoA also held that the applicant had not succeeded in proving that the marks at issue coexisted peacefully within the territory of the European Union. The applicant raised two complaints before the GC alleging infringement of Article 8(1) (b) CTMR. The GC rejected the first complaint and held that the BoA did not err in its assessment of the conceptual meaning of the trade mark applied for. The GC confirmed the BoA's decision since the word element 'asos' is not a known acronym and the expression 'as seen on screen' is not a basic English expression, likely to be understood by the relevant public, especially by the non-English speaking public. Moreover, as the signs at issue do not have a meaning, the conceptual comparison is neutral (Para. 27). The GC rejected also the second complaint (peaceful coexistence) and held that the BoA correctly concluded, in accordance with the relevant Case-Law (T-542/10 and T-316/07) that the items of evidence provided by the applicant, consisting of two declarations from the head of its legal department, should be rejected, as coming from the applicant itself and not being supported by any additional information originating from independent source (Para. 33). Finally, the fact that the opponent opposed the registration of the applicant's trade mark ASOS in the United Kingdom casts doubt upon the peaceful coexistence of the marks at issue (Para. 35). The GC rejected also the opponent's claim for the partial annulment of the BoA's decision. due to the fact that (1) 'bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses' in Class 18, unlike the 'clothing, footwear, headgear' in Class 25, have an essentially practical function and not an essentially aesthetic function. Therefore, goods in Class 18 were not complementary to the goods in Class 25 (Para. 48). (2) The purchase



of the goods at issue in Class 18 is viewed independently from the purchase of goods in Class 25 (Para. 49), (3) even if the goods at issue in Class 18 were to have the same distribution channels and have the same end users with the goods at issue in Class 25. That would not suffice for the conclusion that there is a similarity between those goods (Para. 51). **NO LOC**

◆ **T-170/12; BEYOND VINTAGE / BEYOND RETRO**, Judgment of 30 April 2014, *Beyond Retro Limited v. OHIM* - en. The opponent sought to oppose the registration of the word mark BEYOND VINTAGE, for goods in Classes 14, 18 and 25, on the basis of its earlier CTM for the work mark BEYOND RETRO registered for, inter alia, clothing in Class 25, cf. Article 8(1) (b) CTMR. The Opposition Division (OD) upheld the opposition for Classes 18 and 25, and rejected it for Class 14. The Board of Appeal (BoA) upheld the appeal of the CTM applicant, finding no likelihood of confusion (NO LOC) for any of the claimed goods in Classes 14, 18 and 25, and dismissed the opponent's appeal that LOC should have also been found in Class 14. Before the General Court (GC), the opponent alleges an infringement of Article 8(1) (b) CTMR. The GC partially annulled the BoA on this basis. However, it also held that it erred in finding that there was no conceptual similarity between the signs for the non-English-speaking public (Paras. 65 – 70). It also found that the BoA erred in finding that the degree of visual and phonetic similarity between the marks was low, since the first words of each mark are more likely to catch the public's attention (Paras. 53 - 58). **NO LOC**

**T-47/13; GOLDSTUCK/ GOLDSTEIG**, Judgment of 29 January 2014, *Goldsteig Käseereien Bayerwald GmbH v OHIM* - de.

CTMA	Earlier CTM
	<b>GOLDSTEIG</b>

The applicant sought to register the figurative sign “goldstück”, shown above, as a CTM for goods in Classes 29 and 30 (various foodstuff). The opponent based an opposition on Article 8(1) (b) CTMR using the earlier word CTM GOLDSTEIG, registered for goods and services in Classes 29 and 41. The Opposition Division allowed the opposition. The Board of Appeal (BoA) annulled the Operations Department (OD) decision, finding that there was no likelihood of confusion as the differences between the signs outweigh their similarities. The opponent appealed to the General Court (GC), arguing an infringement of Article 8(1) (b) CTMR. The GC confirmed the BoA was basing its decision on the average consumer with an appropriate level of attention (not a high level of attention) in the EU (Para. 23). The goods are in part identical in part highly similar and in part have some similarity (not disputed). The figurative element of the CTMA is not negligible. The word element in the CTMA is not dominant. Taking into account the overall impression created by the marks as a whole, they are visually dissimilar (Para. 30). The signs are not, as maintained by the opponent, highly phonetically similar. Although their beginning is pronounced identically, there are



relevant differences in their latter parts (Para. 33). The signs are conceptually dissimilar for the German-speaking public and have no meanings for the non-German-speaking public (Paras. 34, 35). The GC did not pronounce itself on the differences in opinion regarding the level of distinctive character of the earlier mark (BoA – weak/ opponent – strong), but found that, as the signs are visually noticed when the goods are purchased, their visual dissimilarity was of greater relevance within the assessment of likelihood of confusion (LOC). **NO LOC**

**T-623/11; MILANOWEK CREAM FUDGE / LUXURY CREAM FUDGE et al**, Judgment of 9 April 2014, *Pico Food GmbH v OHIM* – en.

CTMA	Earlier Marks: DE
	

The applicant sought to register the figurative mark (in colour) represented above as a CTM for goods within Class 30 (i.a. Candy for food, pastry and confectionery, caramels, pralines, chocolate). An opposition based, amongst others, on the earlier figurative marks represented above, registered for goods in Class 30 (Chocolate bars, chocolate products; sweets, drops, toffees, in particular made by using milk, cream and/or butter), was filed on the grounds of 8(1)(b) and, only for marks 1+2, 8(5) CTMR. The Opposition Division rejected the opposition in its entirety. The Board of Appeal (BoA) dismissed the opponent’s appeal. The opponent filed an action before the General Court (GC). Even if, as argued by the opponent, a consumer was to make an impulse purchase of sweets in certain circumstances, there is nothing to suggest that that would be the case as a matter of course. Furthermore, the mere fact that the relevant public makes an impulse purchase does not, however, mean that that public’s level of attention is lower than that of an average consumer (Para. 34). As to the comparison of the goods they were found identical. As to the comparison of the signs, visually, the opponent’s argument that if a trade mark is registered in black and white it covers all the colour combinations which are included in the graphic representation was rejected. The GC ruled that: 1) The fact that a mark is registered in colour or, on the contrary, does not designate any specific colour, cannot be regarded as a wholly negligible element in the eyes of consumers (see i.a. *Specsavers Case*, C-252/12) and 2) The comparison must be made between the signs as they were registered or as they appear in the application for registration. As to the opponent’s reference to *LIBRO/LIBERO*-case (T-418/07), this may be interpreted as meaning that if a Community trade mark is not registered in a specific colour, the proprietor of the mark may use it in a colour or a combination of colours and obtain for it, as the case may be, protection under the relevant applicable provisions. This in particular if that colour or combination of colours have become, in the mind of a significant portion of the public associated with that earlier mark through the use which its proprietor has made of it (see *Specsavers*) (Para. 37 et seq). Even although the signs at issue shared a certain similarity having regard in particular



to the presence of a figurative element representing a cow (which is allusive for the goods at issue), those signs contained significant visual differences. Phonetically and conceptually the signs are not similar. Even if, as the opponent submits, visual similarity were of greater importance in the present case, in view of the way in which the goods concerned are marketed, that would have no effect on the fact that the signs at issue exhibit significant visual differences. Consequently, even if the earlier marks possess an enhanced degree of distinctiveness through use in the relevant territory, the BoA did not err in finding, in the present case, that there was no likelihood of confusion on the part of the relevant public, in spite of the identity of the goods at issue. **NO LOC**

**T-26/13; BALEA / CALDEA**, Judgment of 12 February 2014, *dm-drogerie markt GmbH & Co, KG, v OHIM and Semtee* – en. The opponent opposed the trade mark application on grounds of likelihood of confusion with an earlier international trade mark registration BALEA for goods in Classes 3, 5 and 8. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal, finding that the signs are overall dissimilar and no likelihood of confusion (LOC) is possible even for identical goods in Class 3 and even if the earlier mark enjoyed reputation. In its decision the BoA made reference to a previous case between the same parties, where the General court (GC) had ruled out LOC between the same earlier mark BALEA and a Community figurative mark, which included the word “*caldea*”. Before the GC, the opponent questioned the above findings of the BoA and also claimed that the reference made to the previous judgment is irrelevant, because the opposed then sign was figurative. The GC ruled on the relevance of the previous judgment, finding that it was applicable, because it had considered the similarity between the word elements, which are identical to the ones in the present case (Para. 20). The identification of the relevant public as the public at large was not disputed by the applicant. The BoA assessment relating to the comparison of the goods and services was not reviewed by the GC after the opponent withdrew its claim in this regard at the hearings. The GC confirmed the findings of the BoA as to the lack of visual similarity, making reference to the previous judgment, where it was noted that the differences between the signs are more easily grasped by the average consumer when they consist of limited number of letters, as in the case at hand (Para. 34). The findings of the BoA as regards the low level of phonetic similarity were also upheld. In its reasoning the GC again made reference to the previous judgment, where it was found that the presence in the signs of letters belonging to the group of plosive consonants was not sufficient to make those signs similar, when the rest of the elements gave rise to distinct phonetic differences (Para. 40). The GC further confirmed that conceptually the signs are not similar. When assessing the overall impression, the GC confirmed the previous judgment’s finding that the visual perception has more weight in view of the goods and the way they are usually purchased, compared to the phonetic similarity, which, in the case at hand, is even low (Para. 46). Consequently, the findings of the Board as regards the overall dissimilarity of the signs were confirmed. As one of the conditions for the establishment of LOC was not met, i.e. the similarity of the signs, the BoA was correct in finding no likelihood of confusion, even if the goods and services were identical or similar and the earlier mark had acquired enhanced distinctiveness (Para. 54). **NO LOC**



◆ T-604/11; **MAGNEXT / MAGNET 4**, Judgment of 28 January 2014, *Mega Brands International & Diset, SA v OHIM - en*.

CTM applied for	Earlier Spanish Mark
	MAGNET 4

The applicant sought to register the figurative mark represented above as a CTM for Class 28. An opposition based on the earlier Spanish trade mark above, registered for goods in Class 28, was filed on the grounds of Articles 8(1)(b) CTMR. The opposition was directed against all goods in Class 28 of the CTM. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA) confirmed the decision of the OD and rejected entirely the appeal. The GC took note of the fact that the applicant does not challenge the findings of the BoA concerning the definition of the relevant public, composed of average Spanish-speaking consumers who are reasonably observant and circumspect, and the partial identity of the products covered by the marks at issue (Para. 19). On the comparison of signs the GC held that that the figurative mark applied for has a very weak degree of visual and phonetic similarity to the earlier mark (Para. 24). In particular the GC points out (Paras. 22 and 23) that the figurative mark applied for is clearly divided into two parts: 'mag' and 'next'. The excessive size of the capital letter 'X' and its stylisation has the effect that the relevant public will retain the image of the English word 'next' as a separate element of the mark, which produces a specific visual impression not produced by the sign MAGNET 4. The word 'magnet', which dominates the latter sign, gives the visual impression of a single word, while the figure '4' is not present in the figurative mark applied for. The capital letter 'X' gives rise to a clear pronunciation of the second component of the figurative mark applied for which, combined with the visual separation of the two elements 'mag' and 'next', is likely to result in a phonetic reproduction of that mark as two words, whereas the word 'magnet' in the earlier mark will be pronounced as a single word, which, moreover, does not include the sound produced by the letter 'x'. As regards the comparison of the signs at issue from a conceptual point of view, the BoA was right when it concluded that there was no conceptual similarity between the figurative mark applied for and the earlier mark on the other, since the word 'magnext', which does not exist in Spanish and is not otherwise connected to any current concept, will be perceived as being fanciful. Furthermore, the mark MAGNET 4 does not contain any element that may be associated with the English word 'next' (Para. 26). It follows that, conceptually, the conflicting marks are different (Para. 28). On the assessment that the earlier mark has an average distinctive character the GC held (Paras. 32 and 33) that as the BoA stated in paragraph 19 of the contested decision, the relevant public will associate the earlier mark with objects with magnetic. The GC referred to documents produced by the applicant before the OD and before the BoA evidence consisting, in particular, of results of internet searches showing that the promotion of the magnetic properties of games and toys is a common practice among operators active in the sector, including the owner of the earlier mark, while the Commission adopted Decision 2008/329/EC of 21 April 2008 requesting Member States to ensure that magnetic toys placed or made available on the market display a warning about the health and safety risks they pose (OJ 2008 L 114, p. 90). According to recital 7 in the preamble thereto, magnets had already been used in toys for a long time. The GC concludes that in those circumstances, it must be held that the earlier mark MAGNET 4 sends a message that may be



connected, in the mind of the relevant public, to the characteristics of the products for which they have been registered and which are identical to those covered by the figurative mark applied for, so that contrary to the finding made by the BoA, its distinctive character is not medium, but weak. Concluding on the overall assessment of the likelihood of confusion the GC held that taking account of the very slight degree of similarity between the figurative mark applied for and the weak distinctive character of the earlier mark it must be held that the BoA has made an error of assessment by recognising a likelihood of confusion between them within the meaning of Article 8(1) (b). Even if the products covered by the marks in question are partly identical, the overall impression given to the consumer who is a member of the relevant public by each of those marks is sufficiently different to avoid such a risk, also taking account of the weak distinctive character of the earlier mark. **NO LOC**

**C-301/13P ; CLUB GOURMET/ CLUB DEL GOURMET, EN... El Cortes Inglés**, Order of 6 of February 2014, *El Corte Ingles, S.A. v OHIM – es*. The applicant sought to register the word mark ‘CLUB GOURMET’ as a CTM for goods in Classes 16, 21, 29, 30, 32 and 33. An opposition was filed on the grounds of Article 8(1) (b) and Article 8(5) CTMR. It was based on the earlier Spanish figurative trademark for services in Class 35. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal which had been filed by the opponent. The General Court (GC) dismissed the appeal and upheld the decision of the BoA. It considered that the earlier right identified only one service of Class 35, without any reference to the products covered by other related trademarks. The GC also stated that the opponent had not alleged protection beyond the services of Class 35. Furthermore, it set out that the Office has the obligation to take into consideration the national law only if it previously had indications as regards such national law. Finally, the GC found that the description of the services covered by the earlier mark did not allow a comparison with the challenged goods. The European court of justice (CJ) dismissed the opponent’s appeal in its entirety (Para. 69). **NO LOC**

◆ **T-170/12; BEYOND VINTAGE / BEYOND RETRO**; Judgment of 30 April 2014, *Beyond Retro Limited v. OHIM*, - en. The applicant sought to oppose the registration of the word mark BEYOND VINTAGE, for goods in Classes 14, 18 and 25, on the basis of its earlier CTM for the work mark BEYOND RETRO registered for, inter alia, clothing in Class 25, cf. Article 8(1) (b) CTMR. The Opposition Division (OD) upheld the opposition for Classes 18 and 25, and rejected it for Class 14. The Board of Appeal (BoA) upheld the appeal of the CTM applicant, finding no likelihood of confusion (LOC) for any of the claimed goods in Classes 14, 18 and 25, and dismissed the opponent’s appeal that LOC should have also been found in Class 14. Before the General Court (GC), the applicant alleges an infringement of Article 8(1) (b) CTMR. The GC upheld the BoA’s finding that the goods in Class 14 at issue are not similar to ‘clothing’ in Class 25, in line with established Case-Law, being neither in competition with nor complementary to clothing. Aesthetic harmony is too general a factor to justify by itself a finding that all goods are complementary and thus similar (Paras. 35 to 37). The goods being dissimilar, the BoA did not err in finding that there could be no LOC and that part of the application was dismissed (Para. 44). **NO LOC**



C-308/13 P, C-309/13; GIUSEPPE ZANOTTI DESIGN / ZANOTTI, Judgments of 18 September 2014, *Società Italiana Calzature SpA v OHIM* – it.

CTMAs	Earlier marks
	<p data-bbox="957 582 1077 660"><b>ZANOTTI</b> (CTM)</p>  <p data-bbox="973 828 1061 873">(Italian)</p>

The applicant sought to register the marks represented above as CTMs for goods within Classes 18 and 25. Two oppositions based (in Case C-308/13) on the two below trademarks, registered in the Community for goods in Class 25 and in Italy for goods in Classes 18 and 25 respectively, and only on the below CTM (in Case C-309/13) were filed on the grounds of Article 8(1)(b) CTMR. The Opposition Division upheld the oppositions partially. The Board of Appeal (BoA) upheld the applicant's appeals, considering that the signs are visually and phonetically dissimilar, thus offsetting the existing degree of conceptual similarity due to the presence in the signs of the surname Zanotti. Thus, the BoA held that one of the basic requirements for a finding of likelihood of confusion had not been met. The opponent filed an action before the General court (GC). The GC confirmed the BoA's findings of no likelihood of confusion, considering that the signs are visually dissimilar, given that in the CTMAs the signature dominates the overall impression and that the element 'ZANOTTI', given its position, is only a secondary element, devoid of any autonomous distinctive role. The GC held that the combinations 'GIUSEPPE ZANOTTI DESIGN' on the one hand and 'BY GIUSEPPE ZANOTTI' on the other inform the public as to the person responsible for the appearance of the goods, playing as such a marginal role compared to the figurative element consisting of a handwritten signature, which dominates the overall impression produced by the applied for trademarks. The European court of justice (CJ) confirmed that the GC, by finding that the figurative elements of the applied for trademarks are dominant and that their verbal elements, whilst not negligible, play a secondary role in the overall impression produced by these signs, so that there is no likelihood of confusion, has correctly applied the relevant legal criteria (Para. 46). Contrary to what argued by the opponent, there is no rule by which the verbal element of a complex mark would be more distinctive and dominant than the figurative element (Para. 47). The opponent's arguments as to the distinctive character of the surname Zanotti, the diffusion of the latter and the conceptual and phonetic similarity of the conflicting marks all relate to factual assessments, which cannot be reviewed by the CJ, so that these arguments are inadmissible (Para. 48). The CJ also declared inadmissible the opponent's argument as to the enhanced distinctiveness of the earlier marks, since this argument had not been raised before the GC and admitting it at such belated stage would alter the subject matter as



brought before the lower instance (Paras. 50-51). The CJ then dismissed the opponent’s argument that the element ‘ZANOTTI’ in the applied for marks would have an independent distinctive role, so as to justify a finding of likelihood of confusion. In this respect, the CJ found that an element of a complex mark does not maintain an independent distinctive role if, considered together with the other element/s of the complex mark, it forms a (semantic) whole having a different meaning than the meaning attached to each individual element considered in isolation (Para. 62). Since, in the present case, the GC found that the expressions ‘GIUSEPPE ZANOTTI DESIGN’ and ‘BY GIUSEPPE ZANOTTI’ could be perceived by the relevant public as a unitary whole referring to the designer of the products concerned (Para. 63), the CJ found that the GC correctly held that the above verbal expressions (of which the element ‘zanotti’ is part) have a merely informative, and therefore secondary, role in the applied for trademarks, so that a likelihood of confusion can be safely excluded (Para. 64). **NO LOC**

T-450/11; **GALILEO / GALILEO**, Galileo International Technology LLC v OHIM; Judgment of 11 September 2014 – en.

CTMA	Earlier Mark
	<p style="text-align: center;"><b>GALILEO</b></p>

The interveners sought to register the figurative mark represented above as a CTM for “research and development in the field of satellite radio navigation” within Class 42. An opposition based on the earlier word marks **GALILEO**, registered for goods and services in classes 9, 16, 35, 38, 39, 41, 42 was filed by the applicant on the grounds of 8(1)(b) CTMR. The Opposition Division (OD) dismissed the opposition insofar as the goods and services were deemed to be dissimilar. The Board of Appeal (BoA) dismissed the applicant’s (opponent’s) appeal. The applicant filed an action before the General Court (GC). While reviewing the merits of the contested decision with respect to the comparison of goods and services, the GC pointed out that ‘research and development in the field of satellite radio navigation’ is not an industrial activity or service aimed at the production of goods, but is focused on scientific innovation (Para. 55). The goods covered by the first of the earlier marks in Class 9 and the services covered by the mark applied for in Class 42 were found to be dissimilar, since goods are generally dissimilar to services and even though in some cases they may be complementary, they still have to be regarded as different if they are intended for different publics (Paras. 63-64). As for the goods in Class 9 and the services in Classes 35 and 38 for which the second of the earlier marks enjoyed protection were deemed to be different in nature, not in competition with and not complementary with the services applied for in Class 42 (Para. 85). They were therefore dissimilar. **NO LOC**



◆ **T-195/12; NUNA / NANA et al.**; Judgment of 23 September 2014; *Nuna International BV, Nanu-Nana Joachim Hoepp GmbH & Co. KG, v. OHIM* - en.

CTMA	Earlier marks
	NANA, NANU-NANA

The applicant sought to register the figurative sign represented above as a CTM for classes 12, 18, 20, 21, 25 and 28. An opposition based on CTM's registrations for goods in classes 18, 20, 21, 25 and 28 33 was filed on the grounds of Article 8(1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division rejected the opposition on the ground that there was no likelihood of confusion. The Board of Appeal (BoA) upheld the appeal. It concluded that there was a likelihood of confusion between the sign applied for and the earlier marks with respect to all the goods covered by that sign. By contrast, the 'strollers; buggies; safety car seats for children' in Class 12 and the 'baby walkers' and 'sleeping bags for baby and children' in Class 20 may not be regarded as identical or similar to the goods covered by the earlier marks (Para. 106). The contested decision is annulled in so far as the BoA found that there was a likelihood of confusion as regards, first, the 'strollers; buggies; safety car seats for children' in Class 12 and, secondly, the 'baby walkers' and 'sleeping bags for baby and children' in Class 20 (Para. 108). **NO LOC**

◆ **T-444/12; LINEX / LINES PERLA**, Judgment of 16 October 2014; *Novartis AG v. OHIM* – en. The applicant sought to register the word sign 'LINEX' for 'pharmaceutical preparations, containing lactobacillus acidophilus' in Class 5. The opponent filed an opposition based on the earlier Italian word mark 'LINES PERLA', registered for 'ladies hygienic diaper; hygienic napkins for incontinents' in Class 5, 'disposable napkins made of paper or celluloid, paper tissues' in Class 16 and 'napkins in the form of underpants' in Class 25. The grounds relied on in support of the opposition were, *inter alia*, those referred to in Article 8(1) (b) CTMR. The Opposition Division (OD) upheld the opposition under Article 8(1) (b) in its entirety. The Board of Appeal (BoA) dismissed the appeal. It held that that (i) the relevant public was the Italian general public consisting of consumers exposed to health problems while taking the view that their level of attention varied from high to above average, (ii) there was a high degree of similarity between 'ladies' hygienic diapers' and 'pharmaceutical preparations containing *lactobacillus acidophilus*', since they belonged to the same general category of goods for healthcare, their purpose was to be used in medical treatments or in surgical operations relating, in particular, to urinary incontinence, and they could contain lactobacillus acidophilus, a bacterium which is naturally present in the vagina and is beneficial in combatting yeast infections. In particular, the BoA found that the absence of that bacillus in that part of the body can be remedied by diapers to which *lactobacillus acidophilus* is added in order to combat a possible yeast infection. In addition, the contested goods are sold, *inter alia*, in pharmacies and are targeted at end consumers with health problems linked to urinary incontinence. Taking into account the visual and phonetic similarities of the marks, the BoA found that there was a likelihood of confusion. The General court (GC) annulled the BoA decision. The



GC held that the BoA had erred in defining the relevant public and that the conflicting signs targeted Italian women exposed to gastro-intestinal risks or problems and patients of either sex exposed to both gastro-intestinal risks or problems and problems related to urinary incontinence, the level of attention of the former being high and the one of the latter being above average (Paras. 24-25). The GC endorsed the BoA's finding that it is well known that a large number of pharmacies, and not just in Italy, sell also hygienic diapers (Para. 34). It found, however, that the nature and manner in which the above goods are used are dissimilar. The GC then dismissed the opponent's argument that the conflicting goods are highly similar in that they belong to similar categories, namely 'pharmaceutical preparations' and 'sanitary preparations'. The GC stated that its established Case-Law to the effect that there is a relatively high degree of similarity between the broadly worded categories 'sanitary preparations for medical purposes and for personal hygiene' and 'pharmaceutical preparations' does not entail that the same finding should apply to very specific goods such as those at issue here, although they belong to those broad categories (Para. 39). The GC held that the evidence on file did not allow establishing, as the BoA had found, that *lactobacillus acidophilus* is a medicinal product designed to treat incontinence or urinary tract or vaginal infections which may cause incontinence related problems. The mere fact that that bacterium is recommended in addition to a treatment against incontinence, in so far as its inclusion is recommended in a general change in dietary habits which a patient who suffers from incontinence should make, is not sufficient to allow the conclusion that it has a medicinal or therapeutic purpose (Para. 46). The GC reiterated the settled Case-Law pursuant to which facts alleged on the basis of information taken from Wikipedia must be disregarded since they lack certainty (Para. 47). The GC added that the therapeutic benefits of *lactobacillus acidophilus* as a treatment for incontinence may not be considered to be either proven or well-known and that 'pharmaceutical preparations containing lactobacillus acidophilus' are not connected with the medical treatment for incontinence (Para. 48). As to the BoA's finding that the absence of *lactobacillus acidophilus* in the vagina can be supplemented by napkins to which this bacillus is added in order to combat an eventual yeast infection', the GC noted that (i) when the BoA adopted its decision, it had not been established that medicated hygienic diapers existed, (ii) the existence of such products could not be considered to be a well-known fact, (iii) it had not been demonstrated that it is possible to place a bacterium into the vagina by means of a hygienic diaper or napkin (Para. 53). The BoA therefore should not, on the basis of the evidence available, have found that such a product existed. The GC found only a very low degree of similarity between 'pharmaceutical preparations, containing *lactobacillus acidophilus*' and 'ladies hygienic diapers' and 'hygienic napkins for incontinents', which do not have the primary objective of caring for the body or improving health, but rather of protecting clothing in cases of incontinence or loss of blood (Para. 55). The GC dismissed the opponent's argument that the conflicting goods would be complementary (para. 56). The marks at issue have a relatively low degree of visual similarity and a low degree of phonetic similarity (Paras. 62-63). The GC thus excluded the existence of a likelihood of confusion, taking into account the high/above average level of attention of the consumers concerned, the very low degree of similarity between the contested goods, the average distinctive character of the earlier Italian mark and the rather low degree of visual and phonetic similarity between the marks (Para. 70). **NO LOC**



T-490/12; **GRAZIA / GRAZIA**, Judgment of 26 September 2014, *Arnoldo Mondadori Editore SpA, v OHIM* – en.

CTMA	Earlier Italian mark
GRAZIA	GRAZIA

The CTM applicant sought to register the word mark GRAZIA for services in Classes 35, and 36. The opponent based its opposition on Article 8 (1) (b) and 8 (5) CTMR using among others the earlier Italian mark shown below, registered for goods and services in Classes 3, 9, 16, 18, 25 and 38. The opposition was directed against all the services covered by the application. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal, finding that the goods and services to be compared are dissimilar for which reason no likelihood of confusion may occur. As for the other ground invoked, the BoA found that the opponent did not show the alleged reputation for the earlier marks nor did it show the necessary link between the confronted marks in order to apply Article 8 (5) CTMR. The opponent appealed to the General court (GC), arguing an infringement both of Article 8 (1) (b) and 8 (5) CTMR. In relation to Article 8 (1) b, likelihood of confusion, the GC confirmed the BoA finding on the dissimilarity between the confronted goods and services. They are different in nature, intended purpose and method of use and there is no complementarity or competition between them (Para 27). In particular the applicant's argument that the goods and services covered by the marks have clients in the fashion sector in common, is not sufficient to render them similar (Para 29). The GC concluded that the simple fact that the goods and services covered by the marks at issue are not similar makes it possible to rule out any likelihood of confusion, and that conclusion cannot be affected by any finding that the earlier figurative mark is highly distinctive *per se* or that it is well known to the relevant public (Para 31). As to Article 8 (5) on unfair advantage/detriment, the GC stated at the beginning that the conditions for the application of Article 8 (5) CTMR are a) the marks at issue must be identical or similar; b) the earlier mark cited in opposition must have a reputation; and c) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (Para. 36). As to a) the marks being identical or similar, the first condition is met, since the marks are identical, as also stated in the contested decision (Para. 38). As to b) the reputation of the earlier mark, the GC held contrary to the BoA that the applicant has shown that its earlier mark enjoys a reputation for magazines (Class 16), although that reputation is not to be considered as strong (Para. 68). The GC stressed the fact that the long use of the earlier mark for magazines (since 1938) is a relevant factor (Para. 47). It went on to analyse the further evidence, and found that GRAZIA is the leading weekly magazine in Italy in terms of distribution. The documents in support have a probative value. This wide distribution may also be inferred from the advertising revenue. Moreover, from the market survey produced by the applicant it may be acknowledged that 51% of the relevant public knew that the GRAZIA magazine deals with beauty, etc. The applicant's large promotional activity, although it does not directly refer to the magazines, still is to be taken into consideration as far as the knowledge of GRAZIA is concerned (Para. 47 – 63). As to c) the link between the marks, the GC exposed the factors for the assessment of the link between the marks, which are: (i) the degree of similarity between the marks at issue; (ii) the nature of the goods or services concerned by the marks at issue, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; (iii) the strength of the



earlier mark's reputation; (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and (v) whether there is a likelihood of confusion on the part of the public (Para. 71). The GC concluded finally that although the signs are identical and there is a certain overlap of the public to which the contested services and the earlier goods magazines (Class 16) are directed, the other factors are not complied with in the present case. The goods and services have no connection at all, in particular the business consultancy and financial services do not evoke the same image as the earlier magazines. The earlier mark is reputed but not strongly and has a weak inherent distinctive character for beauty magazines. Finally, there is no likelihood of confusion between the marks (Para. 78). Since one of the conditions for the application of Article 8 (5) CTMR is not met, the action is unfounded. **NO LOC**

**T-267/13; BAUSS / BASS 3 TRES**, Judgment of 18 September 2014, *El Corte Inglés, S.A. v OHIM* - es.

CTMA	Earlier Mark (CTM) et al
BAUSS	

The applicant sought to register word mark BAUSS represented above as a CTM for goods and services within Class 18, 25 and 35. The Opposition Division dismissed the opposition for all the contested goods and services. The Board of Appeal (BoA) dismissed opponent's appeal. The opponent filed an action before the General court (GC). The GC confirmed that the relevant public is the average consumer of the European Union (Para. 29). The identity of the goods and services in question has been expressly recognized by the applicant (Para. 32). It is undisputed that the earlier trade mark has an average distinctive character (Para. 36). 'BASS' is not the most distinctive element of the earlier trade mark; the element 'TRES' on its verbal and numerical form is equally important from the visual perspective (Para. 42). Arguments on the weak distinctive character of the element 'TRES' are to be dismissed, it is not quite plausible that this element would be seen by consumer as indicating that these goods are addressed to children of three years old; it is even less the case as to the contested goods in Class 18 and services in Class 35 (Para. 43). Importance of beginnings of the mark shall be conciliated with overall impression of the signs (Para. 44). Even if the CTM application is aurally reproduced in a single syllable, the appearance in the earlier mark of the letter 'U' generate a notable pronunciation and intonation difference in the Spanish language (Para. 51). Phonetic differences are increased by the presence of the element 'TRES' reproduced in words and numbers in the earlier mark (Para. 52). It is not disputed that the signs are not conceptually similar (Para. 54). The important differences that exist between the signs from the visual and aural perspective, in addition to the conceptual dissimilarity, would not create a likelihood of confusion for the relevant public even when applied to identical goods and services (Para. 59). **NO LOC**

**T-303/06 RENV and T-337/06 RENV, UNIWEB et al / UNIFONDS et al**, (remitted to the General Court (GC) by the European Court of Justice (CJ) in Case C-0317-10P), Judgment of 25 November 2014, *UniCredit SpA v OHIM* - it. The applicant sought to register the word marks



represented below as CTMs for services within Class 36 (these being ‘banking business; financial affairs; monetary affairs; insurance; real-estate affairs; financial and insurance consultancy and information; credit/debit card services; banking and financial services via the Internet’ for UNIWEB and ‘banking business; financial affairs; monetary affairs; assurance; real-estate affairs; financial information’ for UniCredit Wealth Management). The opponent filed two oppositions based on the three earlier German word marks represented below and registered for ‘placement of funds’ in Class 36. The opponent also invoked the existence of a family of marks in Germany, all characterized by the initial element ‘UNI’ and all used to distinguish ‘placement of funds’. The ground invoked was based on Article 8 (1) (b) CTMR. The Opposition Division upheld the oppositions in respect of all of the contested services with the exception of ‘real estate affairs’, which were considered to be dissimilar to ‘placement of funds’. The Board of Appeal (BoA) dismissed the appeals filed by the opponent and the applicant, respectively. The applicant filed two actions before the General court (GC). By a first judgment, the GC annulled the BoA’s decisions, holding that the latter had erred by not properly assessed the issue of the family of marks and by finding that, given its lack of distinctive character, the common element ‘UNI’ could not trigger in the consumers’ minds an association between the contested applications and the opponent’s family of marks. Following an action lodged by the opponent (and supported by the Office with a cross appeal), the European court of justice (CJ) annulled the GC’s judgments, holding that the latter had erred in law in the application of Article 8 (1) (b) CTMR. The CJ remitted the cases to the GC for a new assessment (C-0317/10P). The GC dismissed the actions filed by the applicant and confirmed the BoA’s decisions to the extent that it upheld the oppositions for all of the contested services with the exception of ‘real estate affairs’. However, the GC dismissed the opponent’s argument that ‘placement of funds’ and ‘real estate services’ would be similar. It found that they differ in terms of their nature and intended purpose, and that they are neither in competition nor complementary. In this respect, the GC dismissed the opponent’s argument that, to the extent that ‘placement of funds’ also covers those funds that specialize in real estate, there would be a clear link, and similarity, between these services (Paras. 109-116). Finally, and in relation to an argument that had been raised, the GC acknowledged that, due to the context of financial crisis, there is a certain tendency among banks to operate also in markets adjacent to the financial one, including real estate. However, since the opponent had not proven that this tendency is well-established and that consumers would find it usual that banks also offer real estate services, the existence of such a tendency cannot be taken into account when it comes to comparing the services (Para. 118). **NO LOC**

**T-515/12; THE ENGLISH CUT / EL CORTE INGLES**, Judgment of 15 October 2014, *El Corte Inglés S.A. v. OHIM* – es.

CTMA	Earlier marks: CTMs and ES
THE ENGLISH CUT	



The other party sought to register the verbal sign THE ENGLISH CUT for goods in Class 25. *El Corte Inglés* filed an opposition pursuant to Article 8 (1) (b) CTMR and Article 8 (5) CTMR, based on the word and figurative marks reproduced above, covering namely goods in Class 25. Both the Operations Department and the Board of Appeal (BoA) dismissed the opposition. Before the General Court (GC), the applicant alleges an infringement of Article 8 (1) (b) and of Article 8 (5) CTMR. The GC ruled no visual or aural similarity, only a slight conceptual similarity for the Spanish public (Paras. 28-29). The signs are globally dissimilar. No likelihood of confusion. Since the signs are not similar, Article 8 (5) CTMR cannot be applicable. **NO LOC**

◆ T-341/13; **SO BIO ETIC / SO... ?**, Judgment of 23 September 2014; *Groupe Léa Nature SA v OHIM* – en

CTMA	Earlier mark
	SO...?

The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) annulled the decision of the OD and rejected the CTM application. According to the BoA, the OD failed to examine whether genuine use had been proven. Further, it found that there was a likelihood of confusion between the signs at issue in relation to identical or similar goods. Finally, it held that, with regard to ‘bleaching preparations and other substances for laundry use’, there was a risk that the sale thereof would be detrimental to the reputation of the earlier marks within the meaning of Article 8 (5) CTMR. The applicant filed an action before General Court (GC) relying on four pleas in law. The third plea alleging an infringement of Article 8 (1) (b) was upheld. According to the GC, since, in relatively short word signs, the elements at the beginning and end of the sign are as important as the central elements, it cannot be inferred from the position occupied by the element ‘so’ in the earlier marks that it will attract consumers’ attention more (Para. 71). The element ‘so’ has a laudatory function and has only weak inherent distinctiveness to the goods at issue (Para. 73). The earlier marks are not composite marks therefore a comparison of the signs at issue on the sole basis of their dominant element is not possible (Para. 74). When a mark, such as the mark applied for, is composed of word elements and figurative elements, the word element of the mark is, as a rule, more distinctive than the figurative element, since the average consumer will more easily refer to the goods in question by citing the name rather than describing the figurative element (Para. 75). Notwithstanding that, GC found that the signs at issue have a different length and structure and that, apart from the word element ‘so’, which does not dominate the overall impression, they are not visually similar (Para. 79). The signs at issue are phonetically similar to a low degree since their length, rhythm and intonation are different even though the word ‘so’ is placed at the beginning of the sign applied for and that the consumer is deemed generally to pay greater attention to the beginning of a mark (Para. 81 - 84). The GC did not find a conceptual similarity (Para. 89). Based on the foregoing, the GC found that the signs are not similar (Para. 91). The fourth plea alleging infringement of Article 8 (5) CTMR was upheld, since the similarity of signs at issue, one of the requirements for application of this provision, is not met. **NO LOC**



**T-308/13; ELECTROLINERA / ELECTROLINERA**, Judgment of 18 November 2014; *Repsol, S.A. & Josep Maria Adell Argiles v.OHIM* – es The applicant sought to register the verbal sign ELECTROLINERA as a CTM in Classes 4, 37 and 39. An opposition based on a Spanish earlier mark ELECTROLINERA for goods in Classes 12 and 9 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all goods of the CTM. The Opposition Division (OD) partially upheld the opposition. The Board of Appeal (BoA) partially annulled the decision of the OD. For industrial oils, greases, lubricants and fuels in Class 4 it held that there was a weak but non negligible similarity with vehicles in Class 12 of the earlier mark. It held that there is a certain similarity between electricity in Class 4 and the apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity in Class 9 of the earlier mark. For gas stations services in Class 37 it held that there is a certain degree of similarity with apparatus in Class 9 of the earlier mark. Finally the services of providing, distributing and stocking energy for vehicles in Class 39 of the contested mark were found to be similar to vehicles of Class 12 and to apparatus of Class 9 of the earlier marks. The signs being identical, likelihood of confusion was found with regard to the similar products and services. The relevant public is composed of the average public and the professional public in Spain (Para. 27). Regarding fuels in Class 4 and vehicles in Class 12, the General Court (GC) held that the complementarity link between the two products is not enough to conclude to similarity (Para. 39). As to industrial oils, greases and lubricants in Class 4 and vehicles in Class 12, the BoA was not correct to conclude that the products were similar (Paras. 47 and 53). On the services of Class 39 and the vehicles of Class 12, the GC held that the BoA was not correct to conclude that they are similar (Para. 69). In the global assessment of the likelihood of confusion, although the GC criticises (Para. 69) the similarity found by the BoA in relation with services of Class 39 and vehicles of Class 12, in Para. 84 the GC held that the mistake pointed out in this respect was without consequences in the legality of the BoA decision and annuls the decision only in so far as concerns the conclusion that industrial oils greases and lubricants are similar to vehicles in Class 12 (Para. 86). **NO LOC**

**T-524/11 and T-525/11; LOVOL / VOLVO**, Judgment of 12 November 2014, *Volvo Trademark Holding AB v OHIM* – en.

CTMA	Earlier Mark/Sign
<p><b>LOVOL</b></p>	
<p>(case T-524/11)</p>	
	
<p>(case T-525/11)</p>	



The applicant sought to register the marks represented above as CTMs for goods and services within Classes 7 and 12. Oppositions based *inter alia* on the earlier word mark VOLVO and the earlier figurative trademarks represented below, registered *inter alia* for goods in Classes 7 and 12. The grounds invoked were based on Article 8 (1) (b) and 8 (5) CTMR. The Opposition Division dismissed the oppositions. The Board of Appeal (BoA) dismissed the opponent's appeals. The opponent filed two actions before the General Court (GC) alleging infringement only of Article 8 (5) CTMR. GC's reasoning in both cases was identical. (references made to the case T-525/11): The types of injury referred to in Article 8 (5) CTMR are the consequence of a certain degree of similarity between the earlier and the later marks, by virtue of which the relevant public establishes a link between them even though it does not confuse them (Para. 17). The signs VOLVO and LOVOL are not composed of words which have a particular meaning and can be understood by the relevant public. Similarly, there is nothing in the way the letters are arranged in 'LOVOL' to suggest that the average consumer would divide it into two syllables and look at each separately. Moreover, even if the average consumer were to do so, there is nothing to suggest that, contrary to the normal practice for reading Roman letters, he would then read the first three letters 'l', 'o', and 'v' in reverse order, as 'vol' (Para. 31). Further, both the first and the last letters of those signs are different and the mark applied for contains two 'l's, whereas the trade mark VOLVO contains two 'v's (Para. 33). The figurative elements of the earlier figurative marks further distinguish those marks from the mark applied for (Para. 36). Regarding the aural perception, the letters 'l' and 'v' are pronounced quite differently: 'l' is an alveolar consonant, whereas 'v' is a labiodental consonant. The signs at issue have a different rhythm of pronunciation (Paras. 43 and 44). As regards the conceptual similarity, the opponent submitted a scientific article before the GC. The Office contended that the article was lodged for the first time before the GC. The Office held that it was not appropriate to determine whether the evidence represented by the article in question is admissible, given that, in any event, it does not support the opponent's arguments (Para. 53). The mere fact that the signs at issue contain the letters 'v', 'l', and 'o' and include the letter combination 'vol' is not capable of creating a connection between the signs in the mind of the relevant public or establishing a link between them (Para. 55). **NO LOC**

[T-272/13](#); **M&Co. / MAX&Co.** Judgment of 3 December 2014, *Max Mara Fashion Group Srl v. OHIM* – en.

CTMA	Earlier marks: CTMs and IT
<b>M&amp;Co.</b>	<b>MAX&amp;Co.</b>

The other party sought to register the figurative sign reproduced above for goods and services in Classes 25 and 35. Opposition pursuant to Article 8(1)(b) and Article 8(5) CTMR, based on the figurative marks reproduced below, covering goods and services in Classes 18, 24, 25, 35 and 42. Both the Operations Department (OD) and the Board of Appeal (BoA) dismissed the opposition. Before the General Court (GC), the applicant alleges an infringement of Article 8 (1) (b) CTMR. The GC ruled: that the BoA did not consider negligible the common element '&Co'. It took due account of it



and was right in finding that it has a weak distinctive character and precisely because the signs are short, the relevant public will perceive the differences between them more clearly. The letters 'AX' in the earlier signs differentiate the signs visually, phonetically and conceptually. The fact that a mark [like MAX&Co.] has acquired an enhanced distinctive character through use does not mean that it or the elements of which it is composed must be recognised as having an inherently high degree of distinctiveness. The highly distinctive character of a mark must be ascribed to the mark as a whole and not to all the elements of which it is composed, in particular to those elements which are inherently weak, like '&Co.' in the present case (Para. 61). The signs are not similar. The goods are identical or similar. There is no likelihood of confusion. **NO LOC**

**T-591/13; NEWS+ / ACTU+**, Judgment of 12 December 2014, *Groupe Canal + Euronews v. OHIM – fr.* The intervener sought to register this verbal sign as a CTM for Classes 35, 38 and 41. An opposition based on a French registration for services in Classes 35, 38 and 41 was filed on the grounds of Article 8 (1) (b) CTMR. The opposition was directed against all services of the CTM. The Opposition Division rejected the opposition on the ground that there was no likelihood of confusion. The Board of Appeal (BoA) confirmed the opposition decision. It concluded that there was no likelihood of confusion between the signs even for identical services. Initially, on the relevant public and the level of attention, the assessment of the BoA was confirmed. The relevant public is not only the average consumer but also the professionals who have a higher level of attention. On the comparison of services, the General Court (GC) took note that the assessment of the BoA was not challenged by the applicant. In regard to the visual comparison of signs, the signs only share the sign +, although both signs have four letters none of them is in common. The presence of the sign+ in both signs cannot generate a visual similarity as this is mathematical symbol which implies a concept of increase so it only enjoys a weak distinctive character (Para. 29). In relation with the aural comparison, the assessment of the BoA that the signs do not share any phonetic similarity was not followed the GC estimated that the signs share a weak similarity on the phonetic side because of the presence of the sign + (Paras. 35 and 36). In relation to the conceptual comparison, the GC held that the BoA erred in finding, in the contested decision, that the signs do not share a conceptual similarity (Para. 47). In the global assessment of the likelihood of confusion done, the GC found that the services being identical, the weak phonetic similarity and the very strong conceptual similarities of the signs were neutralised by the visual differences between the signs that produce a different visual impact (Para. 51). Furthermore the sign+ has a weak distinctive character so there is no likelihood of confusion. The decision of the BoA was confirmed in spite of the errors in the assessment of the phonetic and conceptual similarity (Para. 53). A further argument in favour of the absence of the likelihood of confusion is in the fact that ACTU+ is a sign with a weak distinctive character for the services concerned (Para. 54). **NO LOC**

**T-75/13; MOMARID / LOMARID**, Judgment of 2 December 2014, *Boehringer Ingelheim Pharma GmbH & Co. KG v OHIM - en.* The applicant filed a CTM application for the word mark Momarid for goods in Class 5. An opposition was lodged based on the earlier Community word mark LOMARID, registered for goods in Class 5. The Opposition Division (OD) partially upheld the opposition on the basis of Article 8(1) (b) CTMR. The Board of Appeal (BoA) partially annulled the OD decision to the extent that it had upheld the opposition for certain goods in Class 5. In particular the BoA considered the level of attention of the relevant public to be above average for pain- and fever-reducing medications (also available without prescription), and that the 'chemicals



for pharmaceutical use' covered by the mark applied for were dissimilar to the goods covered by the earlier mark. The BoA found that the signs had a degree of visual and phonetic similarity slightly above average. The BoA stated that there was a likelihood of confusion as regards the identical goods but it ruled out the existence of a likelihood of confusion in respect of the goods which were similar to a low degree or dissimilar. The opponent filed an action before the General Court (GC) arguing an infringement of Article 75 and Article 8 (1) (b) CTMR. In relation to Article 75 CTMR, the GC argued that, in spite of the brevity of the BoA statement of reasons in regard of the degree of attention of the public, the applicant was, in view of the wording of the contested decision, in a position to understand that the level of attention was above average on the ground that all of the goods at issue related to the health of the end consumers. It follows that the statement of reasons for the contested decision was sufficient to enable the applicant to dispute the merits of such an assessment, which it has, moreover, done. The first plea put forward by the applicant, alleging infringement of Article 75 CTMR, was therefore rejected (Paras. 25, 26). In relation to its second claim, the applicant submitted in particular that the level of attention of end consumers of preparations for the reduction of pain and fever, such as those covered by the earlier mark, and also for dietetic products was to be regarded as low. The GC stated that, according to the Case-Law, medicines, whether or not issued on prescription, can be regarded as receiving a heightened degree of attentiveness by consumers who are reasonably well informed and reasonably observant and circumspect. Therefore, the applicant's argument was rejected (Para. 41). As regard the comparison of the goods, the GC found that, contrary to what was stated in the contested decision, the 'chemicals for pharmaceutical use' covered by the mark applied for may fall within the category of pharmaceutical preparation which include pharmaceutical preparations for the reduction of pain and fever covered by the earlier mark. Consequently, the BoA erred in finding that the 'chemicals for pharmaceutical use' covered by the mark applied for were dissimilar to the goods covered by the earlier mark (Paras. 75-78). In respect to the comparison of the signs, the GC found that the BoA was right in finding that the degree of visual and phonetic similarity between the signs at issue was slightly above average. As regard the global assessment, the GC confirmed that there was no likelihood of confusion between the marks at issue in respect of the goods which were considered to be similar to a low degree (Paras. 89, 94) **NO LOC**

[T-127/12; FREEVOLUTION / FREE et al](#), Judgment of 4 February 2014, *Free SAS & Noble Gaming Ltd v OHIM* – fr.

CTMA	Earlier French Marks
	 <b>FREE</b> <b>FREE MOBILE</b> <b>FREE.FR</b>



The applicant sought to register the figurative mark represented above as a CTM for Classes 9, 41 and 42. An opposition based on the earlier French trademarks below, registered for goods and services in Classes 9 and 38 was filed on the grounds of Articles 8(1) (b) and 8(5) CTMR. The opposition was directed against some of the goods and services of the CTMA. The Opposition Division rejected the opposition. The Board of Appeal (BoA) confirmed the decision of the OD and rejected the opponent's appeal in its entirety. On 8(1) (b) CTMR, as regards the relevant public, the GC held that the BoA was correct when it concluded that the relevant public is the average French consumer (Para. 23). On the comparison of products, the BoA's decision did not contain any reasoning on it because the signs were considered not similar. The opponent requested the General Court (GC) to examine this point. At paragraphs 28 and 29, the GC confirmed its established case law that as the control of legality of the Board's decision is limited to the subject matter, the comparison of goods was not part of the contested decision; therefore the GC could not decide on it. On the comparison of signs, the GC held that the Board was right when it concluded that visually the earlier signs were dominated by the term FREE, while the contested sign had no dominant element. On the other side, the words EVOLUTION or REVOLUTION were not visually present in any of the earlier signs (Para. 44). The graphics of the contested sign are different, the word is written in capitals and the first and fourth letter are not aligned with the rest of the letters which also are in different colours, therefore the global visual impression is different (Para. 44). On the aural comparison, the GC held (Para. 46) that the verbal element FREE, which has no meaning in French, will be pronounced as an English term in the earlier signs; on the other side, the element "revolution" of the contested mark has a meaning in French and, therefore, the public will pronounce it as a French word. The GC concludes that the beginning of the signs will not be pronounced in a similar way. In relation to the French public that will pronounce the element FREE in the English way there is a play on words possibility between the concept of freedom and the French revolution, freedom being one of the ideals of the French revolution (Para. 49). The opponent claimed that the press cuttings and the different documentation filed showed evidence of a conceptual link between the company FREE, a major telecommunications operator in France, and the concept of REVOLUTION, because the company has changed radically the telecommunications market. The GC rejected this argument and followed the assessment of the Board when it held that both words EVOLUTION and REVOLUTION were currently used to write about technological changes in the telecommunication world and could not be attributed to a particular operator (Para. 51). To conclude on the comparison of the signs, the GC held that the signs have dissimilarities on the visual and phonetic side but major differences conceptually (Para. 53). Moreover, the GC confirmed (Para. 55) that as the marks are not similar, the reputation of the earlier signs cannot be taken into account. On 8(5) CTMR: As the first of the three cumulative conditions set out in Article 8(5) CTMR, the similarity of the signs, is not met, the Board correctly rejected Article 8(5) (Paras. 66 and 73). **NO LOC**



- ◆ T-229/12; **VOGUE / VOGUE**, Judgment of 27 February 2014, *Advance Magazine Publishers & Eduardo Lopez Cabré v OHIM* – en.

CTMA	Earlier CTM and Spanish Mark
	

The Opposition Division (OD) upheld the opposition in part, refusing registration of the mark applied for in relation to the goods ‘umbrellas, parasols, accessories’ in Class 18, on the ground that there was, in relation to those goods, a likelihood of confusion with the earlier CTM VOGUE. It rejected the opposition for the remaining goods. The Board of Appeal (BoA) confirmed the decision of the OD and rejected the opponent’s appeal in its entirety. The General Court (GC) took note of the fact that the opponent does not challenge the findings of the BoA concerning the definition of the relevant public, composed of the average consumer of the goods at issue in the European Union. The average consumer must be deemed to be reasonably well informed and reasonably observant and circumspect (Para. 27). On the comparison of signs, the GC held that, notwithstanding the specific presentation of the word in the mark applied for, the signs at issue are visually highly similar (Para. 45) and that the BoA was correct to conclude that the signs are phonetically identical (Para. 46). On the comparison between umbrellas and accessories, the GC concluded that ‘accessories’ was not precise enough in the sense of the judgment IP TRANSLATOR in case C- 307/10. The GC added that it was not open to the BoA to allow the opposition, as regards accessories, only for ‘accessories for umbrellas’. The BoA was also incorrect, at paragraph 24 of the contested decision, despite having based its analysis on only the earlier CTM VOGUE, to remark that the goods listed in the two Spanish marks did not cover a broader spectrum and did not therefore alter the scope of its assessment. That statement has no factual basis: it is clear that those marks were filed for “all kinds of umbrellas, sunshades, handles, ribs and canes for these’, in contrast to the earlier CTM VOGUE which was registered only for ‘umbrella” (Para. 41). Concluding on the comparison of goods, the General Court held that the goods are either identical (umbrellas) or have a low degree of similarity (parasols and umbrellas) or were not sufficiently identifiable (accessories) for the BoA to be able actually to assess their degree of similarity with the goods protected by the earlier CTM VOGUE, namely, umbrellas (Para. 42). On the assessment that the mark applied for has a distinctive character, the General Court held that the repute of a sign can be taken into consideration only if it has been invoked in support of the scope of protection of the earlier trade mark (Para. 50). Finally, in the global assessment of the likelihood of confusion, the BoA was wrong to consider that there was a likelihood of confusion between the mark applied for and the earlier CTM VOGUE as regards accessories. For the purposes of applying Article 8 (1) (b), a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Consequently, the similarity or identical nature of the signs cannot offset the lack of any assessment of the similarity of the goods, namely, accessories and umbrellas, since it had not been sufficiently defined what was meant by ‘accessories’, for example by seeking to restrict the application for a CTM. **NO LOC**



T-532/12; **SANI / RANI**, Judgment of 24 June 2014, *Rani Refreshments FZCO v OHIM* – en.

CTMA	Earlier Marks
	

The Other Party in the proceedings before the Office sought to register the figurative mark represented above as a CTM for goods and services within Classes 29, 30 and 32. An opposition based on the earlier figurative marks represented below, registered for goods in Classes 32 and Classes 29 and 30 respectively, was filed by the predecessor in title of the applicant on the grounds of Article 8(1)(b) CTMR. The Opposition Division rejected the opposition. The Board of Appeal (BoA) dismissed the appeal filed by the predecessor of the applicant. The applicant filed an action before the General court (GC). The GC pointed out that the BoA's findings that the relevant public was the public at large in the EU and that the goods were partly identical and partly similar had not been challenged. The average level of attention of the relevant public and the normal distinctive character of the earlier marks remained equally undisputed (Paras. 19-21 and 37). It confirmed that the relevant public will focus on the first syllable of the signs at issue and will be able to distinguish them despite their shared ending 'ani' because the aural perception of the first syllable of the contested mark (which begins with the sibilant consonant 's') is very different from the pronunciation of the open syllables of the two earlier marks ('lla/ha' and 'ra') (Paras. 31-33). The GC reiterated its Case-Law that a certain degree of aural similarity is not sufficient, in itself, to justify a finding of likelihood of confusion (LOC) and that visual and conceptual differences between the signs are capable of cancelling out the aural similarities between them (Paras. 39-40) and rejected the applicant's argument that the aural differences will not be noticed in the course of a conversation where drinks are being ordered in a busy and noisy bar or restaurant. The assessment of LOC must be carried out keeping in mind the perception of the relevant public in normal marketing conditions, unless there is evidence to the contrary (Para. 41-43). **NO LOC**

T-240/13; **ALIFOODS / ALDI**, Judgment of 26 November 2014, *Aldi Einkauf GmbH & Co. OHG v OHIM* de.

CTMA	Earlier mark
	<b>ALDI</b>



The Opposition Division rejected the opposition and held that a likelihood of confusion between the marks did not exist. The appeal filed by the opponent was dismissed. First, the GC rejected the opponent's claim that the Board of Appeal (BoA) had committed an error by holding that the existence and validity of the earlier IR with designation to the EU had not been proven. The GC pointed out that the Office excerpt of the earlier IR submitted by the opponent did not prove the existence of the earlier right as required by Rule 19 (2) (a) CTMIR. The Office is not the responsible office for the administration of international registrations (Para. 28). Moreover, the list of goods and services is published by WIPO only in three languages (English, Spanish and French) but not in all five languages of the Office. If the Office excerpts of IRs designating the EU were generally acceptable this would mean a preferential treatment for the languages German and Italian (for which a translation is missing) if the language of the opposition proceedings was in German or Italian. Such a preferential treatment is not foreseen by the law (Para. 30). On the other hand, if the Office excerpts of IRs designating the EU were only acceptable if the language of the opposition proceedings was in English, French or Spanish, this would create a situation of legal insecurity and would be contrary to the principle of equal treatment (Para. 31). Consequently, the BoA correctly decided to disregard the earlier international registration as its existence had not been proven by the opponent (Para. 32). Second, the GC confirmed that a likelihood of confusion between the conflicting marks did not exist. The goods and services at issue are directed to the general public and, in relation to some services like advertising, to specialists. The degree of attention varies from average to high (Para. 41). The conflicting signs are visually different. The figurative elements and the additional word 'foods', must not be disregarded when comparing the signs (Para. 54-55). The overall visual impression of the conflicting signs is clearly different (Para. 59-60). The signs are also phonetically different bearing in mind, in particular, the additional element 'foods' of the contested mark (Para. 64). Finally, the marks are also conceptually not similar (Para. 73). Since one of the requirements of Article 8 (1) (b) CTMR, namely the identity or similarity of the marks, is not fulfilled in this case, a likelihood of confusion does not exist (Para. 76). **NO LOC**



T-516/12; **SENSI SCANDIA / SCANDIA HOME**, 25 September 2014, *Ted-Invest EOOD v. OHIM*  
- en.

CTM	Earlier CTM
	<p><b>SCANDIA HOME</b></p>

A request for a declaration of invalidity was filed on the grounds of Article 53 (1) (a) in conjunction with Article 8(1) (b) CTMR against the figurative CTM registration represented above. It was based on the earlier Community word mark as registered for goods in classes 20 and 24 a directed against the goods of the CTMR in classes 20 and 24. The Cancellation Division (CD) upheld the application for a declaration of invalidity on the ground that there was a likelihood of confusion under Article 8 (1) (b) CTMR. The appeal lodged by the applicant against that decision was dismissed by the BoA, which confirmed the findings of the CD. In particular, the BoA found that the similarity between the marks, together with the identity and similarity of the goods gave rise to a likelihood of confusion. The BoA's decision was appealed before the General GC (GC). In relation to the comparison of the goods at issue, , the GC found in particular that there was similarity to an average degree between 'beds' and 'mattresses' covered by the contested mark in Class 20, on one hand, and 'pillows' in Class 20 and 'bedding products (such as bed linens, bed sheets) in Class 24 covered by the earlier mark. These goods share the same primary purpose (enhance the rest and sleep), are directed to the same users and sold in the same outlets. Finally, there is a relation of complementarity between them (paras. 22-28). As far as the signs are concerned, the GC confirmed the Board's findings that they are visually similar to a low degree and phonetically they are similar to an average degree, since at least half of the verbal elements composing each of the signs are pronounced in a similar way. At the conceptual level, the GC found that the common element 'scandia' alludes to Scandinavia. The element 'sensi' (abbreviation of the adjective sensitive in several European languages) and the element 'home' both convey the idea of comfort. Therefore, the GC concluded that, as a whole, the signs at issue are likely to evoke "Scandinavian comfort" and are therefore conceptually similar (paras. 33-36). In relation to the distinctive character of the earlier mark, the GC noted that the element 'home' has a low distinctive character in connection to the relevant goods which are intended for indoors. The word 'scandia' is an ancient and poetic name for Scandinavia. Therefore, it would not be perceived as a reference to the geographical origin of the goods but rather as a simply evocative term to a style of the goods. In the light of the foregoing, it must be concluded that the earlier mark as a whole has normal inherent distinctiveness (paras. 38-45). Therefore, the BoA's finding that that 'scandia' is likely to be perceived as the dominant element of the signs at issue must therefore be upheld. It follows from the foregoing that the difference between the signs is insufficient to exclude all likelihood of confusion between the marks on the part of the public. **NO LOC**



**T-493/12; GEPRAL / DELPRAL**, Judgment of 24 September 2014, *Sanofi SA v OHIM* – en. The applicant sought to register the word mark GEPRAL as a CTM for goods within Class 5, corresponding to the description ‘oncological preparations and preparations for cardiovascular treatments’. Sanofi SA filed an opposition based on the earlier word mark DELPRAL, registered for goods in Class 5, corresponding *i.a.* to the description ‘pharmaceutical preparations for the treatment of the disorders of the central nervous system’, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division (OD) upheld the opposition. The Board of Appeal (BoA), however, annulled the decision of the OD on the ground that there was no likelihood of confusion. The BoA reasoned its decision saying that there was a low degree of similarity of between the goods as well as between the signs at issue and relatively high degree of attentiveness of the relevant public. The opponent filed an action before GC relying *i.a.* on infringement of Article 8 (1) (b) CTMR. In regards of the goods in question, GC emphasized that those two sub-categories are not only encompassed in the category ‘pharmaceutical products’ or ‘pharmaceutical preparations’, but are also, on account of being medicines subject to medical prescription, marketed through the same distribution channels which in itself indicates a certain degree of similarity between the goods (Para. 22). On the other hand, the attentiveness of the relevant public in respect of medicines is high and the therapeutic indication, which is different in regards of the goods in the present case, is of decisive importance (Para. 23 and 24). The products cannot be regarded as being in competition or interchangeable with each other. Therefore, the goods were similar only to a low degree. In respect of the comparison of the signs, according to GC the Office may not contend that the relevant public pays particular attention to the beginning of the signs. In the present case, given the identity of the final sequence of letters ‘pral’, the slight visual dissimilarity of the elements ‘Ge’ and ‘Del’ and the visual impression of similarity produced by the signs at issue as a whole, the relevant public is not likely to spot those differences in isolation and pay particular attention to them. The GC therefore found a high degree of visual similarity (Para. 30 and 31). Regarding the phonetic similarity, the BoA did not conclude correctly that the syllables ‘del’ and ‘gep’ had perceptible differences. The phonetic comparison ought to have been made between the syllables ‘del’ and ‘ge’, on the one hand, and the syllables ‘pral’, on the other. Such comparison leads to at least an average degree of phonetic similarity between the signs (Para. 33). The overall high degree of similarity between the marks is coupled with a low degree of similarity between the goods in question which constitutes a relevant factor in the context of the global assessment of the likelihood of confusion. It could lead the relevant public, even if it has a higher than average degree of attentiveness, to believe that those medicines come from the same undertaking or from economically-linked undertakings marketing a ‘family of products’, all designated by the common ending ‘pral’ (Para. 40). GC therefore concluded that there is a likelihood of confusion and annulled the contested decision. **NO LOC**



T-36/13, ANTONIO BACCIONE Judgment of 16/07/2014, *Errea Sport SpA v OHIM* – it.

CTMA	Earlier marks
	

The applicant sought to register the figurative mark represented above as CTM for, among others, goods in classes 18 and 25. An opposition was filed on the grounds of Articles 8 (1) (b) and 8(5) CTMR. It was based on the following marks on an earlier Community mark, registered (among others) for goods in classes 18 and 25 and an earlier Italian mark registered (among others) for goods in class 25. The Opposition Division (OD) dismissed the opposition for all the contested goods and an appeal was filed against the OD's decision. The Board of Appeal (BoA) dismissed the appeal. The appeal was rejected under Article 8 (1) (b) CTMR since a likelihood of confusion between the signs had to be excluded. The BoA dismissed the appeal under 8(5) CTMR due to the lack of similarity between the signs. The opponent filed an action before the General Court (GC) arguing, an infringement of Articles 8(1)(b) and 8(5) CTMR. In particular, the opponent argued that the BoA erred in the evaluation of the similarity of the signs and in the global assessment of the likelihood of confusion. The GC dismissed the appeal. In relation to Article 8 (1) (b) CTMR, the GC found that, visually, the earlier complex mark and the contested mark have in common a figurative element resulting from two rhombuses overlapping each other. However, this similarity is not sufficient to counteract the significant visual differences between the signs. These differences concern both the internal part of the rhombuses and the word elements in the signs. Therefore, the figurative elements of the signs will be perceived as different by the relevant public (paragraphs 45 and 47). The word elements are visually different since they have only two letters in common, which are also placed in distinct positions. Therefore, the BoA did not err in finding that the marks have a different overall visual impression. The marks are different phonetically and, also conceptually because, even if they do not bear any concept, they evoke different contents: the name of person or a surname in one case and a fancy word of an acronym in the other (paragraph 52). The earlier Italian figurative mark and the contested one are also different. The same conclusions remain valid for the visual comparison between the marks. Phonetically, the marks are different because one can be pronounced and the other not (paragraph 67). From a conceptual point of view, the marks are neutral or dissimilar because the contested mark evokes the name of a person whereas the earlier figurative mark does not have any word element. As far as Article 8 (5) CTMR is concerned, the GC found that, since the marks at issue are not similar, and similarity is an essential condition for the applicability of this provision, the opponent's plea fails under this article without being necessary to assess whether the opponent had filed elements with the evidence filed by the opponent (paragraphs 84 and 85). **NO LOC**



**T-138/13; VISCOTECH / VISCOPLEX**, Judgment of 19 November 2014, *Evonik Oil Additives GmbH v OHIM* – nl. The applicant sought to register the word mark VISCOTECH as a CTM for goods within Classes 1 and 4. An opposition based on the earlier international registrations concerning the word mark VISCOPLEX, registered for goods in Class 1 or in Classes 1 and 4 (the “earlier rights”), was filed on the grounds of 8(1)(b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal upheld the opponent’s appeal. The applicant filed an action before the General Court. The factor of relevant public and the factor of level of its attention are independent from each other. Thus, the fact that the relevant public is composed of the general public does not necessarily imply that its level of attention is average and, *vice versa*, the fact that the relevant public is composed of professionals does not imply that the level of its attention is high (Para. 47). In regards of the "motor oil additives and lubricant additives not included in other Classes' in Class 1 and "motor oils and lubricants" in Class 4 covered by the mark applied for, given the technical nature of these products, the relevant public will buy them only after careful consideration of their characteristics. When products are intended to be used in connection with technically complex and expensive goods, the relevant public will pay special attention when purchasing them, bearing in mind that they can cause severe damage to such property. The goods concerned have a dangerous character and may cause damage to the environment in case of misuse, which confirms that the relevant public will be particularly vigilant and attentive in relation to them (Para. 48). When some elements of mark are descriptive in relation to the goods and services covered, these elements are granted a weak distinctive character, or very low. Because of their low or very weak distinctive character, descriptive elements of a mark will generally not be considered by the relevant public as being dominant in the overall impression produced by it, unless, due to their position or their size, they appear as likely to prevail in the public perception (Para. 56). As regards the common initial part of the marks, "visco", the prefix is descriptive for German public in relation to one of the main technical characteristics of oils, greases and fuels, i.e. their viscosity (Para. 57). The word element "visco" must be considered secondary in the overall impression created by the marks. Its presence in the marks cannot, by itself, make them similar, and the suffixes "plex", in the case of the earlier mark, and 'tech', in the case of the mark applied for, must be considered the dominant elements of those marks (Para. 60). With respect to the visual comparison, the marks are only vaguely similar, since the relevant public’s attention will be attracted more to the final part of these marks (as the most distinctive part), than to their initial part which has a very weak distinctive character in relation to the goods covered (Para. 66 and 69). Further, because of its distinctive character, the common prefix "visco" produces no lasting aural impression on the relevant public (Para. 75). The earlier mark has a normal inherent distinctive character, the attention of the relevant public is high and the marks have a lower level of average similarity, therefore, no likelihood of confusion was found (Para. 79 and 82). **NO LOC**



**Other LOC related cases**

◆ **T-161/12; FREELOUNGE / FREE** et al, Judgment of 4 June 2014; *Free SAS v. OHIM (FREELONGE / FREE et al, - fr.* The Opposition Division (OD) upheld the opposition in its entirety. The Board of Appeal (BoA) annulled this decision in part, finding that the services of ‘Online publication of electronic books and periodicals, publication of periodicals and books in electronic form, including on the Internet’ in Class 41, covered by the CTMA were dissimilar to the services of ‘Online broadcasting of information via telecommunication networks; telecommunication and computer aided transmission of messages and images’ in Class 38, covered by the earlier mark. According to the GC, the concept of ‘publication’ in Class 41 goes beyond the mere activity of edition of texts with a view to their diffusion. The ‘publication’ encompasses the activity of bringing information or documents to the public’s awareness (Para. 24). The GC also found that the BoA erred in restricting the definition of ‘online broadcasting of information’ as mere technical services aiming at putting two persons in contact in spite of distance. Such services can also aim at bringing informative contents (such as news) to the public’s awareness (Para. 25). Nothing prevents that the informative contents in question could take the form of electronic books the publication of which is covered by the CTMA (Para. 26). The GC points out that the BoA had found ‘printed matters’ in Class 16 to be similar to the services of ‘Online broadcasting of information via telecommunication networks’. For the public targeted both by the services of ‘online publication of electronic books’ and ‘online broadcasting of information’, the common purpose of the services is to make information available (Para. 27). These services have the same intended purpose in spite of a partially different nature (Para. 28). The fact that both services are supplied online reinforces the similarity (Para. 29). They are also complementary or in competition (Para. 30). This similarity is not ruled out by the fact that the e-Commerce directive n° 2000/31 distinguishes between the liability applicable to providers of access to an information network and to editors of content. This is so because the scope of the services of ‘online broadcasting of information’ includes services of broadcasting of information in the form of articles or electronic magazines and books (Para. 32-34). The BoA wrongly considered that the services covered by the CTMA would target a much narrower public (Para. 36). The GC cannot alter the contested decision and substitute it by a decision refusing the CTMA in entirety. It is for the BoA to assess whether there is likelihood of confusion bearing in mind the degree of similarity of the signs and that of the services in Classes 41 and 38 (Para. 44). Therefore the GC remitted the case to the BoA for renewed assessment of likelihood of confusion.

◆ **C-411-13P; REPRESENTATION OF A CHICKEN**, Order of 8 May 2014, *OHIM v Sanco S.A. & Marsalman S.L – es.*

CTM applied for	Earlier Spanish mark
	



The CTM applicant sought to register the figurative mark reproduced above in Classes 29, 35 (*advertising, commercial agencies, franchising, export and import*) and Class 39 (*transport, storage and distribution of chickens*). The opponent opposed the registration on the basis of the Spanish figurative mark reproduced above, covering goods in Classes 29 (*meat, poultry and game meat extracts*) and Class 3 (*live animals*) based on Article 8(1)(b) CTMR. The Opposition Division (OD) partially upheld the opposition, but rejected it for ‘advertising, commercial agencies, franchising, export and import’ in Class 35 and ‘transport, storage and distribution of chickens’ in Class 39. The Board of Appeal (BoA) dismissed the appeal. Upon appeal from the opponent, the General Court (GC) annulled the BoA’s decision (T-249/11). The GC finds two errors, both relating to the professional (specialised) public. As to the substance, the Office submitted three heads of claim: The GC erred in considering that there is automatically similarity between a product and a service that has such product as its object. If chicken were similar to the service of transport of chicken, the owner of a mark registered for services of transport could oppose registration of a mark applied for any kind of products, as they could all be transported. The GC also erred in considering that the services of advertising, commercial agencies, franchising, export and import are to be offered by a chicken farmer as an ancillary activity to the sale of its products, to a professional buyer of poultry or meat. The European Court of Justice (CJ) ruled partly manifestly unfounded, partly manifestly inadmissible. The GC did not find automatic similarity. It took into account many factors in order to find similarity. The GC rightly found that the BoA did not conclude that there exists a close connection, even if it is reduced, between the products of the earlier mark and the services applied for in Classes 35 and 39. The GC also erred in abandoning, when assessing the complementarity of the services at hand, the criterion of the importance of the use from a functional point of view, for a vaguer criterion, based on the importance of a product or of a service ‘in relation with the purchase’ of another product or service. As far as CJ ruling manifestly unfounded, the BoA should have assessed the importance of the goods and services for the use of each other from the point of view of the relevant public. The GC erred in finding some similarity between the goods and services, based only on their complementarity, without globally assessing the similarity of the goods and services. Complementarity was not the only factor taken into account by the GC when finding similarity between G&S.

### **C. Article 8(3), 53 (1) (b) CTMR – TM filed by agent**

[T-184/12, HEATSTRIP / HEATSTRIP](#), Judgment of 9 July 2014, *Moonich Produktkonzepte & Realisierung GmbH v OHIM – de*. On article 8(3) CTMR. The relationship between the CTM applicant and the opponent was based on cooperation that resulted in fiduciary obligations. As regards the terms ‘agent’ and ‘representative’ as used in Article 8(3) CTMR, it must be found that those terms must be interpreted broadly, so as to cover all kinds of relationships based on a contractual arrangement under which one party is representing the interests of the other, regardless of how the contractual relationship is categorised. It is sufficient for the purposes of Article 8(3) CTMR that there be some agreement of commercial co-operation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the trade mark applicant – whether expressly or implicitly – a general duty of trust and loyalty as regards the interests of the trade mark proprietor. Nevertheless, some kind of agreement has to exist between the parties. If



the applicant acts completely independently, without having entered into any kind of relationship with the proprietor, he cannot be treated as an agent for the purposes of Article 8(3) CTMR. Thus, a mere purchaser or client of the proprietor cannot be regarded as an 'agent' or as a 'representative' for the purposes of that provision, since such persons are under no special obligation of trust to the trade mark proprietor (paras. 58, 59 with reference to T-262/09 FIRST DEFENSE). The absence of a formal distribution or agency contract signed by the parties does not exclude the existence of a *de facto* relationship that would be relevant within the context of Article 8(3) CTMR. A binding contractual relationship can be established by means of business letters exchanged by the parties (para. 60). As considered by the BoA, these emails show that both parties were actively cooperating in the promotion of the product, by advertising it in brochures and exhibiting it at a fair, in order to create the best conditions for a successful marketing: the opponent supplied the material for these purposes and the applicant adapted it to the German market. The BoA was therefore correct in the assessment that the relationship between the parties on the date of the application for the CTM was more than that between the seller and purchaser, but rather a tacit cooperation agreement that led to fiduciary obligation for the CTM applicant (para. 67). Such a cooperation can exist even if it is not exclusive (para 69) and despite the fact that the CTM applicant was not a part of the distribution structure of the opponent (para 70).

#### D. Article 8(4), 53(1) (c) CTMR – Non registered marks/other signs used in the course of trade

◆ **T-356/12; SÔ: UNIC / SO... ? ONE, SO... ? CHIC, et al. Judgment of 3 April 2014.** *Debonair Trading Internacional Lda v OHIM*. In relation to Article 8(4) CTMR, the Board of Appeal (BoA) held that the opposition was not admissible according Rule 15(2) (b) (iii) CTMIR, since the applicant had indicated that the opposition was based on non-registered marks in the European Union, whereas such a category of intellectual property rights did not exist. Regarding the alleged infringement of Rule 15(2) (b) (iii) CTMIR, the Court firstly noted that it is not true that the opponent had not provided a representation of the earlier signs used in the course of trade. Since they are word signs, the reference to them in the corresponding pages of the notice of opposition must be considered to be a representation of those signs (Para. 43). Then the Court noted that in the letter attached to the notice of opposition the opponent claimed that "Leaving aside the registrations of the opponent's marks, the opponent has the right to prevent use of the mark applied for in the UK and Ireland at least on the basis of the law of passing off and in other Community [S]tates on the basis of the law of unfair competition having regard to the extensive goodwill and reputation earned". In light of the above, the GC held that the opponent incorrectly checked the box entitled 'EM'. This fact, however, did not render entirely inadmissible its opposition based on Article 8(4) CTMR. The information provided in the notice of opposition and in the attached letter made it possible to understand that it was claiming protection for the non-registered marks in the United Kingdom and in Ireland under the rules on passing off (Paras. 44 to 48). Therefore, the BoA erred in declaring inadmissible the opposition founded on Article 8(4) CTMR.



**C-325/13P and C-326/13P, PEEK & CLOPPENBURG**, Judgment of 10 of July 2014, *El Corte Ingles, S.A. v OHIM – de*. The applicant sought to register the word mark Peek & Cloppenburg as a CTM for goods in class 25 and as another CTM for services in class 35. An opposition was filed on the grounds of Article 8 (4) CTMR in conjunction with §§ 5, 6 and 15 of the German Trade Mark Act. It was based on the earlier homonymous German company name and on the right of the owner to prohibit the use of a subsequent trade mark in part of the territory of Germany. The Opposition Division upheld the opposition and rejected the applications. The First Board of Appeal (BoA) dismissed the appeal which had been filed by the applicant. The General Court (GC) confirmed the decision. In particular, it refuted the argument that Article 8 (4) must be interpreted in the way that the opponent must have the right to prohibit the use of the contested trade mark in the entire territory of the relevant Member State and not only in part of it. § 12 of the German Trade Mark Act, to which the applicant refers to support such argument, requires such a nation wide right to prohibit but only addresses the cancellation of national trade marks and is not applicable in opposition proceedings at the level of the Union. The opponent alleged the infringement of Article 8 (4) in so far as (i) all the norms of the national law must be applied because Article 8 (4) only allows to rely on an earlier company name “where and to the extent that” the national law confers the right to prohibit the use of a subsequent trade mark; (ii) the criterion of “more than mere local significance” indicates that the right to prohibit the use must exist nation-wide. The CJ held that Article 8 (4) requires the opponent to show that its sign confers upon the proprietor the right to prohibit the use of a subsequent mark. It does not require proof that such right could be validly exercised at the national level against the other party of the proceedings (para 48). Article 8(4) puts up the autonomous European criterion of “more than mere local significance” and thereby defines autonomously the requirements as to the geographical extension and scope of protection of the earlier sign. Moreover, the principle of unitary character of the CTM does not allow making the interpretation of Article 8(4) dependent on national provisions that vary in the different Member States (para 55).

### E. Article 8(2) (c), 8(5), 53(1)(a) CTMR – Well-known marks/marks with a reputation

**T-113/12; PROBIAL / BIAL**, Judgment of 21 January 2014; *Bial-Portela & C<sup>a</sup>, SA v OHIM and Probiotical Sp – en*.

CTM applied for	Earlier rights
	 BIAL

The applicant filed an application for a figurative CTM PROBIAL (represented above) for inter alia goods in Class 5. The opponent filed an opposition based on a number of previous rights, among which Portuguese word mark BIAL, both registered and well-known, figurative black and white CTM and Spanish mark BIAL (image represented above), international word mark BIAL, registered for Benelux, Germany, France, Italy and Austria, emblem and logo (image represented above) and



business name BIAL used in the course of trade in Portugal. Proof of use was requested for the earlier Portuguese, Spanish and International registrations. The Opposition Division (OD) upheld the opposition on grounds of likelihood of confusion with the earlier CTM. On appeal, the Boards of Appeal (BoA) rejected the opposition, finding that the signs are not similar and no likelihood of confusion could be established. The case was remitted back to the OD for ruling on the rest of the previous rights. The OD found the sign applied for overall dissimilar to the rest of the previous rights and rejected the opposition. On second appeal before the BoA the opponent claimed reputation and well-known character of the mark BIAL for the territory of Portugal, invoking Article 8(5) as well. In its decision the BoA firstly disregarded the earlier CTM, since the decision rejecting the opposition has become final. Secondly, the claim as per Article 8(5) was rejected, because it was brought for the first time before the BoA. The BoA further found that the evidence submitted were insufficient to prove genuine use, since they do not solidly indicate that the company sells pharmaceuticals under the trade mark BIAL. As regards the logo, business name and emblem, the opponent had failed to provide evidence that the signs were used in the course of trade and were with more than mere local significance. For the rest of the cited earlier rights, no likelihood of confusion was found. The General Court (GC) confirmed BoA's finding that CTM must be excluded as basis of the opposition (Para. 34). The Portuguese and International registrations, for which proof of use had been requested, were also rejected, on the grounds of lack of sufficient evidence and the failure of the applicant to contest BoA's findings (Paras. 36-38). As for the claimed well-known mark in Portugal, the GC confirmed the findings of the BoA that the opponent had failed to substantiate that claim by submitting proof that the mark was well known in Portugal. Evidence of the acquisition, duration and scope of protection is to be submitted within two-month period for the date of initiation of the opposition proceedings (Para. 40). With regard to the earlier Spanish trade mark, since the opponent did not contest the conclusion of the BoA as to lack of similarity between the services of that mark and the goods of the sign applied for, the GC confirms those findings (Para. 42). The failure of the opponent to furnish proof of the acquisition, duration and scope of protection of the earlier signs claimed to be used in the course of trade in Portugal and having more than a mere local significance, resulted in the rejection of the claim invoking Article 8(4) as well (Para. 48).

**T-554/12; AAVA MOBILE/JAVA**, Judgment of 27 March 2014, *Oracle America, Inc. v OHIM* - en. The applicant sought to register the word mark AAVA MOBILE as a CTM for goods and services within Classes 9, 38 and 42. As far as the claim under Article 8(5) CTMR is concerned, the fact that the signs are overall dissimilar is sufficient to dismiss the opposition as far as based on that ground.



T-288/12; ZYTeL/ ZYTEL, Judgment of 9 April, 2014, *El du Pont de Nemours and Company v OHIM* – en.

CTM	Earlier marks
	<p>ZYTEL</p>

The figurative sign represented above was registered as CTM for goods within Classes 9, 12 and 37. The opposition based on the earlier trademarks CTM ZYTEL and well known mark ZYTEL was rejected. The Board of Appeal (BoA) dismissed the appeal on the grounds that the goods and services covered by the signs at issue were dissimilar and the opponent failed to demonstrate an unfair advantage to the reputation of the earlier trademarks. The appeal was raised before the GC on the grounds of infringement of Article 8(1) (b) and (5) CTMR. As regards Article 8(5) CTMR the GC held in paragraph 70 that the relevant public of the goods of the earlier mark is completely distinct from the relevant public as regards the goods and services of the later mark. Although the earlier mark has a reputation it is not known to the public of the later mark and as a result the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks. Furthermore, even if the relevant public may overlap to some extent the goods and services under comparison, they are so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public. By making reference to the Judgment in Case C-252/07 (Intel Corporation), (Paras 48-50), the GC has underlined that the nature of the goods or services of the marks under comparison must be taken into consideration for the purpose of assessing whether there is a link between the marks. The GC concluded that in the present case a link between the signs at issue could not have been established due to the fact that the goods covered by the earlier marks were directed at moulders and converters, whereas the goods covered by the mark applied for were directed at the general public or at the specialised public in the field of renewable energies or in the automotive sector (Paras. 71-73), the goods and services at issue had different distribution channels, and finally, that the specialised public displays a high level of attention (Para. 74). **NO LOC**

◆ T-265/13; POLO PLAYER ON BICYCLE / POLO PLAYER ON HORSE, Judgment of 18 September 2014, *The Polo/Lauren Company, LP v. OHIM* – en.

CTMA	Earlier marks
	



The applicant sought to register the figurative mark shown above in Classes 18, 25 and 28. The opponent filed an opposition under Articles 8(1) (b) and 8(5) CTMR based on the two earlier marks shown below and covering, among other, goods in classes 18 and 25. The Opposition Division rejected the opposition. On appeal, the Board of Appeal (BoA) dismissed the appeal, finding that the signs at issue were dissimilar overall and that there could therefore be no likelihood of confusion. Furthermore, in view of the fact that the signs at issue were not similar, the BoA found that one of the cumulative conditions for the application of Article 8(5) CTMR was not satisfied. The General court (GC) annulled the BoA's decision, considering that the signs at issue have, at least, a low degree of visual and conceptual similarity. In particular, the GC pointed out that in the applied for mark the graphic representation of a bicycle occupies an amount of space similar to that of the graphic representation of a person holding a polo mallet in the earlier marks, with the result that one of those representations cannot be given more weight than the other. Furthermore, the fact that the polo mallet is situated above the polo player has the effect of making that accessory clearly visible in the representation of the signs at issue. That element cannot be regarded as negligible (Para. 25). The similarities between the signs cannot be categorised as negligible or insignificant. In particular, the signs represent a person holding a polo mallet in the air. In both cases, the person is not represented in any specific colour and is represented head on, but slightly in profile, at quite similar angles. The same is true of the angle formed by the polo mallet. Furthermore, in both cases, the graphic representation gives the impression that the persons are in motion, which the intervener does not, moreover, dispute. Lastly, the relative dimensions of the signs at issue (that is to say, the ratio between the height and the width of the signs) are quite similar. Although the horse is galloping towards the left, whereas the bicycle is going towards the right, given the angles used, including that used for the polo mallet, and the relative dimensions of the signs at issue, a visual comparison of those signs gives the impression of a certain symmetry (Para. 26). On a conceptual level, the GC dismissed the applicant's argument that the contested mark would refer to bicycle polo, a sport which would be different from traditional polo. In that respect, the GC noted that there was no evidence in the file to suggest that bicycle polo is a sport or game that is sufficiently known to the relevant public for the graphic representation in question to have a clear and specific meaning so that that public will be capable of grasping it immediately. There is, therefore, necessarily a conceptual similarity between the signs, which may be categorised, at least, as low (Paras. 29-31). It must be held that, contrary to the BoA's finding, the signs have a certain degree of similarity which may be categorised, at least, as low (Para. 32). The GC found that, since the BoA's finding was based exclusively on an absence of similarity between the signs, the arguments put forward by the opponent and alleging infringement of Article 8(5) CTMR must also be upheld (Para. 39). **LOC**



**T-90/13; V POLO PLAYER ON HORSE / POLO PLAYER ON HORSE**, Judgment of 18 September 2014, *Herdade de S. Tiago II — Sociedade Agrícola, SA v. OHIM – en.*

CTMA	Earlier CTM, UK and BX mar
	

The applicant sought to register the figurative mark shown above in Classes Classes 3, 18, 25, 28, 41 and 43. The opponent filed an opposition under Articles 8(1)(b) and 8(5) CTMR based on three earlier marks (a CTM, a UK and a Benelux trade mark) shown below and covering, among other, goods in Classes 9, 18, 20, 21, 24, 25 and 28. The Opposition Division (OD) partially upheld the opposition, rejecting the Community trade mark application under Article 8(1)(b) in respect of ‘games and playthings’ in Class 28 and all of the goods in Classes 18 and 25, with the exception of ‘whips, harness and saddlery’ in Class 18. It also rejected, on the basis of Article 8(5), the Community trade mark application in respect of ‘soaps, perfumery, essential oils, cosmetics and hair lotions’ in Class 3, ‘gymnastic and sporting articles not included in other Classes’ in Class 28 and ‘sporting activities, organisation of exhibitions for sporting purposes; sporting activities, including organisation of sports competitions’ in Class 41. By contrast, the opposition was rejected in respect of the other goods and services. On appeal, the Board of Appeal (BoA) confirmed the reasoning and finding of the OD. The General court (GC) confirmed the BoA decision. In first place, it noted that the goods in Classes 18 and 25 covered by the mark applied for and by the earlier CTM and the goods in Class 28 covered by the mark applied for and by the earlier Benelux mark are identical. The GC then confirmed the BoA’s finding that the signs are visually similar to a medium degree. The GC found that the figurative element representing a polo player has an independent distinctive role in the mark applied for and that, due to its position and size it cannot be regarded as negligible in the overall impression created by that mark. The differences in the polo players as represented in the two signs do not make it possible to come to the conclusion that there is no similarity between the figurative elements in the signs at issue. In particular, the relevant consumer will distinctly identify, and remember, a polo player (Para. 34). Although the letter ‘v’, which is used in the mark applied for, also plays a non-negligible role in that mark, in view of its position and size, it is not, however, the dominant element. In addition, since the letter ‘v’ is placed in the background of the mark applied for, it has the effect of highlighting the figurative



representation of the polo player (Para. 35). The signs are also conceptually identical since they both refer to the sport of polo (Para. 38). The GC confirmed the BoA's finding that the earlier marks had enhanced distinctiveness or a reputation in relation to a number of goods in Class 18 and to all the goods in Class 25 (Paras. 39-42). In a global assessment, although the figurative element of which the earlier marks consist is not inherently particularly distinctive in relation to 'clothing, footwear, headgear' in Class 25, the earlier marks have acquired enhanced distinctiveness through use in respect of those goods. By contrast, that is not true of the 'whips, harness and saddlery' in Class 18. Thus, there is a likelihood of confusion between the signs at issue in respect of 'games and playthings' in Class 28 and in respect of all the goods in Classes 18 and 25, with the exception of 'whips, harness and saddlery' in Class 18 (Para. 43). Concerning the alleged co-existence between the signs in Portugal, even if it were established, it would apply only to a part of the relevant public, as regards the earlier Community trade mark, and would have no effect as regards the relevant public for the earlier marks registered in the United Kingdom and Benelux (Para. 46). As regards Article 8(5) CTMR, the GC confirmed the BoA's finding that the use of the mark applied for would be detrimental to the repute of the earlier marks when it comes to 'soaps, perfumery, essential oils, cosmetics and hair lotions' in Class 3, 'gymnastic and sporting articles not included in other Classes' in Class 28 and 'sporting activities, organisation of exhibitions for sporting purposes; sporting activities, including organisation of sports competitions' in Class 41. In that respect, the GC, dismissing the applicant's argument that the above services are not related, directly or indirectly, to the goods covered by the earlier marks, held that there is a certain degree of closeness between the goods and services at issue inasmuch as 'clothing, footwear, headgear' include goods relating to sport. Those goods may therefore be used in the 'sporting activities, organisation of exhibitions for sporting purposes; sporting activities, including organisation of sports competitions' covered by the mark applied for (Para. 57). **LOC**

◆ **C-581/13 P + C-582/13 P, GOLDEN BALLS / BALLON D'OR**, Judgment of 20 November 2014, *Intra-Press SAS + OHIM v. Golden Balls Ltd.* – en. The CTM applicant filed two CTM applications to register the word sign GOLDEN BALLS in relation to various goods and services. Two oppositions were filed based on Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division (OD) rejected both oppositions, finding there was no similarity between the signs and no likelihood of confusion. The Board of Appeal (BoA) overturned that finding: the signs were deemed to be similar overall and likelihood of confusion was found in relation to identical or similar goods (Para. 15). However, the BoA did not consider the opponent's argument on the reputation of its earlier CTM under Article 8 (5) CTMR and did not conduct the required assessment in relation to dissimilar goods. The General Court (GC) annulled the BoA's decisions and found the signs globally dissimilar: even for goods which are identical, the weak, or very weak, conceptual similarity between the signs, which requires a prior translation, cannot suffice to compensate for the visual and phonetic dissimilarities (Para. 58). The opponent filed before the European Court of Justice (CJ) an action based on 3 pleas in law. The CJ partially upheld the appeals and remits the case to the Office to examine the opposition under Article 8 (5) CTMR. As to the distortion of facts in the assessment of the abilities of the relevant public (including the average francophone consumer) to understand English, the CJ rejected the ground of appeal as being inadmissible: it is not obvious from the documents that the GC distorted the opponent's position concerning the average level of knowledge of the English language among French-speaking consumers (Para. 40). On the infringement of Article 8 (1) (b) CTMR, firstly, the CJ rejected as being manifestly unfounded the arguments on the incorrect assessment of the relevant public (Para. 55): it does not



emerge from the Judgments that the relevant public was limited to the average French-speaking consumer by the GC (Para 47-52), the GC did not fail in its duty to state reasons since it analysed the signs, justified the assessment of conceptual dissimilarity, considering the public's perception (Paras. 53, 54). Secondly, the CJ dismissed the arguments concerning the significance placed on the prior translation for the purpose of assessing the conceptual similarity of word marks which are in different languages: this is an attempt to request the CJ a re-examination of the factual assessment conducted by the GC (Paras. 61-63). Thirdly, the CJ rejected the argument about the incorrect assessment of the distinctiveness of the earlier mark, considering that it was based on an incorrect reading of the GC's decision: the GC took into account the distinctiveness of the opponent's trademark, concluding that "in any event" a higher distinctiveness would not have affected the overall assessment of the likelihood of confusion on the relevant public (Paras. 64-67). *infringement of Article 8 (5) CTMR* The CJ, endorsing the arguments raised by the opponent, held that the GC erred in ruling out the application of Article 8 (5) CTMR since it did not exclude that the marks at issue were similar enough for them to be linked: a low degree of conceptual similarity was found (Paras. 75-78). *the action at First Instance* The CJ remits the case for the Office to examine the opposition under Article 8 (5) CTMR (Paras. 82-85).

◆ **T-10/09 RENV**; **F1 LIVE / F1 FORMULA 1**, Judgment of 11 December 2014, *Formula One Licensing BV v. OHIM* – en.

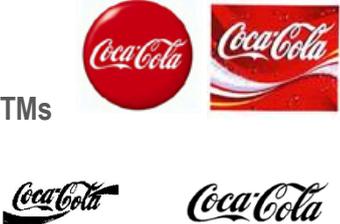
CTMA	Earlier marks
	<p data-bbox="1018 1133 1050 1160">F1</p> 

The Board of Appeal (BoA) had dismissed the opposition under Article 8 (1) (b) CTMR on account of the differences between the signs and the intrinsic descriptiveness of the word mark "F1". The opposition was dismissed under Article 8 (5) CTMR because there cannot be any of the misconducts envisaged by this provision where the signs only coincide in a descriptive element that is, the word element "F1". In its first judgment, the General Court (GC) confirmed that the common element 'F1', taken to mean racing cars and by implication car races, is perceived as a descriptive element denoting the subject of the printed matters and telecommunications services covered by the mark applied for, this element alone cannot be interpreted as a reference to a commercial origin and thus cannot lead to a risk of confusion (GC, Judgment of 17 February 2011, Case T-10/09, *Formula One Licensing BV / OHIM*, (F1-LIVE / F1), paras 46-50 and 57). On appeal, the European Court of Justice (CJ) did not deny that the Office must 'verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign'. However, the Office exceeds its competence where it characterises an earlier mark as being descriptive or generic since this is equivalent to denying it any protection. It is therefore necessary to



acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based. The CJ thus annulled a GC judgment which excluded any risk of confusion between the earlier word mark 'F1' and the figurative CTM application 'F1-Live' on account of the purely descriptive nature of the common element of the signs in respect of printed matters and telecommunication services. By doing so, the GC called into question the validity of the earlier trade mark and therefore infringed Article 8(1)(b) CTMR (CJ, 24 May 2012, Case C-196/11 P, Formula One Licensing BV / OHIM, (F1-LIVE / F1), para. 41-44 and 49-52). The case was remitted to the GC. The GC observes that the 'f1' word element is the usual abbreviation of the expression 'Formula 1'. This common element has therefore a weak distinctive character (para. 38). Moreover, this element is not dominant in the CTMA which forms a complex sign and which will be perceived visually as a whole (para. 39). The reputation claimed in respect of the earlier marks is in fact limited to the earlier figurative mark (para 40 and 48). The elements of differentiation do not totally outweigh the similarity resulting from the common element 'F1' (para. 45), which is not negligible in the CTMA (para. 51). The GC establishes LOC on account of the fact that the combination of the word 'Live' with the word 'f1' "helps to anchor in the mind of the relevant public the image of Formula 1 motor racing conveyed by that word element" (para. 51). Because the F1 mark is reproduced identically, the public will interpret the mark applied for as a variant of that earlier mark and, accordingly, as having the same commercial origin (para. 52).

◆ **T-480/12; MASTER / COCA-COLA**, Judgment of 11 December 2014, *The Coca-Cola Company v. OHIM* - en.

CTMA	Earlier marks
	<p>UK</p> 
	<p>CTMs</p> 

The other party sought to register the figurative sign reproduced above for goods in Classes 29, 30 and 32. Opposition pursuant to Article 8 (1) (b) and Article 8 (5) CTMR, based on the figurative marks reproduced below, covering identical and similar goods and services in Classes 30, 32, 33 and 43. Both the Opposition Division and the Board of Appeal (BoA) dismissed the opposition. Before the General Court (GC), the applicant alleges an infringement of Article 8 (5) CTMR. The applicant claims that the BoA wrongly conflated the matter of the similarity of the signs under Article 8 (1) (b) and under Article 8 (5). The GC stated that the types of injury referred to in Article



8 (5) may be the consequence of a lesser degree of similarity of the signs, provided that it is sufficient for the relevant public to make a connection between those marks, that is to say, to establish a link between them (Para. 32). Only if there is some similarity, however faint, between the conflicting marks, a global assessment must be carried out in order to ascertain whether, notwithstanding the low degree of similarity between the signs, there is, on account of the presence of other relevant factors such as the reputation or recognition of the earlier mark, a likelihood of confusion (LOC) or a link made between those marks by the relevant public (Para. 33). Food products in Classes 29 and 30 are normally purchased in supermarkets and are selected directly from the shelf by consumers, who are guided more by the overall visual impression. Thus, the figurative elements of a sign are deemed to play a more important role than its word elements. As a result, the common figurative element ('tail') is at least as important as the finding that there is no textual overlap between the word elements of the signs (Para. 52). The BoA failed to carry out a global assessment taking into account that both signs are written in Spenserian script and failed to establish that element of visual similarity between them (Para. 59). Visually, the signs do not only have clear differences, but also elements of similarity, owing to the 'tail' flowing from their first letters ('c' and 'm' respectively) in a signature flourish and to their shared use of the Spenserian font, which is not commonly used in contemporary business life (Para. 64). There is a low degree of visual similarity between the signs. As the relevant goods are usually sold in self-service stores, the elements of visual similarity and dissimilarity are of greater importance. Overall, there is a low degree of similarity between the signs, as their aural and conceptual differences are cancelled out by the elements of overall visual similarity (Para. 70). Given the degree of similarity, however faint, between the signs, there is a risk that the relevant public might establish a link between the marks at issue. There is a sufficient degree of similarity between the signs for the relevant public to make such connection, for the purposes of the Case-Law according to which the types of injury referred to in Article 8 (5) may be the consequence of a lesser degree of similarity between the earlier and later marks (Para. 74). The BoA should therefore have examined the other conditions for applying Article 8 (5). As the decision is annulled, the BoA will have to examine such conditions. The risk of free-riding may be established on the basis of logical deductions resulting from an analysis of the probabilities and by taking account of the usual practices in the relevant commercial sector as well as all the other circumstances of the case, including the use, by the proprietor of the mark applied for, of packaging similar to that of the goods of the proprietor of the earlier mark. The Case-Law allows taking account of any evidence intended to facilitate the analysis of the probabilities as regards the intention of the proprietor of the CTM applied for and *-a fortiori* - any evidence relating to the actual commercial use of the mark applied for (Para. 88). The BoA erred in disregarding the evidence produced by Coca-Cola relating to the commercial use of the mark applied for. The purpose of opposition proceedings is to ensure –for reasons of legal certainty and sound administration– that trademarks whose use could successfully be challenged downstream before the courts are not registered upstream (Para. 91). It is for the BoA to examine the evidence. The contested decision is annulled

**T-618/13, AAVA CORE / JAVA**, Judgment of 11 December 2014, *Oracle America, Inc. V OHIM – en*. The applicant filed a CTM application for the word mark AAVA CORE for goods and services in Classes 9, 38 and 42. 5. An opposition was lodged based on the earlier reputed Community word mark JAVA, registered for goods and services in Classes 9, 38 and 42. The grounds invoked were Articles 8(1)(b) and 8(5) CTMR. The Opposition Division rejected the opposition and the Board of Appeal (BoA) dismissed the appeal filed by the opponent. The BoA, in so far as the opposition was



based on Article 8(1)(b) CTMR, held that, in the absence of similarity between the signs at issue, there was no likelihood of confusion, even if the goods and services were identical and even though the earlier trade mark enjoyed a reputation. Secondly, in so far as the opposition was based on Article 8 (5) CTMR, the BoAd held that ‘no certain degree of similarity’ had been established between the signs, such that the public concerned would establish a link between them. The opponent filed an action before the General Court (GC). The GC confirmed that a general reference in the application to the pleadings and annexes that the opponent lodged before Office is inadmissible (Para. 17). The relevant public is made up of the general public and professionals inter alia in the scientific, information technology and telecommunications sectors. The goods and services covered by the trade marks at issue are identical. The word ‘aava’ will be perceived as a distinctive word. With regard to the part of the relevant public which speaks Finnish, that word, which refers in particular to the concept of ‘open’, bears no relation to the goods and services covered by the trade mark applied for (Para. 31). The word CORE, for at least a large proportion of the public, which does not have special knowledge of English and of digital electronics, will not be perceived as being descriptive of some of the goods at issue, but as an invented word, and, therefore, distinctive (Para. 32). Even if it were necessary to hold that the word ‘core’ is descriptive and cannot be considered to be the dominant element in the sign, that would not however mean that it must, on that basis alone, be regarded as insignificant (para, 35). The relevant public will notice the difference existing in the first letter making up the signs, namely the letter ‘a’ in the trade mark applied for and the letter ‘j’ in the earlier trade marks. That difference is increased by the unusual repetition of the letter ‘a’ at the beginning of the word ‘aava’ (Para. 43). The signs at issue, when assessed in their entirety, are not visually similar and they are phonetically dissimilar (Paras. 46-52). For the relevant public, the trade mark applied, AAVA CORE, either has no meaning, or refers to the concept of ‘open’, or to certain digital electronics materials. Secondly, the earlier trade marks refer, in all the languages of the European Union, to the island of Java. It follows that the signs are not similar. The reputation of the trade mark JAVA has no impact on the perception of its conceptual contents (Paras. 57-58). There is no likelihood of confusion between the signs in the light of their lack of similarity (Para. 65) and the opposition must therefore fail as far as based on Article 8 (5) CTMR.

**T-541/11; GULBENKIAN / FUNDAÇÃO CALOUSTE GULBENKIAN**, Judgment of 26 June 2014, *Fundação Calouste Gulbenkian & Micael Gulbenkian v OHIM* – en.

CTMA	Earlier mark
GULBENKIAN	<p data-bbox="954 1659 1353 1693"><b>Fundação Calouste Gulbenkian</b></p> 



The intervener sought to register the word sign **GULBENKIAN** represented above as CTM for classes 4, 33 35,37,41,42 and 44. An opposition based on the well-known mark below, the company name *Fundação Calouste Gulbenkian* and the logo represented below covering the following goods and services: Arts (plastic arts and music); charity (health and human development); science (research and promotion); education (support and development); technical and management services related to the oil industry was filed on the grounds of Articles 8 (1) (b) and 8 (4). The Opposition Division (OD) partially upheld the opposition on the basis of Article 8 (1) (b) CTMR, finding that there was a likelihood of confusion between the well-known mark and the mark applied for with regard to the educational services in Class 41 and to healthcare in Class 44. In so far as it was based on Article 8 (4) CTMR, the OD found that the applicant had not provided evidence that the logos satisfied all of the conditions set out in Article 8 (4) CTMR and it took the view that the applicant had also failed to submit evidence that the company name had been used, in the field of science (research and promotion) or technical and management services related to the oil industry, before the date on which the application for registration of the mark applied for was filed. The Board of Appeal (BoA) partially upheld the applicant's appeal, in respect of the services relating to development of studies and projects, as well as to consultancy, in Class 42, and dismissed the appeal as to the remainder. On the evidence of use of the well-known mark and the company name as regards technical and management services related to the oil industry the General Court (GC) confirmed the findings of the BoA that the applicant has not, as it was required to do, in view of the way in which it defined the earlier rights on which it based its opposition, put forward any argument or any evidence already submitted in the course of the proceedings before the Office that makes it possible to prove the existence of the well-known mark or the use of the company name in respect of 'technical and management services related to the oil industry'. Therefore the applicant is not justified in complaining that the BoA found that it had not established either the existence of the well-known mark as regards the services in question or the use of the company name in relation to those services (paragraphs 43 and 44). It follows that he is not justified in claiming that, in respect of the goods and services covered by the mark applied for which do not bear any degree of similarity to the goods and services in respect of which its earlier rights have been proved, the BoA erred in rejecting its opposition both on the basis of Article 8 (1) of Regulation No 207/2009, as regards the well-known mark, and on the basis of Article 8 (4) of that regulation, as regards the company name. On the costs, the GC for the first time made use of Article 90(a) of the Rules of Procedure and ordered the intervener to refund the interpreting costs occasioned by his request to be allowed to plead in Portuguese at the hearing, which he did not attend. Those costs, which were in fact borne by the European Court of Justice, and consist of the remuneration, daily allowance, travel and accommodation expenses of the free-lance interpreter used by the GC, amount to EUR 1 807.48 in total.

**T-173/11; CARRERA / CARRERA**, Judgment of 27 November 2014, *Kurt Hesse and Lutter & Partner GmbH v OHIM – de*. The applicant sought to register the word mark *Carrera* as a CTM for goods within Class 9. An opposition based on the earlier word marks *CARRERA* registered for goods in Class 12 was filed on the grounds of Article 8 (1) (b) and Article 8 (5) CTMR. The Opposition Division dismissed the opposition. The Board of Appeal (BoA) upheld the opponent's appeal finding that the signs are identical and there exists likelihood of confusion in respect of part of the goods applied for (mobile navigation apparatus, in particular satellite-based mobile navigation apparatus). In regards of the remaining goods the BoA found that the mark applied for would take unfair advantage of the distinctive character of the earlier marks. The applicant filed an



action before the General Court (GC). Subsequently, the application was partially transferred. In regards to the plea on violation of Article 8 (5) CTMR, the GC stated that as to the conditions of taking unfair advantage of the distinctive character or the reputation of the earlier marks, the applicants cannot maintain that the opponent was required to prove the actual and present damage to its marks. Accordingly, the documents provided by the applicants in order to prove that they had made extensive use of the marks applied for, and as a result, to require the opponent to prove not only the existence of a serious risk of future damage but the existence of an actual and present detriment to its marks, is irrelevant (Para. 67 – 68). According to the BoA there exists a “transfer of image” of earlier marks in favour of the marks applied for, since all the goods covered by the marks applied for can be used in motor vehicles and they may be associated with the technique and mobility as well as motor vehicles (Para. 70). The fact that the goods covered by the marks applied for are not intended to be installed in motor vehicles in the factory, does not exclude that these goods can be used in the motor vehicles (Para. 72). **LOC**

## F. Other issues

### Exhaustion of rights

[no entry]



#### IV. PROOF OF USE

**T-37/12; TEEN VOGUE / VOGUE moda en lluvia**, Judgment of 27 February 2014, *Advance Magazine Publishers v OHIM* – en. The applicant sought to register the figurative mark represented above as a CTM for various goods in Class 18. An opposition was based on the above earlier word mark and figurative marks on the grounds of Article 8(1) (b) CTMR. Upon the request from the applicant, the opponent provided documents in order to show that the earlier marks had been put to genuine use. The applicant alleged that the Board of Appeal (BoA) had infringed *Article 42(2) and (3) CTMR and Rule 22(3) CTMIR* by finding genuine use of the earlier Spanish word mark VOGUE as regards ‘*umbrellas; parasols; parts and fittings for all the aforesaid goods*’ in Class 18 by (1) estimating that the documents submitted by the opponent, ‘*considered as a whole*’, proved that the earlier Spanish word mark VOGUE had been put to genuine use, whereas such use should have been shown by each of those documents, (2) improperly determining that each item of evidence submitted by the opponent includes necessary indications concerning the place, time, extent and nature of the use which had been made of the earlier national mark, (3) incorrectly taking into account a declaration filed by the director of the company and which had been belatedly filed for the first time before the BoA. The General Court (GC) rejected the first plea in law on the grounds that: (1) Rule 22(3) CTMIR does not provide that each item of evidence must necessarily contain all the information on the place, time, extent and nature of the use of the earlier mark. Whereas either one or more of those items of evidence, considered alone, may not provide indications in respect of all of the mentioned criteria, all the relevant requirements may be satisfied when considering the evidence as a whole (Para. 36); (2) in the present case, the invoices issued to Spanish buyers and the extracts from catalogues concerning the sale of the goods submitted by the opponent were sufficient to establish, as regards the place, time, extent and nature, genuine use of the earlier Spanish word mark VOGUE (Paras. 38-39); (3) the BoA correctly exercised its discretion under Article 76(2) CTMR and in accordance with established Case-Law by considering that the above mentioned declaration (confirming that the catalogues in the case-file had indeed been distributed to Spanish customers and to potential customers and that the codes on the invoices referred to goods bearing the earlier Spanish word mark VOGUE) was not a new item of evidence, but merely confirmed the documents previously filed within the time-limit, (Paras. 42-44).

**T-71/13 ANNAPURNA**, Judgment of 6<sup>th</sup> March 2014, *Annapurna SpA / Anapurna GmbH*– en. The owner was granted registration of the word mark ANNAPURNA for goods in Classes 3, 18, 24 and 25. The cancellation applicant submitted an application for revocation of the mark at issue under Article 51(1) (a) CTMR. The Cancellation Division declared the mark at issue to be revoked for part of the goods in Classes 3, 18, and 24. It maintained the validity of the registration in respect of the remaining goods in Classes 3, 18, and 24 and of all the goods in Class 25. The Board of Appeal (BoA) partially upheld the appeal filed by the cancellation applicant. However, it maintained the registration of the mark at issue in relation to the following goods: – Class 18: ‘Bags’; – Class 24: ‘Bed covers and bed linen’; – Class 25: ‘Clothing, slippers and headgear’. The cancellation applicant filed an action before the General court (GC) arguing an infringement of Article 51(1) (a) CTMR to the extent that the use of the mark at issue was not demonstrated in relation to the above mentioned goods. The cancellation applicant argued in particular that the BoA: 1) failed to analyse specifically the evidence 2) failed both to identify the place and duration of the use 3) failed to check whether the mark was affixed to that evidence 4) failed in excluding any alteration of the



distinctive character of the registered mark in relation to the signs ANNAPURNA and ANNAPURNAPULSE shown in the evidence. The GC dismissed the appeal. In relation to the first point, the GC argued that an individual assessment of each item of evidence is not necessary since genuine use must be assessed globally. The GC confirmed the finding of the contested decision that the various items of evidence submitted (invoices, newspaper and magazine clippings, photographs, labels and packaging), taken as a whole, demonstrate the use of the mark in the European Union. (Paras. 34-36). In particular, as far as the nature of the use is concerned, the GC stated that, according to the case law, a connection between the use of the mark at issue and the goods concerned can be established without it being necessary for the mark to be affixed on the goods (paragraph 48). In this regard, the GC noted that the mark is affixed, in large letters and at the top of each of the invoices. Therefore, the invoices establish a clearly visible connection between the mark at issue and the goods mentioned on the invoices (Para. 48). Furthermore, although the probative value of an item of evidence is not in itself decisive, it may nevertheless be taken into account in the overall assessment as to whether the use is genuine. That is also the case, for example, where that evidence corroborates the other relevant factors of the present case (Para. 45). As far as the claim of alteration of the distinctive character is concerned, the GC argued that the majority of the evidence represents the mark at issue in its registered form. Therefore, it is not necessary to assess if ANNAPURNA and ANNAPURNAPULSE are or not consistent with the mark as registered. The GC rejected the argument of the cancellation applicant that the Board extended the protection of the mark at issue to 'bed linen', for which the mark was not registered. It pointed out that, since 'bed linen' can be considered to be part of a larger category of 'household linen', which is a category of goods in relation to which the mark was indeed registered, the BoA did not extend the protection of the mark beyond the list of registered goods (Para. 55). The GC finally found that the BoA had correctly applied the Aladdin case law in finding that the use shown for various single items of clothes would establish use for all the category of clothes (Paras. 61-68).

**T-38/13, PEDRO / Pedro del Hierro**, Judgment of 8 May 2014; *Pedro Group Pte Ltd v OHIM* – en. The applicant sought to register the word mark PEDRO as a CTM for *inter alia* all kinds of clothing items in Class 25. An opposition was based, amongst others, on the earlier figurative mark Pedro del Hierro, registered for *inter alia*, 'ready-made clothing for ladies, gentlemen and children, footwear (except orthopaedic footwear) and headgear in Class 25 was filed on the grounds of 8(1) (b) and 8(5) CTMR. On request the opponent submitted documents to proof use. The Opposition Division rejected the opposition in its entirety; 8(1) (b) and 8(5) CTMR did not apply. The Board of Appeal (BoA) partially accepted the opponent's appeal. The applicant filed an action before the General court (GC). As to the proof of use (POU) assessment, this was to be made in the light of several considerations as made in Case T-427/09 CENTROTHERM as well as in Case C-149/11 Leno Marken. The BoA rightly found, having regard to all the facts and circumstances relevant to establishing whether the commercial exploitation of the earlier CTM was real, that the mark had been put to genuine use in Spain (i.a. for ready-made clothing for ladies and gentlemen). Furthermore, some of the evidence, namely the locations of the shops marketing the mark in other European countries and the magazine articles in English and Portuguese show the gradual and continuous expansion of that mark in the territory of other Member States, mainly in Portugal, but also, to a lesser extent, in Belgium and France. It is not possible to rely on the analysis carried out



by the GC in T-334/01 HIPOVITON to dispute the POU assessment carried out by the BoA; the opponent filed numerous documents proving that the earlier CTM had been used with a view to its marketing, namely catalogues showing the earlier mark or goods marketed by the opponent, including those bearing the earlier Community trade mark. The BoA took into consideration the context within which and the market on which the goods covered by the earlier CTM were marketed. The relevant public is the average consumer in all the EU-Member States and the various clothing items are identical to the ‘ready-made clothing for ladies and gentlemen’ in Class 25 (not disputed). Documents bearing a date after filing date cannot be deprived of evidential value if they enable conclusions to be drawn with regard to the situation as it was on the filing date. The printout from the website ‘Leading Brands of Spain Forum’ contains many items of information about the earlier Community trade mark, its history and its expansion over a period of more than 25 years throughout Spanish territory. The other items of evidence, (i.a. catalogue, press dossier and various press articles in Spanish) point in the same direction. In the case at hand there is no need for evidence of the sales figures and the advertising and promotion expenditure.

**T-381/12; RON PALMA MULATA DE CUBA / PALMA MULATA**, Judgment of 12 March 2014, *Ana Borrajo Canelo et al vs. OHIM* – es.

Signs as used	Registered CTM
	<p><b>PALMA MULATA</b></p>

The applicants filed a request for revocation for non-use of the CTM “PALMA MULATA” (word mark) registered for “rum” (Class 33). The Cancellation Division as well as the Board held that the CTM proprietor has shown genuine use of the registered mark and dismissed the request for revocation of the applicants. The applicants appealed to the GC, arguing an infringement of Article 15 (1) (a) CTMR. The GC clarified beforehand two procedural issues. First of all, it stated that the claim of the applicants to declare the contested decision as contrary to the CTMR has to be interpreted as claim to annul the contested decision. Consequently it is admissible (Para. 16 – 17). The claim of the intervener asking the GC to confirm the contested decision is inadmissible. This is confirmed by the Case-Law (Para. 18). The subject matter of the dispute refers to the genuine use of the registered CTM, namely the nature of use. All the other aspects of use are undisputed (Para. 21). The GC first refers to the Case-Law concerning the permitted alterations of the use of a mark which nonetheless is still to be considered as valid use of the mark (Para. 26). The word elements “RON” and “de CUBA” will be understood by the public as reference to the alcoholic drink, “rum” as well as its well-known geographical origin “from Cuba”. Those elements are purely descriptive (Para. 32). Consequently, the distinctive elements are “palma” and “mulata”. Although the term “mulata” is written in much bigger letters, the expression “palma” has due to its position at the beginning and the type face still a degree of distinctive character within the signs as used (Para. 33). With reference to the figurative element which appears in the second variant of the



marks as used, the GC concluded that the public usually retains rather word elements than figurative elements which moreover may not be pronounced. The representation of a woman's bust is neither particularly original nor unusual. Consequently, this element will be seen as decorative rather than an indicator of the producer (Para. 38). The applicants finally put forward that the second mark as used has been applied for as CTM which at the end had not been registered in consequence of a successful opposition. They concluded that in application of the *ratio decidendi* in the case BAINBRIDGE T-194/03, such use may not be validly invoked. The GC dismissed this argument by arguing that the mentioned judgment forbids invoking the use of a registered mark for another similar one. In the case at hand the mark of the Intervener has not been registered. Consequently, the situation is different from the one indicated before.

[T-495/12](#), [T-496/12](#) and [T-497/12](#) **DRACULA BITE et al/DRACULA**, Judgment of 5 June 2014;  
Language of the case: EN

CTMS applied for	Earlier Mark/Sign
	

The applicant sought to register the figurative marks represented above as CTMS for Class 33 and 35 goods. An opposition based on the earlier mark above, registered for goods in Classes 33 and 35 was filed on the grounds of Articles 8(1) (b). The CTM applicant requested the filing of proof of use as the mark was registered in Romania since 1995. The Opposition Division rejected the oppositions in their entirety. The Board of Appeal (BoA) dismissed the actions, holding that the documents filed by the opponent did not demonstrate genuine use of the earlier mark within the meaning of Article 42(2) and (3) CTMR and of Rule 22(2) CTMIR. The General court (GC) confirmed the findings of the BoA that the six invoices filed, which were the only documents dated, show that the marketing period for the products referred to in those invoices was particularly short, less than three months. Furthermore, apart from the first one, dated 2 February 2009, the six invoices come within the period from the date the Community mark applications were lodged, 9 February 2009, to the date they were published, 23 November 2009. In those circumstances, although those invoices may be taken into account, the duration and the frequency of the use adduced do not support the conclusion that the products bearing the name of the earlier mark were marketed continuously over the relevant period (Para. 34). On the duration of use, contrary to the opponent's claim that the BoA misconstrued the criterion of duration of use, the GC stated that this is based on a misreading of the contested decisions. Indeed, the GC confirmed the conclusion of the BoA when it explicitly mentioned in paragraph 24 of each of the contested decisions that it was not a matter of examining whether the earlier mark had been put to continuous use over the course of the relevant period, but one of ensuring that the mark had been put to genuine use during that period. And more particularly of assessing whether the scale and frequency of the use of that mark was such as to demonstrate its presence on the market in an actual and consistent manner over time, with the sign's configuration remaining stable, which was not the case here (Para. 35). In relation to the fact that the name of the opponent did not appear in the invoices, the findings of the BoA were also confirmed. The GC held that in the absence of any information in



that regard, the BoA rightly found in Para. 30 of each decision that the nature of the relationship between Scandic Distilleries and the opponent had not been clarified (Para. 36). The GC added that contrary to what the opponent claimed, nothing in the file supported the conclusion that Scandic Distilleries' use of the earlier mark should be regarded as having been made with the consent, tacit or otherwise, of the opponent, and therefore as use by the opponent in accordance with Article 15(2) CTMR. Moreover, the opponent has not even established that the earlier mark had been used publicly and outwardly (Para.37). As regards the extent of the use, the GC noted that only the six invoices contain information on the extent of the use of the earlier mark. The sales figures in these are not sufficient to establish effectively the presence of the earlier mark on the Romanian market given the nature of the products concerned. The sales volume is marginal bearing in mind the average monthly consumption of vodka on the Romanian market, estimated by the applicant on the basis of statistical data provided in its pleadings and at the hearing and which were not contested by the opponent (Paras. 38 and 39). If, as the opponent claimed, the six invoices were to be regarded as samples, the fact that they were issued on dates that were close together and the fact that they relate to a period that is particularly short and particularly close to the publication of the applicant's Community mark applications, could not entirely exclude the possibility of a purely token use of the earlier mark. The opponent should have demonstrated that the sales – although they are very limited in time, despite the fact that the opponent had registered its mark in 1995, and they concern quantities which are not large – constitute use which was objectively such as to create or preserve an outlet for the goods concerned and entailed a volume of sales which, in relation to the period and frequency of use, was not so low that it could be concluded that the use was merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. The opponent did not do so in the present case. In addition, the additional evidence which could have supported the information contained in the six invoices on the extent of the use of the earlier mark, such as those listed on an indicative basis in Rule 22(3) CTMIR would not have been difficult for the opponent to obtain and there is nothing in the documents before the GC to show that the opponent claimed it was impossible to supply other evidence, in particular concerning the extent of the use of the earlier mark (Paras. 41 and 42). It is true that the opponent did produce other documents, such as the copies of a photograph of part of a bottle and a promotional text which could provide an indication of the nature of the use of the earlier mark concerning alcoholic beverages, except beers, and of the form in which it was used. However, that evidence does not substantiate the place, time or still less extent of the use (Para. 43). The GC concludes that the evidence, considered as a whole, does not provide sufficient indications of the place, time, extent and nature of use of the earlier mark (Para. 45). Finally the argument about whether the differences in the form in which the earlier mark was used and the form in which it was registered altered the distinctive character of that mark as it was registered, was not necessary to discuss.

**C-414/13 P; Wolfgang Amadeus Mozart PREMIUM / W. Amadeus Mozart**, Order of 20.05.2014, *Reber Holding GmbH & Co. KG v OHIM – de*. In the judgment T-530/10 the General court (GC) confirmed a decision of the Board of Appeal (BoA) which rejected the proof of use as insufficient in opposition proceedings. The opponent filed an appeal to the European court of Justice (CJ) claiming an infringement of articles 43 (2) and (3) CTMR; 15 (1) CTMR and 15 (2) CTMR. The CJ dismissed the appeal as partially inadmissible and partially unfounded. The assessment of the probative weight to be given to the sworn statement conducted by the GC comes within the scope of the facts of the case (Para. 32). Whereas the evaluation of the evidence is an issue of fact that



cannot be reviewed within the appeal, failure to take all of that evidence into account, on the other hand, constitutes an error of law (Para. 33). The CJ took into consideration the sworn declaration as well as the documents submitted to support it, but found them insufficient. According to the CJ findings it was not impossible for the opponent to submit further evidence (invoices, requests, advertisement) in order to support the sworn declaration. Insofar the facts of this case are different from those underlying the judgment in T 86/07 (DEITECH) to which the opponent refers (Paras. 40, 41).

◆ **T-47/12; EQUITER/EQUINET**, Judgment of 27 March 2014, *Intesa Sanpaolo SpA v OHIM* - en.

CTM Application	Earlier CTM
	<p style="text-align: center;"><b>EQUINET</b></p>

The applicant sought to register the above figurative mark as a CTM for goods and services within Classes 9, 16, 35, 36, 38, 41 and 42. An opposition was filed against a part of the goods and services in Classes 9, 35, 36 and 38 on the grounds of Article 8(1) (b). The applicant requested proof of the genuine use of the earlier mark on the basis of Article 42(2) CTMR. The examiner rejected the opposition on the ground that, even if the evidence submitted by the opponent met the conditions relating to the place, time and extent of the use of the earlier mark, it did not meet the requirement relating to the nature of the use of that mark. The Board of Appeal (BoA) upheld the appeal lodged by the opponent, annulled the examiner's decision and remitted the case to the first instance. In particular, the BoA held that the opponent had proved genuine use of the earlier mark for the services in Classes 35, 36 and 38 by providing audited financial accounts, invoices, excerpts from the opponent's website and press clippings showing use of the earlier mark for 'financial services, valuation and research services, public relations services and business consultancy services and advisory services'. The BoA thus remitted the case to the examiner for the assessment of likelihood of confusion. The applicant raised the plea that the BoA had infringed Article 42(2) and (3) CTMR. According to the applicant, the BoA's assessment was vitiated by errors relating to the place, time, extent and nature of use of the earlier mark, the link between its use and the services for which it was registered and, lastly, the link between the earlier mark as registered and the mark as used. The GC noted that 'financial services, valuation and research services and public relations services' are not included as such among the services in respect of which the earlier mark is registered (Para. 27). In this respect, it rejected OHIM's explanation, following a written question prior to the hearing, that the BoA's intention had been to determine only the services in respect of which the earlier mark had been used, whereas the issue of whether those services were included in the list of services in respect of which that mark was registered would be examined by the Opposition Division, to which the case had been remitted (Para. 28). The GC expressed a concern that such an approach would lead to an increase in the number of procedures aimed at examining the existence of genuine use, in a way that is contrary both to the letter and to the spirit of Article 42(2) CTMR (Para. 29). The GC held that it is impossible to know, from the BoA's decision, whether, by referring to 'financial services', the BoA meant to designate all or even a part of the services in Class 36 in respect of which the earlier mark is registered, and



that it is impossible in practice to ascertain for which services the earlier mark must be deemed to be registered for the purposes of the opposition, which is liable to prevent any subsequent assessment of the likelihood of confusion (Para. 32). Furthermore, as regards ‘business consultancy and advisory services’ in Class 35, although the BoA concluded that the earlier mark was put to genuine use with regard to such services, it did not refer to the evidence produced which would demonstrate that use (Para. 33). Therefore, the BoA’s decision is vitiated by a failure to state reasons in so far as, first, it is not possible to identify from it the services, among those in respect of which the earlier mark is registered and which are cited as justification for the opposition, in connection with which that mark was put to genuine use and, second, it does not state the grounds on which the BoA held that genuine use of the earlier mark had been demonstrated in connection with business consultancy and advisory services, falling within Class 35 (Para. 38).

**T-551/12; REBELLA / SEMBELLA**, Judgment of 23 January 2014; *Coppenrath-Verlag GmbH & Co KG v OHIM - de*.

CTMA	Earlier CTM	Forms in which earlier CTM was used
Rebella	SEMBELLA	

The applicant sought to register the word sign Rebella as a CTM, inter alia for goods in Classes 20 (furniture etc.) and 24 (textiles, blankets etc.). The opponent based an opposition on Article 8(1)(b) CTMR using the earlier word CTM, SEMBELLA, registered for goods in Classes 17, 20 and 22. The opponent had to prove use of his CTM. The Opposition Division partially allowed the opposition. The applicant as well as the opponent appealed to the Board of Appeal (BoA). The BoA found that the opponent had proved use through use in two forms differing from the CTM as registered. It found likelihood of confusion for identical and similar goods. The applicant appealed to the General court (GC), arguing an infringement of Article 42(2) in connection with Article 15(1)(a) CTMR and an infringement of Article 8(1)(b) CTMR. Use in a form differing from that registered: The GC confirmed the approach in C-12/12 (Colloseum Holding) that the condition of genuine use within the meaning of Article 15(1) CTMR may be satisfied where a registered trade mark is only used with another composite mark of which it constitutes one of the elements or where it is used only in conjunction with another mark, and the combination of those two marks is itself registered as a trade mark, provided the trade mark continues to be understood as a reference to the origin of the relevant goods (Paras. 39 et seq.). It confirmed that the figurative elements in the present case are only decorative and negligible and that they do not affect the distinctive character of the word “sembella” (Para. 43).



T-528/11; **FOREVER / 4 EVER**, Judgment of 16 January 2014, *Aloe Vera of America, Inc. v OHIM* – en.

CTMA	Earlier CTM
	

The applicant sought to register the figurative sign FOREVER, shown above, as a CTM, inter alia for goods in Class 32 (juices, bottled fresh water). The opponent based an opposition on Article 8(1)(a) and 8(1)(b) CTMR using the earlier figurative CTM, 4EVER, shown below, registered for goods in Class 32 (juices). The Opposition Division upheld the opposition and rejected the application for registration of the CTM. The Board of Appeal (BoA) dismissed the appeal, finding that the earlier trade mark had been put to genuine use in the course of relevant period five years and that the goods were in part identical and in part similar. The phonetic identity, conceptual identity and low level of visual similarity between the signs were also found. In the light of those facts, the BoA stated that there was a likelihood of confusion. The opponent appealed to the General Court (GC), arguing an infringement of Article 42(2) and (3) CTMR and, second, an infringement of Article 8(1) (b) of that regulation. The GC rejected the applicant’s argument based on Article 42(2) and (3). Despite the fact that on the related invoices submitted by the intervener, the element “4ever” is written in ordinary character and therefore it is not an exact reproduction of the earlier mark, these differences do not affect the function of identification (Para. 35). Although the related invoices were issued only to a limited number of customers, the period and frequency of use is not so low to be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. The intervener proved that submitted evidence was sufficient for a finding of genuine use (Paras. 39-41).

T-345/13; **CPI / Cpi**, Judgment of 4 July 2014, *Construcciones, Promociones e Instalaciones S.A. v. OHIM* - es.

CTMA	Earlier signs: ES mark, ES trade name
	 <b>Construcciones, Promociones e Instalaciones, S.A.-C.P.I.</b>

The CTM applicant sought to register the figurative mark reproduced above for construction services in Class 37. An opposition based on the Spanish mark and on the Spanish trade name used in the course of trade in Spain reproduced below, both for services in Class 37 was filed with reference to Articles 8(1) (b) and 8(4) CTMR. The Opposition Division (OD) dismissed the opposition and the Board of Appeal (BoA) dismissed the appeal, as no use of the earlier signs had been proved. Before the General Court (GC), the opponent alleges an infringement of Article 42,



(2) and (3), as well as of 8(4) CTMR. The GC confirms that the opponent did not prove that the earlier mark has been used publicly and outwardly. The opponent is a subsidiary of *El Corte Inglés* and it only makes construction and renovation works for other firms that also belong to the *El Corte Inglés* group (Paras. 31 and 32). The GC indicates that the use of a trade mark in order to procure goods or services or within the framework of relations with public bodies cannot be considered as a use in order to create or preserve an outlet for those goods or services (Para. 35). Regarding Article 8(4), the GC confirms that the BoA was right in refusing to take into account documents with the mention '*C.P.I., S.A. construcciones*', as they do not prove the use in the course of trade of the trade name invoked ('*Construcciones, Promociones e Instalaciones, S.A.-C.P.I.*'). Furthermore, since the invoices issued by suppliers are not associated to other documents that can prove the intention to make profits through the commercialisation of goods or services aimed at end-users, they do not prove the exercise of an economic activity (Para. 50).

**T-184/12, HEATSTRIP / HEATSTRIP**, Judgment of 9 July 2014, *Moonich Produktkonzepte & Realisierung GmbH v OHIM – de*. The applicant sought to register the word mark HEATSTRIP for goods in classes 9, 11 and 35. An opposition was filed pursuant to article 8(3) and 8(4) CTMR based on an earlier unregistered trade mark HEATSTRIP. The opponent claimed to be the proprietor of the unregistered mark 'HEATSTRIP' protected in Australia, Canada, United States and United Kingdom in relation to 'heating apparatus and parts thereof; thermostats, timers and electric controllers for heating apparatus' and offered evidence regarding the use in these countries and its relation with the applicant. The opposition division rejected both grounds of opposition as unsubstantiated. The Board of Appeal (BoA) annulled this decision and allowed the opposition pursuant to article 8(3) CTMR. It considered that in the light of the evidence provided, the opponent owns the earlier unregistered trade mark in Australia and that there existed a fiduciary relationship between the parties. The applicant filed an action to the General court (GC), claiming an infringement of article 76 (1) CTMR, 75 (2) CTMR and 8(3) CTMR. The General court (GC) rejected all claims. On article 76(1) CTMR: The BoA did not infringe this provision by undertaking its own investigation as to the applicable Australian law. According to this rule, it is in general for the applicant to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law (para. 19 with a reference to C-263/09 "ELIO FIORUCCI"). Restricting the factual basis of the examination by the Office does not preclude it from taking into consideration, in addition to the facts which have been expressly put forward by the parties to the opposition proceedings, facts which are well known, that is, facts which are likely to be known by anyone or which may be learnt from generally accessible sources (para. 20 with references to further Case-Law). The opponent provided information on Australian law taken from World Trademark Yearbook 2006. According to it a trade mark acquires protection in Australia, if it has acquired reputation, but do not give a definition of this term. The BoA was correct, however, in its assumption that this term corresponds to the concept of "goodwill" in the Common law systems rather than to the "reputation" in the meaning of article 8(5) CTMR. Firstly, the documents provided show rather that the requirement of the reputation is fulfilled when the mark "has come to the attention of the relevant public and has attained a level of significance in the public mind" (para 28). Furthermore, the concepts of "goodwill" and "reputation" are close terms of the Common law that are known to the OHIM and were interpreted by the Court (para 30 with a reference to further case law).



T-196/13; LA NANA Judgment of 16 July 2014; *Nanu-Nana Joachim Hoepf GmbH & Co. KG v. OHIM*; en.



The other party filed the CTM application for goods in classes 16, 20 and 24. The mark was registered on 26 May 2010. On 14 December 2010, the applicant filed a declaration for invalidity based on the earlier German word mark “NANA”, registered for, inter alia, goods in classes 16, 20 and 24. The other party requested proof of use of the earlier German mark. The Cancellation Division rejected the application for invalidity on the ground that the applicant did not prove genuine use of the earlier mark. The appeal filed by the applicant was dismissed. The General court confirmed the reasoning of the Board of Appeal as to the insufficient proof of use of the earlier German mark “NANA”. The evidence submitted by the applicant consisted of two affidavits signed by an employee of a company belonging to the same group as the applicant, and various photos, including one of a Nanu-Nana shop front, and others, undated, of various goods such as folded paper boxes, albums, calendars, stickers, blocks, artists’ materials, cards and other paper products, napkins, recipe books, furniture and home décor articles. The goods depicted all bear labels and stickers with the earlier mark on their packaging. The accompanying documents are not sufficient to corroborate the information given in the affidavits. In particular, the applicant did not furnish other evidence to supplement the turnover figures given in the affidavits (para. 33). Moreover, the content of the affidavits was not sufficiently specific as regards the time and extent of use in relation to the goods covered by the mark. For example, in 2007, it is stated in the affidavits, in respect of Class 16, that the applicant sold 287 types of goods and around 9 million products, with a total turnover of approximately EUR 17 million. Apart from quantitative indications, the affidavits did not contain any additional details as regards the goods or types of goods sold (para. 34). The statements in the affidavits relating to the turnover in respect of Classes 16, 20 and 24 did not make it possible to determine for which goods or which part of the goods in those classes the earlier mark had been used (para. 37). It should not have been difficult for the applicant to obtain additional documents like, for example, invoices, catalogues or newspaper advertisements (para. 39). The ‘*Deitech*’ judgment (T-86/07) quoted by the applicant is not a valid precedent for various reasons: First, the affidavits submitted in ‘*Deitech*’ are not comparable to those in the present case because the goods for which the mark had been used, namely footwear, were mentioned specifically in the affidavits (para. 45). Secondly, the brochures provided in ‘*Deitech*’ confirmed the affidavits as regards the place, time and nature of use in respect of the goods concerned (para. 46). Furthermore, as regards the alleged inability on the part of the applicant to provide other evidence, the fact that the sales slips provided to consumers and delivery notes issued by the manufacturers and suppliers of the goods did not refer to the earlier mark does not preclude the applicant from, for example, providing such documents in order to show, at the very least, the types of goods marketed and also the extent and duration of marketing of the goods. In ‘*Deitech*’, the applicant claimed that it was impossible for it to provide invoices and delivery notes to retailers because it was both the manufacturer and the retailer of its footwear, which it distributed by means of its own subsidiaries, hence the impossibility of providing delivery notes. That is not the case here (para. 48).



T-204/12; **VIAVITA / VILA VITA PARC**, Judgment of 14 July 2014, *Vila Vita Hotel und Touristik GmbH & Viavita v OHIM* – fr.

CTM applied for	Earlier marks
<p style="text-align: center;"><b>VIAVITA</b></p>	<p style="text-align: center;"><b>VILA VITA PARC</b></p> 

The intervener sought to register the word sign **VIAVITA** represented above as CTM for Classes 36 to 45. An opposition based on an Austrian and a German earlier marks below, covering services in Classes 39 and 42 (the Austrian earlier mark) and 3, 35, 37, 39 and 41 (the German earlier mark) was filed on the grounds of Article 8(1) (b). The CTM applicant requested that the opponent filed proof of use of both earlier marks. The Opposition Division (OD) partially upheld the opposition on the basis of Article 8(1) (b) CTMR finding that there was a likelihood of confusion between the marks for certain services in Class 43. The Board of Appeal (BoA) annulled the OD decision and considered that the opponent did not prove the use of the earlier signs as the forms in which the marks were used were under a form which substantially differed from the ones that were registered. On the earlier Austrian mark the argument of the opponent that there was use of the essential part of the mark namely the VILA VITA element was rejected by the General court (GC). It confirmed the assessment of the BoA which held that the PARC element of the mark was not negligible, being a distinctive element not in relation with the services at stake. The GC took note that in fact the earlier Austrian mark had been used as *vila vita hotel & feriedorf Pannonia*. If the element *feriedorf* which means holiday village could be descriptive of the services in question it was not the case of the element *Pannonia*. The BoA was therefore correct in concluding that the form in which the earlier Austrian sign was used differed substantially of the form in which the mark was registered. On the earlier German mark, the GC noted that the figurative elements contained in the mark as registered (a representation of the planet Earth and phone numbers) were not taken in the mark as used, they were replaced by other figurative elements such as a butterfly, different types of palm tree leaves and other verbal elements. These changes are so that they do not allow recognizing the mark as registered. The figurative elements used are above the verbal element VILA VITA and occupy the same important place as the verbal elements. These figurative elements enjoy also a distinctive character as they do not describe the services in question. The verbal elements contribute also to modify the size of the sign and therefore change also the appearance of the mark as registered. The fact that the element Vila Vita is also reproduced in the mark does not alter the correct conclusion of the BoA that the use of this unique verbal element is not enough. The BoA was then correct to hold that the omission of the representation of the planet Earth and the addition of figurative and verbal elements that were not in the registration substantially modified the mark as registered. As the opponent was not able to demonstrate genuine use of the mark the opposition is rejected.



◆ **T-132/12; LAMBRETTA**, Judgment of 30 September 2014, *Scooters India Ltd, v. OHIM* – en. The applicant is the owner of the Community word mark LAMBRETTA since 2001, for goods in classes 6, 7 and 28. In 2007, the intervener applied for partial revocation of the CTM for all the goods (no genuine use). The Cancellation Division (CD) revoked the mark as from 2007 in respect of all the goods. The Board of Appeal (BoA) dismissed the appeal, as it found that the evidence was not sufficient to prove genuine use. The applicant claims that the BoA examined the new evidence submitted to the BoA in isolation, not in conjunction with the evidence already provided to the CD. The General court (GC) stated that the BoA is bound to examine whether or not, in the light of all the relevant matters of fact and of law, a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal. In order to examine whether an earlier mark has been put to genuine use, a global assessment must be carried out, taking into account all the relevant factors. An accumulation of evidence may allow the necessary facts to be established (Para. 25). However, the BoA exclusively assessed the new evidence. It did not even mention the evidence previously submitted to the CD. Furthermore, the BoA did not formally adopt the assessment made by the CD (Para. 26). The GC concluded that the BoA infringed its obligation to carry out a global assessment which took into account all the relevant factors of the particular case.

◆ **T-300/12; FAIRGLOBE / GLOBO**, Judgment of 8 October 2014, *Lidl Stiftung & Co. KG v. OHIM* – en.

CTMA	Earlier mark
	GLOBO

The registration was sought for a figurative sign reproduced above, for the goods in Classes 29 and 30. An opposition was filed by *A Colmeia do Minho Lda*, based on two earlier national marks: (i) Portuguese word mark GLOBO, registered in 1996 for goods in Class 29; and (ii) Portuguese word mark GLOBO registered in 2001, inter alia, for goods in Classes 29 and 30. The opposition relied on the ground set out in Article 8(1) (b) CTMR. At the applicant's request, the opponent was required to provide proof of genuine use of the earlier trademarks in accordance with the Article 42 (2) and (3) CTMR. The opponent referred for this purpose to six invoices provided already in its observation and did not submit any further evidence. The Opposition Division (OD) found that the genuine use of the earlier trademarks had been established for some of the goods referred to and that there was a likelihood of confusion between those marks and the mark applied for concerning the goods at issue which were identical or similar. Based on an appeal filed by the applicant, the Board of Appeal (BoA) granted the appeal in part. The OD as well as the BoA found, in relation to part of the goods, that the opponent had demonstrated to the requisite legal standard that the earlier marks had been put to genuine use in Portugal considering the sales figures contained in the invoices to be sufficient for the purposes of proof of genuine use. As regards the probative value of the six invoices, the General court (GC) highlighted the low level of legibility of those



invoices and found that the BoA was wrong merely to rely on the total amounts of the invoice (Para. 39 and 45). Since proof of use must concern each good and service individually or homogeneous groups of goods and services, the BoA erred in taking into account an aggregation of sales relating indiscriminately to distinct products: “the Board of Appeal took into account the total amounts of each invoice corresponding to the aggregation of the sales figures for all the items referring to the sign GLOBO, even though the goods referred to in those invoices did not all come within the same coherent and homogeneous category of goods” (para. 49). Even if account was taken of the detailed sales figures relating to the categories and subcategories of goods, those figures amount only to hundreds of euros for each product – which is insufficient (para. 52). Although use does not have to be quantitatively significant in order for it to be deemed genuine, it must still be proved by use which objectively is such as to create or preserve an outlet for the goods. In the present case, the sales figures were very low and therefore not enough to exclude the possibility of use that is merely token (Para. 53). It is necessary for a proprietor relying on invoices as evidence to submit a quantity of examples which makes it possible to discount any possibility of merely token use of that mark and, consequently, is sufficient to prove that it has been genuinely used (Para. 55). The submission of number of invoices may support the finding that use was sufficiently important because they were submitted ‘for illustrative purposes’, thus not reflecting the entirety of the sales generated over the relevant period. However in this case, since the opponent did not submit a sufficient quantity of invoices, the low volume of sales in the six invoices cannot constitute conclusive evidence of use which is not minimal at the level of actual sales. The invoices are, therefore, not illustrative of actual amounts (Para. 56). Since the six invoices prove only four specific acts of use over a period of 22 months, it cannot be concluded that there was high intensity or certain constancy over time in the use of those marks (Para. 63). Further, the nature of the goods in question cannot explain the low commercial volume demonstrated in the present case (Para. 65). The GC referred to the judgment *CENTROTHERM*, T-427/09, in which the GC found that invoices which showed only a low degree of use that was limited in time, even accompanied by other documents, admittedly of low probative value, did not enable the BoA to find that the evidence of genuine use was sufficient. It can be concluded, *a fortiori*, that in the present case the six invoices alone, demonstrating only four specific acts of use and a low volume of sales, respectively, for each coherent and homogeneous category of goods, do not make it possible to establish, to the requisite legal standard, the genuine nature of the use (Para. 76). Based on the aforesaid, the first plea of the applicant was accepted and the GC therefore annulled the BoA’s decision in that it found that genuine use of the earlier marks had been demonstrated to the requisite legal standard.



- ◆ **T-543/12; BUGUI VA / BUGUI et al**, Judgment of 24 October 2014, Xavier Grau Ferrer v OHIM, - es.

CTMA	Earlier marks	Forms in which earlier CTM was used
	<p>ES</p>   <p>CTM</p>	<p>BUGUI</p> 

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 31, 35 and 39. An opposition based on the earlier figurative marks represented below, registered for goods in Class 31 (Spanish trade mark) and Classes 31, 32 and 39 (CTM), was filed on the grounds of Article 8 (1) (a) and (b) CTMR. A database printout (Sitadex) corresponding to the earlier Spanish mark, that identifies its figurative nature and colours but without a graphical representation, was attached to the notice of opposition. The Opposition Division partially upheld the opposition on the basis of the only earlier mark considered to be substantiated, i.e. CTM, and found likelihood of confusion after having previously determined that its genuine use for part of the goods had been proven. Both parties appealed. The opponent submitted a new Sitadex printout showing a graphical representation of the Spanish mark. The Board of Appeal (BoA) confirmed the CTM as the only substantiated earlier mark and found genuine use of that mark as registered had not been proven. The BoA dismissed the opponent's appeal and upheld the applicant's appeal. The opponent filed an action before the General Court (GC). During the proceedings before the GC, the judgments of the PROTI cases (C-121/12P and C-122/12P) were adopted and the GC asked the Office if it maintained the position defended in its initial response. Genuine use of the earlier figurative CTM was proven. The nature of use becomes the issue. Even though the evidence does not contain the earlier mark as registered, the GC finds that the three versions of the sign shown by the evidence (see above) differ from the earlier mark in insignificant elements, they being, therefore, 'globally equivalent' (Para. 86). The global impression of the ER is dominated by the distinctive term 'BUGUI', the remaining elements being secondary (descriptive/common/ornamental) (Paras. 81-85).

- ◆ **T-445/12; KW SURGICAL INSTRUMENTS / KA We**, Judgment of 26 September 2014, *Koscher + Würtz GmbH, v OHIM* - de. The applicant designated the EU for its International Registration "KW Surgical" for goods in Class 10. The intervener filed an opposition based on Article 8 (1) (b) CTMR using the earlier German mark "Ka We", registered for goods in Class 10.



The Opposition Division rejected the opposition because the similarity of the signs was held to be insufficient. For reasons of procedural economy the evidence intended to show the proof of use of the earlier mark has not been examined. The Board of Appeal (BoA) upheld the appeal of the intervener, finding that there was likelihood of confusion, taking into account, the identity of the goods and the similarity of the signs. The BoA did not examine the evidence intended to show the proof of use of the earlier mark. The applicant appealed to the General Court (GC), arguing an infringement of Article 8 (1) (b) CTMR. As regards the plea for annulment of the contested decision, with reference to the request for proof of use, the GC deeply analyses this issue from a procedural point of view. It confirms the Case-Law that the genuine use of the earlier mark is a matter which, once raised by the applicant for the trade mark, must be settled before a decision is given on the opposition proper. The request for proof of genuine use of the earlier mark therefore adds to the opposition procedure a specific and preliminary question and in that sense changes the content thereof (Para. 30). Moreover, it follows from that continuity in terms of their functions between the different departments of the Office that, in the context of the review which the BoA must undertake of the decisions taken by the Office units which heard the application at first instance, the BoA are required to base their decisions on all the matters of fact and of law which the parties put forward either in the proceedings before the department which heard the application at first instance or in the appeal (Para. 28). The GC concludes that even if the applicant would not have raised before the BoA the question whether the Intervener has shown genuine use of its earlier mark, this issue has to be examined (Para. 29). As a consequence the GC annulled the decision because the evidence intended to show genuine use of the earlier mark has not been examined.

◆ **T-278/12; PROFLEX / PROFEX**, Judgment of 9 December 2014, *Inter-Union Technohandel GmbH v. OHIM* - en.

CTMA	Earlier German mark
	<p>PROFEX</p>

The applicant sought to register the figurative sign reproduced above for goods in Classes 9, 12 and 25. An opposition was lodged pursuant to Article 8 (1) (b) CTMR, based on the mark reproduced below, covering goods in Classes 6, 8, 9, 11, 12, 16, 17 and 21. Following a request of proof of use, the Opposition Division (OD) rejected the opposition in its entirety, finding that the opponent had not produced sufficient evidence to prove genuine use of the earlier trade mark. On appeal, the Board of Appeal (BoA) annulled that decision and referred the case back, holding in essence that, by failing to consider certain evidence adduced by the opponent, the OD had relied on an incomplete factual basis in taking its decision. The OD gave a new decision in which it concluded that genuine use of the earlier mark had been established with regard to some of the goods for which it was registered, namely, various types of accessories for bicycles and motor vehicles. The OD then examined the likelihood of confusion and partially upheld the opposition in respect of a range of goods in Classes 9 and 12. On appeal, the BoA found that, contrary to the finding made by the OD, the opponent had not demonstrated the extent of the use and had



consequently failed to prove genuine use of the earlier mark. Before the General Court (GC), the opponent alleged an infringement of Article 42(2) and (3) CTMR and Rule 22 CTMIR and an infringement of Article 76(1) CTMR. The GC annulled the BoA's decision. It noted that the evidence of use examined by the BoA included, among other, (i) an affidavit, dated and signed by a representative of the opponent, appended to which were tables, also signed and dated, displaying information on the turnover from the sale of a number of bicycle and motor vehicle accessories marketed under the earlier mark; (ii) three articles in the monthly magazine test, published by the *Stiftung Warentest* (the official German foundation for product testing) which referred to bicycle helmets on the one hand and car seats on the other marketed under the earlier mark, and (iii) dated catalogues referring to bicycle and motor vehicle accessories marketed under the earlier mark and where reference was made to the articles in the *Stiftung Warentest's* magazine tests. The GC confirmed the BoA's finding that, given the links between the signatory of the affidavit and the opponent, probative value could not be attributed to that statement unless it was supported by other evidence (Paras. 52-53). However, the BoA was under a duty to consider whether the evidence, other than the affidavit, substantiated the information given in that statement and should not have confined itself to considering whether that evidence — in itself, without the affidavit — established the extent of the use of the earlier mark (Para. 63). The articles on product testing published in *Stiftung Warentest's* magazine test are different in nature and function from the advertising material at issue in the judgment in case T-298/10 *BIODANZA* (on which the BoA had relied and where the advertising material was the only evidence of use)(Para. 72). The function of the articles concerning *Stiftung Warentest's* magazine test is not to advertise a product, but to present its advantages and disadvantages and to compare it with identical products marketed under other trademarks, in order to help consumers in their choice of purchase. These articles - whatever the extent of their distribution to the public (a point which had been extensively debated by the parties) relate to products which are already on the market and they contain information on the average price of the products on the market. The BoA should have considered both those articles (which provide information concerning the extent of the use of the earlier mark in relation to the products tested) and the references, in the advertising catalogues submitted, to tests carried out by *Stiftung Warentest*, and should have assessed them in the light of the information given in the affidavit (Paras. 74-77). Given that the first plea in law raised by the opponent must be upheld and that the contested decision must be annulled, there is no need to examine the second plea (Para. 78).

[T-463/12](#); **MB / MB&P**, Judgment of 6. November 2014, *Eugen Popp and Stefan M. Zech v OHIM* – de.

CTMA	Earlier CTM
MB	<b>MB&amp;P</b>

The applicant sought to register the word mark represented above as a CTM for “services of a patent attorney’s office” within Class 45. An opposition pursuant to article 8 (1) (b) CTMR was filed on the basis of an earlier CTM represented below and protected for services in class 35 and 42. The CTM applicant requested proof of use. The Opposition Division rejected the opposition due to



the differences between the marks. The Board of Appeal (BoA) allowed the opposition in its entirety. It considered that the proof of use was sufficient for “services of a patent attorney” in Germany and found the likelihood of confusion. The applicant filed an action before the Court claiming infringements of Article 42 (2) CTMR and Article 8 (1) (b) CTMR. As far as the applicant contests the probative value of the affidavit provided as proof of use for the first time in the reply, it is not a new plea in the meaning of Article 48(2) of the Rules of Procedure, but an extension of its plea based on Article 42(2) CTMR which was raised in the application. It is admissible. On Article 42 (2) and 15 (1) CTMR, the numerous invoices filed by the opponent prove together with the business cards and the correspondence the use of the earlier mark for the “services of a patent attorney” for which it is registered in Class 42. The invoices list typical services of a patent attorney (Paras. 38 et seq.). This cannot be questioned by the fact that the invoices contain also opponent’s company name. There is no requirement that a trade mark has to be used in isolation (Para. 43 with a reference to further judgments). Further documents, as business cards and correspondence were filed (Para. 49). The affidavit was made by the partner of the opponent company which could reduce its probative value (Para. 54) unless it is supported by further documents as it was in this case (Para. 58).

**T-341/13; SO BIO ETIC / SO... ?**, Judgment of 23 September 2014; *Groupe Léa Nature SA v OHIM* – en. The applicant sought to register a figurative mark for goods in Classes 3 and 25. An opposition was filed based on the earlier marks: (i) Community trademark **SO...?**, registered for goods in Class 3, and (ii) UK trademark **SO...?**, registered for goods in Class 25, on the grounds of Article 8 (1) (b), Article 8 (4) and (5) CTMR. The Opposition Division (OD) rejected the opposition. The Board of Appeal (BoA) annulled the decision of the OD and rejected the CTM application. According to the BoA, the OD failed to examine whether genuine use had been proven. Further, it found that there was a likelihood of confusion between the signs at issue in relation to identical or similar goods. Finally, it held that, with regard to ‘bleaching preparations and other substances for laundry use’, there was a risk that the sale thereof would be detrimental to the reputation of the earlier marks within the meaning of Article 8 (5) CTMR. The applicant filed an action before General Court (GC) relying on four pleas in law. The second plea alleging an error of law in the assessment of the genuine use of the earlier marks was also rejected. The concept of use of a mark on the market, as a factor of enhanced distinctiveness or reputation, does not have the same scope as the concept of genuine use for the purposes of Article 42 (2) CTMR. The examination relating to whether the earlier mark is distinctive makes it possible, where that mark is found to be distinctive, to strengthen a finding that there is likelihood of confusion with the mark applied for and occurs at the same time as or after the comparison of the signs at issue. By contrast, the examination relating to whether there has been genuine use of the earlier mark takes place at an earlier stage, at the request of the applicant for a trade mark, and is decisive for the examination of the opposition. The BoA did not err in law in finding that the OD had not examined the question of genuine use of the earlier marks and on adjudicating itself on that question (Paras. 35 and 37). For the purposes of Article 42 CTMR it is sufficient that a trademark has been put to genuine use during a part of the relevant period for it. Producing evidence relating to the place, time, extent and nature of use of the trademark in connection with the goods covered, during a specified period, is necessary (Para. 46 and 47). It is sufficient that the opposition is justified on the basis of one earlier right for the registration of that application to be refused (Para. 52).



**T-498/13 NAMMU / NANU**, Judgment of 11 December 2014, *Nanu-Nana Joachim Hoepp GmbH & Co., v. OHIM* – en. The other party before the Board of Appeal (BoA), *Vincci Hoteles SA* sought to register the word mark NAMMU for goods and services in Classes 3 and 44. The sign was registered as a CTM in 2007. Nanu-Nana applied for a declaration of invalidity of the CTM, based on the earlier German word mark NANU, registered *inter alia* for goods in Class 3. The CTM owner requested that the applicant furnish proof of genuine use of the earlier mark. The Cancellation Division (CD) rejected the application for a declaration of invalidity, on the ground that genuine use of the earlier mark had not been proved. The BoA dismissed the appeal. The evidence of use was insufficient, as the affidavits set out only global turnovers for goods in Class 3 without any further detail. Furthermore, the photographs were inconclusive and did not show that the goods were marketed in Germany during the relevant period and the argument that it had been unable to submit other documents like invoices or catalogues was inconclusive. The General Court (GC) finds that the third affidavit and the accompanying data, submitted for the first time before the GC, are not a confirmation of the first and second affidavit. They are thus inadmissible (paragraph 37). Figures in the 1<sup>st</sup> and 2<sup>nd</sup> affidavits concern goods in Class 3 generally and do not make it possible to ascertain what use was in fact made of the earlier mark, particularly because they do not show the extent of use in Germany during the relevant periods. The labels affixed to the goods in the photographs are almost all in English or in languages other than German, so that they do not show on their own that the earlier mark was in fact used in Germany. An overall assessment of the evidence submitted shows that proof of genuine use has not been furnished. This conclusion is not called in question by the DEITECH Judgment (Case T-86/07), which can be clearly distinguished from this case. In DEITECH, in addition to the written statements of its employees, the applicant submitted brochures which constituted sufficiently solid and objective supporting evidence. Furthermore, precise particulars were also submitted as to the volumes of sales of shoes and the turnover generated and the difficulties in providing other evidence were plausible, contrary to what happens in the current case (paragraphs 51-53). The application is dismissed.

**T-374/12; KASTEEL / CASTEL BEER**, Judgment of 25 November 2014, *Brouwerij Van Honsebrouck v OHIM* – fr. The applicant obtained the international registration with the designation of European Community, registered for the goods and services within Class 32, namely beers, ales. An opposition based on the earlier French word mark CASTEL BEER, registered for goods in Class 32, beers, was filed on the grounds of Article 8 (1) b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) dismissed the applicant's appeal finding that (i) the opponent proved the genuine use of the earlier mark, (ii) the goods are identical and (iii) the marks are visually similar in the way that the more distinctive part of the earlier mark "CASTEL" coincides with the sole word element of the application. Further, the figurative element of the application has only a decorative function. The marks are not conceptually similar, except for a part of relevant public that will perceive the meaning of both terms "KASTEEL" and "CASTEL" as "castle". The applicant filed an action before the General Court (GC). The applicant claims that the evidence submitted by the opponent has not proved sufficiently the genuine use of the earlier mark in France (Para. 33). The requirement of genuine use is not aimed for evaluation of the commercial success of the trademark holder, for a control of the strategy of an enterprise or even to reserve the trademark protection only for quantitatively important commercial operations (Para. 41). The turnover and the amount of sales of the goods sold under the earlier mark cannot be assessed in absolute terms and must be related to other factors, such as the volume of commercial activity, production or marketing capacity or the degree of diversification of the undertaking using the



trademark and the characteristics of the products or services on the market concerned (Para. 42). Since the internet article submitted as an evidence of genuine use does not relate to the relevant period, it cannot prove the genuine use as sole evidence. It must be considered, however, that the duration of commercial life of such product generally extends over time and the continuity of the use also provides indications to be taken into account for establishing that the use was objectively intended to create or maintain a market share. Therefore the evidence not covered by the relevant period, nevertheless far from being devoid of interest, must in this case be considered and evaluated in conjunction with other elements, as it can bring evidence of actual commercial exploitation and reputation of the mark (Para. 51). In regards of genuine use, it is not possible to make a distinction within the category of goods “Beers” in terms of their origin for the purposes of examination of the importance of use. The criterion of purpose or destination is a key criterion in the definition of a sub-category of the goods and services since it guides the choice of the consumer when searching for a product or service that can meet its specific needs. In case of beers the purpose of the goods is identical, irrespective of their origin (Para. 58). In regards of the affidavit serving as evidence, it is appropriate to verify the credibility and veracity of the information contained therein, taking particular account of the origin of the document, the circumstances of its issuance and its recipient, and to ask whether the document appears sound and reliable. In this case, the certificate in question comes from a manager of a branch of a company which, although linked to the intervener by a trademark license agreement, is a third party, independent of the intervener. In addition, the information provided by the certificate is supported by sales invoices for the products concerned (Para. 61).

**T-538/12; ALPHATRAD**, Judgment of 16 January 2014, *Optilingua Holding SA v OHIM* - fr. A request for a declaration of revocation for non-use was filed against the figurative CTM ‘ALPHATRAD’ registered for services in Classes 35, 38, 41 and 42. The Cancellation Division revoked the CTM in its entirety. The Board of Appeal (R 444/2011-4) dismissed the CTM proprietor’s appeal. The only proof of use consisted of 9 reminders to clients in respect of pending payments the amount of which is unknown (except one which refers to a pending payment of 338 €). The Board of Appeal considered that proof of the extent of use was missing. The CTM proprietor filed an action before the General Court. The CTM proprietor only challenged the Board’s finding as regards ‘commercial translation’ services in Class 42, on the basis of additional material which was submitted for the first time before the GC. The General Court dismissed the appeal. Since the Board was not required to examine *ex officio* the genuine use of the contested mark, the new evidence of use provided for the first time before the General Court is declared inadmissible (Para. 20). The CTM proprietor’s argument that the Board should have presumed the existence of other letters is unfounded (Para. 33). The 9 reminders to clients in respect of pending payments only show a sporadic and symbolic use which cannot be held as genuine use (Para. 39). It does not appear that the letters are numbered upwards in chronological order, so that no conclusion on the extent of use can be drawn (Para. 42). The registration does not cover debt collection services but ‘commercial translation’ services, the use of which could have been easily proven by submitting invoices and brochures (Para. 43).



C-141/13 P; **WALZERTRAUM / WALZERTRAUM**, Judgment of 17 July 2014, *Reber Holding GmbH & Co. KG v OHIM* – de.

CTMA	Earlier Mark
	Walzertraum

The applicant sought to register the figurative represented above as a CTM for goods within Classes 21 and 30. An opposition based on the earlier national word mark **Walzertraum** registered for goods in Class 30, with the following description: bakery products, confectionery, chocolate products and sweets, was filed on the grounds of Article 8 (1) (b) CTMR. The Opposition Division upheld the opposition. The Board of Appeal (BoA) upheld the applicant's appeal finding that the opponent did not provide sufficient proof of use of the earlier mark. The opponent filed an action before the General Court (GC). The GC dismissed the action. The opponent filed an appeal before the European Court of Justice (CJ) alleging the violation of Article 42 (2) in connection with Article 42 (3) CTMR and the violation of the principle of equal treatment. The CJ emphasized that the qualification of genuine use depends on the characteristics of the goods or services concerned and on the relevant market. Therefore, not every proven commercial operating can be deemed automatically as a genuine use of the mark at issue (Para. 32). The GC correctly applied the concept of genuine use when conducted an overall assessment taking into account the sales volume of the product protected by the mark, the nature and characteristics of the product, the geographic extent of the use of the mark, advertising carried on the website of the opponent and the continuity of the use of the earlier mark, realizing some interdependence between the factors likely to prove genuine use of the mark (Paras. 33 and 34). The examination of the genuine use must be based on the goods as specified in the trade mark application and not on a possible marketing concept (Para. 43). Application of the principles of equal treatment and sound administration must be always exercised with respect to the principle of legality (Para. 45). The appeal to CJ which merely repeats or reproduces the pleas and arguments previously submitted to the GC without specifically identifying the error in law vitiating the judgment under appeal, is in reality an application for a re-examination of the action submitted to the GC which falls outside the jurisdiction of the CJ (Para. 54). In regards of the argument on incorrect determination of the category of goods, the GC was correct in holding that the relevant market is a German chocolate market (Para. 56). The GC is not bound by the decisions of the Office therefore the argument on the difference of the treatment related to a previous decision of the Office is unfounded (Para. 57).



## V. OTHER CANCELLATION

### A. Article 52(1) (b) CTMR - Bad Faith

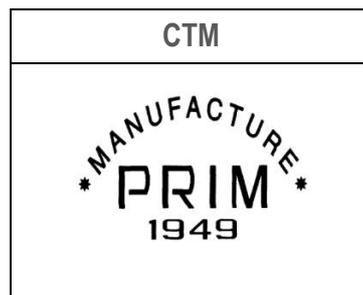
**C-65/12; RED BULL.** Preliminary Ruling of 16 January 2014, *Bulldog e.a. v. Red Bull* – en. RED BULL is the owner of the Benelux word and figurative mark RED BULL KRATING-DAENG, registered 11/7/83, inter alia for 'non-alcoholic drinks) Mr de Vries is the owner of several Benelux marks for goods in Class 32: THE BULLDOG (word and figurative), registered on 14/7/83; THE BULLDOG (word), registered on 23/12/99; THE BULLDOG ENERGY DRINK (word and figurative), registered on 15/6/2000. Before RED BULL filed its mark in 1983, Mr de Vries was using the sign THE BULLDOG as a trade name for hotel, restaurant and café services. RED BULL brought an action requesting that Mr de Vries be ordered to cease production and marketing of energy drinks in packaging that displays the BULL DOG sign. Mr de Vries brought an appeal before the Dutch Supreme Court against a restrictive interpretation of the concept of DUE CAUSE. In his view, use in good faith of the sign THE BULLDOG as a trade name, before the mark RED BULL KRATING DAENG was filed, constitutes due cause. The Dutch Supreme court then asked, should Art. 5(2) TMD be interpreted as meaning that the use by a third party of a sign that is similar to a trade mark with a reputation in relation to goods identical may be considered to be with 'due cause' if it is demonstrated that that sign was being used before that mark was filed? The European court of Justice (CJ) ruled that it rejects a restrictive concept of due cause. Due cause may not only include objectively overriding reasons, but it may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation (Para. 45). The concept of due cause is intended to strike a balance between the interests in question, by taking account of the interests of the third party using that sign (p. 46). The proprietor of a trade mark with a reputation (red bull) may be obliged, pursuant to the concept of due cause, to tolerate the use by a third party of a sign similar (the bulldog) for an identical product, if that sign was being used before the mark was filed and the use in relation to the identical product was made in good faith. The national court must take account, in particular, of, the intention of the person using that sign (Para. 55), how that sign (the bulldog) has been accepted by, and what its reputation is with, the relevant public. Furthermore it must take into account the degree of proximity between the goods and services for which that sign (the bulldog) was originally used and the product for which the reputed mark (red bull) was registered. It must also take into account if it is a natural extension of the range of services and goods for which the sign (the bulldog) already enjoys certain repute with the relevant public? (Paras. 57-58) Finally it must take into account the economic and commercial significance of the use for that product of the sign which is similar to that mark. The greater the repute of the sign (the bulldog) was used before, the more its use will be necessary for marketing a product identical to that for which the mark (red bull) was registered, *a fortiori* as that product is close to the range of g/s for which that sign was previously used (Para. 59)

**T-327/12; SIMCA,** Judgment of May 8, 2014, *Simca Europe Ltd. v. OHIM* – de. The invalidity applicant requested the declaration of invalidity of the CTM SIMCA (word) for goods in Class 12 based on bad faith (Article 52 (1) (b) CTMR). The Cancellation Division dismissed the action. The Board of Appeal (BoA) reversed the decision of the first instance and declared the invalidity of the CTM because it found that the application has been filed in bad faith. **SUBSTANCE:** The General



Court (GC) confirmed the Case-Law that the three factors set out in the judgment C-529/07, *Chocoladefabriken Lindt & Sprüng* are only examples drawn from a number of factors which can be taken into account in order to decide whether the applicant was acting in bad faith at the time of filing the application. Consequently, account may also be taken of the origin of the word or the sign which forms the mark at issue and of the earlier use of that word or sign in business as a mark, in particular by competing undertakings, and of the commercial logic underlying the filing of the application for registration of that word or that sign as a Community trade mark (Paras. 38 and 39). The mark SIMCA has been used for cars since 1930 and the invalidity applicant has trademark protection for SIMCA in different Member States as France, Germany, Spain etc. for goods in Class 12. However, the mark has not been used since 1980 (Para. 42). The mark had at the date of filing still a certain degree of reputation among the public interested in cars. The applicant knew this residual reputation of the SIMCA marks and was looking for an appropriate mark which was no longer used and which accordingly had no legal protection (Paras. 45 - 53). The GC finally concluded that the BoA was entitled to infer from the particular circumstances of the present case that the real purpose of the applicant was to ‘free-ride’ on the reputation of the invalidity applicant’s registered marks and to take advantage of that reputation (Para. 56). The judgment puts the emphasize that the clear and evident intention to take advantage of the residual reputation of the sign SIMCA on the motor vehicle market, to create an association with the earlier marks and to compete with those earlier marks if they were re-used by the invalidity applicant is to be considered as bad faith in the sense of Article 52 (1) (b) CTMR (Para. 63). This conclusion is not based on the “offer of compensation” to the invalidity applicant (Para. 70). The fact that the applicant had started the use of the registered SIMCA mark is not relevant (Para. 74). Also the fact, that the applicant worked in the past for the invalidity applicant is not decisive for the outcome (Para. 79).

**T-215/12; MANUFACTURE PRIM 1949**, Order of 02/10/2014; *MPM-Quality v.o.s. and Eutech a.s. v OHIM* – cs.



An application for invalidity was filed against the figurative CTM represented above and registered for goods in Classes 9, 14 and services in Class 35, based on Articles 52(1)(b) and 53(1)(a) CTMR (bad faith filing and relative grounds for invalidity (likelihood of confusion, unfair advantage/detriment)). The Cancellation Division rejected the request, stating that the application for invalidity was inadmissible according to Article 165(4) (b) insofar as it was based on Czech and Slovak earlier trademarks. Regarding the invoked earlier international trade mark, the submitted evidence was not enough for proving genuine use. Bad faith was not proven in the proceedings either; mere knowledge of the earlier marks is not sufficient, in itself, to conclude that the applicant was acting in bad faith. The Board of Appeal (BoA) dismissed the applicants’ appeal. The applicants filed an action before the General court (GC). The GC rejected the action as partially



manifestly inadmissible and partially manifestly lacking any foundation in law. The action was found to be unclear and poorly structured (par 22); the GC nevertheless identified six pleas in law: (1) breach of Article 8(1)(a)(b) CTMR; (2) breach of Article 8(5)CTMR; (3) breach of Article 54 and 165(4) CTMR; (4) breach of Article 56 and 41 CTMR; (5) incorrect assessment of evidence of use of earlier international registration; (6) breach of Article 52(1)(b) CTMR. The first two pleas in law were rejected as irrelevant, because the applicants requested the Court to carry out a substantial assessment of Articles 8(1) and (5), which was not carried out by the BoA. The third plea in law was found to be manifestly lacking any foundation in law. A CTM cannot be declared invalid if the earlier national right was registered, applied for or acquired in a new Member State prior to the date of accession (Art 165(4) CTMR). Article 54 invoked by the applicants was not at all mentioned in the BoA's decision. The fourth plea in law is manifestly inadmissible. The arguments of the applicants stating that the assertions of the Office regarding joint ownership of the earlier marks are "totally irrelevant and unfounded" are not sufficiently clear and precise to enable the defendant to prepare its defence and the GC to exercise its power of judicial review. Regarding the fifth plea, the part of applicants' argumentation where they state that the Office "essentially erred in law" as it did not attribute sufficient weight to the evidence provided (one affidavit), is considered manifestly inadmissible, as it is too general to enable the defendant to prepare its defence and the GC to exercise its power of judicial review. The applicants' argument that the submitted affidavit was "incorrectly assessed by the Office" is considered manifestly unfounded; it is evident that the BoA duly examined the affidavit in question before concluding that it was not enough to prove use of the earlier international registration. The sixth plea is partially manifestly inadmissible and partially manifestly unfounded. Firstly, the applicants' arguments are very short, unclear and imprecise. The applicants criticise the Office for not having taken into account the evidence submitted by them and for not having given appropriate weight to such evidence. This criticism is again too vague and hence manifestly inadmissible. The arguments regarding previous knowledge of the applicants' marks by the CTM proprietor are manifestly unfounded. Firstly, this fact became clear during the proceedings and secondly, mere knowledge is not sufficient, in itself, to conclude that the applicant was acting in bad faith. The applicants' assertions that the BoA did not deal with the issue of licence agreements between the parties is erroneous, because the BoA dealt with this issue in paragraph 41 of the contested decision. Regarding the inclusion of numeral 1949 in the contested CTM, supposedly giving a wrong impression about the company's history and hence inserted in bad faith, the GC stated that mere insertion of a year in the contested CTM cannot be on its own conclusive about any bad faith on the part of the CTM proprietor. This argument is manifestly unfounded.

**T-506/13; URB**, Judgment of 7 November 2014, *Urb Rulmenti Suceava SA v OHIM* - en. This case concerns a situation where the Romanian collective trade mark URB were once exploited by different producers of bearings, under the control of a public entity linked to the Romanian Government and which also owned those collective marks. Following the start of a privatisation process, the assets of this public entity were transferred to a private company which became the registered owner. However, several companies, including the invalidity applicant and another company of which the CTM proprietor, a physical person, was the manager and shareholder, were authorised to use the earlier collective trademarks. In 2002, following an amendment, the use regulation did no longer contain the list of undertakings authorised to use those collective trademarks. It was rather established that third parties would have the right to use them only under a franchise agreement managed by the registered proprietor of those trademarks, but the invalidity



applicant never entered such an agreement. Following registration of the contested mark **URB** by the CTM proprietor, the invalidity applicant sought its cancellation, relying, on the one hand, on two earlier registered Romanian collective trademarks and on two International trademark registrations designating a number of Member States and, on the other, of the alleged bad faith of the CTM proprietor. The evidence showed that these four registrations stood in the name of a third company, The invalidity applicant asserted that it was authorised to use those trademarks and to file the invalidity action, as the registered owner of those trademarks, expressly requested, had declined to do so. The Cancellation Division rejected the invalidity request on the grounds that no evidence had been adduced of the bad faith of the CTM proprietor and that the invalidity applicant, which was not the proprietor of the earlier marks, was not entitled to rely on them to argue the existence of a likelihood of confusion. On appeal, the Board of Appeal confirmed the first instance's decision. The General Court (GC) dismissed the appeal. It was not persuaded by the invalidity applicant's argument that, given the refusal to act of the registered owner of the earlier marks, it was entitled, pursuant to the provisions of Article 22(2) and (3) and of Article 72 CTMR, to bring invalidity proceedings. In first place, the GC noted that under Article 56(1)(b) CTMR, an application for a declaration of invalidity may be submitted to the Office, where Article 53(1) applies, by the proprietors of earlier trademarks and licensees authorised by the proprietors of those trade marks (Para. 17). It did not appear from the documents before the GC that the invalidity applicant either had a licence or, in any event, had been authorised by the registered proprietor of the earlier marks to file an application for a declaration of invalidity with the Office (Para. 19). Secondly, the GC noted that the provisions of Articles 22(3) and 72 CTMR are not applicable to invalidity requests but only to actions for infringement, and that the same was true of the provisions of Romanian law relied on by the invalidity applicant (Para. 20). As to the alleged bad faith, the GC referred to the existing Case-Law and recalled that account may also be taken of the commercial logic underlying the filing of the application for registration of a Community trade mark. Even in circumstances where several producers were using, on the market identical or similar signs for identical or similar products, capable of being confused with the sign for which registration was sought, still the CTM proprietor's registration of the sign may be in pursuit of a legitimate objective (Para. 35). The GC held that it was understandable, from a commercial point of view that the CTM proprietor wished to extend the protection of the **URB** trade mark by registering it as a Community trade mark. In that respect, the evidence on file showed that, during the period which preceded the filing, the CTM proprietor used the trademark, through a connected company, and generated turnover from goods marketed under the trademark in several Member States, which was a plausible incentive for filing an application for the registration of a Community trade mark (Para. 41). The invalidity applicant did not establish that it was the CTM proprietor's intention to exclude it from the market (Para. 44). The fact that the CTM proprietor knew or should have known that a third party (i.e. the invalidity applicant in this case) has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the CTM proprietor was acting in bad faith when filing the application (Para. 47).





had failed to assess accurately the precise scope of its own powers. Had the Board considered itself competent to assess the validity of the 1986 agreement, it might have come to a different conclusion. The Office filed an appeal to the European Court of Justice (CJ), raising three pleas in law and alleging (i) infringement of Article 76(1) CTMR and of Rule 37 CTMIR; (ii) infringement of the right to be heard, insofar as the Office's right to be heard regarding the judgment of 14 June 2007 was not observed; and (iii) manifest inconsistency and distortion of the facts which affect the reasoning followed and the conclusion reached by the GC. In particular, by its first plea, the Office submitted that the GC could not rely on an article of the Italian Civil Code and on the judgment of the Italian Supreme court of Cassation, since those two factors had not been invoked by the parties and did not, therefore, fall within the subject-matter of the dispute brought before the BoA. The Office argued that it read the judgment of the CJ in Case C-263/09 P *Edwin v OHIM* as confirming that it is for the party relying on national law to provide the Office not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law. The CJ held that it is not apparent from the judgment in *Edwin v OHIM* that a rule of national law, made applicable by a reference such as that in Article 53(2) CTMR, should be treated as a purely factual matter, the existence of which the Office and the GC merely establish on the basis of the evidence before them (Para. 37). The review by the Office and by the GC must be conducted in the light of the requirement of ensuring the practical effect of the CTMR, which is to protect registered CTMs (Para. 40). The scope of the decision the Office is called to take in an invalidity scenario necessarily implies that the Office's role cannot be of mere validation of the national law as submitted by the invalidity applicant (Para. 43). The GC must be able to confirm, beyond the documents submitted, the content, the conditions of application and the scope of the rules of law relied upon by the applicant for a declaration of invalidity (Para. 44). The GC did not err by holding that the Office must — of its own motion and by whatever means considered appropriate — obtain information about the national law of the Member State concerned, where such information is necessary for the purposes of assessing the applicability of a ground for invalidity relied on before it and, in particular, for the purposes of assessing the accuracy of the facts adduced or the probative value of the documents submitted (Para. 45). Since the parties before the GC were not given the opportunity to submit their observations on the above mentioned judgment of the Italian Supreme Court of Cassation, the GC infringed the Office's right to be heard (Paras. 57-60). The CJ therefore set aside the judgment of the GC and referred the case back to the lower instance for a ruling on the merits of the action.

**C-409/12; KORNSPITZ**, Preliminary Ruling of 6 March 2014; *Backaldrin Österreich The Kornspitz Company GmbH v Pfahnl Backmittel GmbH* – de. Backaldrin is the owner of the Austrian mark “KORNSPITZ” for bakery goods and baking mixes in Class 30. The company produces a baking mix which it supplies primarily to bakers. They turn that mix into bread rolls with a specific shape. Backaldrin consented to the use of that trade mark by the bakers in the sale of that bread roll. Pfahnl, a competitor of Backaldrin, filed a revocation request against “KORNSPITZ” under paragraph 33(b) of the Austrian TMA before the Austrian Patent Office (*Österreichisches Patentamt*), alleging that it has become the common name of the bread roll. The competitors of Backaldrin are aware that KORNSPITZ is a trade mark. However, according to Pfahnl, the end consumers perceive the sign as the common name for bread rolls which are oblong in shape and have a point at both ends. This perception is also due to the fact that the bakers do not inform the



end consumers that KORNSPITZ is in fact a trade mark. The Cancellation Division of the Austrian Patent Office granted the application for revocation. Backaldrin appealed against that decision to the Supreme Patent and Trade Mark court (*Oberster Patent- und Markensenat*). The Supreme Patent and Trade Mark court referred three questions to the European court of justice (CJ) concerning the interpretation of Article 12(2) (a) TMD. The first question relates to the relevant public for assessing whether a trade mark has become the common product name. The second question seeks guidance as regards the term “inactivity” in the meaning of Article 12(2) (a) TMD. The third question refers to the possible relevance of alternative names when applying this norm. The CJ replied to the questions as follows: Article 12(2) (a) TMD must be interpreted as meaning that, in a case such as that at issue in the main proceedings, a trade mark is liable to revocation in respect of a product for which it is registered if, in consequence of acts or inactivity of the proprietor, that trade mark has become the common name for that product from the point of view solely of end users of the product (Para. 30). Article 12(2) (a) TMD must be interpreted as meaning that it may be classified as “inactivity” within the meaning of that provision if the proprietor of a trade mark does not encourage sellers to make more use of that mark in marketing a product in respect of which the mark is registered (Para. 36). Article 12(2) (a) TMD must be interpreted as meaning that the revocation of a trade mark does not presuppose that it must be ascertained whether there are other names for a product for which that trade mark has become the common name in the trade (Para. 40).

◆ **T-453/11; LAGUIOLE / FORGE DE LAGUIOLE**, Judgment of 21 October 2014, *Gilbert Szajner v. OHIM* – fr. The term **Laguiole** is the name of a small city in France known for its production of cutlery, and the generic name of a specific knife. The CTM Laguiole had been refused in respect of “side arms” in Class 8. It was however registered for G&S in Classes 8, 14, 16, 18, 20, 21, 28, 34 and 38. A request for cancellation was filed by the French company **Forge de Laguiole** on the basis of the earlier rights held on its corporate name (Article 53(1) (c) and 8(4) CTMR). The protection was claimed in respect of the activities mentioned in the company’s articles of incorporation that is, “production and sale of all articles of cutlery, scissors, presents which are all articles related to tableware”. The request for cancellation was dismissed in its entirety by the Cancellation Division. On appeal, the Board of Appeal (BoA) annulled this decision and declared the CTM invalid for all G&S except services in Class 38. The BoA considered that, according to the French law (including its Case-Law) a corporate name is protected in respect of all activities carried out in accordance with its articles of incorporation, provided such activities are sufficiently specified therein. This was the case of “production and sale of all articles of cutlery, scissors”. Regarding activities which might be too unspecific (“production and sale of presents – all articles related to tableware”), the BoA had regard to the concrete activities for which the cancellation applicant had engaged business. It found in particular that the cancellation applicant had been active in the trade of products relating inter alia to tableware, hunting, wine tasting, golf and smoking. According to Article L711-4 of the French IP Code, a corporate name is protected against use of a later mark under the condition of the existence of a risk of confusion. The BoA considered that, as descriptive as it may be the word **Laguiole** was co-dominant in the earlier corporate name and that the goods and services for which the CTM is registered are identical or similar to the activities for which the earlier corporate name is protected. In its application before the General court (GC), the CTM holder claimed a violation of Article 53 (1) (c) CTMR and 8(4) CTMR. In particular, it claimed that the protection of corporate names according to the French law was subject to the principle of speciality, as for trademarks, and was limited to the specific activities



currently carried out by a company (without regard being due to the activities mentioned in the articles of incorporation). The CTM holder therefore contented that the earlier right should not be protected beyond the activity of cutlery and that none of the contested good and services were similar to cutlery.

As regards the admissibility of a national judgment rendered after the contested decision and its impact on the review of legality, the CTM holder submitted, for the first time before the GC, a judgment of the French Supreme Court adopted after the Board's decision and which supported its view, as well a number of other documents. While the latter was considered inadmissible (para. 23), the former was considered admissible (para. 24).

The principle following which the party who relies on 8(4) must submit the content of the national law (C-263/09 Fiorucci) does not exclude the possibility to control the legality of the Board's decision in the light of a national decision which has been adopted on a subsequent date (para. 24 and 45). This is all the more so where a judgment merely clarifies the Case-Law (para. 46). Interpretative judgments have a retroactive effect: the Case-Law in force on a given date does not lead to acquired rights (para. 48). Even if the French Supreme Court's judgment is, as such, a "new fact", it interprets the French law as the Board should have done on an earlier date and as the GC must now do (para. 50).

In regard to scope of protection of a corporate name according to the French law the GC does not question that the right to oppose or cancel a later trade mark (as foreseen under Article L711-4 of the French IP Code) includes the right to prohibit its use, within the meaning of Article 8(4) (para. 37). The GC further observes that the issue of the scope of protection of corporate names was debated in the French Case-Law until the French Supreme Court adopted a judgment on 10 July 2012 by which it held that "the corporate name is protected only in respect of activities currently carried out by the company rather than for those listed in the articles of incorporation" (para. 43).

The conclusion is therefore that the protection of the corporate name "Forge de Laguiole" must be limited to the activities which were concretely carried out by the cancellation applicant on the date of which the contested CTM was filed (para. 51). The GC challenges that this corporate name was ever used in activities other than cutlery and forks (para. 72). Use in respect of boxes for knives, casings, bottle-openers or multi-functional knives (that is, mere accessories rather than "autonomous products") cannot extend the scope of protection recognised to the corporate name (para. 60-66).

On likelihood of confusion, the GC examined likelihood of confusion in the light of the principles set by the French Case-Law that is, an overall examination of relevant factors including the similarity of the signs, the degree of similarity of the economic sectors covered by these signs and the higher or lower inherent degree of distinctiveness of the earlier sign (Para. 78). The GC confirmed that the "Hand tools and implements (hand operated); spoons; saws; razors, razor blades; shaving cases; nail files and nail nippers, nail-clippers; manicure sets" in Class 8 and "paper-cutters" in Class 16 are similar to the cutlery activity of the cancellation applicant (Para. 85-94). "Screwdrivers" are however dissimilar (Para. 93). "Shaving brushes, fitted vanity cases" in Class 21 are complementary to sharp instruments such as knives and can be sold in the same outlets. They are therefore similar (Para. 85). "Corkscrews; bottle-openers" are similar to the cancellation applicant's knives equipped with cork-screws (Para. 97). However, kitchen utensils, earthenware



and recipients are dissimilar, having in mind that the earlier right cannot claim protection for “tableware” in general (Para. 96). “Precious metals; precious stones, boxes in precious metals” in Class 14 are dissimilar to cutlery (Para. 99). The same conclusion applies to “leather goods, cases, boxes” in Class 18. The fact that casings for knives can be made of leather does not suffice to establish a degree of similarity given that leather is a raw material addressed at manufacturers whereas knives are addressed at the end users (Para. 101). Likewise, all goods in Class 16 are dissimilar to the cancellation applicant’s activity, except “paper-cutters” and “envelopes” (to a low degree). The sole fact that paper products, including catalogues, are necessary for carrying out a company’s business does not create a degree of similarity. Equally, the fact that papers and printed matters can be sold in the same retail outlets as “paper-cutters” is not decisive given that stores selling writing instruments usually offer for sale a vast assortment of products (Para. 104). The same conclusion applies to jewellery, bags, frames etc. (Para. 106), sport articles, smoking articles (Paras. 107 and 110) with the exception of “cigar cutters; pipe cleaners” in Class 34 (this is because the cancellation applicant had shown use for a cigar cutter, Para. 109).

Regarding the comparison of the signs, the GC noted that the word “Laguiole” has a descriptive nature in respect of knives and, more generally, in respect of the core activity of the cancellation applicant. However, the same can be said about the word “Forge” (Para. 124). Taken on their whole, the signs have a medium degree of visual and aural similarity, and a high degree of conceptual similarity (Paras. 125-127).

The GC assessed the distinctiveness acquired by use of the earlier corporate name in the same manner as it would do for trade marks (Paras. 132-133). However, the cancellation applicant did not substantiate a reputation for its corporate name (Paras. 159-160), notwithstanding the awards it received for its knives and collaborations with celebrities (Paras. 143, 148, 155). The media exposure given to the cancellation applicant was limited (Para. 157). Likelihood of confusion is established in respect of goods which have a high or medium degree of similarity with the cancellation applicant’s activities, that is, “Hand tools and implements (hand operated); spoons; saws; razors, razor blades; shaving cases; nail files and nail nippers, nail-clippers; manicure sets” in Class 8; “paper-cutters” in Class 16, “corkscrews; bottle-openers; shaving brushes, fitted vanity cases” in Class 21 and “cigar cutters; pipe cleaners” in Class 34 (Paras. 162-163). The CTM is annulled in respect of such goods. Likelihood of confusion is excluded for all other goods, including “envelopes” which have only a remote degree of similarity with the cancellation applicant’s paper-cutters and its activity of production of knives (Para. 164).

◆ **T-307/13 ORIBAY**, Judgment of 9 December 2014, *Capella EOOD v. OHIM* – es. The applicant requested the revocation of the CTM ORIBAY, registered for goods and services in Classes 12, 37 and 40. Regarding the goods in Class 12, the request quoted the goods for which the mark had been registered, but added: ‘with the exception of’ four subcategories of goods for which the applicant admitted that the mark had been used. The Cancellation Division (CD) declared the revocation as requested by the applicant. The Board of Appeal (BoA) annulled the CD decision and dismissed the revocation request. It declared inadmissible the Class 12 request, as it should have been directed against all the products for which the CTM had been registered. The BoA took the view that it is not possible to apply for revocation for lack of use while at the same time admitting that the mark has been used. The applicant invokes breach of Article 51(1) (a) and



Article 56 CTMR as well as of Rule 37(a) (iii) CTMIR. The Office did not defend the decision of the BoA. The General Court (GC) stated, that when a mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, an applicant for revocation who considers that the contested mark has been genuinely used for part of the products or services can legitimately exclude from the revocation request those products or services (Para. 25). The BoA erred in declaring the request inadmissible (Para. 30). It also erred in considering that the request breached the general principle *nemo potest venire contra factum proprium* (No one may set himself in contradiction to his own previous conduct) (Para. 32).

### C. Article 54 CTMR – Acquiescence

**T-281/13; METABIOMAX / metabiarex**, Sofia Golam v OHIM, *Judgment of 11 June 2014* - el. The applicant sought to register the word mark METABIOMAX as a CTM for goods and services within Classes 5, 16 and 30. An opposition based on the earlier word mark metabiarex, registered for goods in Class 5, was filed on the grounds of 8(1)(b) CTMR. The Opposition Division (OD) upheld the opposition for all goods in Class 5, with the exception of ‘herbicides’. The Board of Appeal (BoA) partially annulled the decision of the OD. The applicant filed an action before the General Court (GC). The fact that the opponent in the past did not oppose the registration of other marks containing the elements “meta”, “bi” and the letter “x” cannot preclude it from exercising its rights under 8(1)(b) and 8(2)(a)(ii) CTMR (Para. 55).



## VI. DESIGN MATTERS

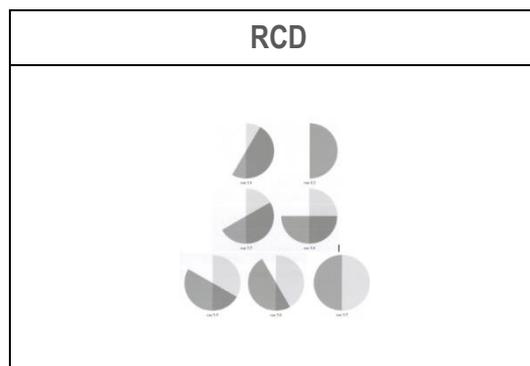
### A. Article 3(a), 9 CDR - Registration Proceedings

[C-479/12](#); **Design of a gazebo**, Preliminary Ruling of 13<sup>th</sup> February 2014. *H. Gautzsch Grosshandel GmbH & Co. vs. Münchener Boulevard Möbel Joseph Duna GmbH - de.*

The plaintiff in the national proceedings before the German Courts produced and sold a gazebo. The defendant started to sell its own gazebo, imported from China. The plaintiff brought infringement proceedings, claiming that the defendant's gazebo infringed its prior unregistered Community design rights. The defendant claimed that the challenged design had been independently created in China at the beginning of 2005, that it was presented to European customers in March 2005 at the Chinese manufacturer's showrooms in China and that a model had been sent to a Belgian company in June 2005. The European Court of Justice (CJ) first addressed the issue of the *scope of the concept of 'disclosure'* in the context of the conflict between two *unregistered designs*. Referring to the need to prove that the earlier design has become known, in the normal course of business, to the members of the circles specialised in the sector concerned, operating within the European Union, the CJ held that it is possible that an unregistered design may reasonably have become known in those circles if images of the design were distributed to traders operating in that sector, this being a question of fact to be assessed by the national court, having regard to the circumstances of the case before it. By this finding the CJ endorses a broader notion of the relevant 'specialised circles', which are not to be construed as only including persons which are involved in creating designs and developing or manufacturing products based on those designs. The CJ then addressed the issue of *disclosure to one single undertaking* and held that it is possible that an unregistered design may not reasonably have become known to the relevant circles, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, this also being a question of fact to be assessed by the national court. This confirms that it might prove difficult to show that the prior art has been made available to the relevant specialised circles if the disclosure is limited to one single undertaking. The CJ then dealt with the issue of the *burden of proof* in demonstrating copying in unregistered Community design infringement proceedings and, while confirming the established principle that the burden of proof rests on the person seeking to assert his right, held that if it is likely to be "impossible or excessively difficult" for the right holder to come up with evidence of copying, the national court must use all procedures available to it to counter that difficulty, including any rules which provide for the burden of proof to be "adjusted or lightened". Thus, it would appear that, in certain circumstances, it might be sufficient for the right holder to establish facts from which copying might be reasonably inferred, before the burden shifts to the defendant to rebut those facts. The CJ then addressed the issue of the *defences of the extinction of rights over time and of an action being time-barred* that may be raised against an action brought on the basis of an alleged infringement of an unregistered Community design and held that these defences are governed by national law, which must be applied in a manner that observes the principles of equivalence and effectiveness. Finally, the CJ held that *claims for destruction of infringing products* are governed by the law of the Member State in which the acts of infringement or threatened infringement have been committed. On the other hand, *claims for compensation for damage* resulting from infringement are governed by the national law of the Community design court hearing the proceedings.



**C-435/13 P; DESIGN OF WATCH DIALS.** Judgment of 18 July 2014, *Erich Kastenholz v OHIM* – de. The General court (GC) confirmed the decision of the Board of Appeal (BoA) which rejected the invalidation request against a registered Community design in the case [T-68/11](#). The invalidity applicant filed an appeal to the European court of justice (CJ) claiming the infringement of Article 5 and Article 6 CDR.



The CJ rejected the first plea (infringement of Article 5 CDR) as inadmissible, as it was directed against the decision of the BoA and not against the judgment under appeal, being a mere repetition of the appellant's submission before the GC (Para. 30 et seq.) The second plea (infringement of Article 6 CDR) was rejected as inadmissible as it did not contain a reasoning in which an error in law was claimed, and was directed against the decision of the BoA and concerned a question of facts (Para. 44 et seq.) The third plea (infringement of Article 25 (1) (f) CDR), in which the appellant claimed an erroneous application of the German copyright law, was considered obviously unfounded. It was for the invalidity applicant (now the appellant before the CJ) to prove the applicability of the provision of the national law he relied on (Para. 55).

**C 345/13; DESIGN OF CLOTHES,** Preliminary ruling of 19 June 2014, *Karen Millen Fashions Ltd v Dunnes Stores, Dunnes Stores Ltd* – en. 1. Article 6 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs is to be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually. 2. Article 85(2) of Regulation No 6/2002 must be interpreted as meaning that, in order for a Community design court to treat an unregistered Community design as valid, the right holder of that design is not required to prove that it has individual character within the meaning of Article 6 of that regulation, but need only indicate what constitutes the individual character of that design, that is to say, indicates what, in his view, are the element or elements of the design concerned which give it its individual character. In 2005 Karen Millen Fashions Ltd ('KMF'), a company incorporated under the law of England and Wales which carries on the business of producing and selling women's clothing, designed and placed on sale in Ireland a striped shirt (in a blue and a stone brown version) and a black knit top ('the KMF garments'). Examples of the KMF garments were purchased by representatives of Dunnes, a substantial



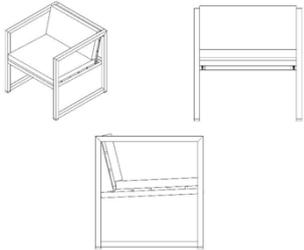
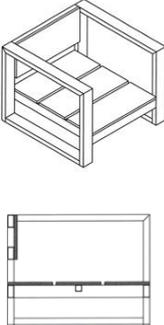
retailing group in Ireland, from one of KMF's Irish outlets. Dunnes subsequently had copies of the garments manufactured outside Ireland and put them on sale in its Irish stores in late 2006. Asserting itself to be the holder of unregistered Community designs relating to the garments, on 2 January 2007, KMF commenced proceedings in the High Court in which it claimed, inter alia, injunctions restraining Dunnes from using the designs, and damages. The High Court upheld that action. Dunnes brought an appeal against the judgment of the High Court before the Supreme Court. The proceedings were suspended and a preliminary ruling was requested regarding the following questions: '1. In consideration of the individual character of a design which is claimed to be entitled to be protected as an unregistered Community design for the purposes of [Regulation No 6/2002], is the overall impression it produces on the informed user, within the meaning of Article 6 of that Regulation, to be considered by reference to whether it differs from the overall impression produced on such a user by: (a) any individual design which has previously been made available to the public, or (b) any combination of known design features from more than one such earlier design? 2. Is a Community design court obliged to treat an unregistered Community design as valid for the purposes of Article 85(2) of [Regulation No 6/2002] where the right holder merely indicates what constitutes the individual character of the design or is the right holder obliged to prove that the design has individual character in accordance with Article 6 of that Regulation?' Question 1: The European court of justice (CJ) considered that the question was whether Article 6 of Regulation No 6/2002 must be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user by one or more earlier designs, taken individually, or by a combination of features taken in isolation and drawn from a number of earlier designs (Para. 23). The CJ found that there is nothing in the wording of Article 6 of Regulation No 6/2002 to support the view that the overall impression referred to therein must be produced by such a combination (Para. 24). The reference to the overall impression produced on the informed user by 'any design' which has been made available to the public indicates that Article 6 must be interpreted as meaning that the assessment as to whether a design has individual character must be conducted in relation to one or more specific, individualised, defined and identified designs from among all the designs which have been made available to the public previously (Para. 25). The CJ pointed out that that interpretation is correct regardless of whether it is assumed that the overall impression on the informed user is produced by a direct or indirect (based on an imperfect recollection) comparison between the designs at issue. (Paras. 26-29). Question 2: The CJ considered that the question was whether Article 85(2) of Regulation No 6/2002 must be interpreted as meaning that, in order for a Community design court to treat an unregistered Community design as valid, the right holder of that design is required to prove that it has individual character within the meaning of Article 6 of that regulation, or need only indicate what constitutes the individual character of that design (para. 36). The CJ stated that it is apparent from the very wording of Article 85(2) of Regulation No 6/2002 that, in order for an unregistered Community design to be treated as valid, the right holder of that design is required, first of all, to prove that the conditions laid down in Article 11 of that regulation have been met and, secondly, to indicate what constitutes the individual character of that design (Para. 37). The CJ pointed out that Article 85 of Regulation No 6/2002, paragraph 2, establishes a presumption of validity of unregistered Community designs (para. 39). In that context, the Court noted that the different procedures provided for in Article 85 of Regulation No 6/2002 with regard to a registered Community design and an unregistered Community design arise from the need to determine, with regard to the latter, the date as from which the design at issue is covered by the protection under that regulation and specifically what is covered, which, as there are no registration formalities, may be more difficult to



identify in the case of an unregistered design than for a registered design (Para. 43). As regards the second condition set out in Article 85(2) of Regulation No 6/2002, the Court found that the wording of that provision, in merely requiring the holder of an unregistered Community design to indicate what constitutes the individual character of that design, is unambiguous and cannot be interpreted as entailing an obligation to prove that the design concerned has individual character (Para. 45).

## B. Article 25b CDR – Invalidity Proceedings

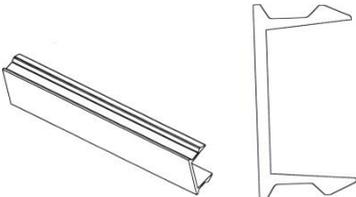
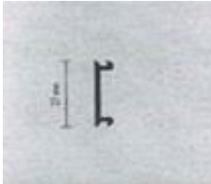
[T 339/12](#); **DESIGN OF AN ARMCHAIR**, Judgment of 4 February 2014, *Gandia Blasco, SA v OHIM* - EN

RCD	Previous RCD
	

The RCD holder registered the contested design, as displayed above. The invalidity applicant filed for a declaration of invalidity based on Articles 4 to 9 CDR and its previous RCD, also displayed below. The Invalidity Division rejected the application as it found that the contested design was new and had individual character within the meaning of the Articles 5, 6 and 25(1) (b) CDR. The Board of Appeal dismissed the appeal as the overall impression produced by the earlier design was not such as to deprive the contested design of its individual character. The invalidity applicant appealed referring to an alleged infringement of Article 6 CDR. The GC maintained that the informed user knows the various designs which exist in the sector concerned, possesses knowledge of the features which are normally included. Due to his interest in the products, he is particularly observant and shows a relatively high degree of attention when using them (not disputed) (Paras. 14-15, 20). Overall impression is to be determined in the light of how the product is used. The inclined backrest and seat will give rise to a different comfort from that of a straight back and seat. The use made of that armchair by the circumspect user is liable to be affected by such a difference (Para. 30). Regarding parts that are outside the user's field of vision, these will have no great impact on how the design is perceived. Parts found underneath the cushion of an arm chair seat is such a part (Paras. 32-34). The GC thereby confirmed the BoA decision that the applied for design was new and had individual character



- ◆ **T-39/13; DESIGN OF A SKIRTING BOARD**, Judgment of 3 October 2014; *Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński v. OHIM* – en.

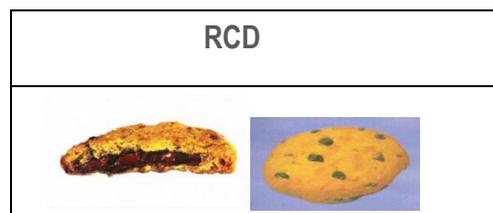
RCD	Earlier design
	

The holder obtained registration for the design shown above, in respect of ‘skirting boards’. The invalidity applicant filed an application for a declaration of invalidity, relying on Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Articles 4, 5 and 6 of that regulation, and arguing that the contested design was not new, because it was anticipated by a third party’s earlier design, as shown below. The Cancellation Division upheld the application for a declaration of invalidity. The Board of Appeal (BoA) dismissed the appeal, holding that the contested design lacked novelty and individual character. In particular, the BoA found that the contested design was part of a complex product as defined in Article 3(c) of Regulation No 6/2002 and that the only visible part of that design during normal use was the flat surface of its base part. Since the flat surface of the contested design was the same as the flat surface of the earlier design, the BoA concluded that the two designs were identical and that, consequently, the contested design was not new and did not produce a different overall impression. The General court (GC) rejected the holder’s arguments that (i) the contested design is a multifunctional product capable of being used in two potential ways (i.e. to cover a recess in a skirting board and to be cover a channel in a floor or wall), so that its use cannot be restricted to use as a component part of a complex product, and that (ii) Article 3(c) of Regulation No 6/2002 must be narrowly construed and that, consequently, a design must not be regarded as constituting a component part of a complex product unless that is the only reasonable way in which to use it. The GC found that from the file it was clear that the contested design constitutes a component part of a complex product, being intended to cover a recess in a skirting board (Para. 27), and the purely hypothetical use of the contested design in order to cover a channel in a floor or wall cannot be taken into account. The GC then addressed the issue of whether the earlier design is visible during normal use and found that, although the BoA had held that the only visible feature of the earlier design was (as in the case of the contested design) the flat front surface, the catalogue which had been submitted



by the invalidity applicant to prove the disclosure of the earlier design showed that this is to be attached to the back part of a skirting board (i.e. not used to cover a recess in a skirting board), so that it is not visible during normal use of the complex product of which it is a part (Para. 49). The GC thus annulled the BoA's decision, finding that an application for a declaration of invalidity cannot be based on an earlier design which, as a component part of a complex product, is not visible during normal use of that product by the end user (which in the case of skirting boards is the person occupying a room where skirting boards have been installed), this normal use excluding maintenance, servicing or repair work such as the installation or the replacement of cables in a recess of a skirting board, operations which would be carried out by specialists and not by the end user as defined above (Para. 53).

**T-494/12; DESIGN OF A BISCUIT**, Judgment of 9 September 2014, *Biscuits Poult SAS v OHIM + Banketbakkerij Merba BV* – en. The applicant filed an application for the registration of RCD. The design in respect of which registration was sought, intended to be applied to 'cookies', is represented below.



The intervener applied for a declaration of invalidity of the design pursuant to Article 25 (1) (b) CDR read in combination with Article 6 CDR. The Cancellation Division dismissed the application. The Board of Appeal (BoA) declared the contested design invalid on the ground that it lacked individual character. The applicant brought an action before the General Court (GC), alleging the infringement of Article 6 CDR. The GC dismissed the action and endorsed the BoA's findings. The BoA did not err in finding that the contested design had to be declared invalid on the ground that it lacked individual character (Para. 35). In particular, the GC observed that: the BoA did not err in stating that the non-visible characteristic of the product (the layer of chocolate filling inside the cookie) does not relate to the appearance and cannot take into account in the examination of the requirements to fulfil for register a design (para 25, 29 and 31); the applicant misunderstood the meaning and the function of Article 4 (2) and (3) of RCDR which relate to a "complex product" and are ineffective in the current proceeding: the product at issue is not a "complex product" (Paras. 27 and 28); the BoA did not err in the assessment of individual character. Given the designer's considerable freedom in the sector, the differences highlighted by the applicant (such as number, dimensions and prominent presence of chocolate chips, smoother surface) are not liable to produce a different overall impression on an informed user (Paras. 32-34).

◆ **T-315/12; DESIGN OF HEATING RADIATORS**, Judgment of 12 March 2014, *Tubes Radiatori S.r.l. v OHIM* – it.



Contested registered Community design	Earlier German designs

The design holder registered the design represented above, the product indication being 'heating radiators'. An invalidity action based on two prior designs - as shown below - forming part of an earlier registered German design was filed on the grounds of Articles 25(1)(b) and 6(1)(b) CDR, alleging lack of individual character of the contested design. The Invalidity Division (ID) upheld the application for invalidity, declaring invalid the contested RCD due to lack of individual character under Article 6(1)(b) CDR. The Board of Appeal (BoA) dismissed the design holder's appeal. The latter filed an action before the General court (GC). The GC endorsed the BoA's finding that the informed user to be taken into account is the person who buys radiators to have them installed at home such person being aware of what is available on the market, of the current trends and of the basic features of heating radiators (Para. 63). The GC then confirmed the BoA's finding to the effect that the designer's freedom when it comes to heating radiators is relatively high. The circumstance that a radiator must have a certain number of elements allowing the circulation of a heating fluid does not significantly influence either the configuration of such elements or the shape and general aspect of the radiator (Para. 78). The circumstance that, in a previous decision, the Office considered that the state of the art, when it comes to heating radiators, is saturated, is not relevant when it comes to assessing the designer's freedom, considering that the latter is not hindered by what might be prevailing trends in the relevant field (Para. 85). On the other hand, the GC considered that a saturation of the state of the art, if ascertained, can indeed influence the informed user's perception to the extent that he/she would pay more attention to minor differences between the various designs or models concerned (Para. 87). The GC noted that the design holder had, during the administrative proceedings before the Office, invoked the saturation of the state of the art for heating radiators, and that the reasoning and words of the ID appear to indicate that this instance of the Office acknowledged, albeit implicitly, a certain saturation of the state of the art (Para. 89). The GC noted that the BoA, in its assessment of the individual character, did not address the design holder's above argument. The GC dismissed the Office's argument (brought before the GC) that the design holder had failed to substantiate its argument as to an alleged saturation of the state of the art. The GC considered such an argument to amount to a belated attempt to remedy a deficiency in the BoA reasoning, and declared it inadmissible (Para. 95). The GC therefore annulled the decision of the BoA, on the grounds that it was affected by a lack of reasoning (Paras. 100-101).



---

## VII. ENFORCEMENT

**C-360/12; COUNTERFEITING OF A PERFUME BOTTLE**, Preliminary ruling of 5 June 2014, *Coty Germany GmbH v First Note Perfumes NV – de*. The concept of ‘the Member State in which the act of infringement has been committed’ in Article 93(5) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in the event of a sale and delivery of a counterfeit product in one Member State, followed by a resale by the purchaser in another Member State, that provision does not allow jurisdiction to be established to hear an infringement action against the original seller who did not himself act in the Member State where the court seized is situated. 2. Article 5(3) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters must be interpreted as meaning that, in the event of an allegation of unlawful comparative advertising or unfair imitation of a sign protected by a Community trade mark, prohibited by the law against unfair competition (*Gesetz gegen den unlauteren Wettbewerb*) of the Member State in which the court seized is situated, that provision does not allow jurisdiction to be established, on the basis of the place where the event giving rise to the damage resulting from the infringement of that law occurred, for a court in that Member State where the presumed perpetrator who is sued there did not himself act there. By contrast, in such a case, that provision does allow jurisdiction to be established, on the basis of the place of occurrence of damage, to hear an action for damages based on that national law brought against a person established in another Member State and who is alleged to have committed, in that State, an act which caused or may cause damage within the jurisdiction of that court. The German company Coty Germany GmbH is the proprietor of rights to a three-dimensional Community trade mark representing a perfume bottle. The Belgium company First Note Perfumes NV, is a perfume wholesaler which sold in Belgium perfumes in a bottle, similar to that represented in the trade mark referred to above, to a German trader, who resold them in Germany. Coty Germany brought an action in Germany against, First Note Perfumes NV, claiming that the distribution by First Note Perfumes NV of that perfume constituted an infringement of a trade mark, unlawful comparative advertising and unfair imitation. That action was dismissed both at first instance and on appeal by the German courts. It was held on appeal that the German courts had no international jurisdiction. Coty Germany brought an appeal on a point of law before the *Bundesgerichtshof*. The proceedings were suspended and a preliminary ruling was requested regarding the following questions: 1. Is Article 93(5) of Regulation ... No 40/94 to be interpreted as meaning that an act of infringement is committed in one Member State (Member State A), within the meaning of [that provision], in the case where, as a result of an act in another Member State (Member State B), there is participation in the infringement in the first-named Member State (Member State A)? 2. Is Article 5(3) of Regulation ... No 44/2001 to be interpreted as meaning that the harmful event occurred in one Member State (Member State A) if the tortious act which is the subject of the action or from which claims are derived was committed in another Member State (Member State B) and consists in participation in the tortious act (principal act) which took place in the first-named Member State (Member State A)? **Question 1** The European court of justice (CJ) considered that the



question was whether the concept of ‘Member State in which the act of infringement has been committed’ in Article 93(5) of Regulation No 40/94 must be interpreted in a manner analogous to that of the ‘place where the harmful event occurred’ in Article 5(3) of Regulation No 44/2001 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (the “Brussels I” Regulation) (Para. 25). According to Article 5(3) of the “Brussels I” Regulation, the expression ‘place where the harmful event occurred or may occur’ is intended to cover both the place where the damage occurred and the place of the event giving rise to it, so that the defendant may be sued, at the option of the applicant, in the courts for either of those places. However, the Court pointed out that the rules of Regulation No 40/94 have the character of *lex specialis* in relation to the rules provided for by the “Brussels I” Regulation (Para. 27). More specifically, the application of Article 5(3) of the “Brussels I” Regulation to Community trade mark infringement actions is expressly precluded by Articles 90(2) and 92 CTMR (now, Articles 94(2) and 94) CTMR) (Para. 28). Consequently, the duality of linking factors, namely the place of the event giving rise to the damage and that where the damage occurred, accepted by the CJ’s Case-Law relating to Article 5(3) of the “Brussels I” Regulation, cannot apply to the interpretation of the concept of ‘the Member State in which the act of infringement has been committed or threatened’ in Article 93(5) of Regulation No 40/94 (now Article 97(5) CTMR). The latter must be interpreted independently (Para. 31 and 32). The “linking factor relates to active conduct on the part of the person causing the infringement and therefore refers to the Member State where the act giving rise to the alleged infringement occurred or may occur, not the Member State where that infringement produces its effects” (Para. 34). Any other interpretation would conflict with the wording of Article 94(2) of Regulation No 40/94 (Para. 35). Given the reasons above, the CJ concluded that jurisdiction under Article 93(5) of Regulation No 40/94 may be established solely in favour of Community trade mark courts in the Member State in which the defendant committed the alleged unlawful act (thus excluding jurisdiction based on the place of the event giving rise to the infringement) (Para. 37). **Question 2** The CJ considered that the question was whether Article 5(3) of the “Brussels I” Regulation must be interpreted as meaning that, in the event of an allegation of unlawful comparative advertising or unfair imitation of a sign protected by a Community trade mark, prohibited by the law against unfair competition of the Member State in which the court seized is situated, that provision attributes jurisdiction to hear an action for damages based on that national law against one of the presumed perpetrators who is established in another Member State and is alleged to have committed the infringement in that State (Para. 39). The CJ pointed out that actions concerning a Community trade mark may be brought under the law of Member States relating in particular to civil liability and unfair competition (Para. 40). Those actions do not come within the jurisdiction of the Community trade mark courts (Para. 41). The CJ stressed that in such cases article 5(3) of the “Brussels I” Regulation is applicable in order to establish the jurisdiction of the court seized (Para. 42). Consequently the applicant may choose to sue the defendant either before the competent court for the place where the damage occurred, or the one for the place of the event giving rise to it (Para. 46). The CJ confirmed that, in circumstances in which only one among several presumed perpetrators of the alleged harmful act is sued before a court within whose jurisdiction he has not acted, the event giving rise to the damage may not be regarded as taking place within the jurisdiction of that court for the purpose of Article 5(3) of the “Brussels I” Regulation (Para. 50). As to whether Article 5(3) of the “Brussels I” Regulation allows jurisdiction to be established, on the basis of the place where the damage occurred, the CJ concluded that an action relating to an infringement of the national law may be brought before the German courts, provided the act



committed in another Member State caused or may cause damage within the jurisdiction of the court seized (Para. 57).

**C-535/13; HONDA**, Preliminary Ruling Order of 17 July 2014. *Honda Giken Kogyo Kabushiki Kaisha v. Maria Patmanidi AE* – en. HONDA is the owner of national and community trade marks for its products, mainly cars. Honda sued Maria Patmanidi AE in front of the *Monomeles Protodikeio Athinon* (first instance court in Athens sat by a single judge). HONDA claims that this company imports to Greece authentic cars manufactured by Honda in Thailand that are targeted at the Asian market. This parallel import is infringing HONDA's exclusive right. The *Monomeles Protodikeio Athinon* questions the Case-Law on parallel imports based on the judgment in case *Silhouette International Schmied* (C-355/96, EU:C:1998:374), in particular wonders if this Case-Law is applicable in spite of the entry into force of Articles 101 and 102 TFUE. The questions were therefore referred by the Greek court to the European court of justice (CJ). The CJ reminds that its substantial Case-Law on parallel imports remains unchanged. When the products have never been put into the market with the consent of its trademarks owner this one can oppose it. Articles 101 and 102 of the TFUE have not changed the interpretation of Article 7 of Directive 89/104 or 13 of the CTMR. In relation with the TRIPS agreement the Court held that the Treaty did not contain rules on exhaustion of rights as stated in Article 6 of the TRIPS. In conclusion the Court answered the national Court that Articles 5 and 7 of Directive 89/104 and Articles 9 and 13 of the CTMR must be interpreted in the sense that the owner of trade mark may oppose the first place into the EU market if its products holding its trademarks have been done so without his consent

**C-98/13; ROLEX**, Judgment of 6 February 2014 (Preliminary Ruling); *Martin Blomqvist v Rolex SA* – da. Martin Blomqvist, a resident of a Member State, ordered in 2010 a watch described as a Rolex from a Chinese on-line shop. The seller sent the watch in parcel from Hong Kong to Denmark by post, where it was inspected by the customs authorities on arrival. In accordance with the procedure laid down by the customs regulation, Rolex then requested the continued suspension of customs clearance, having established that the watch was in fact counterfeit. Since Mr Blomqvist refused Rolex to consent to the destruction of the watch, Rolex brought an action before the *Sø-og Handelsretten* (Maritime and Commercial Court), seeking an order that Martin Blomqvist allow the destruction of the watch without compensation. That court granted Rolex's claim. Martin Blomqvist brought then an appeal before the *Højesteret* (Danish Supreme Court). The *Højesteret* raised the question, whether the circumstances of the case constitute an infringement of intellectual property right, taking into consideration that for the customs regulation to apply 1) there must be a breach of copyright or of a trade mark right which is protected in Denmark and 2) the alleged breach must take place in the same Member State. The *Højesteret* decided to stay the proceedings and to refer the European court of justice (CJ) a number of questions in a request for a preliminary ruling. The CJ replied to the questions as follows. Term of 'distribution to the public' within the meaning of (a) Article 4(1) of the copyright directive and term of 'use in the course of trade' within the meaning of Article 5(1) and (3) of the trade mark directive and Article 9(1) and (2) of the Community trade mark regulation must be interpreted as meaning that the mere fact that the sale was made from an online sales website in a non-member country cannot have the effect of depriving the holder of an intellectual property right to the



goods which were the subject of the sale of the protection afforded by the customs regulation, without it being necessary to verify whether such goods were, in addition, prior to that sale, the subject of an offer for sale or advertising targeting European Union consumers (para. 34). Article 2(1)(a) and Article 2(1)(b) of customs regulation must be interpreted as meaning that the 'counterfeit goods' or 'pirated goods' coming from a non-member State which are imitations of goods protected in the EU by a trade mark right or copies of goods protected in the European Union by copyright, a related right or a design can be classified as 'distribution to the public' or '[use] in the course of trade' where it is proven that they are intended to be put on sale in the EU, in particular, where it turns out that the goods have been sold, offered for sale or advertised to customers in the EU (para. 33). Customs regulation grants holder of an intellectual property right to goods sold to a resident of a Member State through an online sales website established in a non-member country the protection at the time when those goods enter the territory of that Member State merely by virtue of the acquisition of those goods.



## VIII. OTHER

### **Seniority (Article 34 CTMR)**

[no entry]

### ***Restitutio in integrum (Article 81, former 78, CTMR)***

**T-61/13; NUEVA**, Judgment of 21 May 2014, *'Melt Water' UAB, v OHIM* – It. The applicant sought to register a figurative sign as a CTM for goods in Class 32, mineral water. In particular the GC held that the applicant did not demonstrate the care and diligence required for the purposes of monitoring and complying with the time-limit prescribed for payment of the appeal fee. A normally careful and diligent applicant for a Community trade mark which, just like the applicant, has chosen English as the second language in its application for a Community trade mark ought at least to have been able to verify the wording of the English version of Article 60 CTMR as the wording in English clearly links the payment of the fee for appeal to the filing of the notice of appeal, which is subject to a period of two months, and not to the lodging of the statement setting out the grounds of appeal, which is subject to a period of four months (Para. 41). Even on the assumption that the applicant sought to argue that, although it had exercised all due care required by the circumstances, it had been unable to comply with the time-limit for payment of the appeal fee, it did have the possibility of bringing *restitutio in integrum* proceedings before the Office and could have submitted an application under Article 81 CTMR (Para. 43). Judging the circumstances of the case exceptional within the meaning of the first subparagraph of Article 87(3) of the Rules of Procedure, fairness requires that the Office OHIM should bear its own costs and pay those incurred by the applicant (Para. 48).



## Classification of Goods and Services

C-420/13; **NETTO Marken-Discount**, Preliminary ruling of 10 July 2014, *Netto Marken-Discount AG & Co. KG v Deutsches Patent- und Markenamt - de.*



On 10 September 2011, Netto Marken-Discount filed the German trade mark application for, *inter alia*, retail services in relation to “services, particularly services provided by retail stores, wholesale outlets, through mail order catalogues or by means of electronic media, for example websites or television shopping programmes, in relation to the following services: in Class 35: Advertising; business management; business administration; office functions; in Class 36: Issue of vouchers or tokens of value; in Class 39: Travel arrangement; in Class 41: Entertainment; in Class 45: Personal and social services intended to meet the needs of individuals” in Class 35. The German Patent and Trademark Office (DPMA) rejected the application for Class 35 on the basis that the services in that class could not be clearly distinguished from other services in either their substance or scope. Netto Marken-Discount brought an action for annulment of that decision before the German Federal Patent Court (*Bundespatentgericht*). The German Federal Patent Court referred three questions to the European court of justice (CJ) concerning the interpretation of Article 2 TMD. By the first question, the referring Court asks whether “retail services for services” could fall under the concept of “services” in the meaning of Article 2 TMD. By its second question, the German Federal Patent Court asks whether Article 2 TMD requires that a trade mark application for retail services must identify specifically and precisely both the services rendered which constitute the retail service and the services to which the retail service refer. The third question seeks guidance whether the retail services extend even to services provided by the retailer itself. The CJ considered the third question inadmissible as it relates to the scope of protection conferred by a trade mark and bears no relation to the issue in the main proceedings. As regards the first two questions, the CJ replied as follows: 1) Services rendered by an economic operator which consist in bringing together services so that the consumer can conveniently compare and purchase them may come within the concept of ‘services’ referred to in Article 2 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Para. 40). 2) Directive 2008/95 must be interpreted as imposing a requirement that an application for registration of a trade mark with respect to a service which consists in bringing together services must be formulated with sufficient clarity and precision so as to allow the competent authorities and other economic operators to know which services the applicant intends to bring together (Para 53).



**T-51/12; LAMBRETTA**, Judgment of 30 September 2014, *Scooters India Ltd, v. OHIM* – en. The applicant is the owner of the Community word mark LAMBRETTA since 2002, for goods in classes 3, 12, 14, 18 and 25. In 2007, the intervener applied for partial revocation of the CTM for the goods in classes 3, 12 and 18 (no genuine use). The Cancellation Division partially revoked the mark as from 2007 in respect of the relevant goods, except for some goods in Class 3. The Board of Appeal (BoA) stated that the goods protected in Class 12 coincided with the class heading (vehicles; apparatus for locomotion by land, air or water). Since the evidence of use related only to spare parts, but not to vehicles, apparatus for locomotion by land, air or water, the BoA did not examine it and confirmed revocation for the whole Class 12. The decision was adopted in December 2011, before IP Translator judgment. The question at issue was whether the indication of the class heading of Class 12 was to be understood by the Office as referring solely to ‘vehicles; apparatus for locomotion by land, air or water’ *stricto sensu*, or more generally, to all the goods in Class 12. In the meantime, the IP Translator preliminary ruling stated that class heading can be used to identify the goods and services covered by the trade mark application, provided that such identification is sufficiently clear and precise (Para. 56). Furthermore, if all the general indications of a particular class heading are used to identify the G/S for which protection is sought, the applicant has to specify whether the application covers all the G/S included in the alphabetical list or only some (in such case: specify those covered). The IP Translator judgment guidance must be applied by the courts even to legal relationships arising and established before the judgment (Para. 24). As far as the Office’s Communication of 2/2012, for CTMs registered before 21.6.12, use of all the general indications in the class heading implies protection of all the G/S included in the alphabetical list of that class. The President of the Office justified this approach by referring to an earlier Communication of April 2003. The Communication of 2/2012 applies the principles of legitimate expectations and of legal certainty. A legitimate expectation had been created by the Office (Para. 27) The fact that the CTM at issue had been registered before the publication of the Communication of 4/2003 could be relevant in the light of the principle of legitimate expectations, but not in the light of the principle of legal certainty, which protects the interest of the public (and not only of TM proprietors) in the possibility of establishing with certainty the scope of the protection conferred by earlier registrations (Para. 29). In any case, there is no limitation in Communication 2/12 regarding marks registered before the publication of Communication 4/03 (Para 30). Furthermore, Communication 4/03 was intended ‘to explain and clarify’ the practice of the Office and states that the rules ‘will continue to be applied in the various proceedings’. Therefore, Communication 4/03 was not intended to introduce a new practice, but to explain and clarify the previous practice of the Office (Para. 31). Even if Communication 2/12 is disregarded, the General court has already recognised that the principle of legal certainty requires the conclusion that the owner of a CTM is using all the general indications in a class heading. Therefore, the words ‘vehicles; apparatus for locomotion by land, air or water’ in the case at hand must be interpreted as protecting the mark for all the goods in the alphabetical list of Class 12. The BoA was required to examine the genuine use of the mark LAMBRETTA in relation to the spare parts included in the alphabetical list.



---

**ANNEX 1: ALPHABETICAL LIST OF GC AND CJ JUDGMENTJUDGMENTS AND IMPORTANT ORDERS IN 2014 BY NICKNAME OF TRADE MARK (ICLAD CASE QUOTATION MANUAL)**

***Actions On Appeal From The Office***

AAROA / ARO, Judgment of 11 September 2014 in Case [T-536/12](#), Aroa Bodegas, S.L & Bodegas Muga v. OHIM

AAVA MOBILE / JAVA. Judgment of 27 March 2014, in Case [T-554/12](#), Oracle America, Inc. v OHIM

AAVA CORE / JAVA, Judgment of 11 December 2014 in Case [T-618/13](#), Oracle America. Inc. V OHIM

AB IN DEN URLAUB, Judgment of 24 June 2014, in Case [T-273/12](#); Unister GmbH v OHIM

ALIFOODS / ALDI, Judgment of 26 November 2014 in Case [T-240/13](#), Aldi Einkauf GmbH & Co. OHG v OHI

ALPHAREN / ALPHA 3, Order of 17 July 2014 in Case [C-490/13P](#), Cytochroma Development Inc. v OHIM

ALPHATRAD, Judgment of 16 January 2014 in Case [T-538/12](#), Optilingua Holding SA v OHIM

ANNAPURNA, Judgment of 6<sup>th</sup> March 2014, in Case [T-71/13](#), Annapurna SpA v Anapurna GmbH

ANTONIO BACCIONE, Judgment of 16/07/2014 in Case [T-36/13](#), Errea Sport SpA v OHIM

4711 Aqua Mirabilis / AQUA ADMIRABILIS, Judgment of 27 February 2014 in Case [T-25/13](#), Mäurer & Wirtz GmbH & Co. KG v OHIM

ARIS/ARISA, Judgment of 20 May 2014 in Case [T-247/12](#) Argo Group International Holdings Ltd v OHIM

ARTI / ARTITUDE, Judgment of 11 December 2014 in Case [T-12/13](#), Sherwin-Williams Sweden AB v. OHIM

ASOS / ASSOS, Judgment of 29 April 2014 in Case [T-647/11](#), Asos plc v OHIM

BALEA / CALDEA, Judgment of 12 February 2014 in Case [T-26/13](#), dm-drogerie markt GmbH & Co, KG, v OHIM and Semtee

BATEAUX-MOUCHES, Judgment of May 21, 2014, in Case [T-553/12](#), Compagnie des Bateaux-Mouches v OHIM



BAUSS / BASS 3 TRES, Judgment of 18 September 2014 in Case [T-267/13](#); *El Corte Inglés, S.A. v OHIM*

◆ BEYOND VINTAGE/BEYOND RETRO, Judgment of 30 April 2014, in Case [T-170/12](#), *Beyond Retro Limited v OHIM*

BIG PAD, Judgment of May 7<sup>th</sup> 2014, in Case [T-567/13](#), *Sharp KK v OHIM*

◆ BIOCERT / BIOCEF, Judgment of 10 December 2014 in Case [T-605/11](#), *Novartis AG v. OHIM + Dr Organic Ltd*

◆ BOTTLE WITH A STRAND OF GRASS, Judgment of 11 December 2014 in Case [T-235/12](#), *CEDC International sp. z o.o. v OHIM*

◆ BUGUI VA / BUGUI et al, Judgment of 24 October 2014 in Case [T-543/12](#), *Xavier Grau Ferrer v OHIM*

Caffé KIMBO / BIMBO, judgment of 12 June 2014 in Case [C-285/13P](#), *Bimbo, SA v OHIM*

CARE TO CARE, Judgment of 23 January 2014 in Case [T-68/13](#), *Novartis AG v OHIM*

CARRERA / CARRERA, Judgment of 27 November 2014 in Case [T-173/11](#), *Kurt Hesse and Lutter & Partner GmbH v OHIM*

CHOCOLATE BOXES, Judgment of 11. December 2013 in Case [T-440/13](#), *Zakład Wyrobów Cukierniczych „Millano” Krzysztof Kotas v OHIM*

CLUB GOURMET/ CLUB DEL GOURMET, EN... *El Cortes Inglés*, Order of 6 of February 2014, in Case [C-301/13P](#), *El Corte Ingles, S.A. v OHIM*

◆ CLORALEX / CLOROX, Order of 30 January 2014, in Case [C-422-12P](#), *Industrias Alen SA de CV and The Clorox Company v OHIM*

compressor technology / KOMPRESSOR PLUS et al, Judgment of 4 December 2014 in Case [T-595/13](#), *J BSH Bosch und Siemens Hausgeräte GmbH v OHIM*

CONTINENTAL WIND PARTNERS / CONTINENTAL, Judgment of 11 September 2014 in Case [T-185/13](#)

CPI / Cpi, Judgment of 4 July 2014 in Case [T-345/13](#), *Construcciones, Promociones e Instalaciones S.A. v. OHIM.*

CUBES, Judgment of 25 November 2014 in Case [T-450/09](#), *Simba Toys GmbH & Co. KG v OHIM*

CURVE, Judgment of 26 September 2014 in Case [T-266/13](#), *Brainlab AG v OHIM*

DARSTELLUNG EINES GELBEN BOGENS, Judgment of 26<sup>th</sup> of February 2014, in Case [T-331/12](#), *Sartorius Lab v OHIM* (not yet included in the Overview)

DA ROSA / AROSA, Judgment of 12 December 2014 in Case [T-405/13](#), *Le Comptoir d'Épicure, A-Rosa Akademie GmbH v. OHIM*

DELTA / DELTA PORTUGAL, Judgment of 10 September 2014 in Case [T-218/12](#), *Micrus Endovascular LLC v. OHIM*

DELUXE, Judgment of 17 December 2014 in Case [T-344/14](#), *Lidl Stiftung v. OHIM*

◆ DEMON / DEMON, Judgment of 13/02/14 in Case [T-380/12](#), *Demon International LC v OHIM*



DESIGN OF AN ARMCHAIR, Judgment of 4 February 2014 in Case [T 339/12](#), Gandia Blasco, SA v OHIM

DESIGN OF A BISCUIT, Judgment of 9 September 2014 in Case [T-494/12](#), Biscuits Poult SAS v OHIM + Banketbakkerij Merba BV

◆ DESIGN OF HEATING RADIATORS, Judgment of 12 March 2014 in Case [T-315/12](#), Tubes Radiatori S.r.l. v OHIM

DESIGN OF RED SHOELACE TIPS, Judgment of 11 September 2014 in [C-521/13P](#), Think Schuhwerk GmbH v OHIM.

◆ DESIGN OF A SKIRTING BOARD, Judgment of 3 October 2014 in Case [T-39/13](#), Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński v. OHIM

DESIGN OF WATCH DIALS. Judgment of 18 July 2014 in [C-435/13 P](#), Erich Kastenholtz v OHIM

DEVICE OF A WAVY LINE, Judgment of 6 November 2014 in Case [T-53/13](#), Vans, Inc. v OHIM

DODIE / DODOT, Judgments of 8 October 2014 in Cases [T-122/13](#), [T-123/13](#) and [T-77/13](#), Laboratoires Polive v OHIM

DORATO/RESERVE IMPERIAL, Judgment of 9 April 2014, in Case [T-249/13](#); MHCS v OHIM

DRACULA BITE / DRACULA, Judgments of June 5<sup>th</sup> 2014, in Cases, [T-495/12](#), [T-496/12](#) and [T-497/12](#) European Drinks SA & SC Alexandrion Grup Romania Srl v OHIM

E / E, Judgment of 11 July 2014 in Case [T-425/12](#), Sport Eybl & Sports Experts GmbH v OHIM, Language of the case

ecoDOOR, Judgment of 10. July 2014 in Case [C-126/13](#), BSH Bosch und Siemens Hausgeräte GmbH v OHIM..

ELECTROLINERA / ELECTROLINERA, Judgment of 18 November 2014 in Case [T-308/13](#), Repsol, S.A. & Josep Maria Adell Argiles v.OHIM

◆ ELITE BY MONDARIZ/ELITE, Judgment of 9 April 2014 in Case [T-386/12](#), Elite Licensing Company, S.A. v OHIM.

ENI / EMI, Judgment of 21 May 2014 IN Case [T-599/11](#), SpA v OHIM

◆ EQUITER/EQUINET, Judgment of 27 March 2014, in Case [T-47/12](#), Intesa Sanpaolo SpA v OHIM

European Network Rapid Manufacturing, Judgment of 13 March 2014, in Case [T-430/12](#), Heinrich Beteiligungs GmbH v OHIM

EUROSKY / SKY, Judgment of 18 November 2014 in Case [T-510/12](#), Conrad Electronic SE v OHIM

EXACT, Judgment of 22 May 2014 in Case [T-228/13](#), NIT Insurance Technologies Ltd. v OHIM

◆ FAIRGLOBE / GLOBO, Judgment of 8 October 2014 in Case [T-300/12](#), Lidl Stiftung & Co. KG v. OHIM

FEMIVIA / femibion, Judgment of 16 July 2014 in Case [T-324/13](#), Endoceutics, Inc. v OHIM,

FLEXI, Judgment of 13 June 2014 in Case [T-352/12](#), Grupo Flexi de León, SA de CV v OHIM



FLOWER ELEMENT ON CLOTHES, Judgment of 14 March 2014, in Case [T-131/13](#), Lardini S.r.l. v OHIM

FleetDataServices / TruckDataServices, Judgment of 26 March 2014, in Cases [T-534/12](#), [T-535/12](#), Still GmbH v OHIM

FOCUS/FOCUS, Judgment of 4 April 2014, in Case [T-568/12](#), Sofia Golam v OHIM

◆ FOUR STARS / FIVE STARS, Judgment of 3 September 2014 in Cases [T-686/13](#) and [T-687/13](#), Unibail Management v. OHIM,

◆ F1 LIVE / F1 FORMULA 1, Judgment of 11 December 2014 IN Case [T-10/09 RENV](#), *Formula One Licensing BV v. OHIM*

FOREVER / 4 EVER, Judgment of 16 January 2014, in Case [T-528/11](#), Aloe Vera of America, Inc. v OHIM

◆ FREELOUNGE / FREE, Judgment of 4 June 2014 in Case [T-161/12](#), Free SAS v OHIM

FREEVOLUTION / FREE et al, Judgment of 4 February 2014 in Case [T-127/12](#), Free SAS & Noble Gaming Ltd v OHIM

FUNNY BANDS, Judgment of 19 November 2014 in Case [T-344/13](#), Out of Blue KG v OHIM (not summarized)

GALILEO / GALILEO; Judgment of 11 September 2014 in Case [T-450/11](#); Galileo International Technology LLC v OHIM

GE / GE et al, Judgment of 28 February 2014 in Case [T-520/11](#), Genebre S.A. v. OHIM

GENERIA / GENERALIA generacion renovable, Judgment of 9 December 2014 in Case [T-176/13](#), DTL Corporación, S.L. v. OHIM

GEPRAL / DELPRAL, Judgment of 24 September 2014 in Case [T-493/12](#), Sanofi SA v OHIM

GIFFLAR Judgment of 9 July 2014 in Case [T-520/12](#), Pågen Trademark AB v OHIM

GIUSEPPE ZANOTTI DESIGN / ZANOTTI, Judgments of 18 September 2014 in Cases [C-308/13 P](#), [C-309/13](#), Società Italiana Calzature SpA v OHIM

GLAMOUR / TUDOR GLAMOUR, Judgment of 4 July 2014 IN Case [T-1/13](#), Advance Magazine Publishers, Inc. v. OHIM

◆ GOLDEN BALLS / BALLON D'OR, Judgment of 20 November 2014 in Cases [C-581/13 P](#) + [C-582/13 P](#) Intra-Press SAS + OHIM v. Golden Balls Ltd.

GOLDSTUCK / GOLDSTEIG, Judgment of 29 January 2014 in Case [T-47/13](#), Goldsteig Käsereien Bayerwald GmbH v OHIM

GRAPHENE, Judgment of 16 October 2014 in Cases [T-458/13](#) and [T-459/13](#), Joseba Larrañaga Otaño y Mikel Larrañaga Otaño v OHIM

GRAZIA / GRAZIA, Judgment of 26 September 2014 in Case [T-490/12](#), Arnoldo Mondadori Editore SpA, v OHIM

GULBENKIAN / FUNDACÃO CALOUSTE GULBENKIAN, Judgment of 26 June 2014 in Case [T-541/11](#), Fundação Calouste Gulbenkian &, Micael Gulbenkian v OHIM



HEATSTRIP / HEATSTRIP, Judgment of 9 July 2014 in Case [T-184/12](#), Moonich Produktkonzepte & Realisierung GmbH v OHIM

HIPERDRIVE, Judgment of 22 May 2014, in Case [T-95/13](#), Walcher Meßtechnik GmbH v OHIM

HOLZMICHEL / MICHEL, Judgment of October 1st 2014 in Case [T-263/13](#), Lausitzer Früchteverarbeitung GmbH v OHIM

IMPERIA / IMPERIAL, Judgment of 28 January 2014 in Case [T-216/11](#), Progust, SL & Soprallex & Vosmarques SA v OHIM

INNOVATION FOR THE REAL WORLD, Order of 12 June 2014 in Case [C-448/13P](#), Delphi Technologies, Inc. v OHIM,

IP ZONE et al, Judgment of 12 March 2014, in Cases [T-102/11](#), [T-369/12](#), [T-370/12](#), [T-371/12](#), American Express v OHIM

JUNGBORN / BORN, Judgment of June 11<sup>th</sup>, 2014 in Case [T-401/12](#), Robert Klingel OHG v OHIM

KAATSU, Judgment of 7 November 2014 in Case [T-567/12](#), Kaatsu Japan Co. Ltd. v OHIM

KAISERHOFF / KAISERHOFF, Judgment of 25 November 2014 in Case [T-556/12](#), Royalton Overseas Ltd v OHIM + S.C. Romarose Invest Srl

KASTEEL / CASTEL BEER, Judgment of 25 November 2014 in Cases [T-374/12](#) and [T-375/12](#), Brouwerij Van Honsebrouck v OHIM

◆ KW SURGICAL INSTRUMENTS / Ka We, Judgment of 26 September 2014 in Case [T-445/12](#), Koscher + Würtz GmbH, v OHIM

◆ LAGUIOLE / FORGE DE LAGUIOLE, Judgment of 21 October 2014 in Case [T-453/11](#), *Gilbert Szajner v. OHIM*

LAMBRETTA, Judgment of 30 September 2014 in Case [T-51/12](#), Scooters India Ltd, v. OHIM

◆ LAMBRETTA, Judgment of 30 September 2014 IN Case [T-132/12](#), Scooters India Ltd, v. OHIM

MANUFACTURE PRIM 1949, Order of 02/10/2014 in Case [T-215/12](#), MPM-Quality v.o.s. and Eutech a.s. v OHIM

MELT WATER ORIGINAL, Judgment of 14 January 2015 in Case [T-69/14](#), Research and Production Company « Melt Water » UAB v OHIM

MICRO / MICRO, Judgment of 16 January 2014 in Case [T-149/12](#), Investrónica, SA v OHIM

NANA, Judgment of 16 July 2014 in Case [T-196/13](#), Nanu-Nana Joachim Hoepf GmbH & Co. KG v. OHIM.

◆ NATUR / NATURA et al, Judgment of 13 November 2014 in Case [T 549/10](#), Natura Selection SL v. OHIM

La qualité est la meilleure des recettes, Judgment of 15 February 2014, in Case [T-570/11](#), Dr. August Oetker Nahrungsmittel KG v OHIM

LEISTUNG AUS LEIDENSHAFT, Judgment of 25<sup>th</sup> of March 2014 in Case [T-539/11](#), Deutsche Bank AG v OHIM



LIDL / LIDL MUSIC, Judgment of 27<sup>t</sup> February 2014 in Case [T-226/12](#), Lidl Stiftung & Co. KG v OHIM

◆ LINEX / LINES PERLA, Judgment of 16 October 2014 in Case [T-444/12](#); Novartis AG v OHIM

LOVOL / VOLVO, Judgment of 12 November 2014 IN Cases [T-524/11](#) and [T-525/11](#), *Volvo Trademark Holding AB v OHI*

◆ MAGNEXT / MAGNET 4, Judgment of 28 January 2014 in Case [T-604/11](#) , Mega Brands International & Diset, SA v OHIM

MAGNEXT / MAGNET 4, Judgment of 28 January 2014 in Case [T-292/12](#), Mega Brands International & Diset, SA v OHIM

MARINE BLEU / BLUMARINE, Judgment of May 14<sup>th</sup> 2014, in Case [T-160/12](#), Adler v OHIM

◆ MASTER / COCA-COLA, Judgment of 11 December 2014 IN Case [T-480/12](#), The Coca-Cola Company v. OHIM

MB / MB&P, Judgment of 6 November 2014 in Case [T-463/12](#), Eugen Popp and Stefan M. Zech v OHIM – de

M&Co. / MAX&Co. Judgment of 3 December 2014 in Case [T-272/13](#), Max Mara Fashion Group Srl v. OHIM

MEDINET, Judgment of 10<sup>th</sup> of April 2014, in Case [C-412/13P](#), Franz Wilhelm Langguth Erben v OHIM (not yet included in Overview)

MEGO / TEGO et al, Judgment of 23<sup>rd</sup> September 2014 in [Case T-11/13](#), Tegometal International AG v OHIM

MENOCHRON / MENODORON, Judgment of 28<sup>th</sup> April 2014, in Case [T-473/11](#), Longevity Health Products, Inc. v OHIM

METABIOMAX / metabiarex, Judgment of 11 June 2014, in Case [T-281/13](#) , Sofia Golam v OHIM

◆ METABOL / METABOL-MG, Judgment of 11 June 2014 in Case [T-486/12](#), Sofia Golam v OHIM

METABIOMAX / BIOMAX, Judgment of 11 June 2014 in Case [T-62/13](#), Sofia Golam v OHIM

MILANOWEK CREAM FUDGE / LUXURY CREAM FUDGE, Judgment of 9 April 2014, in Case [T-623/11](#), Pico Food GmbH v OHIM

MOL BLUE CARD / TARJETA BLUE BBVA et al, Judgment of 17 July 2014 in Case [C-468/13P](#), *MOL Magyar Olaj- cs Gazipari Nyrt. v. OHIM + Banco Bilbao Vizcaya Argentaria SA*

MOMARID / LOMARID, Judgment of 2 December 2014 in Case [T-75/13](#), Boehringer Ingelheim Pharma GmbH & Co. KG v OHIM

NAMMU / NANU, Judgment of 11 December 2014 in Case [T-498/13](#), Nanu-Nana Joachim Hoepp GmbH & Co., v. OHIM



NEWS+ / ACTU+, Judgment of 12 December 2014 in Case [T-591/13](#), Groupe Canal + Euronews v. OHIM

◆ nfon / fon et al, Order of 16. January 2014 in Case [C-193/13 P](#), nfon AG v OHIM

NOBEL / NOBEL, Judgment of 19 June 2014 in Case [T-382/12](#), Kampol sp. z o.o. v OHIM

NORWEGIAN GETAWAY, Judgment of 23 January 2014, in Case [T-513/12](#), NCL Corporation Ltd. v OHIM

NORWEGIAN BREAKAWAY, Judgment of 23 January 2014, in Case [T-514/12](#), NCL Corporation Ltd. v OHIM

NOTFALL, Judgments of 12 November 2014 in Case [T-188/13](#), Murnauer Markenvertrieb GmbH v OHIM

NOTFALL CREME, Judgments of 12 November 2014 in Case [T-504/12](#), Murnauer Markenvertrieb GmbH v OHIM

NUEVA, Judgment of 21 may 2014, in Case [T-61/13](#) 'Melt Water' UAB, v OHIM

◆ NUNA / NANA et al, Judgment of 23 September 2014 IN Case [T-195/12](#), Nuna International BV, Nanu-Nana Joachim Hoepp GmbH & Co. KG, v. OHIM

◆ OCTASA / PENTASA, Judgment of 9 April 2014, in Case [T-502/12](#), Farmaceutisk Laboratorium Ferring A/S v OHIM

◆ ORIBAY, Judgment of 9 December 2014 in Case [T-307/13](#) , Capella EOOD v. OHIM

ORIGINAL EAU DE COLOGNE, Judgment of 25. November 2014 in Case [T-556/13](#),, Verband der Kölnisch-Wasser Hersteller e. V. v OHIM

PARA.METRICA / Para.meta, Judgment of 30 January 2014 in Case [T-495/11](#) , Michael Streng v OHIM

PASSION TO PERFORM, Judgment of 25 March 2014, in Case [T-291/12](#), Deutsche Bank AG v OHIM

PATRIZIA ROCHA, Order of 30 January 2014 in Case [C-324/13 P](#), Fercal Consultoria e Servicos, Ld, v OHIM

◆ PEDRO/Pedro del Hierro, Judgment of 8 May 2014, in Case [T-38/13](#), Pedro Group Pte Ltd v OHIM

PEEK & CLOPPENBURG, Judgment of 10 of July 2014 in Cases [C-325/13P](#) and [C-326/13P](#) , El Corte Ingles, S.A. v OHIM



PIONEERING FOR YOU, Judgment of 12 December 2014 in Case [T-601/13](#), Wilo SE v. OHIM

◆ POLO PLAYER ON BICYCLE / POLO PLAYER ON HORSE, Judgment of 18 September 2014 in Case [T-265/13](#), *The Polo/Lauren Company, LP v. OHIM*

PREMENO / PRAMINO, Judgment of 11 December 2014 in Case [C-31/14P](#), OHIM v Kessel medintim GmbH and Janssen-Cilag GmbH

◆ PROFLEX / PROFEX, Judgment of 9 December 2014 in Case [T-278/12](#), *Inter-Union Technohandel GmbH v. OHIM*

◆ PRO OUTDOOR / OUTDOOR, Judgment of 11 September 2014 in Case [T-127/13](#), *El Corte Inglés S.A. v. OHIM*

PROBIAL / BIAL, Judgment of 21 January 2014 in Case [T-113/12](#); Bial-Portela & C<sup>a</sup>, SA v OHIM and Probiotal Spa

PROTEKT / PROTECTA, Judgment of 15. July 2014 IN Case [T-576/12](#), Grzegorz Łaszkiwicz v OHIM

PROTEKT / PROTEK, Judgment of 15. July 2014 IN Case [T-18/13](#), Grzegorz Łaszkiwicz v OHIM

PYROX/PYROT, Judgment of 8 May 2014, in Case [T-575/12](#), Pyrox GmbH v OHIM;

QUINTA S. JOSÉ DE PERAMANCA / PÈRA MANCA et al, Judgment of 27 February 2014, in Case [T-602/11](#), Pêra-Grave S.A.U. v. OHIM

REBELLA / SEMBELLA, Judgment of 23 January 2014 in Case [T-551/12](#); Coppenrath-Verlag GmbH & Co KG v OHIM

REHABILITATE, Judgment of 11 December 2014 in Case [T-712/13](#), Monster Energy Company v. OHIM

◆ REPRESENTATION OF A CHICKEN, Order of 8 May 2014 in Case [C-411-13P](#), OHIM v Sanco S.A. & Marsalman S.L

RON palma MULATA de CUBA / PALMA MULATA, in Case [T-381/12](#), Judgment of March 12<sup>th</sup> 2014, Canelo v OHIM

SANI / RANI, Judgment of 24 June 2014 in Case [T-532/12](#), Rani Refreshments FZCO v OHIM

SELOGYN / SELESYN, Judgment of 12. December 2014 in Case [T-173/13](#), *Selo Medical GmbH v OHIM*

SENSI SCANDIA / SCANDIA HOME, 25 September 2014 n Case [T-516/12](#), Ted-Invest EOOD v. OHIM

SHAPE OF AN INFANT CHAIR, *Hauck GmbH & Co. KG v. Stokke A/S et al.*; Opinion of Advocate General Szpunar of 14 May 2014 in Case [C-205/13](#)

◆ SHAPE OF CLASP LOCK, Judgment of 6 March 2014 in Case [C-97/12P](#), Louis Vuitton Malletier v OHIM

SHAPE OF CUPS, Judgment of 25 September 2014 in Case [T-474/12](#), *Giorgio Giorgis v OHIM*,



SHAPE OF AN ELECTRONIC SCREEN, Judgment of 26 February 2014 in Case [T-331/12](#), Sartorius Lab Instruments GmbH & Co. KG v. OHIM

SHAPE OF A HAND, judgment of 27 March 2014 in Case [C-530/12](#), OHIM v National Lottery Commission

SHAPE OF AN OLIVE OIL BOTTLE, Judgment of 11/04/2014, in Case [T-209/13](#), Olive Line International, S.L. v OHIM

SHAPE OF A PRODUCT, Judgment of 6 March 2014, (Joined Cases C-337/12P to C-340/12P); Pi-Design and Others v Yoshida and OHIM (C-337/12P and C-339/12P), in Case [C-337/12P](#) and OHIM v Yoshida (C-338/12P and C-340/12P)

SHAPE OF A LIQUEUR BOTTLE, Judgment of 16 July 2014 in Case [T-66/13](#), *Franz Wilhelm Langguth Erben GmbH & Co KG. v OHIM*

SHAPE OF A TURNBUCKLE, Judgment of 25. September 2014 in Case [T-171/12](#), Peri GmbH v OHIM

SHAPE OF WATER BOTTLE, Judgment of 14 January 2015 in Case [T-70/14](#), Research and Production Company « Melt Water » UAB v OHIM

SHOE WITH FIVE STRIPES, Judgment of 13 June 2014 in Case [T-85/13](#), K-Swiss, Inc. v OHIM

SIMCA, Judgment of May 8 2014 in Case [T-327/12](#), Simca Europe Ltd. v OHIM

SKYSOFT / SKY, Judgment of 15 October 2014 in Case [T-262/13](#), Skysoft Computersysteme GmbH v. OHIM

SMILECARD, Judgment of 25 September 2014 in Case [T-484/12](#); CEWE Stiftung & Co. KGaA v OHIM;

◆ SO BIO ETIC / SO... ?, Judgment of 23 September 2014 in Case [T-341/13](#), Groupe Léa Nature SA v OHIM – en

◆ SÔ: UNIC / SO... ? ONE, SO... ? CHIC, et al. Judgment of 3 April 2014, in Case [T-356/12](#); Debonair Trading Internacional Lda v OHIM

◆ SOTTO IL SOLE / VIÑA SOL et al, Judgment of 25 September 2014 in Case [T-605/13](#), *Alma-The Soul of Italian Wine LLLP v. OHIM-*

STAR FOODS/STAR SNACKS, Judgment of 8<sup>th</sup> May 2014, in Case [C-608/12P](#), Greinwald/Wessang v OHIM

STAR / STAR LODI, Judgment of 10<sup>th</sup> September 2014 in Case [T-199/13](#), DTM *Ricambi Srl vs. OHIM*

◆ STAR / STAR, Judgment of 8 October 2014 in Case [T-342/12](#), Max Fuchs v. OHIM

SUBSCRIBE, Judgment of 14 July 2014 in Case [T-404/13](#), NIT Insurance Technologies Ltd. v. OHIM.



◆ Sun Park Holidays / Sunparks Holiday Parks, Judgment of 16 January 2014 in Case [T-383/12](#), Ferienhäuser zum See GmbH v OHIM

SUN FRESH / SUNNY FRESH, Judgment of 23 January 2014 in Case [T-221/12](#), The Sunrider Corporation v OHIM

◆ T / T, Judgment of 7 October 2014 in Case [T-531/12](#), *Tifosi Optics, Inc. v OHIM*

THE ENGLISH CUT / EL CORTE INGLES, Judgment of 15 October 2014 IN Case, [T-515/12](#), El Corte Inglés S.A. v. OHIM

THE HUT / LA HUTTE, Judgment of 24 June 2014 in Case [T-330/12](#), The Hut.com Ltd & Intersport France v OHIM

THE LEADERSHIP COMPANY, Judgment of 12 December 2014 in Case [T-43/14](#), Heidrick & Struggles International Inc. v OHIM

THE SPIRIT OF CUBA, Judgment of 24 June 2014 in Case [T-207/13](#), 1872 Holdings vof & Havana Club International SA v OHIM

THE YOUTH EXPERTS, Judgment of 18 November 2014 IN Case [T 484/13](#), Lumene Oy v OHIM

TEEN VOGUE / VOGUE moda en lluvia, Judgment of 27 February 2014, in Case [T-37/12](#), Advance Magazine Publishers v OHIM

TEEN VOGUE / VOGUE, Judgment of 27 February 2014 in Case [T-509/12](#), Advance Magazine Publishers & Nanso Group Oy v OHIM

TrinkFix / DrinkFit, Judgment of 12 December 2014 in Case [T-105/13](#), Ludwig Schokolade GmbH & Co. KG v. OHIM

ULTRA CHOCO / ultra choco, Judgment of 21 January 2014 in Case [T 232/12](#), Agroekola EOOD v OHIM

◆ ULTRAFILTER INTERNATIONAL, Judgment of 19<sup>th</sup> June 2014, in Case [C-450/13P](#), Donaldson Filtration Deutschland vs. OHIM

UNIWEB et al / UNIFONDS et al, (remitted to the General Court (GC) by the European Court of Justice (CJ) in Case C-0317-10P), Judgment of 25 November 2014 in cases [T-303/06 RENV](#) and [T-337/06 RENV](#), UniCredit SpA v OHIM

UNITED AUTOGLAS / AUTOGLASS, Judgment of 16 October 2014 in Case [T-297/13](#), United Autoglas Deutschland GmbH & Co. KG v OHIM

URB, Judgment of 7 November 2014 in Case [T-506/13](#), Urb Rulmenti Suceava SA v OHIM



- ◆ YOGHURT-GUMS, Judgment of May 15<sup>th</sup> 2014, in Case [T-366/12](#), Katjes Fassin GmbH & Co. v OHIM
  
- ◆ YouView+ / You-View.tv, Judgment of 1 July 2014 in Case [T-480/13](#), You-View.tv v OHIM – en
  
- VALDASAAR / Val d'Azur, Judgment of 9 December 2014 in Case [T-519/13](#), Leder & Schuh International AG v. OHIM
  
- V POLO PLAYER ON HORSE / POLO PLAYER ON HORSE, Judgment of 18 September 2014 in Case [T-90/13](#), Herdade de S. Tiago II — Sociedade Agrícola, SA v. OHIM
  
- VIAVITA / VILA VITA PARC, Judgment of 14 July 2014 in Case [T-204/12](#), Vila Vita Hotel und Touristik GmbH & Viavita v OHIM
  
- VISCOTECH / VISCOPLEX, Judgment of 19 November 2014 in Case [T-138/13](#), Evonikj Vil Additions GmbH v OHIM
  
- ◆ VOGUE / VOGUE, Judgment of 27 February 2014 in Case [T-229/12](#), Advance Magazine Publishers & Eduardo Lopez Cabré v OHIM
  
- WALICHNOWY MARKO / MARKO, Order of 13. February 2014, in Case [C-177/13P](#), Marek Marszałkowski v OHIM,
  
- WASH & COFFEE, Judgment of 14 July 2014 in Case [T-5/12](#), BSH Bosch und Siemens Hausgeräte GmbH v OHIM
  
- WALZERTRAUM / WALZERTRAUM, Judgment of 17 July 2014 IN Case [C-141/13 P](#), Reber Holding GmbH & Co. KG v OHIM
  
- WATT, Judgment of 4 December 2014 in Cases [T-494/13](#) and [T-495/13](#), Sales & Solutions GmbH v OHIM
  
- Wolfgang Amadeus Mozart PREMIUM / W. Amadeus Mozart, Order of 20.05.2014 in Case [C-414/13 P](#); Reber Holding GmbH & Co. KG v OHIM
  
- ZENATO RIPASSA / RIPASSO, Judgments of 27 November 2014 in cases [T-153/11](#) and [T-154/11](#), Cantine Broglie 1 Srl v OHIM
  
- ZIECON / CERCON, Judgment of 1 July 2014 in Case [T-239/12](#), Jyoti Ceramic Industries PVT. Ltd v OHIM
  
- ZYTeL/ ZYTEL, Judgment of 9 April, 2014, in Case [T-288/12](#), El du Pont de Nemours and Company v OHIM



## Preliminary Rulings

KORNSPITZ, Preliminary Ruling of 6 March 2014, in Case [C-409/12](#), Backaldrin Österreich The Kornspitz Company GmbH v Pfahnl Backmittel GmbH

Design of a gazebo, Preliminary Ruling of 13<sup>th</sup> February 2014 in Case [C-479/12](#), H. Gautzsch Grosshandel GmbH & Co. v Münchener Boulevard Möbel Joseph Duna GmbH.

RED BULL, Preliminary Ruling of 16 January 2014 in Case [C-65/12](#), Bulldog e.a. v. Red Bull

COUNTERFEITING OF A PERFUME BOTTLE, Preliminary ruling of 5 June 2014 in Case [C-360/12](#), Coty Germany GmbH v First Note Perfumes NV.

NETTO Marken-Discount, Preliminary ruling of 10 July 2014 in Case [C-420/13](#), Netto Marken-Discount AG & Co. KG v Deutsches Patent- und Markenamt

HONDA, Preliminary Ruling Order of 17 July 2014 in Case [C-535/13](#), Honda Giken Kogyo Kabushiki Kaisha v. Maria Patmanidi AE.

ROLEX, Judgment of 6 February 2014 in Case [C-98/13](#), (Preliminary Ruling); Martin Blomqvist v Rolex SA

DESIGN OF CLOTHES, *Karen Millen Fashions Limited / Dunnes Stores & Dunnes Stores*, Preliminary Ruling in Case, [C-345/13](#).

DESIGN OF A RETAIL STORE, Preliminary Ruling in Judgment of 10 July 2014 in [C-421/13](#), Apple Inc. v Deutsches Patent- und Markenamt,