



EUIPO

EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

International Cooperation and Legal Affairs Department
Legal Practice Service

OVERVIEW OF GC/CJ CASE LAW 2015

STATUS: 31/12/15



The Legal Practice Service of the International Cooperation and Legal Affairs Department prepares a yearly overview of the GC/CJ case law regarding trade mark and design matters. The judgments and orders are arranged in categories to be browsed more easily according to their content.

This overview includes judgments, preliminary rulings and important orders rendered by the GC and the CJ.

Cases in which the GC or CJ have decided differently from the EUIPO are indicated by the symbol ♦ before the case number.

Cases that are cited in more than one category in the present report are indicated by the symbol ♦ before the case number.

While the annual summary is published after the entry into force of the Amending Regulation (EU) 2015/2424 in March 2016, all of the summaries and citations were compiled during 2015, where use of 'Community' instead of 'Union' (as in CTMA and CTM) as an abbreviation and CTMR and CTMIR for the legal texts were still applicable. For this reason, any use or reference to previous terminology such as the abovementioned should be read as an EUTM application or registration, or the legal texts of the EUTMR and EUTMIR respectively.

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

Each reference to a case contains an abstract of the relevant issues, together with an indication of the language of the proceedings. The original and its available translations can be accessed by CTRL + click on the respective case number.

For more detailed information, please see the GC/CJ database, which contains keywords, relevant legal norms, facts in brief and headnotes of each judgment.

Please note that the document does not necessarily reproduce the exact wording of the judgments, preliminary rulings or orders.



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



Table of Contents

I.	Procedural Matters	5
A.	Procedures before the GC/CJ.....	5
1.	Admissibility	5
2.	Essential procedural requirements.....	21
3.	General principles of Community Law	26
B.	Procedures before the Office	27
1.	Admissibility	27
2.	Essential procedural requirements.....	30
3.	General principles of Community law	44
4.	Others	49
II.	Absolute Grounds for Refusal/Invalidity	53
A.	Articles 7(1)(a) and 52(1)(a) CTMR — signs of which a CTM may consist	53
B.	Articles 7(1)(b), (c) and (d) and 52(1)(a) CTMR — non-distinctive, descriptive, customary.....	53
I.	Non-distinctive	53
II.	Distinctive.....	86
III.	Descriptive.....	91
IV.	Not descriptive	124
C.	Articles 7(1)(e) and 52(1)(a) CTMR — shape	126
D.	Articles 7(1)(f) and 52(1)(a) CTMR — public policy/morality.....	128
E.	Articles 7(1)(g) and 52(1)(a) CTMR — deceptive.....	128
F.	Articles 7(1)(h) and (i) and 52(1)(a) CTMR — emblems, etc.	129
G.	Articles 7(1)(j) and (k) and 52(1)(a) CTMR — geographical indications for wines and spirits — agricultural products and foodstuffs	129
H.	Articles 7(3) and 52(2) CTMR — distinctiveness acquired through use	130
III.	Relative Grounds for Refusal/Invalidity	136
A.	Articles 8(1)(a) and 53(1)(a) CTMR — identical signs/goods and services	136
B.	Articles 8(1)(b) and 53(1)(a) CTMR — likelihood of confusion	136
I.	Likelihood of confusion (LOC)	136
II.	No likelihood of confusion (NO LOC)	201
III.	Other LOC related cases	239
C.	Article 8(3) and Article 53(1)(b) CTMR — trade marks filed by agents	248
D.	Article 8(4) and Article 53(1)(c) CTMR — non-registered marks/other signs used in the course of trade.....	248
E.	Article 8(2)(c), Article 8(5) and Article 53(1)(a) CTMR — well-known marks/marks with a reputation.....	256
F.	Other issues.....	272



IV.	Proof of Use	274
V.	Other Cancellations	287
	A. Article 51(1)(a) CTMR – revocation due to non-use.....	287
	B. Article 52(1)(b) CTMR — bad faith.....	294
	C. Article 53(1), (2) and (3) CTMR — other relative grounds for invalidity.....	299
	D. Article 54 CTMR — acquiescence	301
VI.	Design Matters	302
	A. Article 3(a) and Article 9 CDR — registration proceedings	302
	B. Article 25(1)(b) CDR — invalidity proceedings	302
VII.	Enforcement	314
VIII.	Others	315
	A. Seniority (Article 34 CTMR)	315
	B. <i>Restitutio in integrum</i> (Article 81 CTMR).....	315
	C. Classification of Goods and Services	316
	D. Exhaustion of rights.....	316
	E. Surrender	317
	F. Written Communications	317
Annex 1:	319



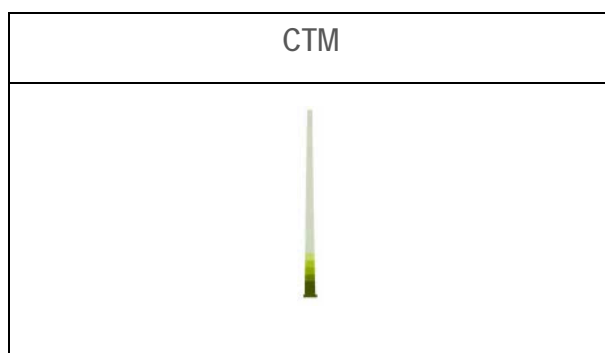
I. Procedural Matters

A. Procedures before the GC/CJ

1. Admissibility

1.1 Right to appeal, form, deadline

[C-35/14 P](#); **2D SHAPE WITH COLOURS**, Judgment of 12 February 2015, *Enercon GmbH v OHIM & Gamesa Eólica SL* – EN.



The CTM applicant registered as a colour mark the sign indicated above for ‘Wind energy converters and their parts’ in Class 7. An application for cancellation was filed. The Cancellation Division (CD) upheld the application on the grounds of Articles 7(1)(b) and 52(1)(a) CTMR. The CTM applicant filed an appeal against the CD’s decision. The BoA upheld the appeal, considering that the contested mark was composed of a figurative sign consisting of a two-dimensional shape with colours and had a sufficiently distinctive character. The cancellation applicant filed an application for annulment before the General Court (GC), which upheld the first plea. According to the GC, the BoA’s assessment and decision were based on an erroneous understanding of the nature of the mark: it is a colour mark, not a figurative one. Having found that error, the GC did not examine the distinctive character. The CTM proprietor lodged an appeal before the Court of Justice of the European Union (CJ). The grounds of appeal before the CJ were (i) the violation of the TM right due to the violation of a procedural rule and (ii) the violation of Article 7(1)(b) CTMR. The CJ dismissed the appeal as manifestly inadmissible pursuant to Article 181 RPCJ. The CJ held that the CTM proprietor did not acquire the status of ‘intervener’ before the GC and, therefore, he was not entitled to bring an appeal against the GC’s decision before the CJ pursuant to Article 56 of the Statute of the CJ (paras 24-25). The CJ stated that the CTM proprietor should have lodged a response to the application for annulment pursuant to Articles 134 and 135 RPCJ (paras 22-23), in which case it would have acquired the status of an ‘intervener’. The fact that the CTM proprietor had sent the mandate given to his lawyer and the acceptance of the language of the proceedings to the GC is not relevant in order to acquire the status of ‘intervener’ (para. 24). The CTM proprietor had not participated in the proceedings before the GC, especially since it had neither submitted its own conclusions nor supported those of one of the parties (para. 25).

◆ [T-593/13](#); **WINDER CONTROLS**, Judgment of 30 January 2015, *Siemag Tecberg Group GmbH v OHIM* – DE. The BoA confirmed the rejection of the word mark WINDER CONTROLS for goods and services in Classes 7, 9, 37, 41 and 42 pursuant to Article 7(1)(b) and (c) CTMR. The applicant filed an



action before the GC. The GC dismissed the action. The request for the oral hearing in the application to the GC is inadmissible, as it must be made within one month after the closure of the written procedure, Article 135a Rules of Procedure of the General Court (RPGC) (para. 13 et seq.). With regard to the alleged infringement of Article 7(1)(b) CTMR, if all elements of the mark are descriptive, their combination is, in general, also descriptive, unless the overall impression of the mark differs from the mere sum of those elements (para. 28). The mark applied for consists of the words 'winder' and 'control', both being descriptive for the goods and services at issue (paras 35-36). The combination is not unusual (para. 37). The BoA did not infringe the duty to state the reasons. Even if the products in question are of different art, they can be all used with a 'winder control system' and build therefore a homogeneous group (para. 41). The mark is not distinctive, Article 7(1)(b) CTMR (para. 52 et seq.).

[T-488/13](#); **engineering for a better world**, Order of 22 January 2015, *GEA Group AG v OHIM* – DE. The BoA notified its decision to reject the CTMA by fax. The respective transmission report stated the word 'OK'. The applicant filed a court action almost three months thereafter. The date of receipt of the fax transmitting the contested decision constitutes the starting point of the period prescribed for instituting proceedings against Office decisions notified by fax. The applicant does not dispute that its representative's IT system recorded and stored the fax but that it had actual knowledge thereof before the Office registry informed him thereafter (paras 7 and 17). However, according to case law, such knowledge is not required for notification purposes. Due notification of a decision has been effected once it has been communicated to the addressee and the addressee is in a position to take cognisance of it (para. 19). The latter places an obligation on the notifier to use best endeavours, which corresponds with the external aspect of the notification, rather than an obligation on the notifier to interfere in the internal functioning of the entity addressed (para. 20). According to case law, the production, by the Office, of fax transmission reports that included items conferring probative value on them is sufficient to prove that the fax in question had been received by the addressee. If there is a fax transmission report stating the word 'OK', it can be considered that the fax sent has been received by the addressee (para. 21). A malfunction of a fax machine does not constitute unforeseeable circumstances or *force majeure* under Article 45 of the Statute of the CJ either. These concepts contain both an objective element, relating to abnormal circumstances unconnected to the applicant, and a subjective element involving the obligation, on the part of the applicant to guard against the consequences of the abnormal event by taking appropriate steps, without making unreasonable sacrifices. The malfunction of the fax machine was not unconnected to the applicant's representative. It is an internal instrument of its law firm, which is responsible for it. According to the case law, a company's internal communication problems do not constitute unforeseeable circumstances or *force majeure*. As to the electrical works carried out during the months of the notification causing interruptions to the power supply and network connections, the applicant's representative did not take the appropriate step to check whether all incoming fax were forwarded to the inbox (paras 25-38). As a preliminary matter, the GC held that that Article 48(1) RPGC does not apply to offers of evidence in observations on a plea of inadmissibility. Such offers are inherent to the right of an applicant to respond to the arguments made by the defendants in its plea of inadmissibility since there is no procedural rule that requires an applicant to set out evidence relating to the admissibility of its action at the stage of the application (para. 30).

◆ [T-621/14](#); **DINKOOL / DIN et al.**, Judgment of 24 June 2015, *Prestação De Serviços, Comércio Geral e Indústria, Lda. v OHIM* – EN. The CTM applicant sought to register the word mark 'DINKOOL' for goods in Classes 1, 2, 3, 6, 7, 12, 16, 20 and 21. An opposition was filed, based on the earlier international trade mark 'DIN' (fig. mark), protected in several Member States (including Germany) for goods in



Classes 1-34. The opposition was further based on the non-registered sign 'DIN', used in the course of trade in Germany for the development of norms, standards and technical rules. The opposition was based on Article 8(1)(b) and Article 8(4) CTMR. The Opposition Division rejected the opposition. The BoA annulled the decision, found a likelihood of confusion and, based on Article 8(1)(b) CTMR, rejected the CTMA in its entirety. The applicant filed an action before the GC. The GC noted at the outset that the applicant's claim that the earlier mark has not been genuinely used was raised for the first time before the GC and is therefore inadmissible (paras 16-20).

◆ [T-337/14](#); **mobile.de proMotor / mobile**, Judgment of 22 April 2015, *Rezon OOD v OHIM* – DE. The cancellation applicant filed an application before the GC. The GC dismissed the application in its entirety. With regard to the alleged errors of the decision of the CD, the GC pointed out the inadmissibility of the claim. According to Article 65(1) CTMR, only decisions of the BoA are subject to an appeal before the GC (para. 23).

◆ [C-622/13 P](#); **CASTEL / Castell**, Order of 30 April 2015, *Castel Frères SAS v Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell and OHIM* – EN. The applicant registered the word mark 'CASTEL' as a CTM for goods in Class 33. An application for invalidity was filed based on the indication of geographical origin 'Castell', protected for wines in Germany, France, Greece, Italy and Spain. The CD dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal after finding that 'Castell' was an indication of geographical origin relating to wines produced in Germany and was perceived as such by the relevant public. The spelling difference was likely to create some distance and a conceptual difference between the terms in question. The invalidity applicant filed an action before the GC based on six pleas in law. Regarding the admissibility of the appeal, the CJ stated the single period of extension on account of distance is not to be considered to be distinct from the period for bringing an appeal referred to in Article 56 of the Statute of the CJ, but rather as an integral part of that period that it extends by a fixed period of time. Thus, the period within which an appeal must be brought is two months and ten days after notification of the decision appealed against (para. 28).

[T-633/14](#); **DEVICE OF A PEACE SYMBOL**, Order of 9 September 2015, *Monster Energy Company v OHIM* – EN. The applicant sought to register the figurative sign representing a peace symbol as a CTM for goods within Classes 5, 30 and 32. The examiner refused to register the sign as a CTM on the ground that it is devoid of distinctive character. The BoA dismissed the applicant's appeal. The BoA notified its decision by fax although the applicant had opted for e-communications. Six months later, the applicant informed the Office that it had not been notified of the BoA decision and requested a new period for bringing an action before the GC. The Office confirmed the notification of the BoA's decision by fax. The applicant filed an action before the GC, which was found to be manifestly inadmissible. **DATE OF NOTIFICATION OF CONTESTED DECISION / PERIOD FROM BRINGING AN ACTION**: The GC observes that the Office's fax machine's transmission report bears the word 'OK' and concludes that the Office had proved to the requisite legal standard that the fax that it sent to the applicant on 20 December 2013 reached the latter on that date and that, therefore, the contested decision, which was reproduced in that fax, was notified to and received by the applicant on 20 December 2013. Thus, even if the Office had not complied with the method of communication by electronic means chosen by the applicant, the contested decision must be deemed to have been notified on that date pursuant to Rule 68 CTMIR (paras 22-24). The GC recalls that to determine the date of receipt of a notification, account should be



taken only of the external aspect of the notification, irrespective of whether that entity effectively received and took cognisance of the notification (para. 26). Thus, the appeal before the GC lodged on 18 August 2014 is out of time. UNFORESEEABLE CIRCUMSTANCES OR *FORCE MAJEURE*: The applicant alleged an accident that gave rise to the malfunction of the representative's fax machine, namely a fire and a flood that resulted in a power cut. The GC recalls that the concept of *force majeure* does not apply to a situation in which, objectively, a diligent and prudent person would have been able to take the necessary steps before the expiry of the period prescribed for instituting proceedings (para. 35). The GC notices that a period of almost six months lapsed between the occurrence of the accident and the date on which the representative became aware of the contested decision. In order to guard against the consequences of the accident, the representative should have checked whether, during the period in which its fax machine was malfunctioning, there had been a failure in the reception of faxes and, to that purpose, should, without making unreasonable sacrifices, have ensured that the progress of that case was followed diligently by establishing as soon as possible after that malfunction had occurred, directly with the Office, whether the latter had notified a decision to him (paras 38-40). Since the representative did not take all reasonable steps to meet the deadline for bringing an action and ensure that the progress of the case was followed diligently in this instance, the concepts of *force majeure* and unforeseeable circumstances do not apply (paras 41-42).

[T-666/14](#); **GREEN BEANS**, Order of 9 September 2015, *Monster Energy Company v OHIM* – EN. The applicant sought to register the word mark 'GREEN BEANS' as a CTM for goods within Classes 5, 30 and 32. The examiner refused to register the word as a CTM on the ground that it is devoid of distinctive character. The BoA dismissed the applicant's appeal. The BoA notified its decision by fax although the applicant had opted for e-communications. Six months later, the applicant informed the Office that it had not been notified of the BoA decision and requested a new period for bringing an action before the GC. The Office confirmed the notification of the BoA's decision by fax. The applicant filed an action before the GC, which was found to be manifestly inadmissible. DATE OF NOTIFICATION OF CONTESTED DECISION / PERIOD FROM BRINGING AN ACTION: The GC observes that the Office's fax machine's transmission report bears the word 'OK' and concludes that the Office had proved to the requisite legal standard that the fax that it sent to the applicant on 20 December 2013 reached the latter on that date and that, therefore, the contested decision, which was reproduced in that fax, was notified to and received by the applicant on 20 December 2013. Thus, even if the Office had not complied with the method of communication by electronic means chosen by the applicant, the contested decision must be deemed to have been notified on that date pursuant to Rule 68 CTMIR (paras 24-26). The GC recalls that to determine the date of receipt of a notification, account should be taken only of the external aspect of the notification, irrespective of whether that entity effectively received and took cognisance of the notification (para. 28). Thus, the appeal before GC lodged on 16 September 2014 is out of time (para. 34). UNFORESEEABLE CIRCUMSTANCES OR *FORCE MAJEURE*: The applicant alleged an accident that gave rise to the malfunction of the representative's fax machine, namely a fire and a flood that resulted in a power cut. The GC recalled that the concept of *force majeure* does not apply to a situation in which, objectively, a diligent and prudent person would have been able to take the necessary steps before the expiry of the period prescribed for instituting proceedings (para. 37). The GC notices that a period of almost seven months lapsed between the occurrence of the accident and the date on which the representative became aware of the contested decision. In order to guard against the consequences of the accident, the representative should have checked whether, during the period in which its fax machine was malfunctioning, there had been a failure in the reception of faxes and, to that purpose,



should, without making unreasonable sacrifices, have ensured that the progress of that case was followed diligently by establishing as soon as possible after that malfunction had occurred, directly with the Office, whether the latter had notified a decision to him (paras 40-42). Since the representative did not take all reasonable steps to meet the deadline for bringing an action and ensure that the progress of the case was followed diligently in this instance, the concepts of *force majeure* and unforeseeable circumstances do not apply (paras 43-44).

◆ [T-209/14](#); **DEVICE OF A GREEN OCTAGON**, Judgment of 25 September 2015, *Carsten Bopp v OHIM* – DE. The applicant sought to register a green octagon for the services ‘advertising and public relations in the form of customer information through labelling of the properties of goods and services’ in Class 35. The examiner refused to register the application under Article 7(1)(b) CTMR. The BoA dismissed the appeal in its first decision (R 605/2010-4), holding that the application lacks distinctiveness for all services in Class 35 regardless of the services in question, which the applicant did not determine with sufficient clarity. The GC set the decision aside (T-263/11), reasoning that the BoA infringed the principle according to which the distinctiveness of a sign must be assessed with regard to the specific goods and services. The BoA dismissed the appeal in its second decision (R 1276/2013-1), as the octagon is a simple geometrical shape in green, a commonly used signal colour, with respect to the services in question. The GC dismissed the appeal. The BoA was competent to dismiss the appeal on the ground of a lack of distinctiveness. The GC in its previous decision did not render any finding determining the final outcome of the assessment under Article 7(1)(b) CTMR (paras 28-31). There is no principle in European Union law according to which the Office must, following a judgment allowing two different interpretations, choose the most beneficial interpretation for the party concerned (para. 32).

◆ [T-364/13](#); **KAJMAN / DEVICE OF A CROCODILE et al.**, Judgment of 30 September 2015; *Eugenia Mocek, Jadwiga Wentka KAJMAN Firma Handlowo-Uslugowo-Produkcyjna v OHIM* – EN. The applicant sought to register the figurative sign ‘kajman’ as a CTM for goods and services in Classes 18, 20, 22, 25 and 36. An opposition was filed against the registration on the basis, inter alia, of an earlier figurative CTM representing the device of a crocodile, which covers, inter alia, goods and services in Classes 18, 20, 24 and 25. The Opposition Division (OD) rejected the opposition. The BoA annulled the decision of the OD in part. The BoA considered there was a likelihood of confusion between the marks at issue in respect of goods in Classes 18 and 25. The applicant filed an application for annulment and the opponent filed an application for annulment in part and alteration before the GC. The GC considered the opponent’s complaint about the high degree of inherent distinctiveness of the earlier mark for goods in Class 20 to be out of time and therefore inadmissible (para. 87).

◆ [T-426/13](#); **AINHOA**, Judgment of 23 September 2015, *L’Oréal v OHIM* – ES. The applicant registered the word mark ‘AINHOA’ as a CTM for goods and services within Classes 3, 35 and 39. An application for revocation was filed based on the grounds that the CTM has not been put to genuine use in the European Union and in connection with the goods or services in respect of which it is registered within a continuous period of five years. The CD upheld the application for the services in Classes 35 and 39 and dismissed the application for the goods in Class 3. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. On the admissibility of part of the documents filed as proof of use by the CTM proprietor, the GC ruled that the proof was filed within the time limit specified by the Office and therefore admissible (para. 10 et seq.).



◆ [T-374/13](#); **Moon**, Judgment of 4 February 2015, *KSR Kunststoff Rotation GmbH v OHIM* – DE. The contested trade mark was the registered CTM ‘Moon’ (word) (for ‘lighting apparatus, in particular exterior and interior lights’ (Class 11)). Both instances cancelled the CTM as being descriptive according to Article 7(1)(c) CTMR. Procedure before the GC: The GC confirmed the case law that the authorisation for the lawyer to file an application may be filed during the proceedings, as long as it is shown that at the moment of filing the lawyer was authorised by the party (paras 11-12).

[T-545/14](#); **engineering for a better world**, Order of 6 October 2015, *GEA Group AG v OHIM* – DE. The applicant appealed the examiner’s decision to refuse the application for the mark ‘engineering for a better world’ under Article 7(1)(b) CTMR. The BoA dismissed the appeal on the same ground (‘first BoA decision’). The applicant filed a second application for an identical mark and, afterwards, an action before the GC against the first BoA decision. Regarding the second application, the examiner refused it on the basis of an assessment of Article 7(1)(b) CTMR. Following the applicant’s appeal against this second refusal, the BoA, after noting that the second application was identical to the first application, referred to the first BoA decision and reiterated it in part, by reason of which the appeal was rejected (‘second BoA decision’). The applicant filed another action before the GC against the second BoA decision. Thereafter, the GC rejected the action concerning the first BoA decision by order as it was filed belatedly. As is recognised in case law, a decision that merely confirms an earlier decision not challenged in due time is not an actionable measure. For the purpose of not allowing the time limit for bringing an action against the confirmed decision to recommence, an action against such a confirmatory decision must be declared inadmissible. A decision is regarded as a mere confirmation of an earlier decision if it contains no new factors as compared with the earlier measure and is not preceded by any re-examination of the situation of the addressee of the earlier measure (T-188/95 – *INSULATE FOR LIFE*) (paras 15-16). The first and the second BoA decision have the same subject matter. The latter does not assess any further issues and was not preceded by a re-examination of the applicant’s mark (para. 19). The applicant’s new reference to the registrations of other marks, in the second set of proceedings, cannot be qualified as substantial new facts. To be of such nature, that factor must be capable of substantially altering the conditions that governed the earlier measure, such as a factor that raises doubts as to the merits of the approach adopted by that measure (paras 21-22). For doubts of this sort, it is insufficient that the BoA did not follow the Office’s decision-making practice because each application is to be assessed on a case-by-case basis (para. 23). Since the applicant merely listed other registrations, despite the comprehensive reasoning given in the first BoA decision, the BoA was not obliged to re-examine the application. In fact, the BoA did not do so because it merely declared the other registrations to be irrelevant in view of the first BoA decision. In any event, addressing new facts cannot be considered as a re-examination of a former decision if there is no corresponding obligation to do so (paras 24-25). Said other registrations do not post-date the first BoA decision. In addition, the obligation to re-examine an application can only arise from the applicant’s submissions, given that a trade mark application must be motivated and documented according to Article 26 CMTR and Rule 1 CTMIR. Moreover, it would promote the possibility of a misuse of proceedings if an application were to trigger such obligation. Case law, however, does not allow the filing of applications with the aim of contesting the respective decision (para. 27). It is irrelevant that the examiner’s decision preceding the second BoA decision was not merely a confirmatory act, because only the second BoA decision is subject of the court proceedings (para. 28). It follows from the above that the second BoA decision merely confirms the final first BoA decision (para. 29). The belated action against the first BoA decision, which was still pending when the second BoA decision was rendered, does not



deprive it of its final character. Otherwise, it would render the case law concerning confirmatory acts of any effect, which has been developed in order to prevent that, by way of bringing of an action, an expired period for filing an action begins to run again (paras 30-33). For these reasons, the action is inadmissible.

◆ [T-395/14](#) and [T-396/14](#), **SHAPE OF A TOY FIGURE I and II (3D MARKS)**, Judgments of 17 June 2015, *Best-Lock (Europe) Ltd v OHIM – Lego Juris A/S* – EN. The invalidity applicant applied for a declaration of invalidity of two three-dimensional (3D) CTMs as regards the goods ‘games and playthings; decorations for Christmas trees’ (Class 28) based upon Article 52(1)(a) in conjunction with Article 7(1)(e)(i) and (ii), and Article 52(1)(b) CTMR. The CD rejected the request as it found that none of the grounds of invalidity invoked by the invalidity applicant were met. The BoA dismissed the appeal. As requested by the Office (and the intervener), the GC dismissed the action for annulment of the BoA’s decision as inadmissible for failure to comply with Article 44(1)(c) RPGC, which provides that an application ‘shall state the subject matter of the proceedings and a summary of the pleas in law on which the application is based’. As regards Article 7(1)(e)(i) CTMR, the GC found that the invalidity applicant had merely asserted that the contested CTMs consist of a shape determined by the nature of the goods themselves — but neither put forward any argument to support that assertion nor provided any reasoning to show that the BoA’s findings in that regard were incorrect. Therefore, the minimum requirements of Article 44(1)(c) RPGC were not met.

[T-453/13](#); **Klaes / Klaes**, Judgment of 12 February 2015, *Horst Klaes GmbH & Co. KG v OHIM* – DE. The applicant sought to register the word mark ‘Klaes’ as a CTM for goods and services, inter alia, within Class 42. An opposition was filed on the grounds of Article 8(1)(b) CTMR based on the earlier figurative mark ‘Klaes’ in relation to services registered in Class 42. The Opposition Division upheld the opposition. The Board of Appeal dismissed the applicant’s appeal, finding a high degree of similarity between the signs and a complementary link between the goods at issue. The applicant filed an action before the GC. The GC firstly recalls in relation to Article 44(1) RPGC that a general reference to other documents cannot compensate the lack of essential elements of the pleas in law which must appear in the action itself (para. 14).

1.2 Claims

1.2.1 Claims to issue directions to the Office

◆ [T-648/13](#); **GLISTEN**, Judgment of 10 February 2015, *IOIP Holdings LLC v OHIM* – EN. The applicant sought to register the word mark ‘GLISTEN’ as a CTM for goods within Class 3. The examiner refused the registration on the ground that it did not comply with Article 7(1)(b) and (c) CTMR. The BoA confirmed the rejection. The applicant filed an action before the GC claiming an infringement of Article 7(1)(b) and (c) CTMR. The applicant’s second head of claim, requesting the GC to order the Office to accept the registration of the mark applied for, is inadmissible insofar as it requests the GC to issue a direction to the Office (para. 10).



1.2.2 Claims to change an Office decision

◆ [T-608/13](#); *easyAir-tours / airtours Ticket Factory*, Judgment of 13 May 2015, *easyGroup IP Licensing Ltd, & Tui AG v OHIM* – EN. In its second head of claim, the applicant sought the rejection of the opposition in its entirety; the GC held that in reality the applicant asks the GC to take the decision which, in the applicant's submission, the BoA should have taken when it had the case. The GC, interpreting the second sentence of Article 64(1) CTMR, held that the BoA may annul the decision of the Office that was responsible for the contested decision and exercise any power within the competence of that department, in the present case rule on the opposition and reject it. Consequently, that measure is one of those that may be taken by the GC in the exercise of its power to alter decisions under Article 65(3) CTMR (para. 20). However the GC held that the 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 therefore, in principle, be limited to situations in which the 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 (judgments of 5 July 2011 in *Edwin v OHIM*, C-263/09 P, ECR, EU:C:2011:452, paragraph 72, and *BETWIN*, EU:T:2013:291, paragraph 78). As for the present case, the GC decided that the conditions for the exercise of the GC's power to alter decisions, as set out in the judgment in *Edwin v OHIM*, are not satisfied. Although it is in fact apparent that the BoA was required to find that there was no likelihood of confusion between the mark applied for and the earlier German figurative mark, the fact remains that the BoA — since it incorrectly found that the comparison of the mark applied for with that earlier mark was sufficient to establish that there was a likelihood of confusion capable of justifying the OD's upholding of the opposition — did not rule on whether there was any likelihood of confusion between the mark applied for and the four other earlier figurative marks (para. 69). Moreover, it held that since the issue of whether there is any likelihood of confusion between the mark applied for and the earlier marks other than that already taken into account was not examined by the BoA, it is not for the GC to examine it, for the first time, in its review of the legality of the contested decision (para. 70). Therefore, as the GC is not able to exercise its power to alter the contested decision in order to annul the OD's decision of 2 April 2012 and reject the opposition in respect of all the goods and services concerned, the applicant's second head of claim is rejected (para. 71). The BoA will have to assess, having regard to the grounds of the present judgment, in particular as regards the overall impression created by the mark applied for, which is different from that created by an earlier mark, the dominant element of which is 'airtours', whether there is a likelihood of confusion between the mark applied for and the earlier marks reproduced above, when making the decision that it is called upon to give on the appeal which is still pending before it (para. 72).

◆ [T-657/13](#); *ALEX / ALEX*, Judgment of 2 July 2015, *BH Stores BV v OHIM* – EN. The applicant sought to register the word mark 'ALEX' as a CTM for goods in Classes 16, 20 and 28. An opposition based, inter alia, on the earlier word mark 'ALEX', registered in Germany for goods in Class 28, was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA confirmed the OD's decision and dismissed the appeal. The opponent filed an action before the GC. In relation to the applicant's argument that the evidence filed by the opponent for the first time before the GC has to be disregarded, the GC recalled the case law according to which the purpose of actions before the GC is to secure review of the legality of decisions of the BoA for the purposes of Article 65 CTMR and, accordingly, the role of the GC is not to re-evaluate the factual circumstances in the light of evidence that has been produced for



the first time before it. For this reason, a part of the evidence was not taken into consideration. The GC found, however, that Annexes 13 and 19 to the application, although produced for the first time before the GC, are not strictly evidence but relate to the Office's usual practice in reaching decisions and to the case law of the EU judicature to which a party has the right to refer, even after the procedure before the Office is complete. Therefore, the GC found that evidence as admissible according to the relevant case law (paras 24-26).

◆ [T-137/14](#); **DEVICE OF A CIRCLE**, Judgment of 23 October 2015, *Castellani Srl v OHIM* – EN. The applicant sought to cancel the CTM for goods in Class 19. The CD revoked the CTM for all the contested goods because the nature of the use was not proven. The appeal before the Second BoA was dismissed, however not because the mark was not used in its registered form but because the extent of the use was not sufficiently proven. The GC dismissed both pleas on which the action was based, the alleged infringement of Article 75 and Articles 15(1)(a) and 51(1)(a) CTMR. ARTICLE 75 CTMR: The applicant's right of defence was not breached by the BoA, since the applicant had the opportunity to present its observations relating to all aspects of the application for revocation, including the extent of use (para. 22). It follows from the continuity in terms of functions between the various departments of the Office that, when the BoA conducts the review of decisions taken by the departments of the Office at first instance, it must base its decision on all the matters of fact and of law that the parties concerned introduced either in the proceedings before the department that heard the application at first instance or in the appeal (para. 23). The extent of the examination that the BoA must conduct in relation to the contested decision before it is not, in principle, determined solely by the grounds relied on by the party, or parties, to the proceedings before it (para. 24).

[C-142/14 P](#); **SUN FRESH / SUNNY FRESH**, Order of 3 June 2015, *The Sunrider Corporation v OHIM* – EN. The CTM applicant sought to register the word mark 'SUN FRESH' as a CTM for goods in Class 32. The OD upheld the opposition. The BoA upheld the appeal. The GC dismissed the action. The opponent filed an application before the CJ for the partial setting aside of the judgment under appeal (insofar as it dismissed its second and third pleas in law). The Office's plea of inadmissibility cannot be accepted, as the Office's argument in that regard is formulated in a general manner and is in no way substantiated by a specific analysis of the grounds of appeal and arguments developed in the appeal that are allegedly inadmissible for the reason given (para. 39-40). The statement as to there being 'medical use in the broad sense of the term', made in the context of the determination of the degree of attention of the relevant public for the purposes of the application of Article 8(1)(b) CTMR does not constitute a legal characterisation of the goods in question as 'medicinal products' within the meaning of Article 1(2) of Directive 2001/83 and Article 2 of Regulation No 726/2004 (para. 55). Hence, in the absence of proof of a distortion of the clear sense of the evidence made by the GC, the findings made by the GC as to the attention of the relevant public constitute factual assessments that are not subject to review by the CJ on appeal (para. 57). The same conclusion must also be drawn as regards the assessment made by the GC that the main function of herbal nutritional supplements in Class 5, such as the herbal concentrate marketed by the opponent under the trade mark 'SUNNY FRESH', is to be consumed 'in order to prevent or remedy medical problems in the broad sense of the term or to balance nutritional deficiencies' (para. 58). Before both the BoA and the GC, the opponent did contest the accuracy of the well-known fact that nutritional supplements are generally offered for sale in pharmacies, drugstores or specialised departments. Although the GC did not ultimately accept the opponent's position, it explained this by stating that the opponent had not put forward any evidence in support of its claim. Hence, the opponent's



right to be heard has not been infringed. Likewise, since no distortion has been established in that regard, that assessment of the evidence by the GC cannot form the subject matter of an appeal (paras 64-67). The opponent did not, in any of the three pleas in law relied on in support of its application before the GC, claim that the decision at issue was vitiated by an error of law on the ground that, in the context of the examination of the similarity of the goods covered by the marks at issue, the BoA ought to have compared the goods covered by the earlier trade mark with each of the goods in respect of which the registration of the mark applied for had been sought. It follows that the opponent's argument constitutes a new argument and it is, therefore, inadmissible at the appeal stage (paras 76-77). The GC merely added an observation as to the difference in the level of attention of that public according to whether the goods are those covered by the earlier trade mark or those covered by the mark applied for. Since the BoA did not express its views as to the level of attention of the relevant public, it cannot be inferred that it implicitly decided that that level would necessarily be the same for the goods covered by the marks at issue (paras 88-90). The criterion based on the usual commercial origin of the goods concerned is in essence the same as that accepted by the GC, and criticised by the appellant, that a 'large part' of the manufacturers and distributors of the goods at issue are the same (para. 101). Even if the decision at issue were to be regarded as being vitiated by error insofar as the BoA stated that the goods covered by the marks at issue required entirely different skill sets for their manufacture and sale, the absence of similarity of those goods was sufficiently established, having regard to the other differences between those goods (para. 113). A difference between the goods covered by the marks at issue as to their main function is clearly relevant, even decisive, for the purposes of the examination of their substitutability and, therefore, of whether they are in competition with each other (para. 124).

◆ [T-588/14](#); **FlexValve**, Judgment of 23 September 2015, *Mechadyne International Ltd v OHIM* – DE. The applicant sought to register the figurative mark 'FlexValve' for various goods and services in Classes 7, 9, 12 and 42. The examiner largely refused this CTMA under Article 7(1)(b) and (c) CTMR. The BoA dismissed the appeal holding that the sign refers to adaptable valves and thus describes the goods and services. The General Court confirmed the BoA decision. By way of stating that the font at hand is similar to other typical fonts and that the goods and services have the same characteristics in common, which are described by the CTMA, the BoA gave sufficient reasons under Article 75 CTMR (paras 60-73).



1.2.3 Claim by applicant to confirm decision

[no entry]

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 the Court

[no entry]

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*

◆ [T-368/13](#); **ANGIPAX / ANTISTAX**, Judgment of 10 February 2015, *Boehringer Ingelheim International GmbH v OHIM* – FR. The applicant sought to register the word mark ‘ANGIPAX’ as a CTM for goods within Class 5 (class heading). An opposition based on earlier Community word mark ‘ANTISTAX’, registered for ‘pharmaceutical products’ in Class 5, was filed on the grounds of Article 8 (1)(b) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The GC upheld the Office’s plea to declare inadmissible the AIPPI report filed by the opponent before the GC that had not been submitted during the administrative phase (para. 19), and confirmed that a judgment from the *Bundesgerichtshof* submitted for the first time before the GC by the opponent for illustrative purposes was admissible.

◆◆ [T-611/11](#); **MANEA SPA / SPA**, Judgment of 17 March 2015, *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM* – FR. The CTMA ‘MANEA SPA’ (word mark), in Classes 3, 24, 25, 43 and 44, was opposed on the basis of, inter alia, two earlier Benelux registrations of the word ‘SPA’ in Classes 3 and 32. According to the case law, the submission of national judgments for the first time before the GC is admissible, regardless of whether these documents were prior to or later than the contested decision if they are merely submitted as illustrative case law precedents (for instance, in the GC judgment of 1 February 2012, *T-291/09, POLLO TROPICAL CHICKEN ON THE GRILL*, paras 34-35). However, if the national judgments are relied on as facts or evidence in support of a previously stated claim, they are inadmissible. In this case, two national judgments were submitted for the first time before the GC in



support of the reputation claim, those judgments establishing the reputation in the Benelux countries. They are therefore inadmissible (para. 29). Even if the parties concentrated their submissions before the BoA on Article 8(5) CTMR, the BoA was called to adjudicate on Article 8(1)(b) CTMR, because the appeals lodged by the parties concerned both grounds. It follows that the opponent is not altering the subject matter of the dispute by contesting before the GC the way Article 8(1)(b) CTMR was applied by the BoA (paras 31-35).


◆ [T-684/13](#); **BLUECO / BLUECAR**, Judgment of 25 September 2015, *Copernicus Trademark Ltd v OHIM* – DE. The CTM applicant sought to register the word mark ‘BLUECO’ for, inter alia, goods in Class 12. The opponent based its opposition on Article 8(1)(b) CTMR using the earlier CTM word mark ‘BLUECAR’, registered, inter alia, for goods in Class 12. The opposition was directed against the goods in Class 12. The OD upheld the opposition for the contested goods. The BoA dismissed the applicant’s appeal. The CTM applicant filed an action before the GC. Regarding the new evidence produced for the first time before the GC, the applicant produced before the GC several documents that had not been produced in the proceedings before the BoA. In support of its line of argument, it presented for the first time before the GC that the term ‘blue’ referred, in particular in the automobile sector, to respect for the environment. The GC recalls that, according to the settled case law, the GC, in reviewing the legality of the decisions of the BoA of the Office, cannot re-evaluate the factual circumstances in the light of evidence adduced for the first time before it. Consequently, the new evidence submitted before the GC with the aim of establishing new facts are found inadmissible (paras 20-23).

◆ [T-3/15](#); **DEVICE OF FIVE STRIPES**, Judgment of 4 December 2015, *K-Swiss v OHIM* – EN. The international registration (IR) holder sought to register the figurative mark as an IR designating the EU (IR No 932 758) for goods and services within Class 25. The examiner refused to register the mark on the ground of Article 7(1)(b) CTMR. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The applicant claimed that the BoA ought to have supplemented the evidence at its disposal. The GC stated that if an applicant claims that the trade mark applied for is distinctive, despite the Office’s analysis, it is for that applicant to provide specific and substantiated information to show that the trade mark applied for has an intrinsic distinctive character (para. 45). It was therefore not for the BoA to supplement the evidence that was available to it (para. 46).

◆ [T-583/14](#); **FLAMINAIRE / FLAMINAIRE**, Judgment of 8 December 2015, *Giand Srl v OHIM* – IT. The CTM applicant sought to register the word mark ‘FLAMINAIRE’ as a CTM for goods in Classes 16 and 34. An opposition based on earlier Spanish word marks ‘FLAMINAIRE’, registered for goods in Classes 16 and 34, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. In reply to the CTM applicant’s arguments invoking breach of the *ne bis in idem* and *res judicata* principles, the GC recalled that the *ne bis in idem* principle applies only to sanctions, therefore it cannot be successfully invoked with regards to opposition proceedings such as those relied upon by the applicant. In any event, the facts of the previous decisions mentioned by the CTM applicant differ from those of the present case (paras 19-20). Likewise, the *res judicata* principle does not apply to administrative decisions such as those of the Office (para. 21).



◆♦[T-100/13](#); **CAMOMILLA / CAMOMILLA**, Judgment of 9 July 2015, *C.M.T. – Compagnia Manifatture Tessili S.r.l., v OHIM – Camomilla S.p.A* – IT.

CTMA	Earlier mark
CAMOMILLA	

Camomilla S.p.A., (the CTM owner) was granted CTM registration for the word mark 'CAMOMILLA' for, inter alia, goods in Classes 3, 9, 11, 14, 16, 18, 20, 21, 24, 25, 27, 28 and 30. Compagnia Manifatture Tessili S.r.l. (applicant before the GC or applicant) submitted an application for a declaration of invalidity of the mark at issue, based on the above figurative Italian mark registered for 'clothing items' in Class 25. The application was filed under Articles 52(1)(b) and 53(1)(a) CTMR in conjunction with Article 8(1)(b) and Article 8(5) CTM. The CD dismissed the application for invalidity. The BoA confirmed the CD's decision and dismissed the appeal. The BoA found that the applicant did not show that the contested mark was registered in bad faith under Article 52(1)(b) CTMR. In relation to Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR, the BoA found that the genuine use of the earlier mark was not proven, in particular as far as the nature of the use was concerned. The BoA also found that the additional documents filed before the BoA to demonstrate the use of the earlier mark could not be taken into account as they had been filed out of time. The BoA stated that belated evidence could be admitted only when 'new elements' occurred to the extent that it became necessary to assess that evidence, which was not the case. Therefore, the ground based on Article 8(1)(b) CTMR was dismissed. The applicant filed an action before the GC, alleging three pleas in law: the infringement of Article 52(1)(b) CTMR, the infringement of Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR and the infringement of Article 53(1)(a) in conjunction with Article 8(5) CTMR. In relation to the infringement of Article 8(1)(b) CTMR in conjunction with Article 53(1)(a) CTMR, the applicant argues that the BoA erred in not taking into account the evidence filed out of the time given by the CD to show genuine use of the earlier marks, without exercising its power and admitting it as complementary to the evidence already submitted. The GC noted that, as is apparent from the wording of Article 76(2) CTMR, the Office may disregard facts that were not submitted or evidence that was not produced in due time by the parties. In stating that the latter 'may', in such a case, decide to disregard facts and evidence, that Article grants the Office wide discretionary powers to decide, while giving reasons for its decision in that regard, whether or not to take such information into account (paras 68-69). Rule 40(6) CTMR expressly states that the Office will reject the application for invalidity if the applicant does not provide proof of use before the time limit expires. (para. 73). In this case, the applicant submitted relevant evidence within the time limit and presented additional evidence after the time limit has expired. The GC noted that, according to the case law, in such cases the BoA cannot exercise its discretionary power only when the late evidence is manifestly irrelevant. On the contrary, taking such facts or evidence into account is particularly likely to be justified where the Office considers, first, that the material that has been produced late is, on the face of it, likely to be relevant to the outcome of the proceedings brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (paras 73-78). In the case at hand, the elements of evidence submitted late, namely pictures showing the mark on the goods and copies of invoices, appear to be prima facie relevant to the decision of the proceedings. Neither results from the file that the applicant had abused the time limits set by knowingly employing delaying tactics or by demonstrating



manifest negligence. It has just added elements of evidence complementary to the evidence already submitted on time. In light of the above, the GC annulled the contested decision (paras 79-81).


◆◆[T-96/13](#); *MACKA / MACKA*, Judgment of 28 October 2015, *Rot Front OAO v OHIM* – EN.

CTMA	Earlier mark
<p data-bbox="316 696 592 775">Ма́ска</p>	

The applicant sought to register the figurative mark represented above as a CTM for goods within Class 30. An opposition based on the earlier sign used in Germany for ‘sweets’ was filed on the grounds of Article 8(4) CTMR. The OD dismissed the opposition and found that the earlier sign was not used as required to obtain protection under German law. The BoA confirmed the decision. The opponent filed an action before the GC claiming an infringement of Article 8(4) CTMR in conjunction with § 4 (2) German Trade Mark Law. The GC allowed the action. On the admissibility of the documents submitted for the first time before the GC, it decided that the applicant is entitled to refer to them insofar as they are documents and arguments relating to national legislation and the national courts’ judicial practice. It is apparent from the case law that neither the parties nor the GC itself can be precluded from drawing on national legislation, case law or academic writing for the purposes of interpreting national law to which, as in the present case, EU law makes reference where reliance is placed on judgments or academic writing in support of a plea alleging that the BoA misapplied a provision of national law (para. 15). However, a new factual aspect in support of the arguments already put forward before the Office cannot be taken into consideration within the context of the present action. The purpose of actions before the GC is to review the legality of decisions of the BoA for the purposes of Article 65 CTMR, therefore it is not the GC’s function to review the facts in the light of documents produced for the first time before it. Accordingly, the documents concerned were excluded, without it being necessary to assess their probative value (para. 17).



◆ [T-354/14](#); **ZuMEX / JUMEX**, Judgment of 9 December 2015, *Comercializadora Eloro, S.A. v OHIM – ES*.

CTMA	Earlier mark
	<p>JUMEX</p>

The applicant sought to register the figurative mark represented above as a CTM for goods in Class 32. An opposition based on earlier word mark 'JUMEX', registered for goods in Class 32, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA upheld the applicant's appeal. The opponent filed an action before the GC. The GC confirms that the evidence submitted for the first time before it is inadmissible (paras 26-30). BELATED EVIDENCE: the BoA correctly made use of its discretionary power and, attending to the reasoning contained in the BoA's decision, correctly rejected it (paras 69-75).

◆ [T-254/13](#); **STAYER**, Judgment of 4 June 2015, *Stayer Ibérica, SA v OHIM – EN*. The GC recalls the judgment in *New Yorker SHK Jeans v OHIM*, C-621/11 P and states that where evidence that is considered to be relevant for the purposes of establishing use of the mark at issue has been produced within the time limit set by the Office under Rule 40(6) CTMR, the submission of additional proof of such use remains possible after the expiry of that time limit. In such a case, the Office is in no way prohibited from taking account of evidence submitted out of time through use of the discretion conferred on it by Article 76(2) CTMR (para. 32). In the context of invalidity proceedings, taking facts or evidence of genuine use submitted out of time into account is particularly likely to be justified where the Office considers, first, that the evidence submitted late is, on the face of it, likely to be relevant to the outcome of the invalidity proceedings brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not preclude such evidence being taken into account (para. 33). The fact that the invoices submitted out of time concerned a larger number of goods than those produced before the CD is not capable of calling into question the fact that they constitute additional evidence (para. 37). Furthermore, it is not necessary that the party concerned be unable to submit evidence within the time limit (para. 41).

1.5 Limitations, including restriction of goods and services

◆ [T-100/14](#); **TECALAN / TECADUR**, Judgment of 30 April 2015; *Tecalan GmbH v OHIM – DE*. The applicant sought to register the word mark 'TECALAN' as a CTM for goods within Class 17. An opposition based on the earlier word mark 'TECADUR', registered for goods in Class 17, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) CTMR. The GC dismissed the action. It affirmed the likelihood of confusion. The limitation of the goods by the CTM



applicant made in the oral hearing cannot be accepted as it changes the subject matters of proceedings (para. 34).

1.6 *Matters of fact appealed to the CJ*

[no entry]

1.7 *Others, including general references to previous statements*

◆ [T-543/13](#); **PRANAYUR / AYUR et al.**, Judgment of 5 March 2015, *Three-N-Products & Munindra Holding v OHIM* – EN. The CTM application for the word mark ‘PRANAYUR’ was filed for products in Classes 5 and 30. An opposition based on four earlier CTMs (one word mark ‘AYUR’, and three figurative marks) for goods in Classes 5 and 30 was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition, the opponent filed an appeal. The BoA dismissed the appeal. On the earlier word mark ‘AYUR’, the GC took note that this word mark was cancelled by the Office and that that cancellation was confirmed by the GC in its judgment (*AYUR*, EU:T:2013:583, para. 11) and, on appeal, by the CJ in its order in *Three-N-Products v OHIM*, EU:C:2014:2078, para. 11. Accordingly, the GC held that there is no longer any need to adjudicate on the plea in law concerning the risk of confusion with that mark. Finally on the other earlier figurative signs, the GC concluded that this second plea in law must be declared inadmissible under Article 44(1)(c) of the RPGC, since the applicant does not present any legal analysis regarding the existence of a likelihood of confusion with those other marks. Accordingly it rejected the second plea in law and the action in its entirety as no infringement of Article 8(1)(b) CTMR has been established.

[T-535/13](#); **VAKOMA / Vacom**, Order of 13 January 2015, *Vakoma GmbH Appellant v OHIM* – DE. The applicant sought to register the figurative mark ‘VAKOMA’ as a CTM for goods within Class 7. The opposition based on the earlier CTM for the word mark ‘VACOM’ and registered also for goods in Class 7 was upheld due to likelihood of confusion pursuant to Article 8(1)(b) CTMR. The BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The action is obviously inadmissible and the GC can decide by a reasoned order (para. 14). The action before the GC has to contain a summary of the pleas in law, pursuant to Article 21(1) of the Statute of the CJ, which applies to the procedure before the GC according to its Article 53 (1) and pursuant to Article 44(1) RPGC. It must be sufficiently clear and precise to enable the defendant to prepare its defence and the GC to exercise its power of review (para. 17). The present action does not contain the necessary clear and precise submissions to support the request to annul it (para. 19). It is limited to repetitions of the contested decision itself (para. 20) or general references to applicant’s submissions in administrative procedure, which cannot replace the required reasoning (paras 20-21 with further case law).



2. Essential procedural requirements

2.1 Right to be heard

◆ [T-715/13](#); **Castello / Castelló, Castelló y Juan S.A.**, Judgment of 5 May 2015, *Lidl Stiftung & Co. KG v OHIM & Horno del Espinar, S L* – EN. The CTM applicant sought to register the figurative sign ‘Castello’ as a CTM for goods in Classes 29, 30, 31. An opposition based on an earlier Spanish figurative sign ‘Castelló’, for services in Class 35, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition in its entirety. The BoA dismissed the appeal. The opponent brought an action before the GC, relying on three pleas in law: (i) infringement of the second sentence of Article 75 CTMR; (ii) infringement of Article 79 CTMR; and (iii) infringement of Article 8(1)(b) CTMR. Concerning the third plea under Article 8(1)(b) CTMR, the GC rejected the plea and confirmed the BoA’s assessment of likelihood of confusion. As regards the infringement of Article 79 CTMR, the GC took note that this plea would be addressed together with the following plea on Article 75(2) CTMR (paras 53-55). Lastly, concerning the infringement of the second sentence of Article 75 CTMR, firstly the GC found that the BoA was fully entitled to rely on the documents sent by the applicant and, without first hearing the applicant, find that no request for proof of genuine use had been lodged during the proceeding before the OD (paras 57-62). Secondly, the GC found that the ground concerning non-notification of the observations in response lodged by the opponent during the proceedings before the BoA was without a factual basis (paras 64-65). Moreover, the GC rejected the argument concerning the failure to notify the filing of documents showing the renewal of the other mark of the opponent, considering that the BoA did not rely on such mark in adopting its decision (para. 67). However, the GC found that the BoA did not allow the applicant to submit its observations on documents showing the renewal of the earlier mark, since they constituted one of the foundations of its decision (paras 69-72). The GC held that such procedural irregularity has had a concrete effect on the ability of the applicant to defend himself (para. 85). Therefore, the plea in law, alleging an infringement of the second sentence of Article 75 CTMR, and the plea alleging an infringement of Article 79 CTMR as concerns the failure to notify the evidence of renewal of the earlier mark, were upheld (paras 88-92) and the contested decision was annulled.

◆ [T-24/13](#); **CACTUS OF PEACE, CACTUS DE LA PAZ / Cactus**, Judgment of 15 July 2015, *Cactus SA v OHIM* – EN. The applicant sought to register the figurative sign ‘CACTUS OF PEACE, CACTUS DE LA PAZ’ as a CTM for goods and services within Classes 31, 35 and 39. An opposition based on earlier word mark ‘CACTUS’, as well as on an earlier figurative mark ‘Cactus’, was filed on the grounds of Article 8(1)(b) CTMR. The OD partially upheld the opposition for ‘seeds, natural plants and flowers’ in Class 31 and ‘gardening, plant nurseries, horticulture’ in Class 44, which are covered by the earlier word mark and it accepted the registration of the contested CTMA for the services in Class 39. The BoA upheld the appeal filed by the opponent and dismissed the opposition in its entirety. The opponent filed an action before the GC relying on three pleas in law. In the second plea in law, the opponent puts forward two complaints. First, that the BoA infringed Article 76(1) CTMR by examining on its own motion whether ‘retailing of natural plants and flowers, grains, fresh fruits and vegetables’ services in Class 35 were covered by the earlier mark and consequently, that the BoA infringed Article 75 CTMR since the opponent did not have the opportunity to present its comments on that point. Secondly, the opponent submitted that the BoA erred in considering that the services in Class 35 were not covered by the earlier marks, and that the OD erred in considering that genuine use of the earlier marks in respect of those services had been established (paras 17-18). Concerning the first complaint, the GC pointed out that



proof of genuine use was an issue raised by the parties before the OD and the BoA. In this regard, the GC further stated that although the parties did not dispute the OD's findings concerning genuine use in relation to the abovementioned services in Class 35, they nonetheless submitted comments on that finding (paras 25-27). In this light, the GC found that the BoA was required to examine the comments submitted by the parties in order to determine whether the OD's decision could be upheld. Therefore, the GC did not find an infringement of Article 76(1) CTMR (para. 28). The GC stressed that the BoA was entitled to examine on its own motion whether the referred services in Class 35 were covered by the earlier marks for the purposes of determining whether they had been put to genuine use. However, the GC found that the BoA committed a procedural error since it was required to give the parties an opportunity to present their comments, under Article 75 CTMR (paras 28 and 30). Regarding the second complaint, the GC found that the BoA erred in finding that 'retailing of the natural plants and flowers, grains; fresh fruits and vegetables' services were not covered by the earlier marks, since the opponent, which registered its earlier marks before the entry into force of Communication No 2/12 and the judgment in 'Praktiker', had the option of using all the general indications listed in the heading of Class 35 in order to demonstrate its intention to cover all the services in that class. In this light, the GC found that the applicant was not required to specify the goods or types of goods concerned by the retail trade in goods (paras 38-40). The first and second pleas in law were upheld, while the third plea was rejected, with the outcome that the BOA's decision was partly annulled.

◆ [T-320/14](#); **WAVY BLACK LINES / WAVY BLACK LINE**, Judgment of 25 November 2015, *Sephora v OHIM* – ES. The applicant sought to register the figurative mark of two wavy black lines as a CTM for goods and services within Classes 3, 35 and 44. An opposition based on the earlier figurative national mark and IR with effect in Bulgaria, the Benelux countries, Spain, Italy, Poland, Portugal and Romania, of the figurative mark of one wavy black line, registered for goods in Class 3, was filed on the grounds of Article 8(1)(b) CTMR. In response to the opposition, the applicant requested the opponent to provide proof of use of the earlier marks for all goods on which the opposition was based pursuant to Article 42(2) and (3) CTMR. Evidence was submitted by the opponent. The OD rejected the opposition. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC. The GC found that there is no infringement of Article 75 CTMR, as the fact that the BoA did not rule on the level of attention of the relevant public in its decision. The finding of the BoA that the signs at issue are dissimilar must be confirmed according to the GC irrespectively of the level of attention of the relevant public (paras 67-73).

2.2 Adequate reasoning

◆ [C-182/14 P](#); **MAGNEXT et al. / MAGNET 4**, Judgment of 19 March 2015, *MEGA Brands International v OHIM* – EN. The appellant sought to register the word mark 'MAGNEXT' (Case T-292/12) and a figurative mark (Case T-604/11) 'MAGNEXT' as two CTM's for Class 28 goods, namely 'toys and playthings, in particular multi-part construction toys, its parts, its accessories and its fittings'. An opposition based on, inter alia, an earlier Spanish word mark 'MAGNET 4', covering goods in Class 28 namely 'games, toys, gymnastic and sports articles not included in other classes; decorations for Christmas trees' was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition on the basis of Article 8(1)(b) CTMR in both cases, finding that there was a likelihood of confusion for both the figurative mark and the word



mark. The BoA confirmed the OD decisions. On appeal by the CTM applicant, the GC joined the two cases to the effect as held in a judgment of 4 February 2014 (T-604/11) that the BoA had made an error of assessment by recognising a likelihood of confusion between the figurative mark applied for and the earlier mark, and in case T-292/12, the GC confirmed the BoA decision. The CJ states that the GC has not provided any reasoning, not even implicitly, which makes it possible to understand why it categorised the element 'magnet' as dominant (para. 57). And the GC has also failed to provide any reasoning, even if only implicit reasoning, for its decision not to include the figure '4' in its assessment of the similarity of the signs at issue (para. 58). Therefore insofar as it is based on an assessment of the visual and phonetic similarity of the signs at issue that is marred by a lack of reasoning, the GC finding that there was a likelihood of confusion, in paragraph 35 of the judgment under appeal, is itself insufficiently substantiated (para. 59). The CJ referred the case back to the GC to complete the assessment of the facts in order to carry out the global assessment of the likelihood of confusion in accordance with the requirements of Article 8(1)(b) CTMR.

◆ [T-337/14](#); **mobile.de proMotor / mobile**, Judgment of 22 April 2015, *Rezon OOD v OHIM* – DE. The cancellation applicant filed an application before the GC. Concerning the alleged lack of reasoning with regard to the applicability of Article 165 CTMR, the GC confirmed that the BoA had explained in sufficient detail the content of the provision and why it was applicable in the present case (both marks applied for / registered before the accession of Bulgaria to the EU) (paras 24-27).

◆ [C-622/13 P](#); **CASTEL / Castell**, Order of 30 April 2015, *Castel Frères SAS v Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell and OHIM* – EN. The applicant registered the word mark 'CASTEL' as a CTM for goods in Class 33. An application for invalidity was filed based on indication of geographical origin 'Castell', protected for wines in Germany, France, Greece, Italy and Spain. The CD dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal after finding that 'Castell' was an indication of geographical origin relating to wines produced in Germany and was perceived as such by the relevant public. The spelling difference was likely to create some distance and a conceptual difference between the terms in question. The invalidity applicant filed an action before the GC based on six pleas in law. The CJ stated that with regards to a supposed absence of a statement of reasons in the judgment under appeal and an allegedly incorrect interpretation by the GC of the concept of abuse of rights within the meaning of EU law, it is clear from Article 56(1)(a) CTMR that an application for a declaration of invalidity based on an absolute ground for invalidity does not require the applicant to show an interest in bringing proceedings (para. 41). Furthermore, recalling the principles set in *Donaldson Filtration Deutschland v ultra air*, Case C-450/13 P, the CJ highlighted that, because it is necessary to protect the public interest underlying Articles 7(1)(b) and (c) and 56(1)(a) CTMR, the Office's task is to assess whether the mark under examination is descriptive and/or devoid of distinctive character in the light of the rules governing the registrability of that mark. The motives and earlier conduct of the applicant for a declaration of invalidity cannot affect the scope of that task. Accordingly, there can be no question of an abuse of rights on the part of the applicant for a declaration of invalidity (paras 43-44).

◆◆ [T-591/14](#); **PerfectRoast**, Judgment of 25 September 2015, *BSH Bosch und Siemens Hausgeräte GmbH v OHIM* – DE. The applicant sought to register the word mark 'PerfectRoast' for, inter alia, goods



in Classes 7 and 11. Both instances partially refused registration for the above goods according to Article 7(1)(b) and (c) CTMR. The applicant appealed before the GC alleging infringement of Article 7(1)(b) and (c) and Article 75 CTMR. The applicant's plea that the BoA did infringe Article 75 CTMR by not considering the registered CTM 'perfectBake', the GC states that indeed the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her 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 (paras 57 and 65). Moreover, as the BoA correctly stated that the cases may not be directly compared and the link between the meaning of the sign and the goods is stronger for the case in question than the other case submitted by the applicant (paras 51 and 58).

◆ [T-78/14](#); **Genuß für Leib & Seele KLOSTER Andechs SEIT 1455 / ANDECHSER NATUR SEIT 1908 et al.**, Judgment of 8 October 2015, *Benediktinerabtei St. Bonifaz Körperschaft des öffentlichen Rechts v OHIM* – DE. By way of assessing the distinctive character of the CTMA's elements and referring to the relative size of 'Andechs', the BoA gave sufficient reason as to why this word possesses a normal distinctive character, dominates the CTMA and has an independent distinctive role therein (paras 17-23). Furthermore, as far as Article 76 CTMR is concerned, the BoA was entitled to consider it a well-known fact that the average consumer is acquainted with images or names of monks or cloisters being depicted on milk products and beverages. The BoA was not obliged under Article 75 CTMR to allow the parties to make observations on this well-known fact before rendering the decision (paras 24-30).

◆◆ [T-382/14](#); **PROTICURD / PROTI et al.**, Judgment of 24 September 2015, *Bernhard Rintisch v OHIM* – EN. The holder of the IR designating the EU sought to register the word mark 'PROTICURD' for, inter alia, goods in Classes 5 and 29. The opponent based its opposition on Article 8(1)(b) CTMR using, inter alia, the earlier German word mark 'PROTI', registered for goods in Classes 29 and 32. The applicant requested the opponent to show genuine use of its earlier marks. The OD upheld the opposition in part for the goods in Classes 5 and 29. The BoA partially annulled the first instance by rejecting the opposition for all of the goods in Class 5 and some of Class 29. The opponent appealed to the GC alleging, inter alia, infringement of Article 75 CTMR (obligation to state reasons). This first plea alleging the infringement of the obligation to state reasons laid down in Article 75 CTMR was upheld and the contested decision was annulled. The case has been reallocated to the BOA for a decision on the substance (R 247/2016-4).

◆ [T-624/14](#); **bice / Bice**, Judgment of 17 December 2015; *Bice international Ltd v OHIM* – DE. The owner of earlier figurative Spanish trade mark 'Bice' in Class 42 filed a request for invalidity (Articles 8(1)(b) and 53(1)(a) CTMR) against the CTM 'bice' (word mark, registered for goods in Classes 29, 30 and 43). Upon request by the owner of the contested CTM, the owner of the earlier Spanish mark provided evidence of



genuine use. The CD rejected the invalidity request in its entirety as it deemed genuine use of the earlier mark not proven. This decision was confirmed by the BoA, which emphasised the limited geographic expansion of use (in one single restaurant in Madrid only) and the lack of solid evidence with regard to the extent of use. The CTM owner filed an application before the GC, requesting the annulment of the BoA's decision. The application was based on one plea of law, namely a claimed infringement of Articles 42 (2) and 57(2) and (3) CTMR. In the oral hearing, the applicant raised a second plea of law, namely a violation of Article 75 CTMR (duty to state reasons). With regard to the claimed violation of Article 75 CTMR (duty to state reasons), which was raised for the first time during the oral hearing, the GC refrained from examining the admissibility of the plea of law, but held that the BoA had in any event sufficiently explained why it deemed the proof of use insufficient, namely because of a very limited geographical dimension of use in conjunction with a marginal extent of use (paras 22-30).

◆ [T-190/15](#); **meet me**, Judgment of 24 November 2015, *Intervog v OHIM* – FR. The applicant sought to register the figurative mark 'meet me' for various goods and services in Classes 9, 38 and 45. The examiner refused this CTMA under Article 7(1)(b) CTMR. The BoA dismissed the appeal on the basis of Article 7(1)(b) CTMR, holding that the mark applied for would only be seen as a promotional message and not as an indication of the commercial origin of the goods and services covered. The GC confirmed the BoA decision. The applicant submits that the BoA did not comply with its duty to state reasons (para. 45). The GC is, however, of the opinion that when the BoA is not obliged to take a position regarding all the arguments of the parties, it did state its reasons as to why it did not see the sign as an indication of origin (para. 50).

2.3 *Ultra petita*

[no entry]

2.4 *Others*

◆ [T-287/13](#); **HUSKY**, Judgment of 13 February 2015, *Husky CZ s.r.o. v OHIM* – EN. The CTM proprietor registered the word mark 'HUSKY' as a CTM for goods within Classes 3, 9, 14, 16, 18 and 25. An application for revocation was filed based on the ground that the mark at issue had not been put in genuine use in connection with the goods in respect of which it had been registered according to Article 51(1)(a) CTMR. The CD has extended, on the request of the CTM proprietor, the time limit for the submission of the evidence proving genuine use several times. The CD granted in part the application for revocation. It decided that the mark could remain registered for 'bags' in Class 18 and 'shirts, trousers, jackets, coats, waistcoats, jumpers, pullovers, sweaters, boots, shoes, tops, jeans, belts and footwear' in Class 25. The BoA dismissed the applicant's appeal. The revocation applicant filed an action before the GC relying on three pleas in law: the taking into consideration of (i) evidence submitted out of time; (ii) untranslated documents; (iii) undated documents as evidence of proof of use. As to the first plea in law (interpretation of Rule 71(2) CTMR), the GC has clarified the existing ambiguity as regards the divergent wording of this Rule in the different EU languages. The English version (and certain other languages versions) states that in *inter partes* proceedings the Office may extend a time limit subject to the agreement of the other parties. The German, Spanish, French and Italian versions state that in *inter*



partes proceedings, the Office may subject the extension to the agreement of the other parties. The BoA has interpreted this provision according to the wording of the German, Spanish, French and Italian versions. The GC, making a teleological interpretation, has given reason to the BoA's interpretation (paras 37-45). It concluded in that Rule 71(2) CTMIR is to be interpreted as meaning that when a party in *inter partes* proceedings requests an extension of time 'OHIM may, but it is not required, to seek the consent of the other party and that this provision has to be read in conjunction with Rule 71(1) CTMIR, from which it follows that the Office, in particular when it decides not to seek the other party's consent, must take account of the circumstances surrounding the request for an extension of time' (para. 46). In regards to the second plea in law (untranslated documents), according to the GC, Rule 22(6) CTMIR supplements and further elaborates on the provisions of Rule 22 (2) to (4) CTMIR (para. 55). Under Rule 22(6) CTMIR, the Office is able to request of the party submitting documents that they be translated where the documents submitted are not in the language of the proceedings (para. 56). In this case, the Office did not err in not requesting an English translation of documents provided in Italian. First, the revocation applicant did not itself request, during the revocation proceedings, that the CTM proprietor provide a translation of those documents. Second, the revocation applicant's arguments focus on extracts from online dictionaries, which show translations of words from English into Italian or from Italian into English, which renders any request for translation nugatory (para. 57). The GC dismissed the action in its entirety, rejecting all three pleas.

3. *General principles of Community Law*

◆ [T-337/14](#); *mobile.de proMotor / mobile*, Judgment of 22 April 2015, *Rezon OOD v OHIM – DE*. The cancellation applicant filed an application to the GC. It claimed a wrong application of Article 165(4)(b) CTMR. The applicant claims that the — undisputed — knowledge of the CTM owner of the existence of the earlier Bulgarian mark should have been taken into account and that this positive knowledge prevents an application of Article 165(4) CTMR. The GC stressed in this respect that the wording of Article 165(4) CTMR is very clear to the contrary and that a 'lack of knowledge' of the earlier mark cannot be construed as an additional necessary condition for the applicability of this provision. In other words, it is irrelevant, in the context of Article 165(4) CTMR, whether the CTM owner at the time of the CTM application knew about the existence of the earlier national mark or not. This does not lead to an undue protection of the CTM vis-à-vis earlier national marks, as Article 165(5) CTMR in conjunction with Articles 110 and 111 CTMR provides for the possibility for the owner of the earlier national mark to prohibit the use of a later CTM, if the earlier national mark was applied for, registered or acquired in good faith in the new Member State prior to the date of accession of that state. Therefore, Article 165 CTMR provides a fair balance between the interests of the CTM owner and the interests of the owner of the earlier national mark (paras 28-34).



B. Procedures before the Office

1. Admissibility

1.1 Right to appeal, form, deadline

◆ [T-657/13](#); **ALEX / ALEX**, Judgment of 2 July 2015, *BH Stores BV v OHIM* – EN. The applicant sought to register the word mark 'ALEX' as a CTM for goods in Classes 16, 20 and 28. An opposition based, inter alia, on the earlier word mark 'ALEX', registered in Germany for goods in Class 28 was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA confirmed the OD's decision and dismissed the appeal. The opponent filed an action before the GC. The applicant (intervener before the GC) claims that the appeal was inadmissible since the opponent filed the grounds of its appeal on 7 February 2013, after expiry of the period prescribed by Article 60 CTMR, a period which, according to the applicant, expired on 4 February 2013. The GC confirmed that reference must be made to Article 7(4) of Decision No EX-11-3 of the President of the Office of 18 April 2011 concerning electronic communication with and by the Office, which was applicable at the time the decision of the OD was given. According to that Article, 'without prejudice to accurately establishing the date of notification, notification shall be deemed to have taken place on the fifth calendar day following the day on which the document was created by the Office's systems'. The GC confirmed that the date of the OD's decision is 3 October 2012, as argued by the Office, and therefore the creation of the document by the Office's systems under Article 7(4) of Decision No EX-11-3 could not have taken place before then. Therefore, under Article 70 (1) and (2) CTMR, read in conjunction with the last sentence of Article 60 CTMR, in the present case the time limit for lodging a statement of grounds of appeal accordingly expired on 8 February 2013 at the earliest. As a consequence, the BoA was right to declare the appeal admissible and the applicant's plea alleging the inadmissibility was rejected (paras 19-22).

◆ [T-223/14](#); **VENT ROLL**, Judgment of 25 November 2015, *Ewald Dörken AG v OHIM* – DE. Upon request, the CD declared the CTM 'VENT ROLL' (applied for in 2004; registered in 2005) invalid for goods in Classes 6, 17 and 19, as the trade mark was deemed descriptive ('ventilation roll') and non-distinctive for the goods at issue. The BoA confirmed the decision. The applicant filed an action before the GC, claiming a violation of Article 7(1)(b) and (c) CTMR, as well as a violation of Article 76 CTMR in several respects. With regard to the applicant's claim of a violation of Article 76 CTMR (burden of proof for the meaning of 'VENT ROLL' in 2004 for the cancellation applicant): The presumption of validity of a registered mark cannot prevent the Office from taking into account well-known facts, which have not been dealt with by the CD (paras 58-61). Based on the foregoing, the action was dismissed.



1.2 New facts, arguments, grounds or evidence

◆ [T-186/12](#); **LUCEA LED / LUCEO**, Judgment of 25 June 2015, *Copernicus-Trademarks Ltd v OHIM & Maquet SAS* – EN. The CTM applicant filed an application for the word mark 'LUCEA LED' for goods in Class 10. The Opponent relied on the earlier CTM 'LUCEO' and claimed priority for the mark 'LUCEO' filed with the Austrian Patent Office for the same goods. The OD upheld the opposition. The CTM



applicant filed an appeal against the OD's decision. The BoA upheld the appeal, annulled the OD's decision and rejected the opposition. It found that the mark on which the opposition was based was not earlier than the mark applied for, considering the filing date and the fact that the right of priority for the mark on which the opposition was based had not been validly claimed. The opponent brought an action before the GC. ON THE ADMISSIBILITY OF THE ACTION: The CTM applicant claimed the inadmissibility of the appeal since the mark on which the opposition was based no longer belongs to the opponent. The GC preferred considering the merits without first ruling on the admissibility of the action since the action is unfounded (para. 29). ON THE MERITS OF THE ACTION: FIRST PLEA IN LAW: Infringement of Article 76(2) CTMR. The GC rejected the argument. It considered that the CTM applicant disputed the priority claim for the mark on which the opposition was based and its precedence as predating the mark applied for by arguing that (i) the priority claim was vitiated by a number of errors, (ii) that only the date of the application for registration of that mark could therefore be taken into account, (iii) that the claim was based on the application for an Austrian mark and (iv) that the opponent had paid the filing fee for that mark only after it had lodged its application for registration of a Community trade mark (paras 36-41).

♦ [T-580/13](#); *real,- / Real*, Order of 21 April 2015, *Real Express SRL. v OHIM* – EN.

CTMA	Earlier Mark
	

The applicant sought to register the figurative mark 'real,-' as a CTM for goods and services in Classes 3 and 35. An opposition based on two earlier Romanian figurative marks, registered for goods and services in Classes 3 and 35, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition under Rule 20(1) CTMIR, noting that the opponent had not proven its entitlement as the owner of the earlier marks. The notice of opposition was filed in the name of 'Real Express', whereas the extracts from the Romanian Trade Mark Office (OSIM) and their English translations filed by the opponent showed that the earlier Romanian marks were registered in the name of 'SC Unibrand SRL'. The OD held that the opponent had not provided any evidence regarding the change of the opponent's name emanating from the official source confirming that the change of name of the trade marks owner has been indeed registered or that OSIM has accepted as admissible the request for a change of name. Almost a month after the notification of the opposition decision and eight months after the expiry of the time limit to substantiate the opposition, the President of the Office received a fax from OSIM (fax of 16 July 2012) confirming that the proprietor of the earlier marks was 'Real Express' as from June 2011. The BoA dismissed the opponent's appeal, holding that Rule 19 in conjunction with Rule 20 (1) CTMIR prevented it from exercising the discretion provided for in Article 76(2) CTMR and the relevant case law. The opponent filed an action before the GC where it raised infringements regarding essential procedural requirements and procedural rules. Most of the arguments raised by the opponent were rejected by the GC as manifestly inadmissible on the ground that they lack clarity and coherence and that, consequently, they fail to satisfy the minimum requirements set out in Article 44(1)(c) (para. 34). The remaining arguments of the opponent that met those minimum requirements were rejected as manifestly unfounded.



(para. 37). According to the GC, the BoA did not find, in paragraph 15, that the applicant had submitted the documents out of time but that those documents did not correspond to the required documentation from the administration by which the marks had been registered, on the ground that they did not serve to confirm the changes of name of the proprietor (para. 38). The mere fact that the Office accepted the opposition fee, processed the requests for proof of use and suspended the opposition proceedings is not, on its own, sufficient for a finding that the Office accepted that *Real Express* was the proprietor of the earlier marks (paras 39 and 40). The argument of the opponent that the decision of the OD was given while the proceedings were suspended is manifestly unfounded since the opponent was informed by the Office that the opposition would be rejected since it had failed to substantiate the earlier marks relied on in support of its opposition, which necessarily implied that the proceedings had been resumed (para. 42). For the sake of completeness, the GC points out that, even if that mere assertion ought to have been interpreted as a complaint by the opponent that BoA failed to take the fax of 16 July 2012 into account, in disregard of Article 76(2) CTMR and Rule 20(1) CTMIR, it would have had to be dismissed for the same reasons as those upheld in the case C-120/12 P, *Rintisch v OHIM* (para. 44). The BoA in essence took the view that Rule 20(1) CTMIR constituted a provision to the contrary for the purposes of Article 76(2) CTMR and that, consequently, it had no discretion to take the fax of 16 July 2012 — submitted by the applicant in order to establish ownership of the earlier marks — into account. In doing so, the BoA erred in law. Nevertheless, for the same reasons as those upheld in paragraphs 36 to 41 of the judgment *Rintisch v OHIM*, the grounds set out by the BoA in paragraph 20 of the contested decision are, in any event, capable of remedying the defect vitiating the contested decision, inasmuch as they permit the inference that the BoA actually exercised its discretion under Article 76(2) CTMR, for the purposes of deciding, in a reasoned manner and having regard to all the relevant circumstances, whether it was necessary to take into account the evidence submitted to it late, in order to give its decision (para. 45).

◆ [T-24/13](#); **CACTUS OF PEACE, CACTUS DE LA PAZ / Cactus**, Judgment of 15 July 2015, *Cactus SA v OHIM* – EN. The applicant sought to register the figurative sign ‘CACTUS OF PEACE, CACTUS DE LA PAZ’ as a CTM for goods and services within Classes 31, 35 and 39. An opposition based on the earlier word mark ‘CACTUS’, as well as on an earlier figurative mark ‘Cactus’, was filed on the grounds of Article 8(1)(b) CTMR. The OD partially upheld the opposition for ‘seeds, natural plants and flowers’ in Class 31 and ‘gardening, plant nurseries, horticulture’ in Class 44, which are covered by the earlier word mark and it accepted the registration of the contested CTMA for the services in Class 39. The BoA upheld the appeal filed by the opponent and dismissed the opposition in its entirety. It held that the OD had erred in considering that the opponent had adduced proof of genuine use of the earlier marks in respect of ‘retailing of natural plants and flower grains; fresh fruits and vegetables’ services in Class 35. No proof of genuine use had been provided for the goods and services covered by the earlier marks. Lastly, the BoA rejected the evidence produced by the opponent to prove genuine use of the earlier marks in respect of the services in Class 39, on the ground that the evidence had been submitted for the first time before the BoA. The opponent filed an action before the GC relying on three pleas in law. In the third plea in law, the applicant claimed that the BoA infringed Article 76(2) CTMR by rejecting evidence submitted by the applicant before the BoA, for the purpose of proving genuine use in respect of services in Class 39. The GC stated that the BoA correctly rejected the evidence of use of the earlier marks, since it had no discretion as to whether or not to take into account the evidence submitted for the first time before it (paras 85-86). The first and second pleas in law were upheld, while the GC rejected the third plea in law with the outcome that the BOA’s decision was partly annulled.



2. Essential procedural requirements

2.1 Right to be heard

◆ [T-322/13](#); **KENZO / KENZO**, Judgment of 22 January 2015, *Kenzo Tsujimoto v OHIM* – EN. The CTM applicant filed an application for the word mark 'KENZO' for services in Classes 35, 41 and 43 (all wine-related). The opponent relied on the earlier CTM 'KENZO' claiming reputation for goods in Classes 3, 18 and 25. The OD dismissed the opposition stating that reputation was not proven. The BoA upheld the appeal of the opponent. The CTM applicant brought an action before the GC based on two pleas in law. On the infringement of Article 76(2) CTMR, the GC dismissed the applicant's claim that the BoA was wrong to have taken into account the evidence of use filed outside the substantiation period to prove reputation and failed to exercise its discretionary power. The GC referred to Case C-120/12 P *Rintisch v OHIM* and made it clear that it is the third subparagraph of Rule 50(1) CTMIR that must be applied in proceedings before the BoA and not Rule 20(1) CTMIR (para. 17). Furthermore, the BoA exercised its discretion under Article 76(2) CTMR to decide that it was appropriate to take that evidence into consideration and, by finding that such evidence was genuinely relevant for the purposes of assessing the earlier trade mark's reputation, provided a statement of reasons for taking that evidence into account (para. 19).

◆ [T-393/12](#); **KENZO / KENZO**, Judgment of 22 January 2015, *Kenzo Tsujimoto v OHIM* – EN. The CTM applicant filed an application for the word mark 'KENZO' for 'wine; alcoholic beverages of fruit; western liquors (in general)' in Class 33. The opponent relied on the earlier CTM 'KENZO' claiming reputation for goods in Classes 3, 18 and 25. The OD dismissed the opposition stating that reputation was not proven. The BoA upheld the appeal of the opponent. The CTM applicant brought an action before the GC based on two pleas in law. As to the infringement of Article 76(2) CTMR the GC dismissed the applicant's claim that the BoA was wrong to have taken into account the evidence of use filed outside the substantiation period to prove reputation and failed to exercise its discretionary power. The GC referred to Case C-120/12 P, *Rintisch v OHIM*, and made it clear that it is the third subparagraph of Rule 50(1) CTMIR that must be applied in proceedings before the BoA and not Rule 20(1) CTMIR. Furthermore, the BoA exercised its discretion under Article 76(2) CTMR to decide that it was appropriate to take that evidence into consideration and, by finding that such evidence was genuinely relevant for the purposes of assessing the earlier trade mark's reputation, provided a statement of reasons for taking that evidence into account (paras 26-36)

◆ [T-414/13](#); **KENZO ESTATE / KENZO**, Judgment of 2 December 2015, *Kenzo Tsujimoto v OHIM* – EN. The GC dismissed the IR holder's claim that the BoA was wrong to have taken into account the evidence of use filed outside the substantiation period to prove reputation and failed to exercise its discretion power. The GC referred to C-120/12 P, *Rintisch v OHIM* and T-393/13, *Tsujimoto v OHIM*, and made it clear that it is the third subparagraph of Rule 50(1) CTMIR that must be applied in proceedings before the BoA and not Rule 20(1) CTMIR (para. 18). Furthermore, the BoA exercised its discretion under Article 76(2) CTMR to decide that it was appropriate to take that evidence into consideration and, by



finding that such evidence was genuinely relevant for the purposes of assessing the earlier trade mark's reputation, provided a statement of reasons for taking that evidence into account (paras 22-23).

◆ [T-522/13](#); **KENZO ESTATE / Kenzo**, Judgment of 2 December 2015, *Kenzo v OHIM* – EN. The IR holder filed an application before the GC for the partial annulment of the BoA's decision, that is to say, as far as it upheld the opposition in respect of the services in Classes 35, 41 and 43. In the opposition proceedings, the opponent timely submitted evidence in order to prove the reputation of its mark. Upon request of the IR holder, the opponent later submitted evidence in order to prove use of its mark. Such evidence was therefore belated with respect to the time limit to prove the reputation of the mark. Nonetheless, in stating that proof of use and proof of reputation are indissociably linked and that only an excessive and illegitimate formalism would dictate that the proof of use could not be adduced as proof of reputation, the BoA exercised its discretion under Article 76(2) CTMR to decide that it was appropriate to take that evidence into consideration and in finding that that evidence was genuinely relevant for the purposes of assessing the earlier trade mark's reputation. It therefore provided a proper statement of reasons for taking that evidence into account (para. 23).

◆ [T-379/13](#); **NANO**, Judgment of 10 February 2015, *Innovation First, Inc. v OHIM* – EN. The applicant sought to register the word mark 'NANO' as a CTM, for goods and services in Classes 9, 28 and 41. The examiner rejected the CTM application for goods in Classes 9 and 28 on the ground of Article 7(1)(b) and (c) CTMR and the applicant filed an appeal. The BoA dismissed the appeal and upheld the contested decision. The applicant filed an action before the GC relying on five pleas in law: (i) infringement of the right to be heard; (ii) infringement of the obligation to state reasons; (iii) breach of Article 76 CTMR insofar as the BOA decision was based on speculation; (iv) infringement of Article 7(1)(c) CTMR; and (v) infringement of Article 7(1)(b) CTMR. Concerning the first plea, contrary to the applicant's claim, the GC found that there was not an infringement of the right to be heard. The Office did set out, from the stage of the proceedings before the examiner, its position which was understood by the applicant, who responded to it in its statement setting out the grounds of its appeal against the examiner's decision. The BoA responded to the applicant's comments in the contested decision (paras 21).

◆ [T-580/13](#); **real,- / Real**, Order of 21 April 2015, *Real Express SRL. v OHIM* – EN. The applicant sought to register the figurative mark 'real,-' as a CTM for goods and services in Classes 3 and 35. An opposition based on two earlier Romanian figurative marks, registered for goods and services in Classes 3 and 35, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition under Rule 20(1) CTMIR, noting that the opponent had not proven its entitlement as the owner of the earlier marks. As to the opponent's argument that the proceedings were suspended without the opponent being given the opportunity to make its views known, the Office suspended the proceedings, in accordance with Rule 20(7) and Rule 21(2) CTMIR, on account of national proceedings against the opponent's earlier marks in Romania. Neither of those rules imposes an obligation on the Office to hear the parties before suspending the proceedings (para. 41). Lastly, the GC also denied an infringement of Articles 63(2) and 64(1) and (2) CTMR. The opponent did have the opportunity to present, before both the OD and BoA, the facts and evidence concerning its entitlement to file the opposition, in accordance with the first provision, and, secondly, the BoA did examine the entitlement issue, in accordance with the second provision (para. 43).



◆ [T-193/12](#); **H / H**, Judgment of 22 January 2015, *MIP Metro v OHIM* – DE. The applicant sought to register the figurative mark ‘H’ as an IR designating the EU, inter alia, for goods within Class 32. The opposition based on the earlier German figurative mark ‘H’ and registered for goods in Class 32 was upheld and confirmed by the BoA. The IR holder filed an action before the GC claiming the infringements of Article 8(1)(b) and Article 75 CTMR. The GC dismissed both pleas in law. The documents filed for the first time in the proceedings before the GC are inadmissible (para. 17). The claimed infringement of Article 75 CTMR must be rejected. The BoA listed all factual and legal arguments for its decision (para. 63).

◆ [T-513/13](#); **SafeSet**, Judgment of 6 March 2015, *Braun Melsungen AG v OHIM* – DE. The applicant sought to register the word mark ‘SafeSet’ as a CTM for goods within Class 10 with specification as follows: ‘Medical infusion apparatus and instruments’. The examiner refused to register the word as a CTM on the grounds of Article 7(1)(b) and (c) CTMR. The Board of Appeal dismissed the applicant’s appeal finding the mark applied for descriptive and devoid of distinctive character. The applicant filed an action before the GC. As regards the obligation to state reasons under Article 75 CTMR, the applicant claimed that the contested decision was contradictory when first stating that the mark applied for was not devoid of a minimum distinctive character while later finding that the mark had only pure promotional and laudatory meaning and therefore was devoid of a minimum distinctive character (para. 13). Based on the reasoning provided by the contested decision, the GC, however, finds the presence of a negation therein only as a clerical error (paras 14-15). The applicant further claimed that the BoA did not take a position on arguments submitted by it. The GC recalled that the BoA is not obliged to provide a statement which exhaustively follows all arguments submitted by the parties (paras 16-17). Also regarding other arguments of the applicant, the motivation provided in the contested decision is sufficient according to the GC (paras 20 and 22).

◆ [T-566/13](#); **HostelTouristWorld.com / HOSTELWORLD.COM**, Judgment of 29 April 2015; *Hostel Tourist World, S.L. v OHIM* – ES. The applicant registered the figurative mark ‘HostelTouristWorld.com’ as a CTM for services within Classes 35, 39 and 43. An application for invalidity was filed based, among other earlier rights, on IR word mark ‘HOSTELWORLD.COM’ registered for services in Classes 39 and 43. The CD dismissed the application for invalidity and the invalidity applicant filed an appeal. The BoA partly upheld the invalidity applicant’s appeal, namely for the services in Classes 39 and 43. The CTM proprietor filed an action before the GC. The GC confirms that an analogous reasoning to that followed by the jurisprudence that states the impossibility of questioning the validity of an earlier IR designating the EU within an opposition is applicable to invalidity proceedings. Consequently, the BoA did not infringe Articles 63 and 64 CTMR when it did not determine the descriptive character of the earlier IR since the IR’s minimum degree of distinctiveness had to be presumed (paras 35-40).

◆ [T-186/12](#); **LUCEA LED / LUCEO**, Judgment of 25 June 2015, *Copernicus-Trademarks Ltd v OHIM & Maquet SAS* – EN. The CTM applicant filed an application for the word mark ‘LUCEA LED’ for goods in Class 10. The opponent relied on the earlier CTM ‘LUCEO’ and claimed priority for the mark ‘LUCEO’ filed with the Austrian Patent Office for the same goods. The OD upheld the opposition. The CTM



applicant filed an appeal against the OD's decision. The BoA upheld the appeal, annulled the OD's decision and rejected the opposition. It found that the mark on which the opposition was based was not earlier than the mark applied for, considering the filing date and the fact that the right of priority for the mark on which the opposition was based had not been validly claimed. The Opponent brought an action before the GC. SECOND PLEA IN LAW: infringement of Article 75 (right to be heard). The GC rejected the argument, considering that the BoA was not obliged to inform the opponent on the final position that the BoA intends to adopt and that, in any case, the opponent was authorised to submit observations during the proceeding before the BoA (paras 90-91 and 98).

◆◆[T-611/13](#); **HOT**, Judgment of 15 July 2015; *Australian Gold LLC v OHIM* – DE. The applicant registered the figurative mark 'HOT' as an IR designating the EU for goods in Classes 3 and 5. An application for invalidity was filed based on Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) and (c) CTMR. The CD partly upheld the application for invalidity. The BoA partly upheld the CTM proprietor's appeal. The invalidity applicant filed an action before the GC. The BoA disregarded the invalidity applicant's observations in the course of the appeal proceedings because it erroneously considered them to have been filed belatedly. As regards the right to be heard under Article 75 CTMR, however, the invalidity applicant did not show that the BoA would have come to a different finding when taking it into account. Said observations contained, in essence, a repetition of the previous submissions which the BoA assessed in its decision. Furthermore, the national court decisions referred to are not binding for the BoA. Therefore, the action is rejected as far as it is based on Article 75 CTMR (paras 14-22). The BoA, however, infringed Article 8(3) of the Rules of Procedure of the BoA (RPBoA) since said observations contained an ancillary appeal. After remittal, the BoA will have to assess the application for invalidity for the goods subject to the ancillary appeal (paras 23-26 and 67).

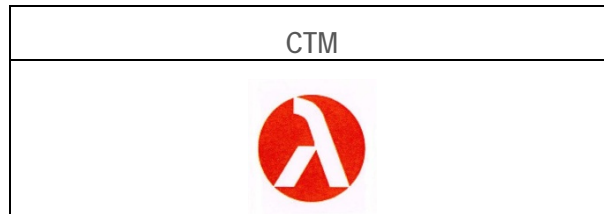
◆◆[T-404/10 RENV](#); **DEVICE OF A HAND**, Judgment of 30 June 2015, *Gambling Commission (formerly National Lottery Commission) v OHIM* – EN. The CTM proprietor obtained the registration of the CTM figurative mark representing a hand. Two applicants filed a joint invalidity request on the basis of Article 52(2)(c) CTMR, invoking a prior copyright, under the Italian law, of a figurative sign representing a hand. The invalidity applicants relied on an agreement dated 16 September 1986 (the date resulting from a post office stamp affixed to it) under which a third party purporting to be the author of the allegedly earlier copyright claimed that he had assigned to one of them his rights to reproduce and use the work in question. The CTM proprietor argued that the mentioned agreement presented certain anomalies that she doubts as to the reliability of the date resulting from the post office stamp affixed to the document and, therefore, on whether an earlier copyright existed at all. DECISION OF THE CD: the CD granted that application for a declaration of invalidity on the ground, in essence, that the applicants for a declaration of invalidity had demonstrated the existence of an earlier copyright protected by Italian legislation and which was virtually identical to the contested trade mark. DECISION OF THE BoA: the BoA dismissed the CTM proprietor's appeal, holding that the anomalies invoked by the CTM proprietor did not give grounds for doubting the veracity of the content of the 1986 agreement. In that context, the BoA considered, in essence, that it was not competent to assess the validity of the 1986 agreement and that this could only be challenged by bringing separate judicial proceedings for a declaration of forgery. The CTM proprietor filed an action before the GC. JUDGMENT OF THE GC: the GC granted the appeal, holding on the one hand that the BoA had infringed Article 53(2)(c) CTMR insofar as it had found that the existence of an earlier copyright had been proved by the invalidity applicants and, on the other, finding that the BoA had



incorrectly assessed its powers to determine whether that agreement was authentic. In particular, the GC referred to an article of the Italian Civil Code and a judgment of the Italian Supreme Court of Cassation (ISCC) interpreting that article — both of which had not been invoked and relied upon by the parties before the Office — and held that, in accordance with that judgment, it was open for the CTM proprietor, without it being necessary to bring separate proceedings for a declaration of forgery, to adduce proof that, in fact, the 1986 agreement had been drawn up on a date other than that shown on the post office stamp. The GC therefore inferred from this that the BoA had misinterpreted the national law applicable pursuant to Article 53(2) CTMR and therefore had failed to assess accurately the precise scope of its own powers. Had the BoA considered itself competent to assess the validity of the 1986 agreement, it might have come to a different conclusion. APPEAL LODGED BY THE OFFICE: the Office filed an appeal to the 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 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. 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 CTM prohibited by virtue of an earlier right, but also particulars establishing the content of that law. JUDGMENT OF THE CJ: 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 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 Office's decision 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 abovementioned judgment of the ISCC, 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. NEW JUDGMENT OF THE GC: the GC issued a new judgment, again rejecting the Office's arguments and noting that the abovementioned judgment of the ISCC necessarily implies greater freedom on the BoA's part in the assessment of the evidence. Thus, the GC annulled the decision of the BoA, holding that it could not be excluded that the BoA would have reached a different conclusion had it considered itself fully competent to assess the validity of the 1986 agreement, which had been filed to prove the existence of the alleged earlier copyright.



◆ [T-215/13](#); **LAMBDA**, Judgment of 15 July 2015, *Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM* – EN.



The Office registered the figurative trade mark for ‘insulating materials’ in Class 17 and ‘building materials (non-metallic)’ in Class 19. Following an application for revocation of the contested mark based on Article 51(1)(a) CTMR, and the submission of evidence of use, the CD partially revoked the rights of the CTM owner as regards ‘building materials (non-metallic)’, with the exception of ‘building materials having insulating properties’ in Class 19. By contrast, it rejected the application for revocation in respect of the goods in Class 17. On appeal, the BoA upheld the appeal in part by revoking the contested mark in respect of all of the goods in Class 19. By contrast, it confirmed the CD’s assessment as regards the goods in Class 17. ON THE ALLEGED INFRINGEMENT OF ARTICLE 75 CTMR: although the CD had infringed the invalidity applicant’s right to be heard by not giving it the possibility to submit its observations on the belatedly filed above declaration, the fact remains that the invalidity applicant was able to submit its observations in that respect before the Board, which duly took them into consideration before adopting the contested decision. The BoA exercised its discretion by taking into account the abovementioned declaration of the external auditing undertaking, although it had been filed after the expiry of the time limit set. Consequently, in accordance with the principle of functional continuity, the BoA was able to correct that irregularity (paras 73-80).

◆ [T-631/14](#); **DEVICE OF A RED SOLE / my SHOES**, Judgment of 16 July 2015, *Roland SE v OHIM* – FR. The applicant sought to register the ‘device of a red sole’ as a CTM for ‘high-heeled shoes’ within Class 25. An opposition based on the earlier figurative IR designating the EU ‘my SHOES’, registered for goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of the right to be heard and (ii) infringement of Article 8(1)(b) CTMR. Concerning the first plea, the opponent claimed that it was not allowed to present observations in reply to the intervener (applicant)’s letter of 27 March 2014, by which the intervener requested the BoA to render its decision as soon as possible. Moreover, it claimed that it was communicated to it after the BoA’s decision was taken. The GC finds that the said letter was not taken into account in the BoA’s decision and in any case it would have had no concrete incidence on the substance (paras 24-25). Therefore, there was no infringement of the right to be heard.



2.2 Adequate reasoning

◆ [T-197/13](#); **MONACO**, Judgment of 15 January 2015, *Marques de l'État de Monaco (MEM) v OHIM* – FR. The IR holder, the Principality of Monaco was granted, by the World Intellectual Property Organisation (WIPO), an IR designating the EU. That registration, which was based on the word mark 'MONACO', was transferred to the Office on 24 March 2011. The examiner partially refused the IR designation on the basis of Article 7(1)(b) CTMR, considering that the word 'Monaco' could be used, in trade, to designate origin, geographical destination or the place of supply of services, so that the trade mark has, in respect of the goods and services concerned, a descriptive character. The IR holder contested the Office's decision before the BoA. The BoA dismissed the appeal. The IR holder filed an action before the GC relying on three pleas in law: (i) lack of reasoning under Article 75 CTMR; (ii) infringement of Article 7(1)(c) CTMR; and (iii) infringement of Article 7(1)(b) CTMR. On the lack of reasoning, the GC rejected the claim explaining that the decision had a very rigorous and detailed analysis (paragraphs 26 to 29 of the contested decision) of the different types of products and services applied for (para. 20).

◆ [T-379/13](#); **NANO**, Judgment of 10 February 2015, *Innovation First, Inc. v OHIM* – EN. The applicant sought to register the word mark 'NANO' as a CTM, for goods and services in Classes 9, 28 and 41. The examiner rejected the CTM application for goods in Classes 9 and 28 on the ground of Article 7(1)(b) and (c) CTMR and the applicant filed an appeal. The BoA dismissed the appeal and upheld the contested decision. The applicant filed an action before the GC relying on five pleas in law: (i) infringement of the right to be heard; (ii) infringement of the obligation to state reasons; (iii) breach of Article 76 CTMR insofar as the BOA decision was based on speculation; (iv) infringement of Article 7(1)(c) CTMR; and (v) infringement of Article 7(1)(b) CTMR. Concerning the second plea, the GC disagreed with the applicant's claim that the BoA infringed the obligation to state reasons. The finding that the trade mark applied for will be perceived by the relevant public, in relation to the goods at issue, as referring to their small size, are not contradictory (paras 24-28). Concerning the third plea, the applicant argued that the BoA did not refer to the word 'NANO' as such, but to the prefix 'NANO-', used in compound words only, and that there is no evidence showing that the meaning of this prefix, as a reference to the extremely small size of the goods or to the use of nanotechnology, may be applied to the term 'NANO' when used alone. In accordance with the BoA's findings, the GC remarked that the applicant has not adduced any evidence to show that the relevant public would not understand the word 'NANO', when used alone, as having the same meaning as the prefix 'NANO-', and, accordingly, as referring either to the size of the goods or to the use of nanotechnology. Therefore, the infringement of Article 76 CTMR was not found (paras 46-54).

[T-233/14](#); **NEXTCARD**, Order of 5 March 2015, *Intesa Sanpaolo SpA v OHIM* – IT. The applicant sought to register the word mark 'NEXTCARD' as a CTM for a range of goods and services in Classes 9 and 36, including magnetic data carriers in Class 9 and financial and monetary services in Class 36. The examiner refused to register the sign as a CTM on the ground that it was descriptive and devoid of distinctive character in relation to the abovementioned goods and services. The BoA dismissed the applicant's appeal. The BoA found that the word 'NEXTCARD' would be perceived by the relevant public with the meaning of 'the most advanced card on the market' in relation to magnetic bank cards (included



in the category of magnetic data carriers). As far as the services in Class 36 are concerned, the consumers will perceive that they are related to or offered together with those cards. Therefore, the sign was found to be devoid of distinctive character under Article 7(1)(b) CTMR. The applicant filed an action before the GC arguing an infringement of Article 75 CTMR. In particular, the applicant first claimed that the BoA did not motivate why it refused the mark applied for in relation to magnetic data carriers, which are different from bank cards. And, secondly, that the BoA did not motivate why it refused the sign for financial and monetary services, among which there are also services not related to bank cards. The GC dismissed the appeal. The decision was well reasoned. The GC recalled the case law according to which the Office has in principle to motivate the refusal in relation to each of the relevant goods and services. However, a global reasoning is admitted when it refers to goods and services that show a sufficiently direct and objective link to the extent that they form a homogeneous category or group. Furthermore, when some goods and services belong to a specific category listed in the mark applied for, the Office may focus on the category as a whole and does not need to analyse any single good or service covered by the category (paras 16-18). Therefore, since bank cards in Class 9 and financial and monetary services (related to bank cards) in Class 36 are included in the wider categories of the mark applied for and the applicant did not limit the list of goods and services, it is not up to the Office to focus specifically on those more restricted categories of goods and services (paras 20-21). In relation to some goods in Class 9 (CDs, DVDs and other digital recording media), the applicant's claim is unfounded because those goods had been accepted for registration. Therefore, the contested decision cannot be appealed with reference to those goods, under Article 65 CTMR, since the applicant was not adversely affected by the decision (paras 19-20). In the light of above, the claim of applicant is manifestly unfounded.

◆ [T-393/12](#); **KENZO / KENZO**, Judgment of 22 January 2015, *Kenzo Tsujimoto v OHIM* – EN. The CTM applicant filed an application for the word mark 'KENZO' for 'wine; alcoholic beverages of fruit; western liquors (in general)' in Class 33. The opponent relied on the earlier CTM 'KENZO' claiming reputation for goods in Classes 3, 18 and 25. The OD dismissed the opposition stating that reputation was not proven. The BoA upheld the appeal of the opponent. The CTM applicant brought an action before the GC based on two pleas in law. On the infringement of Article 75 CTMR, the GC dismissed the applicant's claim that the BoA had not addressed his argument to the effect that he merely wished to use his forename, 'Kenzo', for a certain range of goods and that this constituted due cause for the use and registration of the mark applied for. The GC held that the BoA had responded to this argument by finding that 'no due cause had been demonstrated', and that this response, although laconic, is adequate (paras 15-23).

◆◆ [T-581/13](#); **POLO CLUB / BEVERLY HILLS POLO CLUB**, Judgment of 26 March 2015, *The Royal County of Berkshire Polo Club Ltd. v OHIM* – EN. The applicant sought to register the figurative mark 'Royal County of Berkshire POLO CLUB' as a CTM for a range of goods in Classes 9, 14, 18 and 25. An opposition was lodged, based on the earlier figurative mark 'BEVERLY HILLS POLO CLUB', registered for goods falling within, inter alia, Classes 9, 14, 18 and 25. The opposition was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition in its entirety. The BoA partially annulled the OD's decision and rejected the contested mark for all the goods of Classes 9, 14, 18 and 25, while rejecting the opposition in respect of the goods in Classes 16 and 28. The applicant filed an action before the GC arguing an infringement of Article 8(1)(b) and Article 75 CTMR. Concerning in first place the applicant's claim that the statement of reasons for the BoA's decision was inadequate, due to an alleged lack of clarity as regards the finding that the level of attention of the average EU consumer of the relevant



goods at issue is normal, the GC held that that the BoA had provided sufficient reasons, and clarified that if the reasons given are vitiated by errors, those errors will vitiate the substantive legality of the decision, but not the statement of reasons, which may be adequate even though it sets out reasons which are incorrect (para. 23).


◆ [T-580/13](#); **real,- / Real**, Order of 21 April 2015, *Real Express SRL v OHIM* – EN. The applicant sought to register the figurative mark ‘real,-’ as a CTM for goods and services in Classes 3 and 35. An opposition based on two earlier Romanian figurative marks, registered for goods and services in Classes 3 and 35, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition under Rule 20(1) CTMIR, noting that the opponent had not proven its entitlement as the owner of the earlier marks. The BoA dismissed the opponent’s appeal, holding that Rule 19 in conjunction with Rule 20(1) CTMIR prevented it from exercising the discretion provided for in Article 76(2) CTMR and the relevant case law. The opponent filed an action before the GC where it raised infringements regarding essential procedural requirements and procedural rules. The GC points out that, even if that mere assertion ought to have been interpreted as a complaint by the opponent that BoA failed to take the fax of 16 July 2012 into account, in disregard of Article 76(2) CTMR and Rule 20(1) CTMIR, it would have had to be dismissed for the same reasons as those upheld in the case C-120/12 P, *Rintisch v OHIM* (para. 44). The BoA in essence took the view that Rule 20(1) CTMIR constituted a provision to the contrary for the purposes of Article 76(2) CTMR and that, consequently, it had no discretion to take the fax of 16 July 2012 — submitted by the applicant in order to establish ownership of the earlier marks — into account. In doing so, the BoA erred in law. Nevertheless, for the same reasons as those upheld in paragraphs 36 to 41 of the judgment in *Rintisch v OHIM*, the grounds set out by the BoA in paragraph 20 of the contested decision are, in any event, capable of remedying the defect vitiating the contested decision, inasmuch as they permit the inference that the BoA actually exercised its discretion under Article 76(2) CTMR, for the purposes of deciding, in a reasoned manner and having regard to all the relevant circumstances, whether it was necessary to take into account the evidence submitted to it late, in order to give its decision (para. 45).

◆ [T-250/13](#); **SMART WATER**, Judgment of 18 March 2015, *Naazneen Investments Ltd v OHIM* – EN. The CD upheld the application for revocation of the registered CTM ‘SMART WATER’ on the grounds of Article 51(1)(a) CTMR for all the goods in respect of which it had been registered. The CTM proprietor filed an appeal. The BoA dismissed the appeal and upheld the contested decision. The BoA stated that the evidence provided by the CTM proprietor did not make it possible to establish that the mark at issue had been put to genuine use and, concurrently, there were no proper reasons for non-use. The applicant filed an action before the GC. As to infringement of Article 75, the GC stated, that when the BoA confirms a decision of the CD in its entirety, and given the continuity in terms of function between the BoA and the CD, that decision, together with its statement of reasons, forms part of the context in which the BoA’s decision was adopted (para. 16). The BoA, in confirming the decision of the CD, could reproduce the latter’s assessment; the fact that the BoA did not provide a translation of that earlier decision in the language of the case cannot constitute a failure to provide a sufficient statement of reasons (para. 21).



◆ [T-660/11](#); **POLYTETRAFLON / TEFLON**, Judgment of 16 June 2015, *Polytetra GmbH v OHIM* – EN. The applicant sought to register the word mark ‘POLYTETRAFLON’ as a CTM for a range of goods in Classes 1, 11, 17 and 40. An opposition was lodged, based on the earlier word mark ‘TEFLON’. The opposition was filed on the grounds of Article 8(1)(b) CTMR and Article 8(5) CTMR. The OD dismissed the opposition in its entirety. The BoA annulled the OD’s decision and rejected the contested mark. The CTM applicant filed an action before the GC raising two pleas in law: (i) breach of Article 8(1)(b) and (ii) breach of Article 42(2) and (3) CTMR. Additionally, the GC examined, on its own motion, whether the duty to state reasons for the contested decision had been observed under Article 75 CTMR. The GC found that the BoA’s decision was vitiated by inadequate reasoning since it does not enable the GC to understand the extent to which the pieces of evidence produced by the opponent, and relied on by the BoA, allegedly proved genuine use of the earlier mark for each of the goods among those for which that mark had been registered (paras 19-36).

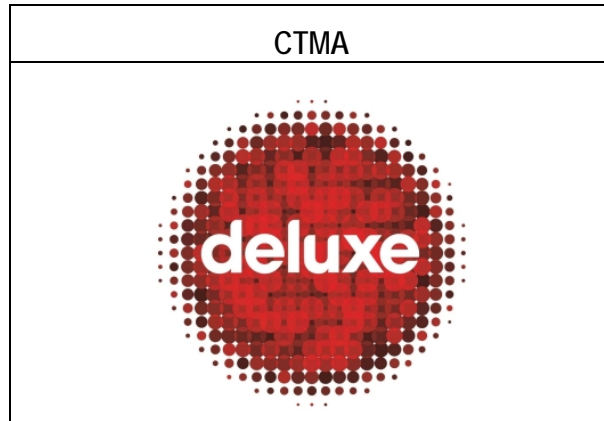
◆ [T-489/13](#); **VIÑA ALBERDI / VILLA ALBERTI**, Judgment of 30 June 2015, *La Rioja Alta, S.A. v OHIM* – ES.

CTMA	Earlier mark
VIÑA ALBERDI	

On 26 November 2004, the word sign ‘VIÑA ALBERDI’ was registered as a CTM for the goods and services in Classes 30, 32 and 33. On 5 November 2009 a request for a declaration of invalidity of the CTM against the goods in Class 33: ‘Alcoholic beverages (except beers)’ was filed on the basis of the earlier German figurative trade mark represented above. The CTM proprietor requested proof of use of the earlier mark and put forward that the challenged CTM claims a Spanish seniority from a well-known trade mark and claimed that the cancellation applicant has tolerated the coexistence of the marks in dispute. The CD declared the registration of the challenged CTM invalid for the contested goods. The BoA confirmed the decision of the CD and considered there was a likelihood of confusion between the marks at issue in respect of contested goods despite the fact that the CTM proprietor limited its list of goods to ‘alcoholic beverages (except beers) and except wines from Italy’. The CTM proprietor filed an application for annulment before the GC. The GC dismissed the action. The GC ruled there was no infringement of Article 75 CTMR. In the judgment, reference was made to the case law establishing that the reasoning of the BoA may be implicit, on condition that it enables the persons concerned to know the reasons for the BoA’s decision and provides the competent GC with sufficient material for it to exercise its power of review (para. 94). Moreover, the BoAs can rely on matters of common knowledge subject to the adversely affected party’s proving an error in assessing that common knowledge of those matters (para. 56). There is no infringement of Article 52(3) CTMR according to the GC as the BoA is not under an obligation to analyse each and every product individually, providing they form part of the same category (paras 102, 28- 45).



◆ [T-222/14](#); **deluxe**, Judgment of 4 June 2015, *Deluxe Laboratories, Inc. v OHIM* – ES.



The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 9, 35, 37, 39, 40, 41, 42 and 45. The examiner refused to register the word as a CTM on the ground that it is descriptive and devoid of distinctive character. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. ARTICLE 75 THE DUTY TO STATE REASONS: The GC refers to the jurisprudence that establishes the BoA's duty, when refusing registration of a trade mark, to state in its decision its conclusion for each of the goods and services specified in the application for registration, and its possibility, where the same ground for refusal is given for a category or group of goods or services, to limit itself to using general reasoning for all of the goods or services concerned. It further refers to the jurisprudence that specifies that the option for the BoA to use general reasoning for a series of goods or services can extend only to goods or services that have a sufficiently direct and specific link to each other to the extent that they form such a sufficiently homogeneous category as to enable all the factual and legal considerations constituting the grounds of the decision in question, first, to explain adequately the reasoning followed by the BoA for each of the goods and services belonging to that category and, second, to be applied without distinction to each of the goods or services concerned (paras 16-17). In this case, the GC concluded that the differences among the goods and services applied for do not allow considering them as a homogeneous category that permits the BoA to use a global reasoning and points out that the BoA used a global reasoning without indicating the existence of a sufficiently direct and specific link among the goods and services that justifies it. The fact that the term 'deluxe' is a laudatory and promotional term that can be applied to all the goods and services at issue, even if proven, is irrelevant (paras 20-27).

◆ [T-172/13](#); **AFRICAN SIMBA / Simba**, Judgment of 22 January 2015, *Novomatic AG, v OHIM* – DE. The CTM applicant sought to register the word mark 'AFRICAN SIMBA' for goods and services in Classes 9, 28 and 41. The opponent based its opposition, inter alia, on Article 8(1)(b) CTMR using, inter alia, the earlier German figurative mark 'Simba', registered for goods in Class 28. The opposition was directed against all the goods and services covered by the CTMA. The OD upheld the opposition partially for the contested goods in Classes 9 and 28. The BoA dismissed the applicant's appeal, finding that there was a likelihood of confusion (for the goods in Classes 9 and 28), taking into account, the identity of the goods and the similarity of the signs. The CTM applicant appealed to the GC, arguing an infringement of Article 8(1)(b), Article 42(2) and (3), and Article 75 CTMR. INFRINGEMENT OF ARTICLE 75 CTMR.



Concerning the duty to state reasons, the GC confirms the constant case law that the reason behind this procedural requirement lies in two main aspects. One is to explain to the parties the reasons for the decision and the measure taken in it and secondly to enable the control of the legality to the higher instances (para. 45). However, there is a difference between lack of reasoning and the wrong reasoning. Wrong reasoning is not equivalent to the lack of any reasoning and does not lead automatically to the annulment of the contested decision (para. 46). The GC notes that the contested decision stated (para. 30) that the application would consist of the depiction of the head of a lion and the stylised reproduction of the word elements. However, the BoA further concluded that the figurative elements would not have a great impact on the marks (para. 54). The GC concluded that this procedural error has no impact on the understanding of the reasons set out in the contested decision. The conclusions drawn by the BoA are still applicable to the case at hand and enable to understand the outcome and to review its legality (paras 56 to 58).

◆ [T-378/13](#), **ENGLISH PINK / PINK LADY**, Judgment of 25 March 2015, *Apple and Pear Australia, Star Fruits Diffusion v OHIM – EN*. The CTM applicant sought to register the word mark ‘ENGLISH PINK’ for goods in Class 31. An opposition was filed pursuant to Article 8(1)(b) and Article 8(5) CTMR, based on the word CTM ‘PINK LADY’, as well as on some figurative CTMs, all covering goods in Class 31. The OD dismissed the opposition. One year before adopting the contested decision, the BoA was notified a final judgment of the Belgian CTM Court — *Tribunal de Commerce de Bruxelles* (TCB) — cancelling the Benelux mark ‘ENGLISH PINK’ (which had been applied for at the same time as the identical ‘ENGLISH PINK’ CTM) because of a likelihood of confusion (LOC) with the earlier ‘PINK LADY’ CTM and Benelux trade marks. The TCB found that the Benelux mark ‘ENGLISH PINK’ infringes the ‘PINK LADY’ marks (both CTMs and Benelux) and prohibited the other party from using the sign ‘PINK LADY’ within the EU. The TCB ruled that the ‘PINK LADY’ CTMs enjoy a high degree of protection and that there is a significant LOC between ‘PINK LADY’ and ‘ENGLISH PINK’. The BoA transmitted the judgment and its translation to the other party, but the contested decision did not even mention it in the summary of the facts. The BoA rejected the opposition, thereby taking the opposite view to the TCB: lack of enhanced distinctiveness, no reputation under Article 8(5) CTMR, and no LOC. Before the GC, the applicant alleges seven pleas, the ones examined by the GC being: (i) Breach of the duty to state reasons regarding the inferences to be drawn from the judgment of the Belgian CTM Court. (ii) Breach of *res judicata*. (iii) Breach of the general principles of legal certainty, sound administration and protection of legitimate expectations. The GC stated the BoA had been duly notified on several occasions of a new fact (the judgment of the TCB) several months before the adoption of the contested decision. But nowhere does the BoA refer to its existence or explain why it does not take the new fact into consideration (para. 32), although it was required to state reasons. The BoA infringed Article 75 CTMR (para. 36).

◆ [T-336/14](#); **NOURISHING PERSONAL HEALTH**, Judgment of 8 October 2015, *Société des produits Nestlé SA v OHIM – EN*. The applicant sought to register the IR designating the EU of the word mark ‘NOURISHING PERSONAL HEALTH’ for goods and services in Classes 5, 10, 41, 42 and 44. The examiner refused registration of the mark applied for in respect of all the goods and services referred to, on the basis of Article 7(1)(b) and (2) CTMR and the BoA dismissed the applicant’s appeal. The applicant filed an action before the GC. The GC rejected the applicant’s plea in law alleging infringement of the obligation of the BoA to state reasons. The GC emphasised the fact that the BoA is not obliged to express a view on every argument submitted by the parties (para. 15) and may use only general



reasoning where the same ground of refusal is given for a category or group of goods and services which are interlinked in a sufficiently direct and specific way (para. 17). The GC stated that the BoA did not infringe its obligation to carry out a stringent and full examination of the facts of its own motion (para. 21 et seq.).

◆◆[T-278/10 RENV](#); **WESTERN GOLD / WeserGold et al.**, Judgment of 24 November 2015, *riha WeserGold Getränke GmbH & Co. KG v OHIM – DE*. The applicant sought to register the word mark ‘WESTERN GOLD’ for goods in Class 33. The opponent based an opposition on Article 8(1)(b) CTMR relying, inter alia, on earlier Community word mark ‘WeserGold’ registered for goods in Classes 29, 31 and 32. The OD upheld the opposition. The BoA set the OD decision aside finding that there is no likelihood of confusion (low similarity of goods in Classes 32 and 33; the signs are visually and aurally similar but conceptually dissimilar; the earlier mark’s distinctiveness is below average due to the element ‘Gold’ with a low degree of distinctiveness). The opponent filed an action before the GC based on an infringement of Article 8(1)(b) CTMR and three further pleas with respect to Articles 64 and 75 CTMR. The GC annulled the BoA decision (T-278/10). After holding that the signs are dissimilar on account of their clear conceptual difference, the GC based its ruling on the fact that the BoA failed to assess the claimed enhanced distinctiveness of the earlier mark. Upon the Office’s appeal, the CJ annulled the GC decision, holding that the omitted assessment of the earlier mark’s distinctiveness could have had no bearing on the outcome since the GC considered the conflicting signs to be dissimilar. The CJ remitted the case to the GC noting that it cannot be adjudicated upon as the GC merely assessed the first out of four pleas. The applicant’s right to be heard is not infringed by the fact that the BoA assessed all earlier marks (as opposed to the OD decision, which was based on the earlier Community mark only) without informing the applicant about this beforehand due to the continuity of function between the Office’s instances (paras 54-66). **INFRINGEMENT OF ARTICLE 75 CTMR**. The BoA gave sufficient reasons with respect to all earlier marks by way of referring to ‘the earlier marks’, mentioning them and noting that the differences in the writing of word marks are irrelevant (para. 72).

◆[T-766/14](#); **FoodSafe**, Order of 23 November 2015, *Actega Terra GmbH v OHIM – DE*. The invalidity applicant requested the invalidity of the word mark ‘FoodSafe’, registered for the following goods in Class 2: ‘Lacquers, in particular for the graphics industry; All the aforesaid goods other than for use in building’ as being descriptive in the sense of Article 7(1)(c) CTMR. Both instances of the Office upheld the request and declared the CTM invalid. The CTM proprietor filed an appeal before the GC claiming an infringement of Article 52(1)(a) and Article 76(1) CTMR. The further complaints from the applicant have been rejected by the GC: The statement that the BoA did not show that the English-speaking public would use the mark, has been rejected with the argument that actual use at the time of filing the CTM application does not have to be shown in order to refuse registration (paras 25 and 27). The GC stresses that the Office does not have to show that the mark is contained in the dictionaries. It suffices to apply the pertinent case law for the assessment on the descriptive character of the mark (para. 27). The GC confirms the case law that due to the presumption of validity in the invalidity proceedings based on absolute grounds, the Office must not investigate and examine on its own motion if the registered CTM was barred from registration at the time of filing. It is up to the invalidity applicant to show that the claimed absolute grounds for refusal were applicable at the time of filing. However, this does not apply to well-known facts, which shall be taken into account (paras 32 to 35). The information contained in the German online dictionary ‘DUDEN’ is to be considered as a well-known fact since it is accessible for the broad



public (para. 36). The argument that the evidence showing the translation of the expression 'Foodsafe' into the German language is not able to reflect the understanding of the relevant English-speaking consumers is not correct. The BoA based its decision on that evidence in order to explain the descriptive character of the mark in the language of proceedings, namely German (paras 41-42).

◆ [T-264/14](#); **WIN365**, Judgment of 23 October 2015; *Robert Hansen v OHIM* – DE. The applicant sought to register the word mark 'WIN365' for, inter alia, services in Classes 36 and 41. Both instances refused registration for the above services according to Article 7(1)(b) CTMR. The applicant appealed before the GC alleging infringement of the above provision. As a preliminary remark the GC states that the applicant's complaint that the BoA did not sufficiently explain the meaning of the number 365 as referring to the days of a calendar year is to be refused. It is a well-known fact that this number will be perceived as a reference to all the days of one year and consequently, there was no obligation for the BoA to further explain this meaning of the number '365'. Moreover, the applicant itself admitted during the administrative proceedings that the number '365' could be perceived as referring to the days of one calendar year. Consequently, there is no lack in the reasoning of the contested decision (paras 18–22).

2.3 *Ultra petita*

[no entry]

2.4 *Others*

◆ [T-253/13](#); **IRAP**, Judgment of 12 November 2015, *Orthogen AG v OHIM* – DE. The contested trade mark was the registered CTM 'IRAP' (word) for goods and services in Classes 1, 10, 42 and 42. The CD cancelled the CTM as being descriptive and devoid of distinctive character according to Article 7(1)(b) and (c) CTMR. The BoA confirmed the First Instance to the extent that it found that the mark is devoid of distinctive character. The applicant put forward that in proceedings for declaration of invalidity based on absolute grounds for refusal, the Office would be bound by the use of the discretionary power of the Office when it accepted the mark for registration (para. 18). According to Article 64(1) CTMR, the BoA is called to carry out an examination by exercising any power within the competence of the department which was responsible for the decision appealed. This involves a full examination as to the merits both as to the factual and legal framework of the case. Consequently, the applicant's plea has to be rejected (paras 18-22).



3. General principles of Community law

◆ [T-197/13](#); **MONACO**, Judgment of 15 January 2015, *Marques de l'État de Monaco (MEM) v OHIM – FR*. The IR holder, the Principality of Monaco was granted an IR designating the EU by WIPO. The examiner partially refused the IR designation on the basis of Article 7(1)(b) CTMR. The IR holder contested the Office's decision before the BoA. The BoA dismissed the IR holder's appeal. The IR holder filed an action before the GC relying on three pleas in law. As regards the violation of Article 7(1)(c) CTMR, first of all the GC analysed the claim that EU law was not applicable to Monaco and other similar international law grounds and held that under EU law, any legal entity, including a public law entity, may apply to benefit from the protection of the Community trade mark (para. 29). This is not only true for companies based in the territory of a state that is not a member of the EU, but also for the non-member states themselves, since those states are, within the meaning of EU law, public law entities (para. 30). As a result, when the Principality of Monaco formulated its request to have the EU designated for the IR of the trade mark at issue, it placed itself within the scope of application of EU law and, therefore, one of the absolute grounds for refusal could be relied upon against it (para. 32). On the request to send a preliminary ruling to the CJ, although the GC considered it was not obliged to answer this ground it decided to examine why this claim could not be accepted (para. 36). Analysing Article 256 TFUE and Article 51 of the Statute of the CJ, the GC held that it was not competent to send preliminary rulings to the CJ and concluded that this ground was in any case inadmissible (paras 38 and 40). On the interest behind the prohibition of Article 7(1)(c) CTMR, the GC refused the argument of the Principality of Monaco that the interest behind the prohibition is not the interest of a third country such as Monaco explaining that when the applicant filed an application it accepted to be judged by the EU regulation (paras 43-44).

◆ [T-106/14](#); **GREENWORLD**, Judgment of 27 February 2015, *Universal Utility GmbH & Co KG v OHIM – DE*. The applicant sought to register the word mark 'GREENWORLD' as a CTM for goods and services in Classes 4, 35 and 39. The examiner refused registration of the mark on the ground that it is descriptive and non-distinctive for the goods and services at stake. The fact that the Office has registered the word mark 'Green World' for goods and services in Classes 7, 37, 39 and 42 is irrelevant for the present proceedings. The question of whether a mark is registrable is to be decided solely on the basis of the CTMR and not on the basis of any prior Office practice (para. 37). Even if the situation that led to the registration of 'Green world' were identical with the present scenario — *quod non* — case law provides that the Office must, when examining an application for registration of a CTM, take into account the decisions already taken in respect of similar applications and consider with special care whether it should decide in the same way or not. Nonetheless, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed to the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full in order to prevent trade marks from being improperly registered (para. 37). In the present case, in light of the goods and services and the relevant consumer perception, the application has been rightly found to be descriptive (Article 7(1)(c) CTMR). Therefore, the applicant cannot rely on prior decisions of the Office in order to challenge the findings in the present case (para. 38).



◆ [T-587/13](#); **cat & clean / CLEAN CAT**, Judgment of 21 January 2015, *Miriam Schwerdt v OHIM* – DE. The applicant sought to register the figurative mark ‘cat & clean’ as a CTM for goods within Class 31. An opposition based on earlier Spanish word mark ‘CLEAN CAT, registered for goods in Class 31, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the applicant’s appeal, finding a likelihood of confusion between the marks. The opponent filed an action before the GC relying on three pleas in law. As regards the plea of infringement of Article 29 et seq. of the Treaty on the Functioning of the European Union (TFEU), a certain level of distinctiveness is recognised similar to the earlier national mark invoked in CTM opposition proceedings (para. 43). The validity of registration of an earlier national mark cannot be contested within the CTM registration procedure (para. 46). The interest of the CTM legislation is to enable the owners of earlier marks to oppose the registration of later marks which are taking an unfair advantage of the distinctive character of the earlier. Thus, far from granting an unjustified monopoly to the owners of the earlier marks, the regime enables them to protect and enhance the substantial investment made to promote the earlier mark (para. 48). As regards the plea of infringement of Articles 16 and 20 of the Charter of Fundamental Rights of the EU (CFR), the freedom to conduct a business does not constitute an absolute right; however, it must be considered in relation to its function in society. It may be subject to a wide range of interventions by public authorities in order to establish limits which are in the public interest, such as in the case of intellectual property (paras 54-56).

◆ [T-188/14](#); **GENTLE CARE**, Judgment of 21 January 2015, *Grundig Multimedia AG v OHIM* – EN. The applicant sought to register the word mark ‘GentleCare’ as a CTM for goods and services within Class 7. The examiner refused to register the word as a CTM based on Article 7(1)(b) and (c) CTMR with respect to part of the goods covered by the CTMA, namely ‘machines for manufacturing, treating, scotching, tenting or washing fabrics, sewing machines and industrial robots with the same function as the machines referred to above; washing machines (laundry/dishwashing machines); electrical machines for cleaning floors and carpets, vacuum cleaners and their parts’. The BoA dismissed applicant’s appeal on the ground that the trade mark applied for was descriptive and devoid of any distinctive character. The applicant filed an action before the GC relying on two pleas in law (i) infringement of Article 7 (1)(c) CTMR and (ii) infringement of Article 7(1)(b) CTMR. The GC found that the principles of equal treatment and sound administration must be consistent with respect for legality. For reasons of legal certainty and sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Since the examination of the sign at issue in the light of that provision could not, in itself, lead to a different conclusion, the applicant’s claims of a failure to take into consideration the registration of identical trade marks cannot succeed (paras 41-44). Based on the foregoing, the sign at issue was found descriptive.

◆ [T-655/13](#); **GREEN**, Judgment of 28 January 2015, *Enercon GmbH v OHIM* – DE. The applicant sought the registration of a CTM for the colour green for goods in Classes 7, 16 and 28. The OD held that the mark lacked distinctive character (Article 7(1)(b) CTMR). The BoA upheld that decision. The applicant filed an action before the GC. INFRINGEMENT OF ARTICLE 43(2) CTMR. The applicant claims that the BoA infringed the abovementioned provision by refusing the request of amendment of the category of mark to a ‘figurative mark’ with colour claim instead of a mark in ‘colour per se’. The GC states that there are two conditions for accepting such amendments of CTM applications. It must be an obvious mistake and secondly it must not substantially change the trade mark (paras 13-14). As to the first condition, there

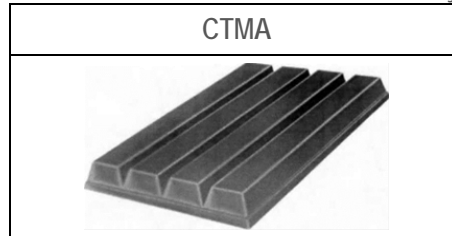


is no indication as to obviousness of the mistake as claimed by the applicant. The sign as represented might be both a figurative mark with colour claim and a mark in colour per se. It is up to the applicant to choose the correct category of mark. Moreover, it must be stressed that the applicant requested for the first time the correction before the BoA. Consequently, the request was filed very late. This first condition was not fulfilled (paras 15-16). As to the second condition, a change in the category of a mark supposes according to the case law a substantial change of the mark, since it has a direct impact on the assessment on absolute grounds for refusal. For the case at hand, a colour mark *per se* has no shape and no limitation, whereas a figurative mark (with a colour claim) has a clear delimitation and shape (paras 16-17). This difference has a direct impact on the perception of the consumers. The second condition is also not fulfilled and the claim of infringement of Article 43(2) CTMR is to be refused (para. 18).

◆ [C-125/14](#); **Be impulse / Impulse**, Preliminary ruling of 3 September 2015, *Iron & Smith kft v Unilever NV* – HU. This request for a preliminary ruling has been made in proceedings between Iron & Smith kft ('Iron & Smith', the applicant), on the one hand, and Unilever NV ('Unilever', the opponent), on the other hand, concerning the variation in the decision of the Hungarian IP Office refusing registration of the mark 'Be impulsive' applied for by Iron & Smith. The earlier CTM 'Impulse' was found to have reputation across the EU, but not in Hungary. The referring CJ observed that Article 4(3) TMD and Article 9(1) CTMR do not offer any indication as to what is the relevant geographical territory within the EU in order to establish that a CTM has a reputation. Furthermore, it is unclear, even if the trade mark has such a reputation, whether it is possible that, where such a mark is unknown in the Member State concerned, the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier CTM (para. 13). First of all, the CJ observed that both Article 4(3) TMD and Article 9(1)(c) CTMR contain the expression 'has a reputation in the Community' which has the same meaning (para. 16). Therefore, the CJ, recalling the judgment in the case 'PAGO International', stated: 'if the reputation of an earlier CTM is established in a substantial part of the territory of the EU which may coincide with the territory of a single Member State, that mark has a reputation in the EU and the CTM owner is not required to produce evidence of that reputation in the Member State in which the application for registration of the later national mark, which is the subject of an opposition, has been filed' (paras 17-20). Secondly, the provisions concerning the requirement of genuine use of the CTM (Article 15(1) and Article 51 CTMR) and the criteria laid down by the case law in order to prove genuine use are not relevant as such for the purpose of establishing a 'reputation' within the meaning of Article 4(3) TMD (paras 23-24) since those provisions pursue a different objective (para. 21). Finally, the CJ, recalling the judgment in the 'Intel' case, ruled that if the earlier CTM has already acquired a reputation in a substantial part of the territory of the EU, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the CTM may still benefit from the enlarged protection introduced by Article 4(3) TMD, where it is shown that a commercially significant part of that public is familiar with that mark and makes a connection between it and the later national mark and there is either actual and present injury to its mark or a serious risk that such injury may occur in the future (paras 27-34).



◆ [C-215/14](#); **SHAPE OF A FOUR FINGER CHOCOLATE-COATED WAFER (3D MARK)**, Preliminary ruling of 16 September 2015, *Société des Produits Nestlé SA v Cadbury UK Ltd* – EN.



Nestlé sought to register the 3D shape of the ‘Kit Kat’ four-finger chocolate-coated wafer (see above) in the UK as a national 3D trade mark. The National Office rejected the application. Nestlé appealed the decision to the High Court of Justice of England and Wales (EWHC) and Cadbury filed a cross-appeal. The EWHC made a reference to the CJ for a preliminary ruling asking: 1) In order to establish that a trade mark has acquired distinctive character following the use that had been made of it within the meaning of Article 3(3) of Directive 2008/95 ..., is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant’s goods in the sense that, if they were to consider who marketed the goods bearing that mark, they would identify the applicant; or must the applicant prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trade marks which may also be present) as indicating the origin of the goods. 2) Where a shape consists of three essential features, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, is registration of that shape as a trade mark precluded by Article 3(1)(e)(i) and/or (ii) of Directive 2008/95 ...? 3.) Should Article 3(1)(e)(ii) of Directive 2008/95 ... be interpreted as precluding registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured as opposed to the manner in which the goods function?’ (2) The grounds for refusal of registration laid down in Article 3(1)(e) operate independently of one another (para. 46). Hence, registration may be refused only where at least one of those grounds is fully applicable to the sign at issue (para. 48) Therefore, Article 3(1)(e) of Directive 2008/95 must be interpreted as precluding registration as a trade mark of a sign consisting of the shape of goods where that shape contains three essential features, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, provided, however, that at least one of the grounds for refusal of registration set out in that provision is fully applicable to the shape at issue (para. 51). (3) By literal interpretation, the ground for refusal provided for in Article 3(1)(e)(ii) of Directive 2008/95 is restricted to the manner in which the goods function rather than to a particular method of manufacturing the shape in question (para. 54). From the consumer’s perspective, the manner in which the goods function is decisive and their method of manufacture is not important (para. 55) Moreover, the manufacturing method is not decisive in the context of the assessment of the essential functional characteristics of the shape of goods either. The registration of a sign consisting of a shape attributable solely to the technical result must be refused even if that technical result can be achieved by other shapes, and consequently by other manufacturing methods (para. 56). It follows that Article 3(1)(e)(ii) of Directive 2008/95 does not preclude registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured. (1) Acquisition of distinctive character may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. However, in consequence of such use, the relevant class of persons must actually perceive the goods or services, designated exclusively by the mark applied for, as originating



from a given undertaking (para. 64). Hence for the purposes of the registration of the mark itself, the trade mark applicant must prove that that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company (para. 66-67) (emphasis added).

◆◆[T-378/13](#), **ENGLISH PINK / PINK LADY**, Judgment of 25 March 2015, *Apple and Pear Australia, Star Fruits Diffusion v OHIM* – EN. The CTM applicant sought to register the word mark ‘ENGLISH PINK’ for goods in Class 31. An opposition was filed pursuant to Article 8(1)(b) and Article 8(5) CTMR, based on the word CTM ‘PINK LADY’, as well as on some figurative CTMs, all covering goods in Class 31. The OD dismissed the opposition. One year before adopting the contested decision, the BoA was notified a final judgment of the Belgian CTM Court — *Tribunal de Commerce de Bruxelles* (TCB) — cancelling the Benelux mark ‘ENGLISH PINK’ (which had been applied for at the same time as the identical ‘ENGLISH PINK’ CTM) because of a likelihood of confusion with the earlier ‘PINK LADY’ CTM and Benelux trade marks. The TCB found that the Benelux mark ‘ENGLISH PINK’ infringes the ‘PINK LADY’ marks (both CTMs and Benelux) and prohibited the other party from using the sign ‘PINK LADY’ within the EU. The TCB ruled that the ‘PINK LADY’ CTMs enjoy a high degree of protection and that there is a significant LOC between ‘PINK LADY’ and ‘ENGLISH PINK’. The BoA transmitted the judgment and its translation to the other party, but the contested decision did not even mention it in the summary of the facts. The BoA rejected the opposition, thereby taking the opposite view to the TCB: lack of enhanced distinctiveness, no reputation under Article 8(5) CTMR, and no LOC. Before the GC, the applicant alleges seven pleas, the ones examined by the GC being: i) Breach of the duty to state reasons regarding the inferences to be drawn from the judgment of the TCB. ii) Breach of *res judicata*. iii) Breach of the general principles of legal certainty, sound administration and protection of legitimate expectations. On the last issue, the GC stated that the judgment of the TCB is, *prima facie*, a relevant factual element for resolving the case in question. There are essential common points between the factual aspects at issue (para. 47). That judgment was delivered by a CTM court, which is part of the autonomous EU trade mark regime (para. 48). In failing to assess the potential impact of this judgment for the outcome of the dispute before it, the BoA failed to assess all the relevant factual aspects of the case with the required diligence and infringed the principle of sound administration. This lack of diligence leads to the annulment of the contested decision (paras 50-52). Furthermore, the GC stated that the judgment of the TCB is not in itself sufficient to enable the GC to alter the contested decision and to ascertain which decision the BoA was required to take (para. 57). When exercising its exclusive jurisdiction over registration of CTMs and when examining oppositions lodged against CTM applications, the Office is not bound by a decision of a CTM court delivered in an action for infringement (para. 60). The unitary character of the CTM does not mean that the principle of *res judicata* precludes the Office and, consequently, the European courts, from examining the possible existence of a LOC in the context of the opposition proceedings concerning the registration of a new CTM, even though it is identical to a national mark which has been held by a CTM court to undermine the earlier CTM (paras 62-64).



4. Others

[C-147/14](#); *EL BAINA / EL BENNA et al.*, Preliminary ruling of 25 June 2015, *Loufti Management Propriété intellectuelle SARL v AMJ Meatproducts NV and Halalsupply NV* — NL.

Registered Benelux Trade Mark	Earlier CTMs
	

This request for a preliminary ruling was made in proceedings between Loufti Management Propriété intellectuelle SARL ('Loufti'), on the one hand, and AMJ Meatproducts NV ('Meatproducts') and Halalsupply NV ('Halalsupply'), on the other hand, concerning an alleged infringement of two figurative CTMs registered by 'Loufti'. 'Loufti' owns two earlier CTMs. First, 'EL BENNA', was registered for goods in Classes 29, 30 and 32; second, 'EL BNINA', was registered for goods in Classes 29 and 30, both CTMs combining the colours red, white and green. 'Meatproducts' registered figurative Benelux trade mark 'EL BAINA' for goods in Class 29 and 30 without any colour combination. 'Halalsupply' has taken over the business of 'Meatproducts', including the latter's trade mark portfolio. According to the national court, the sign considered refers to the same goods, or at least to similar goods to those identified in the two CTMs (para. 12). Furthermore, the relevant public must be defined as being the public composed of Muslim consumers of Arab origin who consume 'halal' food products in the EU and who have at least a basic knowledge of written Arabic (para. 14). The word elements in Latin script are dominant in all signs as well as those in Arabic, although the latter elements are less dominant than the former (para. 15). Even though the national court finds a certain visual similarity between the signs, it remains the case that the pronunciation of those words in that language differs substantially; as does the significance which each holds (para. 16). QUESTION REFERRED TO THE CJ. The Court of Appeal in Brussels referred the following question to the CJ (para. 18): 'Having regard, in particular, to Articles 21 and 22 of the Charter of Fundamental Rights of the European Union, must Article 9(1)(b) CMTR be interpreted as meaning that, in the assessment of the likelihood of confusion between a CTM in which an Arabic word is dominant and a sign in which a different, but visually similar, Arabic word is dominant, the difference in pronunciation and meaning between those words may, or even must, be examined and taken into account by the competent courts of the Member States, even though Arabic is not an official language of the European Union or of the Member States?' ANSWER OF THE CJ. First the CJ underlined that the CTMR, and in particular Article 9(1)(b) thereof, do not make reference to the use of any particular language or alphabet which should or should not be taken into account in assessing the likelihood of confusion (para. 20). The CJ referred to its case law, namely to the judgment in *Henkel v OHIM*, C-456/01 P and C-457/01 P, as regards the relevant public (para. 21), and the judgments in *Aceites del Sur-Coosur v Koipe*, C-498/07 P, EU:C:2009:503, and *XXXLutz Marken v OHIM*, C-306/11 P, as regards the global appreciation of the existence of likelihood of confusion (para. 23). Based on that, the CJ found that the phonetic and conceptual differences should be taken into account because, if they are not, the assessment of the likelihood of confusion could be made only partially and, as a result, without taking into account the overall impression made on the relevant public by the CTMs and the sign considered (para. 25). THE CJ



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

[C-500/14](#); **FORD MOTOR**, Preliminary ruling of 6 October 2015, *Ford Motor Company v Wheeltrims srl* – IT. ‘Wheeltrims’ sells ‘spare part’ wheel trims bearing the trade mark ‘Ford’ without the authorisation of the TM proprietor. ‘Wheeltrims’ aim is to enable the purchaser to make sure that his or her purchase matches the appearance of the rest of his car. Ford brought an action for infringement before the Italian *Tribunale di Torino*. The *Tribunale* made a reference to the CJ for a preliminary ruling asking: 1.) Is it compatible with [EU] law to interpret Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 as conferring on producers of replacement parts and accessories the right to use trade marks registered by third parties in order to allow the end purchaser to restore the original appearance of a complex product and, therefore, also when the proprietor of the trade mark applies the distinctive sign in question to a replacement part or accessory intended to be mounted on the complex product in such a way that it is externally visible and thus contributes to the external appearance of the complex product?. 2.) Is the repair clause set out in Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 to be interpreted as constituting a subjective right for third-party producers of replacement parts and accessories and, if so, does that subjective right include the right for such third parties to use the trade mark registered by another party in respect of replacement parts and accessories, by way of derogation from the rules laid down in the CTMR and Directive (EEC) 89/104 and, therefore, when the proprietor of the trade mark also applies the distinctive sign in question to a replacement part or accessory intended to be mounted on the complex product in such a way that it is externally visible and thus contributes to the external appearance of the complex product? The two questions are examined jointly by the CJ. CJ: Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 foresee that the protection as a Community or national design which constitutes a component part of a complex product cannot be opposed to a third party who uses this design for the repair of that complex product so as to restore its original appearance. These provisions only limit the scope of protection granted by designs and models rights (para. 39). According to recital 7 and to Article 16 of Directive 98/71 and to recital 31 and Article 96 of Regulation No 6/2002, these acts shall be without prejudice to any provision of national or EU law relating to TM (para. 41). Therefore, Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 do not derogate Directive 2008/95 or Regulation No 207/2009 (para. 42). It follows that Article 14 of Directive 98/71 and Article 110 of Regulation (EC) No 6/2002 do not allow a producer of car replacement parts and accessories to use a registered TM for his products without the authorisation of the TM proprietor on the ground that such use of the TM would be the only way to repair the car in question by restoring, as a complex product, its original appearance (para. 45).

[C-379/14](#); **Bacardi**, Preliminary ruling of 16 July 2015, *TOP Logistics BV, Van Caem International BV v Bacardi & Company Ltd, Bacardi International Ltd and Bacardi & Company Ltd, Bacardi International Ltd v TOP Logistics BV, Van Caem International BV* – NL. This request for a preliminary ruling was made in the context of two sets of proceedings between, on the one hand, TOP Logistics BV (‘TOP Logistics’) and Van Caem International BV (‘Van Caem’) against Bacardi & Company Ltd and Bacardi International Ltd (‘Bacardi’) and, on the other hand, Bacardi against TOP Logistics and Van Caem, concerning goods originating from Bacardi. The goods at issue have been produced in a third State. They have been



brought into the customs territory of the EU without the consent of the proprietor of the trade mark and placed under a suspensive customs arrangement. They were then released for free circulation, which brought an end to that customs arrangement and gave rise to payment of import duties, without the consent of the proprietor. QUESTION REFERRED TO THE CJ: The *Gerechtshof te Amsterdam* referred the following question to the CJ (para. 29): Concerning goods originating outside the European Economic Area (EEA) which, after having been brought into the territory of the EEA (neither by the trade mark proprietor nor with its consent), are placed in a Member State of the EU under the external transit procedure or under the customs warehousing procedure ... (1) Where such goods are subsequently placed under a duty suspension arrangement, as in the present case, must those goods then be regarded as having been imported within the meaning of Article 5(3)(c) TMD with the result that there is 'use (of the sign) in the course of trade' that can be prohibited by the trade mark proprietor pursuant to Article 5(1) TMD? (2) If Question 1 is answered in the affirmative, must it then be accepted that in circumstances such as those in the case at issue, the mere presence in a Member State of such goods (which have been placed under a duty suspension arrangement in that Member State) does not prejudice, or cannot prejudice, the functions of the trade mark, with the result that the trade mark proprietor which invokes national trade mark rights in that Member State cannot oppose that presence? ANSWER OF THE CJ: Since the import duties having been paid for the goods at issue in the main proceedings and those having been released for free circulation, those goods have been imported within the meaning of Article 5(3)(c) (para. 35). The proprietor of the trade mark is not in any way obliged to wait for the release for consumption of the goods covered by its trade mark to exercise its exclusive right. It can also oppose certain acts committed without its consent, before that release for consumption, such as the import of the goods concerned and their storage for the purpose of putting them on the market (para. 38). The terms 'using' and 'in the course of trade' do not refer only to immediate relationships between a trader and a consumer (para. 40). There is use of a sign identical to the trade mark, within the meaning of Article 5 TMD, where the economic operator concerned uses the sign in its own commercial communications (para. 41). The use is made in the course of trade where it occurs in the context of commercial activity with a view to economic advantage and not as a private matter (para. 43). That is the case where an economic operator active in the parallel trade of trade-marked goods, imports and stores such goods. By contrast, provision of a warehouse service for goods bearing another's trade mark does not constitute use of a sign identical to that trade mark for goods or services identical or similar to those in respect of which the mark is registered (paras 44-45). Any act by a third party preventing the proprietor of a registered trade mark in one or more Member States from exercising his or her right to control the first placing of the goods bearing that mark on the market in the EEA, by its very nature undermines the essential function of the trade mark. The importation of products without the consent of the proprietor of the trade mark concerned and the holding of those products in a tax warehouse before their release for consumption in the EU has such effect. Such acts also adversely affect the function of the trade mark of identifying the undertaking from which the products originate and under whose control the initial placing on the market is organised. That is not invalidated by the fact that goods imported and placed under the duty suspension arrangement can subsequently be exported to a third State and thus never be released for consumption in a Member State (paras 48-49). THE CJ THUS RULED: Article 5 TMD must be interpreted as meaning that the proprietor of a trade mark registered in one or more Member States may oppose a third party placing goods bearing that trade mark under the duty suspension arrangement after they have been introduced into the EEA and released for free circulation without the consent of that proprietor.



◆ [T-544/14](#); **ALETE / ALETA**, Judgment of 12 November 2015, *Société des produits Nestlé SA v OHIM – DE*. The CTM applicant sought to register the word mark ‘ALETE’ for products in Classes 5, 29, 30 and 32. The OD upheld the opposition. The applicant appealed the decision and asked for a suspension of the proceedings invoking parallel revocation proceedings. The BoA did not suspend the proceedings and dismissed the appeal. The CTM applicant filed an application before the GC for the alteration of the decision of the BoA or, in the alternative, to annul the contested decision. The fact that the genuine use of the earlier mark for a medicine for the treatment of Parkinson’s disease is uncontested by the CTM applicant in the parallel revocation proceedings does not prove genuine use of the earlier mark for the remainder of the products covered by the earlier mark and, therefore, does not constitute a factor justifying the refusal to stay the proceedings before the Office (paras 29-33). The BoA failed to consider several relevant elements of the case: 1) The CTM applicant claimed that it did some research on the use of the earlier mark and that the only use it could find was for a medicine for the treatment of Parkinson’s disease (para. 36). 2) The CTM applicant put forward that the opponent was not using its mark in a significant way and that a search for the word ‘aleta’ on the opponent’s website did not show any result. Even if such arguments were developed by the CTM applicant in order to rebut the enhanced distinctiveness acquired through use of the earlier mark, the opponent did not challenge them (para. 37). 3) When a request for the suspension of proceedings has been filed before the opponent could defend itself in the revocation proceedings, it is, by definition, hard for the CTM applicant to establish a negative fact such as the lack of genuine use (para. 38). It follows that the BoA committed an obvious mistake when it refused to stay the proceedings (para. 40). The contested decision is therefore annulled without it being necessary to rule on the other pleas (paras 45-47).



II. Absolute Grounds for Refusal/Invalidity

A. Articles 7(1)(a) and 52(1)(a) CTMR — signs of which a CTM may consist

[no entry]

B. Articles 7(1)(b), (c) and (d) and 52(1)(a) CTMR — non-distinctive, descriptive, customary

I. *Non-distinctive*

[T-609/13](#): **SO WHAT DO I DO WITH MY MONEY**, Judgment of 29 January, *Blackrock, Inc. v OHIM* 2015 – EN. The examiner refused registration of the word mark ‘SO WHAT DO I DO WITH MY MONEY’ for services in Classes 35 and 36, namely investment advice and business and market research, on the basis of Article 7(1)(b) and Article 7(2) CTMR. The BoA dismissed the appeal. The relevant public consists of both English-speaking average consumers and professionals, such as commercial undertakings that are active in the fields of finance and investment. Their level of attention may be relatively low when it comes to promotional indications. The word mark applied for can be easily understood by the relevant public. It conveys a clear and unequivocal message that is immediately apparent and does not require any interpretative effort on the part of an English-speaking consumer. The BoA did not err in finding that it raises a general concern that the consumer should reflect on his or her financial situation and it merely raises a general demand for the services applied for on the part of the relevant public. According to the GC, the expression ‘SO WHAT DO I DO WITH MY MONEY’ is unequivocal and does not have any particular semantic depth that would prevent the relevant public from making a direct link with the services covered. Furthermore, the fact that there might be many answers, or even no answer, to that question has no bearing on the consumer’s understanding of it. Finally, the GC confirms that the BoA correctly applied the case law, namely the *Vorsprung durch Technik* judgment.

[T-11/14](#): **PIANISSIMO**, Judgment of 21 January 2015 *Grundig Multimedia AG v OHIM* – EN. The applicant sought to register the word mark ‘Pianissimo’ as a CTM for goods within Class 7. The examiner refused to register the word as a CTM on the ground that it lacked distinctive character according to Article 7(1)(b) CTMR. The BoA dismissed the applicant’s appeal. The GC dismissed the appeal. It found that the sign lacked distinctive character for the goods applied for in Class 7. The GC underlined that in the light of the characteristics of the products designated by the trade mark applied for that are included in Class 7, namely machines or apparatus, the use of which is associated with noise, the word ‘pianissimo’, in its meaning of ‘extremely silent’ or referring to a very low sound volume for the Italian-speaking public, will be perceived by the relevant public as a promotional formula indicating that those products function silently (para. 24). As a result the GC found that the BoA was correct to hold, in the light of that meaning of the word ‘pianissimo’ that the sign at issue will not be immediately perceived by the relevant public as an indication of the commercial origin of the goods referred to, but as the description of one of their characteristics (para. 26). It also recalled that a word sign must be refused registration, under Article 7(1)(b) CTMR, where, according to at least one of its possible meanings, it designates a characteristic of the products or services concerned (para. 27). As a result, the fact that the word ‘pianissimo’ also means ‘very slowly’, a meaning which the BoA did not take into consideration, is of no



benefit to the applicant (para. 28). As regards the principle of equal treatment and good administration, the GC held that those principles needed to be reconciled with respect for legality (para. 38). This means that examination must be undertaken in each individual case. In this case, the BoA undertook the full and specific examination of the trade mark applied for before refusing to register it (paras 38-40). And finally, the GC rejected the argument of the applicant, that 'pianissimo' will be for the vast majority of the European public associated with classical music and will have at least a certain degree of distinctive character (para. 41). The GC underlined that the CTM has a unitary character and that therefore it must have distinctive character throughout the European Union. According to Article 7(2) CTMR, it is sufficient that the signs do not have distinctive character in a part of the EU, which may be comprised of a single Member State, in order to be refused (para. 42).

[T-59/14](#), **INVESTING FOR A NEW WORLD**, Judgment of 29 January 2015, *Blackrock, Inc., v OHIM* – EN. The applicant sought to register the word mark 'INVESTING FOR A NEW WORLD' as a CTM for services in Classes 35 and 36. The examiner refused the application on the ground that it lacked distinctive character according to Article 7(1)(b) CTMR. The BoA dismissed the applicant's appeal. The GC dismissed the appeal. The GC confirmed the finding that the relevant public consists of both average consumers and professionals that understand English. The GC found, however, that the BoA's finding that the level of attention of the relevant public was relatively high because what were involved were financial services was incorrect. The attention of the public may be relatively low when it comes to promotional indications, whether what is involved are average end consumers even if, as in the present case, the services concerned are financial and monetary services (para. 27). Nevertheless, since the BoA based its analysis on the premise that the level of attention of the relevant public was relatively high, its findings as regards the lack of distinctive character of the mark applied for could not have been different if it had taken the view that the level of attention of that public was relatively low (para. 28). As correctly stated by the BoA, 'a new world' refers to an area of human activity or understanding. It is true that, in the definition of the latter expression, the BoA did not refer expressly to the adjective 'new' — which, as the Office states, means 'recently created or having started to exist recently', but that is irrelevant as it is an adjective, the meaning of which is well known and unequivocal. The GC confirmed that the word mark 'INVESTING FOR A NEW WORLD', considered as a whole, may be easily understood by the relevant public, in view of the common English words of which it consists, as meaning that the services offered are intended for a new world's needs (para. 32). Therefore, the BoA was right to find that the message conveyed by the expression at issue was that, when purchasing the services in question, the money or capital invested creates an opportunity in a new world, which carries a positive connotation. The mark applied for thus constitutes a banal expression which the relevant public will not need to analyse for it to be understood (paras 32-33). The BoA was therefore right in finding that the sign at issue was devoid of any distinctive character within the meaning of Article 7(1)(b) CTMR. The fact that the expression at issue may be interpreted in a number of ways does not alter the laudatory nature of that expression. In that regard, the applicant submits in particular, that the expression 'a new world' may evoke a 'more difficult world', namely one in which, for example, financial hazards and risks are greater. The fact remains, as the Office observes, that all those possible meanings put forward by the applicant still denote positive connotations of the sign applied for in relation to the services at issue (paras 39-40). The BoA's reading of the judgment *Audi v OHIM*, C-398/08 P, *VORSPRUNG DURCH TECHNIK*, must moreover be confirmed. Contrary to the applicant's opinion, inasmuch as the sign was a widely known slogan that had been used by Audi for many years, it could not be excluded that the fact that members of the relevant public were used to establishing the link between that slogan and the motor vehicles manufactured by the



company also made it easier for that public to identify the commercial origin of the goods or services covered (paragraph 59 of the judgment). Furthermore, the mark *VORSPRUNG DURCH TECHNIK* had a distinctive character, since it could constitute a play on words or be perceived as imaginative, surprising and unexpected, unlike the mark applied for (paras 50-52).

[T-499/13](#); **SMARTER SCHEDULING**, Judgment of 5 February 2015, *nMetric LLC v OHIM* – EN. The applicant applied for an IR designating the European Union (EU for the word mark ‘SMARTER SCHEDULING’ for goods within Class 9. The examiner refused to register the word mark as an IR designating the EU on the ground that the trade mark was devoid of distinctive character. The BoA dismissed the IR holder’s appeal. The IR holder filed an action before the GC. The GC recalls that there is a measure of overlap between the scope of Article 7(1)(b) and the scope of Article 7(1)(c) CTMR, Article 7(1)(b) nevertheless being distinguished from Article 7(1)(c) CTMR in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings (para. 23). The BoA was correct in its finding that the trade mark applied for simply informed the relevant public that the software covered by that mark assisted with scheduling, in which planning, coordination, and execution may be considered essential steps, in a more intelligent manner than other systems (para. 33). Moreover, the applicant’s website clearly indicates — through the use of expressions such as ‘schedule more effectively and more realistically’ or ‘schedule faster and more easily’, which give direct information on the nature of the goods concerned — that one of the main characteristics of the software covered by the trade mark applied for is to make the job of scheduling easier (para. 34). The fact that the term ‘smarter scheduling’ may possibly be associated with other goods or services of other brands is ineffective (paras 35-36). In the case of a trade mark composed of a number of word elements, distinctiveness may, in part, be examined in relation to each of those terms or elements, considered separately, but must in any event depend on an appraisal of the whole that those terms or elements go to make up (para. 40). A word mark consisting of an advertising slogan cannot be required to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness required under Article 7(1)(b) CTMR. However, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan is distinctive, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character. The GC thus confirms the BoA’s finding that the term ‘smarter scheduling’ contains no fanciful element which, beyond its obvious promotional meaning, could enable the relevant public to memorise it easily and instantly as a distinctive mark for the goods concerned (paras 43-45).

◆◆[T-377/13](#); **Ultra.air ultrafilter**, Judgment of 9 March 2015, *ultra air GmbH v OHIM* – DE. The applicant registered the word mark ‘Ultra.air ultrafilter’ as a CTM for goods and services within Classes 7, 9, 11, 37 and 42. An application for invalidity was filed based on the grounds of Article 7(1)(b) and (c) CTMR. The CD dismissed the invalidity application. The BoA annulled the decision of the CD, finding that the term ‘ultrafilter’ is descriptive of all the goods and services covered by the contested mark. In addition, ‘ultra.air’ is understood to mean a superior air, so that these terms are seen as praise for quality filtration products covered by the contested mark and for the other products covered by the same mark that may be part of an air filtration system. The services in Classes 37 and 42 set out above (para. 2) may also cover air production facilities. The juxtaposition of two descriptive elements composing the contested mark was descriptive of an equally high quality air achieved through an ‘ultrafilter’ and the distinctiveness



of the mark at issue also causes the lack of distinctive character. The applicant filed an action before the GC. The relevant public consists of English-speaking professionals from the filtration sector (para. 17). The GC confirmed that the element 'ultra.air' will be perceived by the relevant public as referring to air of an excellent quality. Followed by the word 'ultrafilter', the terms used will be perceived as meaning 'air of excellent quality achieved through an ultrafilter' (para. 18). Even though the word 'air' does not evoke a quality or condition as an adjective would do, the words 'ultra' and 'air' are together perceived as an abbreviated version of a phrase, such as 'ultra pure air', the understanding of which is not changed by inserting the dot between the two words. Furthermore, this understanding becomes more likely because the relevant public consists of professionals in the filtration sector. Moreover, the existence of 'ultrafilter' demonstrates that the association between ultra and a noun is not excluded (para. 19). In this context, it is irrelevant whether the BoA made an accurate translation of the definition of 'ultra' into German, since the conclusions of understanding of this word by the English-speaking public are not affected by the accuracy of the translation of the definition (para. 21). It is thus clear that the mark described the quality, as well as the destination of filters and its parts, filtration media, apparatus and installations for filtering liquids, gas and air and apparatus and installations for evacuating and processing condensate from the drying and filtering of gases and air (para. 21). The BoA also did not err when referring to the compressors in general in relation to compressors for cooling installations and parts therefor (para. 23). The GC confirmed BOA's assessment as regards all goods and services, with the exception of 'time control systems', and the contested decision was partly annulled in respect of the 'time control systems' (para. 42).

[T-654/13](#); **SHAPE OF A CYLINDRICAL CONTAINER (3D MARK)**, Judgment of 16 June 2015, *Gako Konietzko GmbH v OHIM* – DE.



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



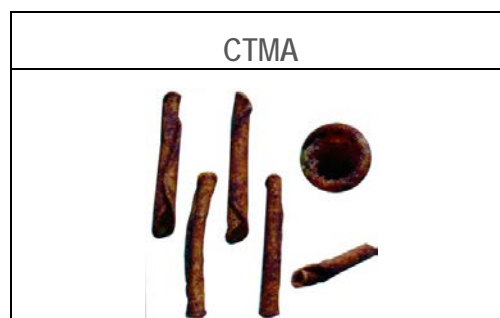
CTMR and of the principle of equal treatment. The GC emphasised at the outset that the criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks (para. 20). However, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a 3D mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products in Classes 3 or 5 on the basis of their shape or the shape of their packaging in the absence of any graphic or word element (paras 23-25). Cylindrical shapes with a lid are common for products of beauty care. The fluting around the lid is merely a common technical feature to facilitate its opening (para. 28). The only feature of the sign which departs from the usual form is the additional smaller lid on top of the main lid. Even if this feature was to be considered uncommon, it would not be sufficient in itself to convey an overall impression significantly departing from the norm in the sector. The 'double lid' is merely a variant of a common feature of containers for creams and liquids prepared in pharmacies (para. 30). It is immaterial in this regard whether the 'double lid' conveys a new, innovative concept. What matters is whether the mark as applied for is distinctive or not (para. 32). Furthermore, the colour combination red/white is not uncommon in the medical/cosmetic sector, where white symbolises hygiene and red symbolises warnings (para. 31). From the fact that the relevant public, which partly consists of highly attentive specialists with regard to goods from the medical sector (pharmacies), it cannot be inferred that this high attentiveness also expands to the packaging of the goods at stake. The public — even the highly attentive one — will generally focus on the label rather than on the form/packaging, when confronted in particular with liquids, which cannot be sold without packaging (para. 34). Finally, it has not been proved by the applicant that the public in the medical sector (as in the sector of washing/cleaning preparations or drinks) has become accustomed to recognising the form of the goods as an indicator of origin (para. 37). With regard to the prior national (Polish and German) registrations of the same mark and the claimed violation of the principle of equal treatment, the GC notes that the BoA is not bound by national decisions, as the CTM system is autonomous and independent from national jurisdictions (para. 46). Based on the foregoing, the action was dismissed.

◆ [T-319/14](#); **RAUSCHBRILLE**, Judgment of 16 April 2015, *Drogenhilfe Köln Projekt gGmbH v OHIM* – DE. The applicant sought to register the word mark 'Rauschbrille' as a CTM for goods and services within Classes 9, 41 and 44. The examiner refused to register the word as a CTM on the grounds of Article 7(1)(b) and (c) CTMR. The BoA dismissed the applicant's appeal. As regards Article 7(1)(c) CTMR, it found that the term 'Rauschbrille' would be understood by the relevant public as 'glasses simulating alcohol intoxication' or 'glasses protecting from alcohol intoxication' and would not be perceived as more than a sum of its elements. Thus, the sign was found descriptive of glasses in Class 9. As regards Article 7(1)(b) CTMR, the BoA found that these glasses, which recreate intoxication or give their holders a feeling of artificial intoxication, could easily designate cultural events concerning a theme of drugs (Class 41) and could convey the idea of medical and psychological treatment to simulate intoxication during 'aversion therapy' (Class 44). Therefore, the BoA found that the sign lacked distinctive character under Article 7(1)(b) CTMR. The applicant filed an action before the GC. As regards the lack of distinctive character of the sign under Article 7(1)(b) CTMR, average German-speaking consumers easily perceive the meaning of 'Rauschbrille'. So they will understand immediately, when confronted with services from Class 41, that 'intoxication glasses' are used as an empirical tool in classes on the prevention of alcoholism and drug addiction, or as a more complex tool in the scope of sport games. The



sign could also easily refer to cultural events with a drugs theme (para. 34). As for Class 44, from the point of view of the relevant public, the use of 'Rauschbrille' in the scope of a medical and psychological treatment was conveying the idea that intoxication glasses were used to simulate intoxication during 'aversion therapy' (para. 35). Considering the above, the GC concludes that the sign applied for is not able to guarantee the identity of origin of the services at issue (para. 36). The GC adds that the argument of the applicant concerning Article 12 CTMR cannot be accepted. This provision concerns only signs already registered and cannot modify the conditions of registration under Article 7(1)(b) CTMR (para. 37).

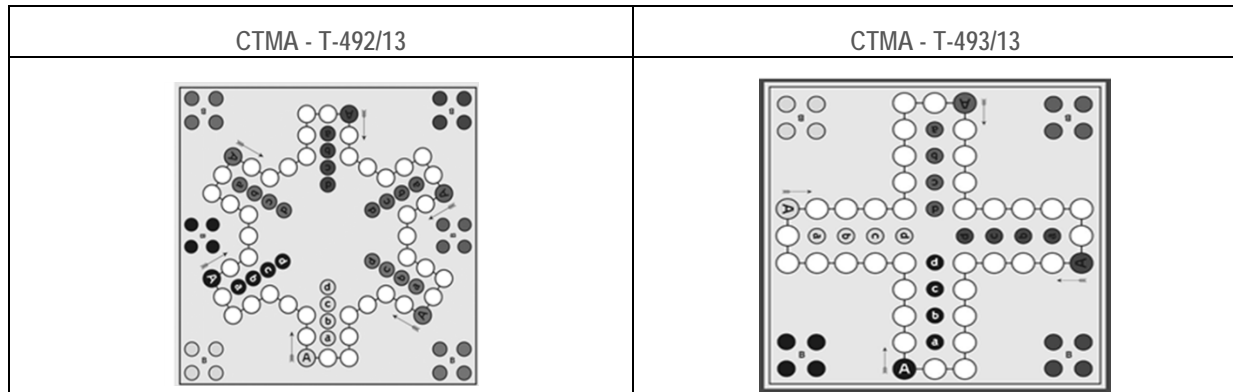
[T-618/14](#); **SHAPE OF A MEXICAN TORTILLA (3D MARK)**, Judgment of 29 June 2015, *Grupo Bimbo, S.A.B. de C.V. v OHIM* – ES.



The applicant sought to register the 3D mark represented above as a CTM for goods in Class 30, namely 'corn fritter snacks or tortilla chips, extruded corn'. The examiner refused to register the application in its entirety, on the basis of Article 7(1)(b) CTMR. The BoA dismissed the applicant's appeal. It found that the CTMA represents a basic geometrical form that does not differ substantially from others in widespread use in the snack sector. The possible differences between this form and a simple, ordinary cylinder are not easily perceptible and will not enable the relevant public to recognise said form at the time of a subsequent purchase. Since these appreciations are based on well-known facts, it is for the applicant to show that consumer's habits in the relevant market are different. The applicant filed an action before the GC claiming a violation of Article 7(1)(b) CTMR. The GC confirmed the findings of the BoA as to the nature of the goods at issue (food products for everyday consumption) and the relevant public (average consumer) (paras 16-17). It recalled the case law regarding the distinctive character of 3D marks consisting of the shape of the goods at issue, concluding that in such cases, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character. Inversely, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) CTMR (paras 24-26). The BoA concluded that the CTMA at issue did not depart significantly from other forms commonly used for snacks and that it is usual to find in any supermarket snacks in various similar forms. This conclusion was based on well-known facts and, as such, there was no need for the Office to submit evidence to support it. It was for the applicant, to the extent it challenged this finding based on well-known facts and invoked the distinctive character of the CTMA, to submit proof in this regard (paras 30-32). The evidence submitted by the applicant (two examples of other types of cylindrical snacks) is not sufficient to prove that the differences between their shape and that of the CTMA are substantial enough to make consumers perceive the latter as the trade mark of a specific manufacturer (para. 38).



◆◆[T-492/13 and T-493/13](#); **DEVICES OF BOARD GAMES**, Judgment of 3 March 2015, *Schmidt Spiele GmbH v OHIM – DE*.



The applicant sought to register the figurative signs as depicted above for goods and services in Classes 9, 16, 28 and 41. The examiner rejected the trade marks applied for as being devoid of any distinctive character (Article 7(1)(b) CTMR). The BoA dismissed the appeals. The signs applied for would represent a depiction of the board of a game and consequently represent the outer appearance of the goods. The alleged acquired distinctiveness according to Article 7(3) CTMR has not been shown. INFRINGEMENT OF ARTICLE 7(1)(b) CTMR: The GC stated that the applicant's opinion that the signs would not represent the depiction of the board of a game is to be refused. The present signs do actually contain all the elements of the well-known game called *Mensch, Ärgere Dich nicht* or a variant thereof, which in particular in the centre of Europe enjoys great popularity (paras 19-21). The consequence is that with respect to the goods in Class 28 that refer to games the signs applied for cannot indicate their origin because they merely indicate their subject matter (para. 37). However, the GC reminded that global reasoning is only possible when the goods and or services have a sufficient connection between each other. In the case in question, the contested decision extended the reasoning applicable to games to neighbouring goods and services, which is legitimate. However, if the link with games becomes very weak, additional reasoning would have been necessary in order to reason the decisions sufficiently (para. 41). The GC therefore specified the goods and services for which the reasoning of the BoA was sufficient and concluded that for the remaining goods and services the decisions are not well reasoned (paras 44-54).

[T-216/14](#); **EXTRA**, Judgment of 28 April 2015, *Volkswagen AG v OHIM – DE*. The applicant sought the registration of the word 'EXTRA' (word) for goods and services in Classes 12, 28, 35 and 37. The first instance refused the application as being devoid of distinctive character (Article 7(1)(b) CTMR). The BoA upheld that decision. The GC states that the relevant public is partly the general public and partly a more sophisticated public. However, even a highly attentive public is normally, when confronted with a slogan as in the case concerned, less attentive (para. 20). The GC further confirms the BoA that the meaning of the sign applied for will be immediately understood as 'addition', 'special' 'extraordinary', so that it conveys a direct indication as to the high quality of the goods and services. The expression is often used in advertising (para. 22). The GC refers to the case law that the expression 'extra' without being precise just denotes a high quality (see T-81/13, 'BigXtra', para. 23). The GC therefore rejects the applicant's



argument that the term does not give a clear idea about any characteristic of the goods or services (paras 27 and 28). Finally, the refusal does not infringe the principle of equal treatment or sound administration. Earlier decisions are not binding and the contested decision gives sufficient reasons for the refusal and is in line with the applicable law (paras 30-33). Consequently, the applied for sign is devoid of distinctive character and may therefore not indicate the origin of the goods or services.

[T-431/14](#); **CHOICE**, Judgment of 22 October 2015, *Volkswagen AG v OHIM* – DE. The applicant sought to register the word mark 'CHOICE' as a CTM for goods and services in Classes 12, 28, 35 and 37. The examiner refused the application in its entirety, based on Article 7(1)(b) and (c) CTMR. The BoA dismissed the appeal on account of Article 7(1)(b) CTMR and stated that the CTMA lacked distinctiveness due to its laudatory character. The CTM applicant filed an action before the GC, claiming a violation of Article 7(1)(b) CTMR. The GC confirmed that the goods and services in question target general consumers as well as a specialised public. Despite the fact that a specialised public generally has a higher degree of attention, the attention can nevertheless be relatively low with regard to promotional statements, if they are not decisive for the specialised public (para. 20). As the sign in question consists of an English word, the meaning is to be determined with regard to the English-speaking public (para. 21). 'CHOICE' can be understood as an adjective ('worthy of being chosen', 'select', 'exquisite', 'of picked quality') or as a noun ('selection', 'preferential determination between things proposed'). The term can either be understood as referring to the superior quality of the products or as indicating that the purchase of these products is a good consumer choice (para. 23). In both understandings, 'CHOICE' is of a laudatory character. It immediately suggests to the consumers that that the products have additional, positive features to the ones usually to be expected from comparable products (paras 28-30). The fact that the CTMA might not be descriptive (Article 7(1)(c) CTMR) is irrelevant, as the BoA based the rejection exclusively on a lack of distinctiveness of the CTMA (Article 7(1)(b) CTMR) (paras 37-38). Based on the foregoing, the action was dismissed.

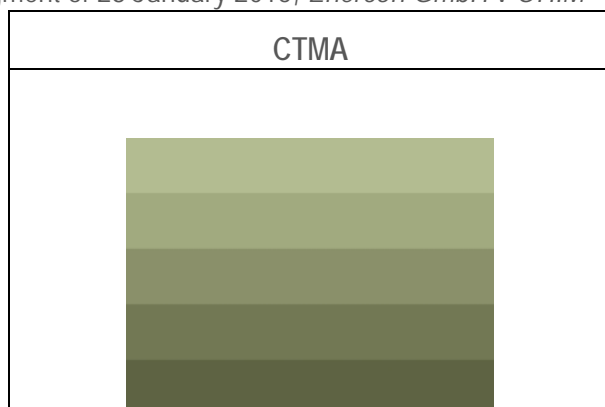
[T-550/14](#); **COMPETITION**, Judgment of 17 September 2015, *Volkswagen AG v OHIM* – DE. The applicant sought to register the word mark 'COMPETITION' as a CTM for goods and services in Classes 12, 28, 35 and 37. The examiner refused the application in its entirety based on Article 7(1)(b) CTMR. The BoA confirmed the examiner's decision. It held that the trade mark denotes a certain category of goods, namely those that can cope with the high demands of a competition as well as services, which prepare vehicles for competitions ('tuning'). Therefore, 'COMPETITION' was deemed non-distinctive for the goods and services at issue. The applicant filed an action before the GC, claiming a violation of Article 7(1)(b) CTMR. At the outset, the GC confirmed that the relevant public consists of specialists (taking part in motor races) as well as the general public interested in vehicles/parts for automotive competitions. 'Competition' is a commonly known, banal English word, which will also be understood in its meaning by the French public (paras 19-20, 24). It obviously denotes goods and services that are suitable for competitions and therefore are of superior quality. It is a laudatory term to underline and emphasise the positive characteristics of the goods and services and their advantages in comparison with other goods and services (para. 24). In connection with the goods in Class 12, 'Competition' merely points out that the vehicles, etc. are apt for competitions, more durable or faster than other vehicles. The meaning of the term is not ambiguous and does not have a semantic depth that would prevent the public from immediately connecting it to the goods and services (paras 25-30). Analogous reasoning applies for the claimed services in Class 37 and 35, which are all directly linked to



the goods in Class 12. In this context, ‘Competition’ directly describes the suitability of the services to prepare vehicles for competitions or the retailing of vehicles apt for competitions. Finally, with regard to ‘toys’, etc. in Class 28, these goods can either be apt for competitions or serve for re-enacting competitions (paras 34-36). The correct findings of the BoA with regard to the non-distinctiveness of the term ‘Competition’ cannot be put into question by the applicant’s argument that the public is used to more or less laudatory trade marks in the automobile sector. This argument is in direct contradiction to the applicant’s claim that ‘Competition’ would not have a laudatory character (para. 39). Finally, the applicant cannot deduct any rights from prior registrations or alleged Office practice, as the BoA is only bound by the law and not by prior Office practice. In any event, each case has to be judged upon its own merits (paras 41-47). Based on the foregoing, the action was dismissed.

[T-385/14](#); **ULTIMATE**, Judgment of 30 September 2015, *Volkswagen AG v OHIM* – DE. The applicant sought to register the word mark ‘ULTIMATE’ as a CTM for goods and services within Classes 12, 28, 35 and 37. The examiner refused to register the word as a CTM pursuant to Article 7(1)(b) and 7(1)(c) CTMR. The BoA confirmed the refusal pursuant to Article 7(1)(b) CTMR. The CTM applicant filed an action before the General Court requesting the registration of the CTM and claiming an infringement of Article 7(1)(b) CTMR. The claim based on Article 7(1)(b) CTMR is ill founded. The CTM applicant does not dispute the laudatory meaning of the word ‘ULTIMATE’ on which the BoA based its decision (paras 14-15). Contrary to the applicant’s argument, the relation between the meaning of the word and the products is not just suggestive or subjective but clear and obvious. The consumers will understand it as an indication of the superior quality of all goods and services of the application (para. 17). There is no reason to assume that — apart from this laudatory meaning — the consumer will perceive the mark as an indication of the commercial origin.

◆ [T-655/13](#); **GREEN**, Judgment of 28 January 2015, *Enercon GmbH v OHIM* – DE.

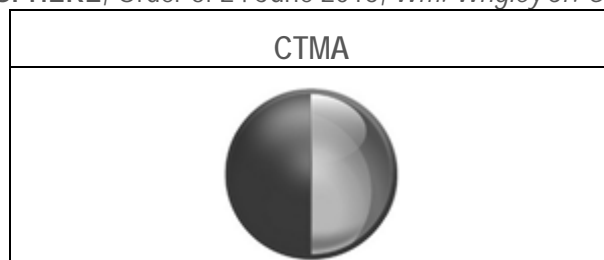


The applicant sought the registration of the above CTM as a colour mark for goods in Classes 7, 16 and 28. The OD held that the mark lacked distinctive character (Article 7(1)(b) CTMR). The BoA upheld that decision. The applicant filed an action before the GC. INFRINGEMENT OF ARTICLE 7(1)(b) CTMR. The GC reiterates the case law that colours *per se* will normally not indicate the origin of goods and services, except for exceptional situations. This might be the case if the colour has acquired distinctiveness through use (Article 7(3) CTMR) (para. 26). The BoA was right in its conclusion that the colour green,



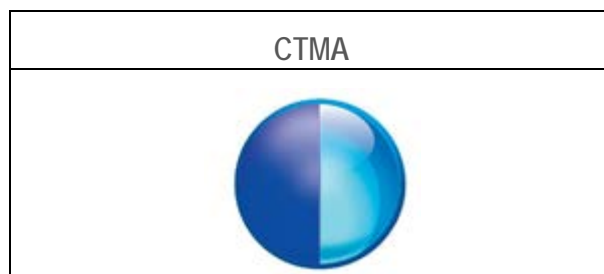
also in variations, is the colour of nature, so that the colour applied for would help to integrate the goods into nature. It serves aesthetic purposes rather than indicating the origin of the goods. The colour green also indicates ecological friendliness as the BoA stated and the degradation of the colour in five equal grades of green is banal and would not render the sign distinctive. The GC confirms that the sign does not contain five different colours but only one in five grades (paras 35-36). Additionally, the GC stresses that goods such as wind energy turbines will not be purchased by the highly attentive specialised public because of the decoration or the outer appearance but rather after a deeper study and clear information of its origin, and dismissed the action.

[T-625/14](#); **DEVICE OF A SPHERE**, Order of 24 June 2015, *Wm. Wrigley Jr. Company v OHIM* – EN.



The CTM applicant sought to register the figurative sign indicated above for goods in Classes 3, 21, 30. The examiner rejected the application for registration in respect of some goods in Classes 3 and 30, namely ‘confectionery, candy, drops and lozenges’. The BoA dismissed the appeal, taking the view that the sign lacked distinctive character for the relevant goods. Before the GC, the CTM applicant alleged infringement of Article 7(1)(b) CTMR. The GC rejected the single plea in law as manifestly unfounded and the whole action as manifestly lacking any foundation in law. First, the GC highlighted that when the sign is affixed to the goods at issue (namely ‘confectionery, candy, drops and lozenges’), it will be perceived as having the appearance of those goods, not the appearance of a ball, shield or logo (para. 22). Secondly, it held that, after finding that the shape of that mark was extremely common for the goods at issue, the BoA correctly concluded that the separation of the mark into two halves by different tones did not make it sufficiently distinctive with regard to the relevant goods (para. 23). Moreover, the GC considered that a sphere or full circle is a banal shape and that there is no originality in the use of different tones (para. 24).

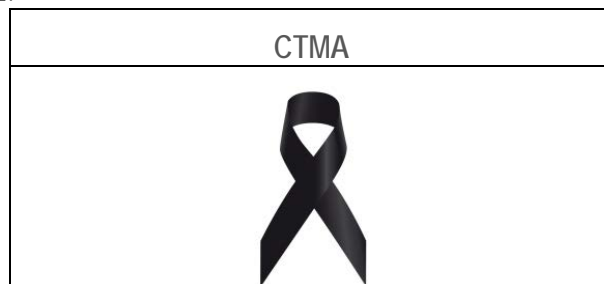
[T-626/14](#); **DEVICE OF A BLUE SPHERE**, Order of 24 June 2015, *Wm. Wrigley Jr. Company v OHIM* – EN.





The CTM applicant sought to register the figurative sign indicated below for goods in Classes 3, 21, 30. The examiner rejected the application for registration in respect of some goods in Classes 3 and 30, namely 'confectionery, candy, drops and lozenges'. The BoA dismissed the appeal, taking the view that the sign lacked distinctive character for the relevant goods. Before the GC, the CTM applicant alleged infringement of Article 7(1)(b) CTMR. The GC rejected the single plea in law as manifestly unfounded and the whole action as manifestly lacking any foundation in law. First, the GC highlighted that when the sign is affixed to the goods at issue (namely 'confectionery, candy, drops and lozenges'), it will be perceived as having the appearance of those goods, not the appearance of a ball, shield or logo (para. 22). Secondly, it held that, after finding that the shape of that mark was extremely common for the goods at issue, the BoA correctly concluded that the separation of the mark into two halves by different tones did not make it sufficiently distinctive with regard to the relevant goods (para. 23). Moreover, the GC considered that a sphere or full circle is a banal shape and that there is no originality in the use of different tones (para. 24).

[T-530/14](#); **DEVICE OF A BLACK RIBBON**, Judgment of 9 September 2015, *Verein Sterbehilfe Deutschland v OHIM* – DE.

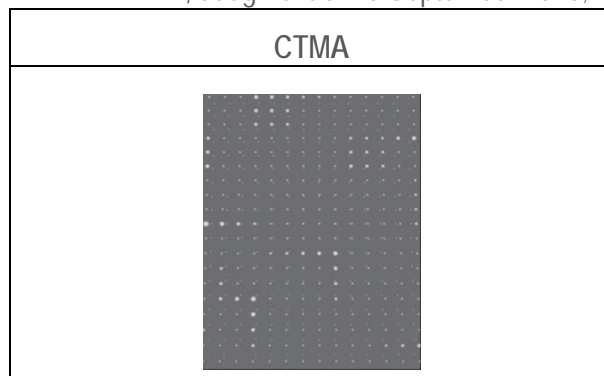


The applicant sought to register the figurative sign displayed above as a CTM for services in Classes 35, 41, 44 and 45 (press services; advertising, publicity/information with regard to death/assisted suicide medical services, etc.). The examiner partially refused the application based on Article 7(1)(b) CTMR. The BoA confirmed the examiner's decision. It held that ribbons such as the present one are frequently used in different colours to indicate affiliation and solidarity with certain groups (e.g. red: AIDS, pink: breast cancer, etc.). Even though the public can differentiate between the different colours, it will not regard such ribbons as denoting a particular commercial origin. Black is known as a typical colour for death and for expressing grief. The black ribbon merely expresses solidarity with the deceased or their relatives. Furthermore, the ribbon does not depart significantly from ribbons commonly used. The applicant filed an action before the GC, claiming a violation of Article 7(1)(b) CTMR. The GC confirmed that the appearance of the ribbon at issue was common and did not depart noticeably from other types of ribbons used in the market. It considered it a well-known fact that ribbons in different colours are commonly used to express solidarity with certain groups of persons (AIDS, breast cancer, etc.) (para. 21). The ribbon at issue will be understood as a symbol of grief and solidarity with the deceased or with persons who have lost a family member/loved one, not as a source of origin (paras 22-23). The services, which all (can) deal with the subject of death in a broader sense, are sufficiently homogeneous to conclude that the ribbon lacks distinctiveness for all the services at issue. In this regard, it would have been for the applicant to indicate for which specific services the mark is allegedly distinctive or which services allegedly do not form part of a homogeneous group (paras 24-25). As far as the applicant claims that the ribbon possesses distinctiveness on account of the (black) colour, which differs from other



colours; it must be noted that colours — despite their ability to evoke feelings and mental connections — are hardly capable of conveying clear-cut information. This is all the more true in light of the fact that colours are widely used in marketing and advertising of goods and services without a clear content (para. 32). All in all, neither the form nor the colour of the ribbon makes it possible to attribute a specific commercial origin to the mark (para. 34). Based on the foregoing, the action was dismissed.

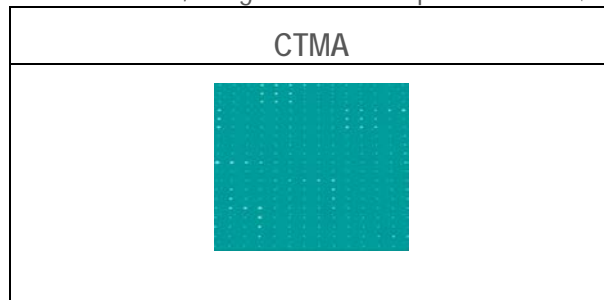
[T-77/14](#); **DEVICE OF A GREY PATTERN**, Judgment of 10 September 2015; *EE Ltd v OHIM* – EN.



The applicant sought to register figurative sign represented above as a CTM for the goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The examiner rejected the application in respect of all goods and services on the grounds of Article 7(1)(b) CTMR. The BoA dismissed the appeal, finding that the sign was inherently devoid of any distinctive character. The CTM applicant filed an appeal before the GC. The CTM applicant claimed infringement of Article 7(1)(b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the BoA. The applicant maintained that the distinctive character of the sign has been proved before the BoA. The action was dismissed in its entirety by the GC. The GC concluded that in cases where each one of the individual features of the mark applied for is devoid of any distinctive character the combination of those features, taken as a whole, is a priori not distinctive in itself. However, the GC ruled that the provision of description of the figurative mark before the GC cannot be considered a new argument and the BoA erred when it dismissed it as inadmissible because providing the description of such mark is not a mandatory requirement (para. 51). According to the judgment, there is no need for each of the goods and services to be assessed and they may be grouped for the purpose of examination and general reasoning may be applied where they form a category or groups sufficiently homogeneous to permit such general reasoning (para. 59). The sign described by the applicant will not be perceived by the relevant consumer as an indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the service of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (paras 63-64). The GC concluded that a high degree of attentiveness with regard to some of the goods and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (para. 70).

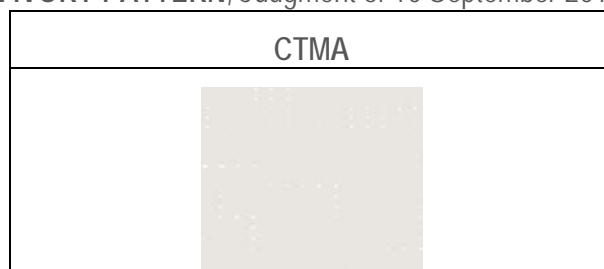


[T-94/14](#); **DEVICE OF A BLUE PATTERN**, Judgment of 10 September 2015; *EE Ltd. v OHIM* – EN.



The applicant sought to register the figurative mark represented above for goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The examiner's decision, rejecting the application for registration in its entirety based on Article 70(1)(b) CTMR, was confirmed by the BoA. The applicant filed an action before the GC. The CTM applicant claimed infringement of Article 7(1)(b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the BoA. The applicant maintained that the distinctive character of the sign has been proven before the BoA. The action was dismissed in its entirety by the GC. The GC pointed out that where a sign is composed of a number of features, each one of which is devoid of distinctive character, the distinctive character of the sign as a whole depends on whether the overall impression is greater than the mere sum of its parts (para. 34). The BoA was correct in finding that the contested sign does not denote a connection with a specific undertaking since it is a mere banal combination of two non-distinctive and barely memorable or noticeable features (para. 46). However, the GC ruled that the provision of a description of the figurative mark before the GC cannot be considered a new argument. The description of such mark is not a mandatory requirement (paras 52-53). According to the judgment, there is no need for each of the goods and services to be assessed and they may be grouped for the purpose of the examination and general reasoning may be applied where they form a category or groups sufficiently homogeneous to permit such general reasoning (para. 59). The sign described by the applicant will not be perceived by the relevant consumer as an indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the service of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (para. 63). The GC concluded that high degree of attentiveness with regard to some of the goods and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (para. 69).

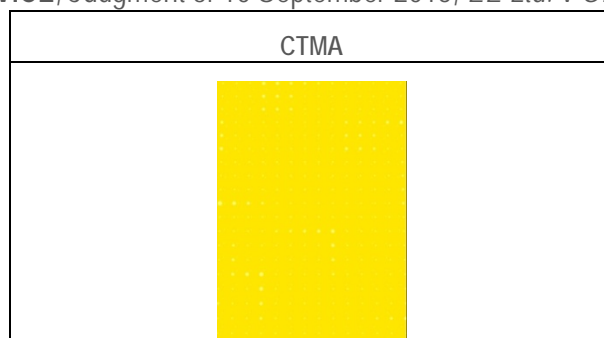
[T-144/14](#); **DEVICE OF AN IVORY PATTERN**, Judgment of 10 September 2015, *EE Ltd. v OHIM* – EN.





The applicant sought to register the figurative mark represented above for goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The examiner's decision, rejecting the application for registration in its entirety based on Article 7(1)(b) CTMR, was confirmed by the BoA. The applicant filed an action before the GC. The CTM applicant claimed infringement of Article 7(1)(b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the BoA. The applicant maintained that the distinctive character of the sign has been proven before the BoA. The action was dismissed in its entirety by the GC. The GC pointed out that where a sign is composed of a number of features, each one of which is devoid of distinctive character, the distinctive character of the sign as a whole depends on whether the overall impression is greater than the mere sum of its parts (para. 34). The BoA was correct in finding that the contested sign does not denote a connection with a specific undertaking since it is a mere banal combination of two non-distinctive and barely memorable or noticeable features (para. 46). However, the GC ruled that the provision of description of the figurative mark before the GC cannot be considered a new argument. The description of such mark is not a mandatory requirement (paras 52, 53). According to the judgment, there is no need for each of the goods and services to be assessed and they may be grouped for the purpose of the examination and general reasoning may be applied where they form a category or groups sufficiently homogeneous to permit such general reasoning (para. 59). The sign described by the applicant will not be perceived by the relevant consumer as an indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the service of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (para. 63). The GC concluded that a high degree of attentiveness with regard to some of the goods and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (para. 69).

◆ [T-143/14](#); **YELLOW DEVICE**, Judgment of 10 September 2015, *EE Ltd. v OHIM* – EN.



The applicant sought to register the figurative mark for goods and services in Classes 7, 9, 16, 25, 35 to 39, 41, 42 and 45. The examiner's decision, rejecting the application for registration in its entirety based on Article 7(1)(b) CTMR, was confirmed by the BoA. The applicant filed an action before the GC. The CTM applicant claimed infringement of Article 7(1)(b) CTMR in consequence of failure to assess the sign as a whole and non-consideration of each of the goods and services individually by the BoA. The applicant maintained that the distinctive character of the sign has been proven before the BoA. The action was dismissed in its entirety by the GC. The GC pointed out that where a sign is composed of a number of features, each one of which is devoid of distinctive character, the distinctive character of the sign as a whole depends on whether the overall impression is greater than the mere sum of its parts

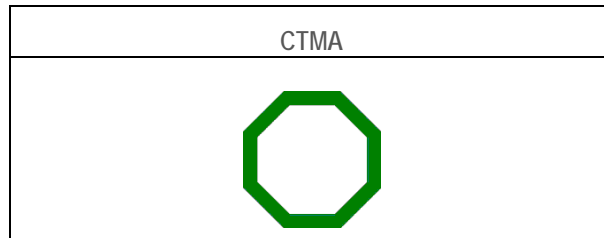


(para. 34). The BoA was correct in finding that the contested sign does not denote a connection with a specific undertaking since it is a mere banal combination of two non-distinctive and barely memorable or noticeable features (para. 46). However, the GC ruled that the provision of description of the figurative mark before the GC cannot be considered a new argument. The description of such mark is not a mandatory requirement and the BoA erred when it dismissed it as inadmissible (paras 52 and 53). According to the judgment, there is no need for each of the goods and services to be assessed and they may be grouped for the purpose of the examination and general reasoning may be applied where they form a category or groups sufficiently homogeneous to permit such general reasoning (para. 60). The sign described by the applicant will not be perceived by the relevant consumer as an indication of origin. In this sense, the GC mentioned the importance of the ability of a sign to distinguish the services of one undertaking from those of other undertakings rather than its ability to be associated with a particular service (para. 64). The GC concluded that high degree of attentiveness with regard to some of the goods and services of the relevant public does not alter the fact that the colour possesses little inherent capacity for communicating specific information (para. 72).

[T-366/14](#); **2GOOD**, Judgment of 25 September 2015, *August Storck KG v OHIM* – EN. The IR holder sought to register the word mark '2GOOD' as an IR designating the EU for goods within Class 30. The examiner refused to register the EU designation on the ground that the mark would be perceived as a laudatory promotional message. The BoA dismissed the IR holders' appeal. The IR holder filed an action before the GC. The relevant public is deemed to be the average consumer who is reasonably well informed and reasonably observant and circumspect, whose level of attention is somewhat reduced (para. 20). It may reasonably be presumed, having regard, in particular, to the very widespread use of the language known as 'SMS language' that the number 2, if it is associated with an English word, will itself generally be read in English and understood as referring to the English words 'two', 'too' or 'to' depending on which English word follows it or precedes it (para. 28). The number 2, combined with the word 'good', will be easily and immediately understood by the relevant public as meaning 'too', as that public will think of the meaning of the expression 'too good' in relation to the goods covered (see paras 24-26). Combining the word 'too', symbolised by the number 2, with another word such as 'good' is not unusual or even rare in current linguistic usage (para. 27). It follows that the mark sought does not have any particular originality or salience; nor does it require a minimum interpretative effort or trigger any particular cognitive process on the part of the relevant public; rather, it is merely an ordinary advertising slogan making the point that the goods covered by the mark sought are excellent (too good) (para. 30). Even if the mark sought is not regarded as an advertising slogan, it merely describes an essential feature of the goods in question: their gustatory qualities (para. 34). The relevant public in the present case will not be confronted with a slogan that can have a number of meanings, or constitute a play on words, or be perceived as imaginative, surprising and unexpected, but simply a statement relating to an allegedly highly positive gustatory quality of the goods covered by the mark sought (para. 35). Since the examination of the trade mark at issue in the light of Article 7(1)(b) CTMR could not, in itself, lead to a different conclusion, the applicant's claims of a failure to take into consideration the registration of identical marks cannot succeed (para. 41). The BoA is not bound by registrations already made in an EU Member State. The same holds true for previous registrations in other English-speaking countries that are not EU Member States (para. 42).



◆ [T-209/14](#); **DEVICE OF A GREEN OCTAGON**, Judgment of 25 September 2015, *Carsten Bopp v OHIM* – DE.



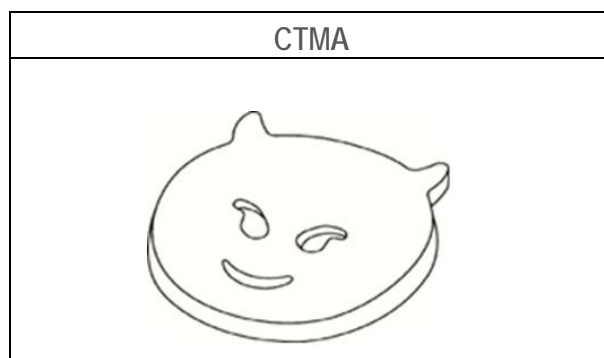
The applicant sought to register a green octagon, namely the figurative sign represented above for the services ‘advertising and public relations in the form of customer information through labelling of the properties of goods and services’ in Class 35. The examiner refused to register the application under Article 7(1)(b) CTMR. The BoA in its first decision (R 605/2010-4) dismissed the appeal, holding that the application lacks distinctiveness for all services in Class 35 regardless of the services concerned, which the applicant did not determine with sufficient clarity. The GC set the decision aside (T-263/11), reasoning that the BoA infringed the principle according to which the distinctiveness of a sign must be assessed with regard to the specific goods and services. The BoA in its second decision (R 1276/2013-1) dismissed the appeal, as the octagon is a simple geometrical shape in green, a commonly used signal colour, with respect to the services in question. The GC dismissed the appeal. The services are directed at professionals taking decisions on their marketing activities relevant for their success. They will thus select the services with a high level of attention, on average (paras 47-48). It is therefore irrelevant whether the consumers of the goods and services marked are acquainted with the sign in question as a seal of quality (para. 50). Green is a common colour and is not suitable to endow the octagon with distinctive character. The octagon is a simple geometrical shape like a pentagon, a rectangle, a triangle or a circle. An octagonal frame does not draw more attention than a simple octagon. The same applies with regard to the fact that the octagon’s inner part is not coloured and contains no figurative element. This would only attract the public’s attention if the sign were placed against different backgrounds. However, such considerations concerning the sign’s actual use cannot be relevant for the assessment in question (paras 53-56). The sign will be perceived as a decorative element, a seal or a label (para. 59).

[T-642/14](#); **EQUIPMENT FOR LIFE**, Judgment of 7 October 2015, *JP Diver Holding Company Ltd v OHIM* – EN. The IR holder sought to register the word mark ‘EQUIPMENT FOR LIFE’, an IR designating the EU for goods and services in Classes 18, 25 and 35. The examiner’s decision, rejecting the application for registration in its entirety based on Article 7(1)(b) and Article 7(2) CTMR, was confirmed by the BoA. The IR holder filed an action before the GC alleging an infringement of Article 7(1)(b) and Article 7(2) CTMR. The GC confirmed the BoA’s decision and dismissed the appeal. The GC pointed out that the word ‘equipment’, irrespective of the specific intended purpose of each of the goods or services covered by the mark applied for, is, because of its meaning, immediately perceptible by the relevant public as relating to all of the elements required for the exercise of an activity (para. 30). The GC found that the word ‘equipment’ is also associated with clothing in Class 25 and is not limited to designating only goods with a technical background or function (para. 32). The meaning of the word ‘equipment’ is broader than the definition given by the applicant and that that word is often used in very varied market sectors in order to designate a group or a set of things necessary to achieve a certain aim. It should be observed, in that regard, that the Office gave examples of those sectors, including travel (travel



equipment) and sport (fitness equipment, scuba-diving equipment). The same is true of the goods concerned in Class 18: by way of example, the expression ‘travel equipment’ is commonly used to describe backpacks, travel bags and luggage (para. 33). The GC confirmed that the expression ‘equipment for life’ will be understood, in relation to the relevant goods, as meaning that those goods will last for the lifetime of the purchaser. Thus, that expression suggests, when applied to the goods concerned, that these are very robust, long-lasting, and they can be made to last a long time. It will thus be perceived as an unambiguous laudatory message suggesting positive characteristics of the goods and services. Moreover, the applicant’s argument that that reasoning does not make sense because the goods concerned are regularly replaced by newer, more fashionable items cannot be accepted. The fact that consumers may replace their clothing in order to follow fashion trends does not affect the message about the durability of the goods concerned clearly conveyed by the sign in question (paras 37-39). The GC recalled the case law, according to which the applicant cannot deduct any rights from prior registrations in Australia, New Zealand and the USA, and that earlier decisions taken by the Office allowed the registration of marks containing the elements ‘equipment’ or ‘life’, as the BoA is only bound by the relevant EU rules and not by any national system and neither by prior Office practice (paras 40-43).

◆◆[T-242/14](#); **SHAPE OF A FACE (3D MARK)**, Judgment of 7 October 2015, *The Smiley Company SPRL v OHIM* – EN.

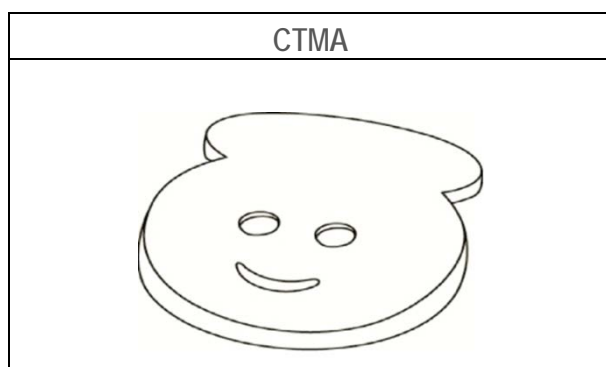


The CTM applicant sought to register the above 3D sign for goods in Classes 29 and 30. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks. Nonetheless average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark that departs significantly from the norm or customs of the sector is not devoid of any distinctive character (paras 32-34). The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 36). In relation to ‘jellies’ in Class 29 and ‘preparations made from cereals, pastry, confectionery, ices’ in Class 30, consumers who are used to a very wide variety of goods such as the ones at issue, and the shapes and decorations of such goods, will perceive the constituent elements of the mark applied for taken individually and the shape created taken as a whole as possible — or even common — variants of the presentation and decoration of those goods. This is true even if the face shape in question were to be



intended to convey positive feelings or curiosity. (paras 41-45). Moreover, average consumers accord confectionery and pastry goods only fleeting attention. The same is true in the sectors of preparations made from cereals, jellies and ices, and particularly true of ice lollies. (para. 46). It is not widely known that 'preserved, frozen, dried and cooked fruits and vegetables; milk products' in Class 29 are also offered with a variety of decorative elements, let alone ornaments as elaborate as faces and other anthropomorphic or zoomorphic elements, contrary to what the BoA essentially stated. Liquid or creamy milk products, such as yoghurts, cannot take such a shape. Preserved, frozen, dried and cooked fruits and vegetables are usually packaged and presented in their natural form, chopped, as coulis or in classic or functional geometric shapes, such as cubes, discs, pebbles, tiles, balls or coils. The exceptional nature of the habits in the sectors concerned involving presenting those goods in the shape of the mark applied for renders that mark capable of indicating the commercial origin (paras 56-60).

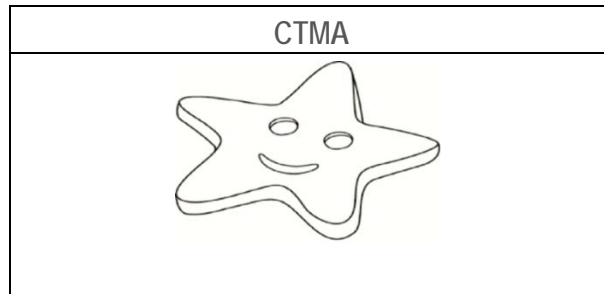
◆◆[T-243/14](#); **SHAPE OF A FACE (3D MARK)**, Judgment of 7 October 2015, *The Smiley Company SPRL v OHIM* – EN.



The CTM applicant sought to register the above 3D sign for goods in Classes 29 and 30. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks. Nonetheless, average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark which departs significantly from the norm or customs of the sector is not devoid of any distinctive character (paras 32-34). The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 36). In relation to 'jellies' in Class 29 and 'preparations made from cereals, pastry, confectionery, ices' in Class 30, consumers who are used to a very wide variety of goods such as the ones at issue, and the shapes and decorations of such goods, will perceive the constituent elements of the mark applied for taken individually and the shape created taken as a whole as possible — or even common — variants of the presentation and decoration of those goods. This is true even if the face shape in question were to be intended to convey positive feelings or affection. (paras 41-45). Moreover, average consumers accord confectionery and pastry goods only fleeting attention. The same is true in the sectors of preparations made from cereals, jellies and ices, and particularly true of ice lollies (para. 46).

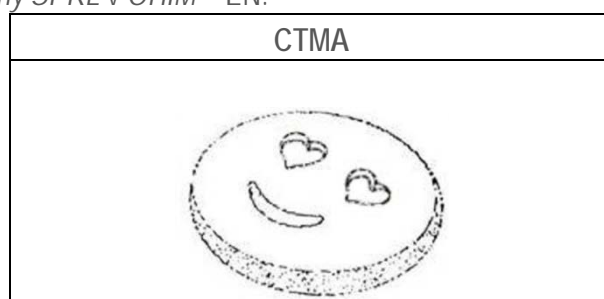


◆◆[T-244/14](#); **SHAPE OF A FACE IN THE FORM OF A STAR (3D MARK)**, Judgment of 7 October 2015, *The Smiley Company SPRL v OHIM* – EN.



The CTM applicant sought to register the above 3D sign for goods in Classes 29 and 30. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks. Nonetheless, average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark that departs significantly from the norm or customs of the sector is not devoid of any distinctive character (paras 32-34). The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 36). In relation to ‘jellies’ in Class 29 and ‘preparations made from cereals, pastry, confectionery, ices’ in Class 30, consumers who are used to a very wide variety of goods such as the ones at issue, and the shapes and decorations of such goods, will perceive the constituent elements of the mark applied for taken individually and the shape created taken as a whole as possible — or even common — variants of the presentation and decoration of those goods. This is true even if the face shape at hand were to be intended to convey positive feelings or affection. (paras 41-45). Moreover, average consumers accord confectionery and pastry goods only fleeting attention. The same is true in the sectors of preparations made from cereals, jellies and ices, and particularly true of ice lollies (para. 46).

[T-656/13](#); **SHAPE OF A SMILEY WITH HEART-SHAPED EYES (3D MARK)**, Judgment of 7 October 2015, *The Smiley Company SPRL v OHIM* – EN.

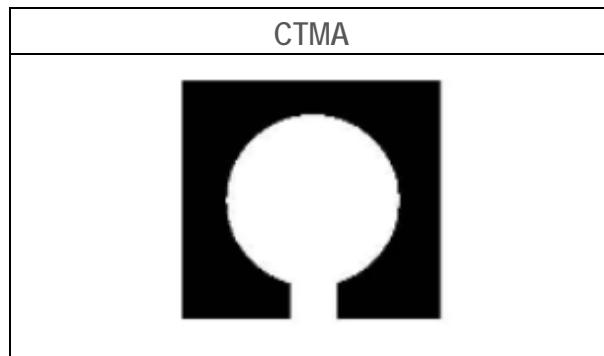


The applicant sought to register the 3D mark represented above as a CTM for goods and services within Classes 29 and 30. The examiner refused to register the trade mark in respect of ‘Preparations made from cereals, bread, pastry and confectionery’ on the ground that the mark applied for was devoid of any



distinctive character within the meaning of Article 7(1)(b) CTMR. The BoA dismissed the applicant's appeal on the ground that the sign applied for shows the shape of the goods themselves. The applicant filed an action before the GC. The GC ruled that the applicant's argument that the BoA did not assess the mark applied for as a whole had no factual basis (para. 31). In relation to the relevant public, the GC stated that the applicant had not disputed the finding that this is average consumers who are deemed to be reasonably well informed, observant and circumspect (para. 33). According to the GC, the constituent elements of the mark applied for taken individually and the shape created taken as a whole will be perceived by the relevant consumer as possible, or even common, variants of the presentation and decoration of the designed goods or as communicating a positive message (paras 36 and 37). Therefore, it did not have distinctive character in respect of these goods (para. 41). The GC rejected the applicant's argument alleging breach of the principle of non-discrimination and of legitimate expectations by making reference to the case law establishing that examination must be undertaken in each individual case and the registration of a sign as a mark depends on specific criteria even if the sign applied for is composed in a manner identical to a mark already registered by the Office (paras 46-47).

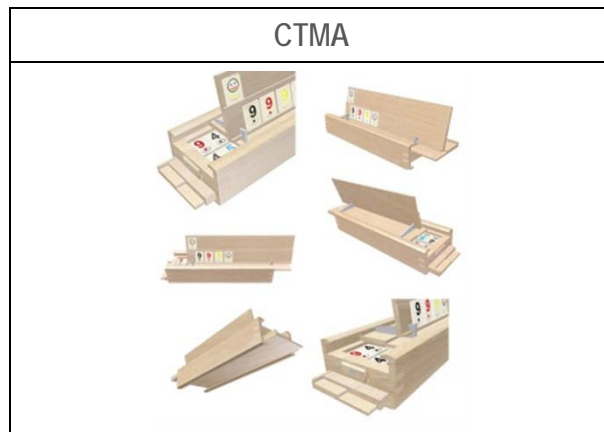
[T-695/14](#); **DEVICE OF A WHITE CIRCLE AND RECTANGLE INSIDE A BLACK SQUARE**, Judgment of 3 December 2015, *Omega International GmbH v OHIM* – DE.



The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 3, 5, 32 and 33. The examiner refused to register the word as a CTM pursuant to Article 7(1)(b) CTMR. The BoA confirmed the refusal. The CTM applicant filed an action before the GC requesting the registration of the CTM and claiming an infringement of Article 7(1)(b) CTMR. The request for a registration of the CTMA is inadmissible, as within its competence to alter the contested decision, the GC only can take the decision which could have been rendered by the BoA. The BoA does not decide to register a mark (paras 9-11 with reference to the case law). The claim based on Article 7(1)(b) CTMR is ill founded. A sign which is excessively simple and is constituted by a basic geometrical figure, such as a circle, a line, a rectangle or a conventional pentagon, is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use (para. 18 with reference to settled case law).



[T-547/13](#); **SHAPE OF A GAMES BOX (3D MARK)**, Judgment of 8 October 2015, *Rosian Express SRL v. OHIM – RO*.



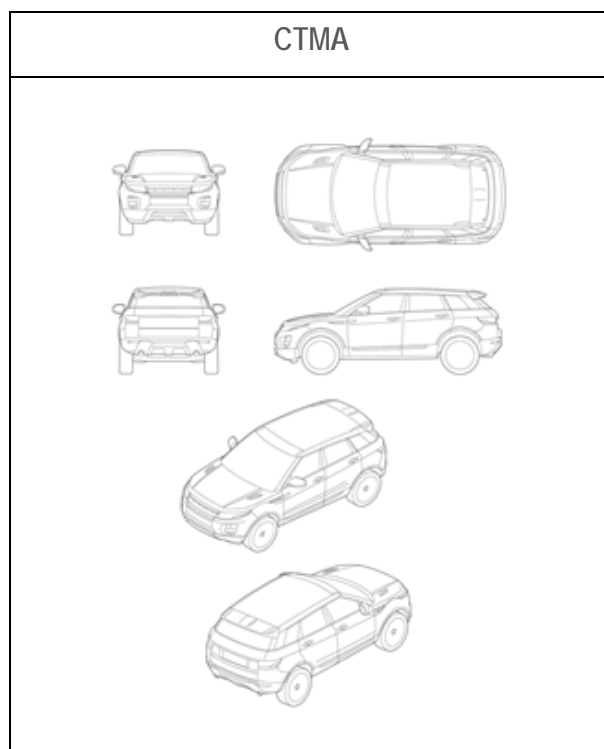
The CTM applicant sought to register the sign above as a 3D mark for goods in Classes 28 and 35. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The goods at issue fall within the category of games and toys. They are intended for general consumption and not only for professionals or enthusiasts since anyone is likely, at some time or another, to acquire such goods either regularly or occasionally. The applicant's arguments that the BoA should have held that the relevant public only had a high level of attention when it comes to durable goods for long-term use were, therefore, incorrect (para. 42). It is common knowledge that the goods at issue are often presented in a rectangular wooden box. Similarly, the way of unfolding and assembling the box, the shape of which constitutes the mark in question does not depart significantly from the norms or customs of the sector. It is well-known that similar sliding systems exist to enable the goods at issue to be put away and to be assembled. Seen as a whole, the different characteristics of the mark applied for likewise do not enable the mark applied for to be considered as differing significantly from the norms and customs of the sector. Consequently, it must be held that the mark applied for is not distinctive (para. 46). The lack of distinctive character of a mark is not affected by how many similar shapes are already on the market, nor by the absence on the market of shapes identical to those in respect of which registration is requested (para. 49). It follows, in particular, that the claims of the applicant that the BoA erred in making reference to other goods on the market, although the latter were counterfeit, is irrelevant (para. 51).

♦ [T-253/13](#); **IRAP**, Judgment of 12 November 2015, *Orthogen AG v OHIM – DE*. The contested trade mark was the registered CTM 'IRAP' (word) for goods and services in Classes 1, 10, 42 and 42. The CD cancelled the CTM as being descriptive and devoid of distinctive character according to Article 7(1)(b) and (c) CTMR. The BoA confirmed the first instance to the extent that it found that the mark is devoid of distinctive character. The BoA was right in concluding that the target public is mainly a specialised public with specific knowledge in the field, because the goods and services are very specific (para. 31). Furthermore the BoA was right in assessing that the term 'IRAP' may be understood by this public as referring to a protein called 'Interleukin-1 receptor antagonist protein'. This conclusion is supported by the documents in the file (para. 33). With respect to the submission of the applicant that the BoA unlawfully



relied on publications coming from the United States, the GC states that the specialised public within the EU will understand the English language which is predominant in the field and that this public will also consult publications from outside the EU (paras 34-35). As for the further argument of the applicant that private consumers will not grasp any meaning when they are confronted with the sign, the GC states that it is sufficient that a substantial part of the target consumers perceives the sign as non-distinctive (para. 36). Moreover, it is reasonable to assume that they will receive advice from specialists when they acquire those kinds of goods and services (para. 37). The applicant contended that even if the expression 'IRAP' would be perceived as an abbreviation of 'Interleukin-1 receptor antagonist protein', this would not be descriptive for the goods and services, as there is no clear and direct link between those goods and services and the meaning of 'IRAP' (para. 42). As to this plea, the GC underlines the fact that the contested decision invalidated the mark based on Article 7(1)(b) CTMR, which means that there is no need to show a direct descriptive character but rather to establish if the expression 'IRAP' has the required distinctive character (para. 44). The BoA established for the different categories of goods and services how the protein (IRAP) could function and concluded that there would be a connection there between. The sign therefore gives information on the goods and services and without being directly descriptive it lacks therefore the distinctive character in order to be acceptable under Article 7(1)(b) CTMR (paras 51-58).

◆◆[T-629/14](#); **SHAPE OF A CAR (3D MARK)**, Judgment of 25 November 2015, *Jaguar Land Rover Ltd v OHIM* – EN.

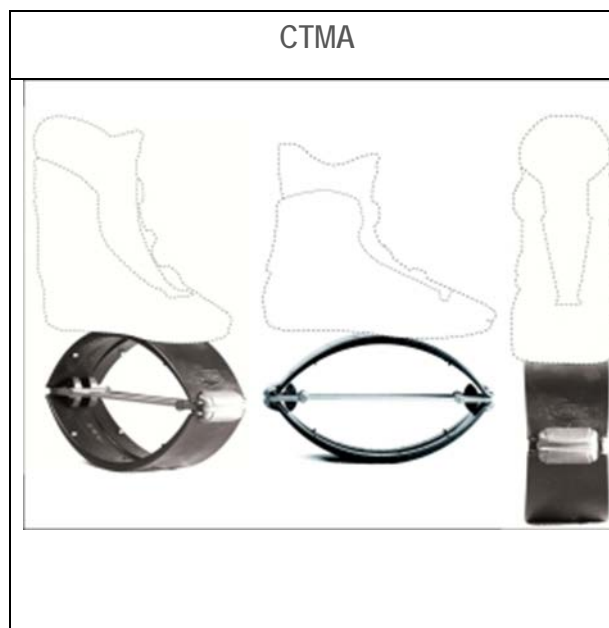


The CTM applicant sought to register the 3D mark above as a CTM for goods, inter alia, in Classes 12 and 28. The examiner refused the application in respect of some of the goods. The BoA annulled the examiner's decision insofar as it refused to register the CTM for 'apparatus for locomotion by air or water'. The CTM applicant filed an application before the General Court for annulment of the BoA's decision. The



goods at issue in Class 12 are aimed at the general public as well as professionals and the goods at issue in Class 28 are aimed at the general public. While that relevant public will have a high degree of attention when purchasing the goods at issue in Class 12, in particular, on account of their price, their degree of attention will be average when acquiring the goods at issue in Class 28, which are generally relatively inexpensive (para. 22). The CTMA consists of a 3D graphic representation, namely of six line drawings of different perspectives of the body of a car. Furthermore, it does not contain any word or figurative element. Even if the applicant's statements regarding the quality and level of detail of the six graphic representations were proved, the fact remains that a high quality and extremely detailed drawing may well contain merely a variation of the typical shape of a car (para. 29). The CTM applied for in no way states that the shape of the car represented in the six line drawings filed for the purposes of registration is that of a car named 'Range Rover Evoque' or 'Evoque'. The BoA was fully entitled to hold that account had to be taken exclusively of the representation of the sign as filed, and not of the photographs of the ready-made car or the verbal explanations provided by the applicant concerning that car. In particular, the BoA did not err in holding that the references to the model 'Range Rover Evoque', or simply 'Evoque', were irrelevant in the present case (paras 35-37). The details of a graphic representation filed for the purposes of registration as a 3D mark must, on their own, make it possible to determine whether the mark applied for departs significantly from the norm or customs of the sectors concerned, and is thus not devoid of any distinctive character. Hence, the BoA cannot be criticised for not having taken account of third-party reviews submitted by the CTM applicant, as they do not concern the six line drawings it filed for the purposes of registration, but rather a ready-made car or photographs of such a ready-made car (paras 39-43).

[T-390/14](#); **KJ KANGOO JUMPS XR**, Judgment of 26 November 2015, *Etablissement Amra v OHIM* – EN.

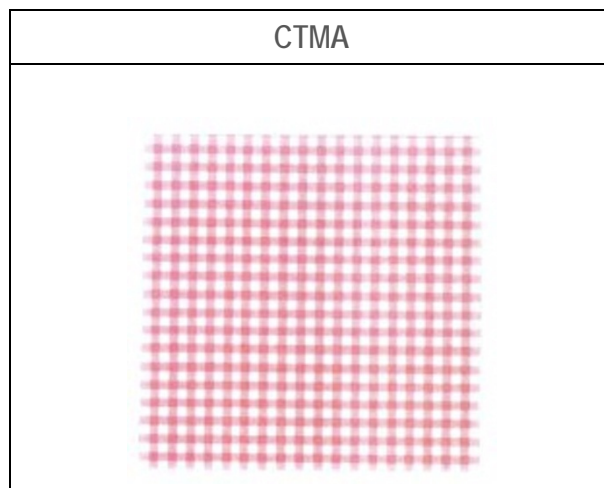


The applicant sought to register the position mark represented above as a CTM for 'gymnastic and sporting articles not included in other classes' in Class 28. The examiner refused to register the mark as a CTM on the ground that it is devoid of distinctive character. The BoA dismissed the applicant's appeal.



The applicant filed an action before the GC. The GC treats the sign as a 3D mark, rather than as a position mark. It confirms that the various elements of the CTM applied for that fulfil only a technical, functional or ornamental role are insufficient, taken as a whole, to confer on it a minimum degree of distinctive character (para. 16). Furthermore, the onus is on the CTM applicant to provide evidence that the mark applied for has an intrinsic distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 22). The mark applied for does not depart significantly from the basic shape of the goods concerned (para. 26). The word and figurative elements of the mark applied for are extremely minor and are of such a superficial nature that they do not bring any distinctive character to the mark applied for as a whole (para. 27).

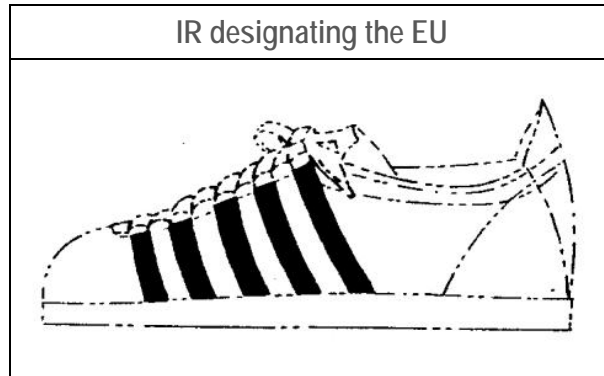
[T-327/14](#); **DEVICE OF A RED AND WHITE CHECKED PATTERN**, Judgment of 3 December 2015, *Compagnie des fromages & Richesmonts v OHIM* – FR.



The Office registered in 2008 the following figurative mark for milk and dairy products excluding dairy desserts in Class 29. In 2010 the intervener brought an invalidity action pursuant to Article 52(1)(a) CTMR, as such mark had been registered breaching Article 7(1)(b), (c) and (d) CTMR. The CD dismissed the action. The BoA declared the nullity of the mark pursuant to Article 7(1)(b) CTMR. The owner of the CTM filed an action before the GC. The GC confirms that the sign is a simple and classic 'motif vichy' combining the colours red and white (paras 43-45). The BoA was right to find that it has not been established that consumers are used to identifying the commercial origin of the relevant products on the basis of a repeated reproduction of white and red squares, in the absence of any other graphic or textual element (para. 52).



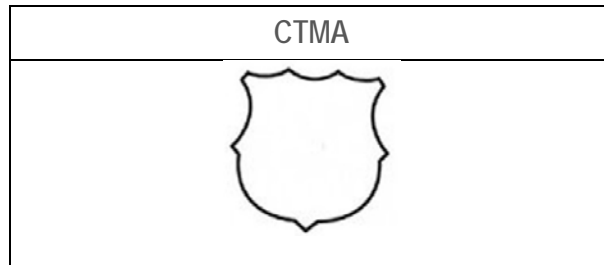
◆ [T-3/15](#); **DEVICE OF FIVE STRIPES**, Judgment of 4 December 2015, *K-Swiss v OHIM* – EN.



The IR holder sought to register the figurative mark represented above as an IR designating the EU (IR No 932 758) for goods and services within Class 25. The examiner refused to register the mark on the ground of Article 7(1)(b) CTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC took the view that the mark applied for is presented in the form of a design intended to be placed on part of the goods concerned, and not in the form of a two-dimensional representation of a shoe, in spite of the discrepancy in the French description of the mark (para. 16). Stripes are nothing more than a rather banal generic embellishment (para. 18). The mark applied for consists of a simple juxtaposition of five sloping, parallel stripes, the size of which varies so as to correspond to that of the side of the shoe (para. 19). Many manufacturers of sports shoes use relatively simple patterns of lines of stripes which they also place on the side of the shoe; the fact that the sign in question extends to the full height of the side of the shoe confirms its lack of originality (paras 21-22). Although the applicant showed that many manufacturers have developed a practice of placing their mark on the side of the shoes and the sellers display in shops the side of the shoes on which the mark appears, that information still does not make it possible to determine that the average consumer has learnt to establish an automatic link between the sign and a particular manufacturer (para. 26). Even if it were accepted that the average consumer pays particularly close attention to the shapes placed on the side of the shoe, to the point that that consumer considers that those shapes generally constitute trade marks, the applicant has not adduced sufficient evidence to establish that, in view of the banal nature of the sign at issue, the average consumer would consider that sign to be an indication of the origin of the goods at issue and not a mere decorative element (para. 33). As regards attentiveness of the public, while it is possible that the consumer may be more attentive to the choice of mark when he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector; this also applies to the sector of sports shoes and casual shoes (paras 36-37).



◆ [T-615/14](#); **DEVICE OF A SHIELD**, Judgment of 10 December 2015; *Fútbol Club Barcelona v OHIM – ES*.



The applicant sought to register the figurative mark represented above as a CTM for goods and services in Classes 16, 25 and 41. The examiner refused to register the mark as a CTM on the ground of Article 7(1)(b) CTMR and took the view that the conditions of Article 7(3) CTMR were not fulfilled. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC confirms that none of the characteristics of the sign applied for contains an element that could attract the consumers' attention. It will rather be perceived as a simple shape that cannot distinguish the goods and services of the applicant from those of other companies (para. 33). The average consumer can only perceive the differences with shields of other football clubs upon direct comparison. The details in the CTMA will hardly remain in the average consumer's memory (para. 36). Shields and similar shapes are often used for products in Class 16 and for services in Class 41 as simple decorative elements, without a trade mark function. They are also used on shoes and clothes (Class 25) as decorative elements or as labels.

[T-70/14](#); **SHAPE OF A WATER BOTTLE (3D MARK)**, Judgment of 14 January 2015, *Research and Production Company « Melt Water » UAB v OHIM – IT*.

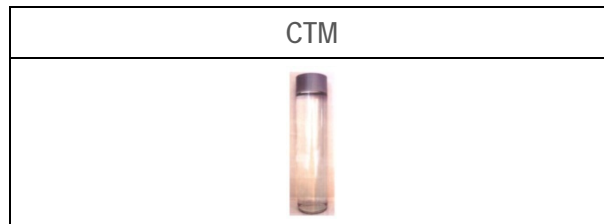


The applicant sought to register the above 3D mark for goods in Class 32. The examiner refused to register the sign on the basis of Article 7(1)(b) CTMR, considering the shape did not depart significantly from shapes of the relevant market. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC confirmed the assessment of the BoA. The relevant public is the average consumer of the EU (para. 24). The GC analysed the different elements of the bottle claimed to be different from the shapes available in the market, reproducing the case law on 3D marks. The GC confirmed that neither the shape (para. 30) of the bottle nor the neck (para. 31) nor the height (para. 32) is very different from bottles available in the market. The GC remarked that the reproduction of the mark did not allow the perception of the size of the bottle in comparison with other bottles available in the



market. In relation to the upper part of the bottle, claimed to have a diamond shape, the GC confirmed that this element did not depart significantly from other bottles of the market (para. 34). It also confirmed that, contrary to the statement of the applicant, the assessment of the BoA was made in conformity with the case law reproduced and summarised in paragraphs 21 and 22 of the judgment. The 3D mark therefore lacks distinctive character and was correctly refused on the basis of Article 7(1)(b) CTMR.

[C-445/13 P](#); **SHAPE OF A CYLINDRICAL BOTTLE (3D MARK)**, Judgment of 7 May 2015, *Voss of Norway ASA, INTA v OHIM, Nordic Spirits – EN*.



The applicant obtained registration of the 3D mark shown above for goods in Classes 32 and 33. The cancellation applicant filed an application for a declaration that the contested trade mark was invalid on the basis, first, of the ground of current Article 52(1)(a) CTMR in conjunction with Article 7(1)(a) to (e)(i) to (iii) CTMR, and, second, of the ground of current Article 52(1)(b) CTMR. The CD rejected the application for a declaration of invalidity, however, the BoA annulled the decision on the basis of the lack of distinctive character of the mark. The CTM proprietor filed an action before the GC. By judgment of 28 May 2013 in case T-178/11, the GC dismissed the action and confirmed the conclusion of the BoA. The CTM proprietor, supported by the International Trademark Association (INTA), filed an appeal before the CJ. As regards Article 99 CTMR and Rule 37 CTMIR, the CJ held that the GC examined whether there was any concrete evidence that would indicate that the composite mark, taken as a whole, is greater than the sum of its parts and did not, contrary to what INTA and the appellant submit, impose the burden of proving the existence of such evidence on the appellant (para. 70). In those circumstances, it held that the arguments of the CTM proprietor and INTA are based on a misreading of the judgment under appeal and must therefore be rejected (para. 71). The GC carried out an analysis of the distinctive character of the components of the 3D sign at issue in the light of the norms of the relevant sector, relying on well-known facts (para. 86). Consequently, the CTM proprietor and INTA are not justified in claiming that the GC did not define the norms and customs of the sector of goods in respect of which the contested trade mark was registered (para. 87). In relation to INTA's argument that the GC erred in law by contrasting 'mere variant' with 'significant departure' in relation to the applicable norms and customs, instead of examining whether the contested trade mark deviates from the shapes that are customarily or normally used in the relevant sector to such an extent that consumers will be able to attach significance to it (para. 88), the CJ held that the GC was correct to confirm that the BoA had not erred in finding that the average consumer in the EU would perceive the contested trade mark, as a whole, merely as a variant of the shape of the goods for which registration of that trade mark was sought. The CJ concluded that the GC correctly held that the contested trade mark, as perceived by the relevant public, is not capable of individualising the goods covered by that trade mark and distinguishing them from those that have a different commercial origin (para. 94). Furthermore, insofar as INTA criticises the GC for holding that the appellant's bottle does not depart significantly from the norms or customs of the relevant sector, the CJ stated that that analysis falls to be classed as an assessment of a factual nature (para. 96). In respect of Article 7(1)(b) CTMR, the CJ confirmed that the GC correctly based its assessment as to



whether the contested trade mark has distinctive character on the overall impression that is conveyed by the shape and the arrangement of the components of that mark, as required by the case law (para. 109). The CJ added that it cannot be maintained that the GC did not carry out a sufficiently detailed analysis of the overall impression conveyed by the contested trade mark, inasmuch as the 3D shape at issue consists of two elements, namely a cylindrical basic shape and a non-transparent cap with the same diameter as that cylinder, and it is difficult to imagine other ways of combining those elements in a single 3D form (para. 110). On the distortion of evidence in the file, the CJ concluded that the GC was correct when it held that the word ‘section’ used by the BoA in paragraph 37 of the contested decision must be understood as meaning ‘part’ and, according to the GC, the vast majority of bottles have a part that is cylindrical (para. 118). So, contrary to what the appellant claims, the GC did not confine its analysis of the 3D sign at issue to a comparison of the shape of that sign with a two-dimensional feature (para. 119). As regards the appellant’s argument that the GC erred in law by applying to the contested trade mark the case law according to which a combination of components, each of which is devoid of distinctive character, can have distinctive character, provided that, taken as a whole, it amounts to more than just a mere sum of its parts, the CJ pointed out that, as is apparent from paragraphs 107 to 109 of the judgment, the GC correctly based its assessment as to whether the contested trade mark has distinctive character on the overall impression that is conveyed by the shape and the arrangement of the components of that mark, as required by the case law (para. 128).

◆ [T-359/12](#); **CHEQUERBOARD PATTERN I**, Judgment of 21 April 2015, *Louis Vuitton Malletier v OHIM – EN*.

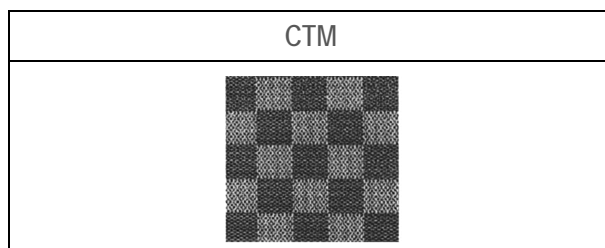


The CTM holder registered the figurative mark shown above for a range of goods in Class 18. The invalidity applicant sought the cancellation of the contested CTM on the grounds of Article 52(1)(a) and Article 7(1)(b), (c), (d), (e)(iii) and (f) CTMR. The CD upheld the invalidity request on the basis of Article 7(1)(b) in conjunction with Article 52(1)(a) CTMR, and Article 7(3) in conjunction with Article 52(2) CTMR. On appeal, the the BoA confirmed the CD’s decision. The BoA found that the chequerboard pattern, as represented in the contested trade mark, was a basic and banal feature composed of very simple elements and that it was well-known that that feature had been commonly used with a decorative purpose in relation to various goods, including those falling within Class 18. As to the claim of acquired distinctiveness, the BoA found that it had not been established that the contested trade mark had acquired distinctive character through the use that had been made of it in a substantial part of the relevant territory, namely in Denmark, Portugal, Finland and Sweden, either at its filing date or after its registration. The GC dismissed the appeal and confirmed the BoA’s findings. As to the issue of the inherent distinctive character of the contested mark, the GC recalled the established case law relating to 3D marks which consist of the appearance of the product itself and noted that it also applies to figurative marks consisting in the shape of the product concerned or a part of the shape of the product (paras 20-31). The GC dismissed the CTM proprietor’s argument that consumers are accustomed to perceiving a



pattern as an indication of the commercial origin of goods as irrelevant, noting that the fact that such signs are recognised as marks by consumers does not necessarily mean that they have an inherent distinctive character, as a mark may acquire distinctive character through use over time (para. 34). The chequerboard pattern is a basic and commonplace figurative pattern which does not differ from the norm or customs of the sector inasmuch as such goods are generally covered with fabrics of different kinds, and the chequerboard pattern, due to its great simplicity, might constitute precisely one of those patterns (para. 37). The chequerboard pattern is one that has always existed and has been used in decorative arts, which have an indisputable link with the goods in Class 18 (para. 38). The juxtaposition of a chequerboard and of a warp and weft pattern does not give rise to any element that diverges from the norm or customs of the sector concerned (para. 41). As regards the applicant's submission that other signs similar to the contested mark have been registered as CTMs, the GC recalled the established case law to the effect that the principles of equal treatment and sound administration must be consistent with respect for legality (paras 47-51). Concerning the CTM proprietor's argument that it is for the invalidity applicant to rebut the presumption of validity of the mark and that the BoA could not legitimately rely on its own 'general experience' in order to rebut the above presumption, the GC held that the BoA's finding that the chequerboard pattern was a basic and banal figurative feature composed of very simple elements was a well-known fact which was corroborated by the evidence filed by the invalidity applicant (paras 61-64), so that the BoA had not infringed the rules on the burden of proof.

◆ [T-360/12](#); **CHEQUERBOARD PATTERN II**, Judgment of 21 April 2015, *Louis Vuitton Malletier v OHIM* – EN.



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



consist of the appearance of the product itself and noted that it also applies to figurative marks consisting in the shape of the product concerned or a part of the shape of the product (paras 20-31). The GC dismissed the CTM proprietor's argument that consumers are accustomed to perceiving a pattern as an indication of the commercial origin of goods as irrelevant, noting that the fact that such signs are recognised as marks by consumers does not necessarily mean that they have an inherent distinctive character, as a mark may acquire distinctive character through use over time (para. 34). The chequerboard pattern is a basic and commonplace figurative pattern that does not differ from the norm or customs of the sector inasmuch as such goods are generally covered with fabrics of different kinds, and the chequerboard pattern, due to its great simplicity, might constitute precisely one of those patterns (para. 37). The chequerboard pattern is one that has always existed and has been used in decorative arts, which have an indisputable link with the goods in Class 18 (para. 38). The juxtaposition of a chequerboard and of a warp and weft pattern does not give rise to any element that diverges from the norm or customs of the sector concerned (para. 41). As regards the CTM proprietor's submission that other signs similar to the contested mark have been registered as CTMs, the GC recalled the established case law to the effect that the principles of equal treatment and sound administration must be consistent with respect for legality (paras 47-51). Concerning the CTM proprietor's argument that it is for the invalidity applicant to rebut the presumption of validity of the mark and that the BoA could not legitimately rely on its own 'general experience' in order to rebut the above presumption, the GC held that the BoA's finding that the chequerboard pattern was a basic and banal figurative feature composed of very simple elements was a well-known fact which was corroborated by the evidence filed by the invalidity applicant (paras 61-64), so that the BoA had not infringed the rules on the burden of proof.

[T-225/14](#); **IDIRECT24**, Judgment of 3 September 2015, *iNET24 Holding AG v OHIM* – DE. The applicant sought to protect the IR designating the EU 'IDIRECT24' (word mark) for various goods and services in Classes 9, 36, 38 and 42, related in particular to IT. The examiner refused the IR under Article 7(1)(b) and (c) CTMR. The BoA dismissed the appeal, holding that the sign describes the goods' and services' availability around the clock on the internet. The GC confirmed the BoA decision based on Article 7(1)(b) CTMR. In holding that the letter 'I' is commonly known as an abbreviation of the internet, the BoA relied on well-known facts that do not require further evidence. This enabled the applicant to understand the BoA's reasoning (paras 20-24). The relevant public consists of English-speaking, average consumers, who will perceive 'IDIRECT24' as being composed of 'I', 'DIRECT' and '24' (paras 51-53). At the beginning of a word, 'I' is an abbreviation for the internet. '24' is a common reference to 24 hours, i.e. permanent, around the clock. Thus, 'IDIRECT24' refers to the concept of the direct availability or accessibility on the internet, around the clock (paras 54-57). This applies to all goods and services, all of which may be acquired or rendered via the internet (para. 63).

[T-714/13](#); **MIGHTY BRIGHT**, Judgment of 8 September 2015, *Gold Crest LLC v OHIM* – EN. The applicant sought to register the word mark 'MIGHTY BRIGHT' for various goods in Classes 11, namely portable clip-on reading lights and light bulbs. The examiner refused this CTM application under Article 7(1)(b) and Article 7(2) CTMR. The BoA dismissed the appeal, holding that 'MIGHTY BRIGHT' in relation to the goods applied for informed the consumers that the reading lights and the bulbs concerned were capable of emitting powerful, strong light. The GC confirmed the BoA decision. The applicant submits, in essence, that the BoA erred in refusing to acknowledge that the mark applied for had distinctive character (para. 9) However the GC found that the allegedly unusual nature of the combination



of the words 'mighty' and 'bright' does not preclude the mark applied for from being descriptive, as the designation 'mighty bright' does not deviate sufficiently from everyday language for the descriptive message as indicated above being attenuated (para. 19). The BoA was right to find that the sign was devoid of distinctive character (para. 25).

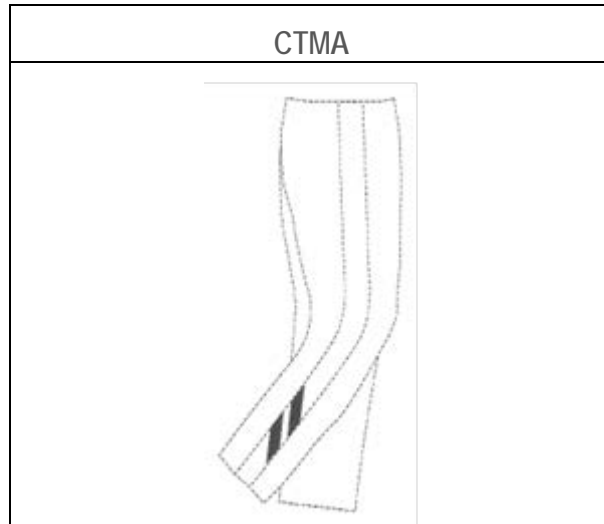
[T-63/15](#); **PARALLEL STRIPES ON A SHIRT**, Judgment of 15 December 2015, *Shoe Branding Europe BVBA v OHIM* – EN.



The applicant sought to register the position mark represented above as a CTM for goods and services within Class 25. The examiner refused to register the mark as a CTM on the ground of Article 7(1)(b) CTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. Although the patterns and simple designs affixed to the products applied for or, more generally, on sports products, may be perceived in some cases as indications of commercial origin, this does not mean that any pattern would be perceived that way (para. 17). The pattern concerned is very simple and ordinary which, as such, lacks distinctive character (para. 20). The applicant had not established that such a pattern would acquire a distinctive character from the fact that it was affixed on a specific part of the shirt (para. 21). Even if it is accepted that the average consumer pays particularly close attention to simple geometric shapes positioned on clothing — especially on the outside of the sleeves of shirts — to such an extent that he or she considers that such shapes are generally trade marks, the applicant has not produced sufficient evidence to establish, given the ordinary nature of the sign at issue, that the average consumer would regard the sign as an indication of the origin of the products at issue and not as a mere decorative element. (para. 28) Accepting that any geometric shape, including the simplest one, has a distinctive character because it is affixed to a particular portion of the sleeve of a sport shirts would result in some manufacturers being able to appropriate simple, primarily decorative, shapes, which must remain accessible to all, except where the distinctive character of the sign has been acquired through use (para. 29).



[T-64/15](#); **PARALLEL STRIPES ON PANTS**, Judgment of 15 December 2015, *Shoe Branding Europe BVBA v OHIM* – EN.



The applicant sought to register the position mark represented above as a CTM for goods and services within Class 25. The examiner refused to register the mark as a CTM on the ground of Article 7(1)(b) CTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. Although the patterns and simple designs affixed to the products applied for or, more generally, on sports products, may be perceived in some cases as indications of commercial origin that does not mean that any pattern would be perceived that way (para. 17). The pattern concerned is extremely simple which, as such, lacks distinctive character (para. 20). The applicant had not established that such a pattern would acquire a distinctive character from the fact that it was affixed, at a certain angle, to a specific part of the pants (para. 21). Even if it is accepted that the average consumer pays particularly close attention to simple geometric shapes positioned on clothing to the point that he or she considers that those shapes are in general marks, the applicant has not produced sufficient evidence to establish, given the ordinary nature of the sign at issue, that the average consumer would regard the sign as an indication of the origin of the products at issue and not as a mere decorative element (para. 28). Accepting that any geometric shape, including the simplest one, has a distinctive character because it is affixed to a particular portion of the side of a pair of sport pants would result in some manufacturers being able to appropriate simple, primarily decorative, shapes, which must remain accessible to all, except where the distinctive character of the sign has been acquired through use (para. 29).

◆ [T-336/14](#); **NOURISHING PERSONAL HEALTH**, Judgment of 8 October 2015, *Société des produits Nestlé SA v OHIM* – EN. The applicant sought to register the IR designating the EU of the word mark 'NOURISHING PERSONAL HEALTH' for goods and services in in Classes 5, 10, 41, 42 and 44. The examiner refused registration of the mark applied for in respect of all the goods and services referred to, on the basis of Article 7(1)(b) and (2) CTMR, and the BoA dismissed the applicant's appeal. The applicant filed an action before the GC. According to the GC, the relevant public is the English-speaking general public and English-speaking specialists, whose level of attention varies from average to high. The GC ruled that in view of the goods and services at issue, the mark applied for will be perceived



immediately by the relevant public as a promotional message and not as an indication of the commercial origin of those goods and services.

◆ [T-190/15](#); **meet me**, Judgment of 24 November 2015, *Intervog v OHIM* – FR.



The applicant sought to register the above figurative mark for various goods and services in Classes 9, 38 and 45. The examiner refused this CTMA under Article 7(1)(b) CTMR. The BoA dismissed the appeal on the basis of Article 7(1)(b) CMTR, holding that the mark applied for would only be seen as a promotional message and not as an indication of the commercial origin of the goods and services covered. The GC confirmed the BoA decision. INFRINGEMENT OF ARTICLE 7(1)(b) CTMR: The applicant submits, in essence, that the BoA erred in refusing to acknowledge that the mark applied for had distinctive character (para. 9). However the GC found that the allegedly unusual nature of the combination of the words 'meet', written in a particular way and 'me' does not preclude the mark applied for from being devoid of any originality that would require an cognitive process from the relevant public (para. 31). The BoA was right to find that the sign was devoid of distinctive character (para. 37). INFRINGEMENT OF THE PRINCIPLE OF EQUALITY: The applicant submits that its application was rejected, whereas similar marks had been registered (para. 38). According to the GC, the principle of equality must be applied with respect for the principle of legality (para. 40).

[T-528/14](#); **GROWTH DELIVERED**, Judgment of 2 December 2015, *Information Resources, Inc. v OHIM* – EN. The applicant sought to register the word mark 'GROWTH DELIVERED' for various services in Classes 35, 41 and 42. The examiner refused this CTMA under Article 7 (1)(b) and (c) and Article 7(2) CTMR. The BoA dismissed the appeal on the basis of Article 7(1)(b) CTMR, holding that 'GROWTH DELIVERED' in relation to the services applied for was a promotional reference to a positive aspect of the services covered, namely that they would deliver growth. The mark applied for would therefore only be seen as a promotional message and not as an indication of the commercial origin of the services covered. The GC confirmed the BoA decision. INFRINGEMENT OF ARTICLE 7(1)(b) CTMR: The applicant submits, in essence, that the BoA erred in its assessment of the relevant public and its level of attention, as well in its assessment of the distinctive character of the mark applied for and finally that it took insufficient account of prior registrations that include the term 'growth' or 'delivered' (para. 12). However the GC found that the BoA was correct in finding that, in the present case, the relevant public was composed of consumers and English-speaking professionals, whose degree of attention was average to high, but could be low for the public of professionals in the case of a promotional message (para. 30). As regards the distinctive character of the mark applied for, the GC confirmed the finding of



the BoA that there was nothing in the mark applied for, beyond the promotional meaning of the services concerned, which would cause it to be memorised as a distinctive mark for those services (para. 49). As for the prior registrations, the GC recalled that the principle of equal treatment must be consistent with respect for legality and that a person who files an application for registration of a sign as a trade mark cannot rely, to his or her advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else (para. 58). The BoA was right to find that the sign was devoid of distinctive character.

II. Distinctive

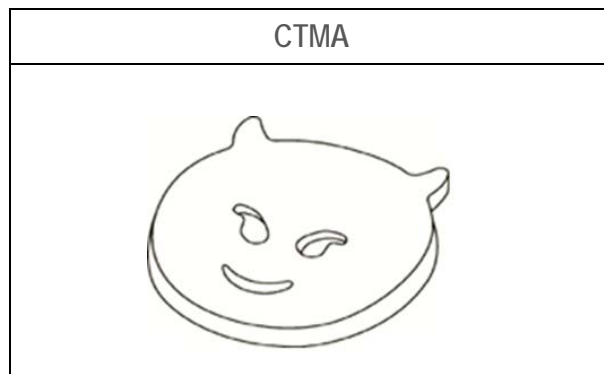
◆ [T-377/13](#); **Ultra.air ultrafilter**, Judgment of 9 March 2015, *ultra air GmbH v OHIM* – DE. The applicant registered the word mark ‘Ultra.air ultrafilter’ as a CTM for goods and services within Classes 7, 9, 11, 37 and 42. An application for invalidity was filed based on the grounds of Article 7(1)(b) and (c) CTMR. The CD dismissed the invalidity application. The BoA annulled the decision of the CD, finding that the term ‘ultrafilter’ is descriptive of all the goods and services covered by the contested mark. In addition, ‘ultra.air’ is understood to mean a superior air, so that these terms are seen as praise for quality filtration products covered by the contested mark and for the other products covered by the same mark which may be part of an air filtration system. The services in Classes 37 and 42 set out above (para. 2) may also cover air production facilities. The juxtaposition of two descriptive elements composing the contested mark was descriptive of an equally high quality air achieved through an ‘ultrafilter’ and the distinctiveness of the mark at issue also causes the lack of distinctive character. The applicant filed an action before the GC. The relevant public consists of English-speaking professionals from the filtration sector (para. 17). The GC confirmed BOA’s assessment as regards all goods and services, with the exception of ‘time control systems’. It found that the contested decision lacks reasoning as regards the ‘time control systems’, which are not mentioned at all. This conclusion cannot be altered by the general reference to the lack of distinctive character (para. 24). As regards the services covered, the GC recalled that the fact that a sign is descriptive only in relation to part of the goods or services covered by a broader category listed in the application does not prevent the sign from being refused registration (para. 25). As regards the perception of the element ‘ultra.air’ by the relevant public, it is clear from the contested decision, that the applicant was able to present his arguments in this regard. Thus, no violation of the right to be heard can be found merely because the BoA did not communicate to the applicant the definition of ‘ultra’ in the *Oxford English Dictionary* (para. 36-37). Based on the foregoing, the contested decision was partly annulled in respect of the ‘time control systems’ (para. 42).

◆ [T-133/13](#); **WET DUST CAN’T FLY**, Judgment of 22 January 2015, *Pro-Aqua International GmbH v OHIM* – EN. The applicant sought to cancel the CTM ‘WET DUST CAN’T FLY’ for goods and services in Classes 3, 7 and 37. The CD’s decision, rejecting the application for invalidity based on Articles 7(1)(b) and (c) and 52(1)(a) CTMR, was confirmed by the BoA. The cancellation applicant filed an action before the GC relying on two pleas in law. The GC dismissed both pleas on which the action was based, the alleged infringement of Article 7(1)(b) and (c) CTMR. On Article 7(1)(b) CTMR, there is no evidence on file that the combination of the words ‘dust’ and ‘wet’ is commonly used in the context of filters and cleaning systems. The expression ‘wet dust can’t fly’ calls for an interpretative effort since the intended purpose of the goods and services in question is not to ‘wet the dust in order to prevent it from flying’. The slogan exhibits a degree of originality and a certain resonance which make it easy to remember



(para. 50). Although the slogan may be slightly suggestive, there is no evidence to support the specific assumption that the goods and services concerned are superior (para. 52). The laudatory connotation of a word mark does not mean that it cannot, nonetheless, be appropriate for the purpose of guaranteeing to consumers the origin of the goods or services which it covers (para. 53).

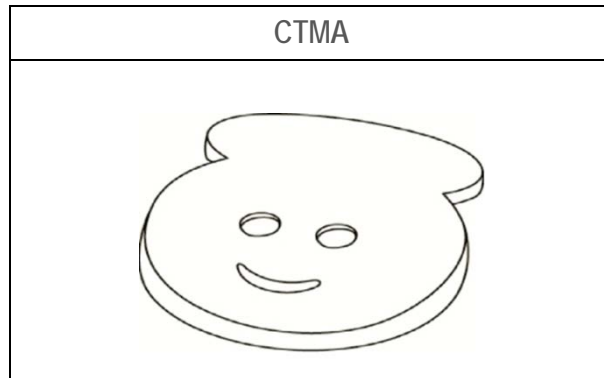
◆◆[T-242/14](#); **SHAPE OF A FACE (3D MARK)**, Judgment of 7 October 2015, *The Smiley Company SPRL v OHIM* – EN.



The CTM applicant sought to register the above 3D sign for goods in Classes 29 and 30. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks. Nonetheless, average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark that departs significantly from the norm or customs of the sector is not devoid of any distinctive character (paras 32-34). The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 36). It is not widely known that 'preserved, frozen, dried and cooked fruits and vegetables; milk products' in Class 29 are also offered with a variety of decorative elements, let alone ornaments as elaborate as faces and other anthropomorphic or zoomorphic elements, contrary to what the BoA essentially stated. Liquid or creamy milk products, such as yoghurts, cannot take such a shape. Preserved, frozen, dried and cooked fruits and vegetables are usually packaged and presented in their natural form, chopped, as coulis or in classic or functional geometric shapes, such as cubes, discs, pebbles, tiles, balls or coils. The exceptional nature of the habits in the sectors concerned involving presenting those goods in the shape of the mark applied for renders that mark capable of indicating the commercial origin (paras 56-60).



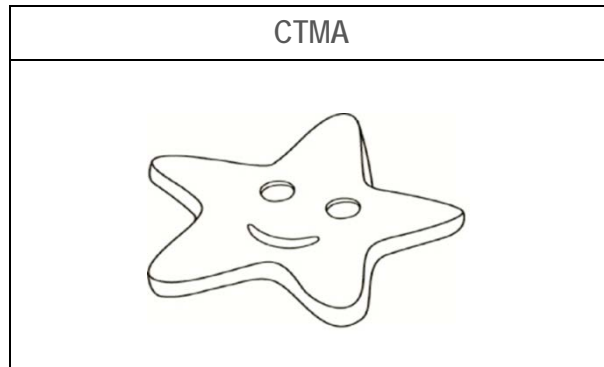
◆◆[T-243/14](#); **SHAPE OF A FACE (3D MARK)**, Judgment of 7 October 2015, *The Smiley Company SPRL v OHIM* – EN.



The CTM applicant sought to register the above 3D sign for goods in Classes 29 and 30. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks. Nonetheless, average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark that departs significantly from the norm or customs of the sector is not devoid of any distinctive character (paras 32-34). The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 36). It is not widely known that 'preserved, frozen, dried and cooked fruits and vegetables; milk products' in Class 29 are also offered with a variety of decorative elements, let alone ornaments as elaborate as faces and other anthropomorphic or zoomorphic elements, contrary to what the BoA essentially stated. Liquid or creamy milk products, such as yoghurts, cannot take such a shape. Preserved, frozen, dried and cooked fruits and vegetables are usually packaged and presented in their natural form, chopped, as coulis or in classic or functional geometric shapes, such as cubes, discs, pebbles, tiles, balls or coils. The exceptional nature of the habits in the sectors concerned involving presenting those goods in the shape of the mark applied for renders that mark capable of indicating the commercial origin (paras 56-60).



◆◆[T-244/14](#); **SHAPE OF A FACE IN THE FORM OF A STAR (3D MARK)**, Judgment of 7 October 2015, *The Smiley Company SPRL v OHIM* – EN.



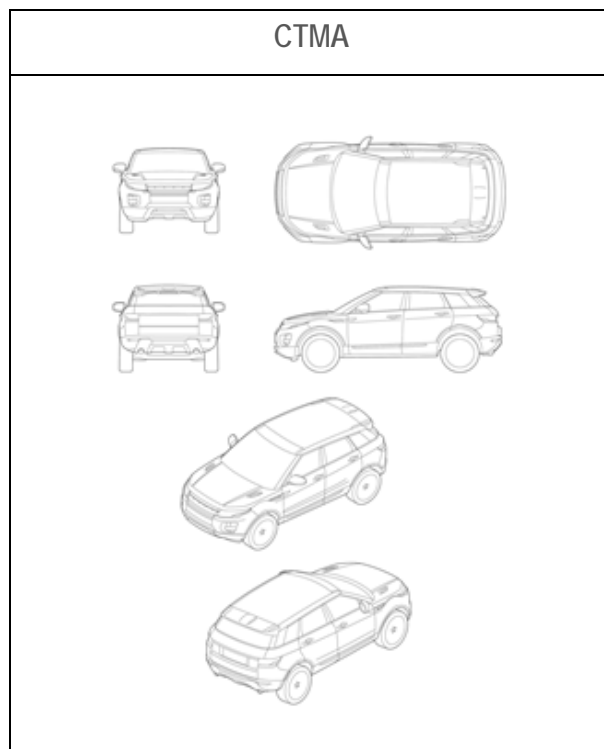
The CTM applicant sought to register the above 3D sign for goods in Classes 29 and 30. The examiner rejected the application. The First BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The criteria for assessing the distinctive character of 3D marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks. Nonetheless, average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Only a mark that departs significantly from the norm or customs of the sector is not devoid of any distinctive character (paras 32-34). The onus is on the CTM applicant to provide specific and substantiated evidence that the trade mark applied for has distinctive character, since it is much better placed to do so, given its thorough knowledge of the market (para. 36). It is not widely known that 'preserved, frozen, dried and cooked fruits and vegetables; milk products' in Class 29 are also offered with a variety of decorative elements, let alone ornaments as elaborate as faces and other anthropomorphic or zoomorphic elements, contrary to what the BoA essentially stated. Liquid or creamy milk products, such as yoghurts, cannot take such a shape. Preserved, frozen, dried and cooked fruits and vegetables are usually packaged and presented in their natural form, chopped, as coulis or in classic or functional geometric shapes, such as cubes, discs, pebbles, tiles, balls or coils. The exceptional nature of the habits in the sectors concerned involving presenting those goods in the shape of the mark applied for renders that mark capable of indicating the commercial origin (paras 56-60).

◆◆[T-381/13](#) and [T-382/13](#); **DAISY / MARGARITAS**, Judgment of 16 December 2015, *Perfetti Van Melle SpA v OHIM* – IT. The applicant sought the registration of the word marks 'DAISY' and 'MARGARITAS' in relation to 'pastries and confectionaries, caramel, sweets, chewing gum, licorice, lollipops, toffee, sugar, chocolate, cocoa, coffee' in Class 30. The examiner refused the trade mark in relation to the abovementioned goods on the basis of Article 7(1)(b) and (c) and Article 7(2) CTMR in relation to the English- and Spanish-speaking consumers in the EU. The examiner found that that part of the public would perceive the signs as a description of the shape of the goods. The examiner then withdrew the objection raised at the first time as far as it concerned 'caramel, sugar, chocolate, cocoa, coffee'. The BoA confirmed the examiner's decision in relation to the abovementioned goods. The BoA, however, found that the applications also had to be rejected in relation to 'caramel, sugar, chocolate, cocoa, coffee'. In that regard, the BoA found that, under Article 64(1) CTMR, it had to exercise the same competencies as the first instance. The applicant filed an action before the GC. The GC noted that,



according to the contested decision, the fact that the signs were devoid of any distinctive character derived directly from the finding that they had a descriptive character in relation to the shape of the goods. Therefore, in the absence of any autonomous reasoning in respect of Article 7(1)(b) CTMR, the decision has to be annulled also as far as that Article is concerned.

◆◆[T-629/14](#); **SHAPE OF A CAR (3D MARK)**, Judgment of 25 November 2015, *Jaguar Land Rover Ltd v OHIM* – EN.



The CTM applicant sought to register the above 3D mark as a CTM for goods, inter alia, in Classes 12 and 28. The examiner refused the application for some of the goods. The BoA annulled the examiner's decision insofar as it refused to register the CTM for 'apparatus for locomotion by air or water'. The CTM applicant filed an application before the GC for annulment of the BoA's decision. The goods at issue in Class 12 target the general public as well as professionals, and the goods at issue in Class 28 are aimed at the general public. While that relevant public will have a high degree of attention when purchasing the goods at issue in Class 12, in particular, on account of their price, their degree of attention will be average when acquiring the goods at issue in Class 28, which are generally relatively inexpensive (para. 22). The CTMA consists of a 3D graphic representation, namely of six line drawings of different perspectives of the body of a car. Furthermore, it does not contain any word or figurative element. The BoA correctly observed that it depicts an apparatus for locomotion by land and not an apparatus for locomotion by air or water. It must, therefore, be regarded as departing significantly from the norm and customs of the sector for 'apparatus for locomotion by air and water' and, consequently, as not being devoid of any distinctive character. The same reasoning also ought to have led the BoA to annul the examiner's decision as regards 'vehicles for locomotion by air and water' (paras 23-26).



III. Descriptive

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



The applicant sought to register the above figurative mark for goods in Class 32. The examiner refused to register the sign as a CTM on the basis of Article 7(1)(b) and (c) CTMR. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC based its analysis on Article 7(1)(c) CTMR and confirmed the assessment of the BoA. The relevant public is the English-speaking public of the EU and the average consumer of the EU (para. 23). The meaning of the verbal elements of the sign 'MELT WATER' and 'ORIGINAL' point the consumers to the goods in question, the mark informs the relevant public that the products of Class 32 are made of natural pure water coming from glacial meltwater (para. 26). In relation to the figurative elements of the sign, the GC approved the conclusion of the BoA that they are not distinctive, the rectangle is a form used in labels and that the font of the word 'original' is usual in labels for beverage packaging. As regards the colour blue, it is not a particular colour for the goods in question. Pure water is often described as being blue (para. 36). The GC concluded that the figurative elements were not more dominant than the verbal ones (para. 27). The sign is therefore descriptive for the goods on the basis of Article 7(1)(c) CTMR. As one of the absolute grounds is sufficient to reject the application, the BoA was correct in omitting to examine the ground of the violation of Article 7(1)(b) CTMR.

◆ [T-197/13](#); **MONACO**, Judgment of 15 January 2015, *Marques de l'État de Monaco (MEM) v OHIM* – FR. The IR holder, the Principality of Monaco was granted an IR designating the EU by WIPO. That registration, which was based on the word mark 'MONACO', was transferred to the Office on 24 March 2011. The goods and services concerned were in Classes 9, 12, 14, 16, 18, 25, 28, 35, 38, 39, 41 and 43. The examiner refused the IR designation for 'magnetic data carriers, paper and cardboard goods not included in other classes, printed matter, photographs, transport, travel arrangement, entertainment, sporting activities and temporary accommodation' in Classes 9, 16, 39, 41 and 43 on the basis of Article 7(1)(b) CTMR, considering that the word 'Monaco' could be used in trade to designate the origin, geographical destination or the place of supply of services, so that the trade mark has, in respect of the goods and services concerned, a descriptive character. The Principality of Monaco, which in the meantime has transferred the marks to *Les Marques de l'État de Monaco* (MEM), a Monegasque public limited company, contested the Office's decision before the BoA. The BoA dismissed the appeal. The IR holder filed an action before the GC relying on three pleas in law: (i) lack of reasoning under Article 75



CTMR; (ii) infringement of Article 7(1)(c) CTMR; and (iii) infringement of Article 7(1)(b) CTMR. As regards the violation of Article 7(1)(c) CTMR, first of all the GC analysed the claim that EU law was not applicable to Monaco and other similar grounds based on international law and held that under EU law, any legal entity, including a public law entity, may apply to benefit from the protection of the Community trade mark (para. 29). This is, not only true for companies based in the territory of a state that is not an EU Member State, but also for the non-member states themselves, since those states are, within the meaning of EU law, public law entities (para. 30). As a result, when the Principality of Monaco formulated its request to have the EU designated for the IR of the trade mark at issue, it placed itself within the scope of application of EU law and, therefore, one of the absolute grounds for refusal could be relied upon against it (para. 32). On the request to send a preliminary ruling to the CJ, although the GC considered it was not obliged to answer this ground it decided to examine why this claim could not be accepted (para. 36). Analysing Article 256 TFUE and Article 51 of the Statute of the CJ, the GC held that it was not competent to send preliminary rulings to the CJ and concluded that this ground was in any case inadmissible (paras 38 and 40). On the interest behind the prohibition of Article 7(1)(c) CTMR, the GC refused the argument of the Principality of Monaco that the interest behind the prohibition is not the interest of a third country such as Monaco, explaining that when the applicant filed an application it accepted that it would be judged by the EU regulation (paras 43-44). As regards the relevant public, the GC dismissed the argument that the public must be defined in relation to the concepts of reputation and luxury. The GC held that whoever the relevant public is, they will understand the term Monaco as a reference to the geographical territory located in Europe (para. 53). Moreover, it confirmed the analysis of the BoA when it defined the public and the level of attention taking into consideration the different products and services (para. 55). In respect of the descriptive character of the word MONACO, the GC confirms that the word 'monaco' corresponds to the name of a globally known principality, not least due to the renown of its royal family, its organisation of a Formula 1 Grand Prix and its organisation of a circus festival. Knowledge of the Principality of Monaco is even more established amongst EU citizens, notably on account of its borders with a Member State (France), its proximity to another Member State (Italy) and its use of the same currency as 19 of the 28 Member States, the euro. There is therefore no doubt that the word 'monaco' will evoke, regardless of the linguistic background of the relevant public, the geographical territory of the same name (para. 52). According to the GC, the Office was also correct to find that the word 'monaco' could be used, in trade, to designate origin, geographical destination or the place of supply of services, so that the trade mark has, in respect of the goods and services concerned, a descriptive character. Furthermore, as a descriptive mark is necessarily devoid of distinctive character, the GC holds that the trade mark 'MONACO' is devoid of distinctive character.

[T-610/13](#); **GREASECUTTER**, Judgment of 30 September 2015, *Ecolab USA, Inc., v OHIM* – EN. The IR holder sought the registration of the word 'GREASECUTTER' as an IR designating the EU for goods in Classes 3 and 5. The Office issued a notice of provisional refusal of protection in the EU of the word mark at issue, pursuant to Article 7(1)(b) and (c) CTMR. The IR holder filed a notice of appeal against that decision. The BoA allowed the appeal in part in respect of 'dentifrices' in Class 3 and 'preparations for destroying vermin; herbicides' in Class 5. However, it upheld the examiner's decision with respect to the other goods on the ground that the mark sought was descriptive of those goods within the meaning of Article 7(1)(c) CTMR and, since it was descriptive, it lacked distinctive character according to Article 7(1)(b) CTMR. The IR holder filed an action before the GC alleging, respectively, an infringement of Article 7(1)(c) and an infringement of Article 7(1)(b) CTMR. The GC confirmed the BoA's decision and dismissed the appeal. The GC noted, as the BoA did, that the term 'greasecutter' is made up of a juxtaposition of two distinct words from the English language, namely 'GREASE', meaning 'animal fat in a



soft or melted condition' and 'CUTTER', meaning 'a person or thing that cuts, in particular a person who cuts cloth for clothing'. In addition, the verb 'to cut' means, inter alia, 'to dissolve' or 'to break down' and the word 'greasy' was also used to refer to something that resembles grease, such as 'greasy hair' or 'greasy skin' (paras 24-26). Therefore, the GC upheld the BoA's finding that the mark at issue could be construed by the relevant public only as a combination of the two descriptive elements of which it is composed and whose meaning does not extend beyond what each of those elements means separately. Thus, the mark sought, taken as a whole, conveys to consumers, without further thought, that the goods covered by the trade mark application are goods that cut (dissolve) or reduce animal fat or greasiness and is thus directly descriptive of their nature, properties or intended use. The GC referred to the case law according to which although the term 'greasecutter' does not exist per se in any language of the EU Member States, it is a neologism, being composed of English words that are easily identifiable by the English-speaking public (para. 28). The GC also stated that the mere fact that there may be other terms that describe more precisely the characteristics of degreasers or scouring preparations, such as 'degreaser', 'grease remover' or 'scouring preparations', does not rule out the application of Article 7(1)(c) CTMR (para. 33). The BoA's references to the results of internet searches for the term 'greasecutter' must be viewed as being purely illustrative and not as having decisive value for establishing the descriptive character of the mark sought. It is not necessary that the sign is already be known as being descriptive; rather, it is sufficient that it could be used for such purposes for it to come within the scope of the absolute ground for refusal in Article 7(1)(c) CTMR (para. 34). The general and abstract list of the goods concerned necessarily encompasses goods which, by their nature, composition, packaging or effects, are intended specifically to remove fat or reduce greasiness. Thus, the purpose of 'bleaching preparations' and 'polishing and abrasive preparations' in Class 3 is to launder, wash or make clean, with the result that they eliminate or remove any greasy impurities. Although it is true that the latter goods are primarily intended to make a surface smooth, such an action will necessarily have the effect of removing any impurities, including possibly grease. 'Cosmetics' and 'hair lotions' in Class 3, and 'disinfectants' and 'fungicides' in Class 5, may have the effect of removing excess sebum produced by the skin and of removing or reducing greasiness (para. 37). Since the applicant did not set out any limitations excluding goods used to dissolve or reduce grease, the BoA was correct in considering that the goods for which registration was refused necessarily included such goods and accordingly concluded that the mark sought was descriptive within the meaning of Article 7(1)(c) CTMR (para. 38). Finally, the IR holder cannot deduct any rights from prior registrations in the USA or alleged Office practice, as the BoA is only bound by the law and not by prior Office practice. Besides, each case has to be judged upon its own merits (paras 39-44).

◆ [T-319/14](#); **RAUSCHBRILLE**, Judgment of 16 April 2015, *Drogenhilfe Köln Projekt gGmbH v OHIM* – DE. The applicant sought to register the word mark 'Rauschbrille' as a CTM for goods and services within Classes 9, 41 and 44. The examiner refused to register the word as a CTM on the grounds of Article 7(1)(b) and (c) CTMR. The BoA dismissed the applicant's appeal. As regards Article 7(1)(c) CTMR, it found that the term 'Rauschbrille' would be understood by the relevant public as 'glasses simulating alcohol intoxication' or 'glasses protecting from alcohol intoxication' and would not be perceived as more than a sum of its elements. Thus, the sign was found descriptive of glasses in Class 9. As regards Article 7(1)(b) CTMR, the BoA found that these glasses, which recreate intoxication or give their holders a feeling of artificial intoxication, could easily designate cultural events concerning a theme of drugs (Class 41) and could convey the idea of medical and psychological treatment to simulate intoxication during 'aversion therapy' (Class 44). Therefore, the BoA found that the sign lacked distinctive character under Article 7(1)(b) CTMR. The applicant filed an action before the GC. With regards to the



descriptive character of the sign under Article 7(1)(c) CTMR, the GC considers that the sign applied for is a neologism made up of the terms 'Rausch' and 'Brille'. Considering the German grammar rules, the relevant German-speaking public will clearly understand that the term designates 'glasses simulating alcohol intoxication' or 'glasses protecting from alcohol intoxication'. The GC confirms the BoA's finding that the sign is not a fancy term and has no additional meaning other than a sum of the two words used (para. 22). Therefore, the BoA correctly concluded that the sign applied for is descriptive of 'glasses' in Class 9 (para. 24).

[T-318/13](#); **LIFEDATA**, Judgment of 12 February 2015, *Vita Phone GmbH v OHIM – DE*. The applicant sought to register the word mark 'LIFEDATA' as a CTM for goods and services in Classes 10 and 44. The examiner refused the application on the ground that it was descriptive and lacked distinctive character according to Article 7(1)(c) and (b) CTMR. The BoA rejected the appeal based on Article 7(1)(b) CTMR. The GC dismissed the action. The GC confirmed all the findings of the BoA decision, namely, that the relevant public consisted of professionals of the medical and related technical sector and of general end consumers. The assessment had to be carried out against the English-speaking public and professionals of other Member States with sufficient command of English (para. 19). The mark was composed of current English terms which referred to a) to the condition of being alive and b) data and information, based on scientific work and used for analysis and calculation (para. 21). In English, compound nouns were often used (para. 23). The mark was just the sum of its parts (para. 26). It was immaterial that 'Lifedata' could be understood as a reference to biographical data. In connection with goods and services of the medical sector, it was likely that the public would link the sign with medical data. In any event, the descriptive content of one meaning was sufficient for the refusal (para. 33). Registrations of the United States Patent and Trademark Office (USPTO) were not relevant and the Office was not bound by previous decisions (paras 37-40). The goods in Class 10 had a common function, the capture and transmission of body values or biosignals. The use of such goods permitted the public to transmit and access data in spite of physical distance. The services in Class 44 were tele-medical services permitting the wireless capture and transmission of data of patients. The services could only be rendered with the goods. Thus, the common function of the goods and the fact that the services could only be rendered with the goods in question justified that the goods and services constituted a sufficient homogenised group permitting the BoA to motivate the non-distinctiveness of the sign in relation to all the goods and services together (para. 51).

◆ [T-106/14](#); **GREENWORLD**, Judgment of 27 February 2015, *Universal Utility GmbH & Co KG v OHIM – DE*. The applicant sought to register the word mark 'GREENWORLD' as a CTM for goods and services in Classes 4, 35 and 39. The examiner refused registration of the mark on the ground that it is descriptive and non-distinctive for the goods and services at stake. The relevant English consumers will understand the word 'green' not only as a colour, but also in a sense of 'environmentally friendly'. In its entirety, 'Greenworld' will therefore be understood as 'environmentally friendly world'. In relation to the relevant goods and services, the consumers will immediately perceive the descriptive content of the trade mark in a sense that the offered goods and services are environmentally friendly and help to build a more ecological world. As the mark is descriptive in its entirety, it also lacks distinctiveness. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC emphasised that it is not sufficient for a mark composed of several words that each element is descriptive on its own. Rather, the combination of the words must also be found to be descriptive as a whole (paras 17-18). The English-speaking public will understand 'green' and 'world' in their descriptive meaning. The combination



'Greenworld' complies with English grammar and syntax rules and does not add any new, non-descriptive meaning to the trade mark. The fact that 'green' has more meanings than just 'environmentally friendly' is irrelevant, as it is sufficient that the mark is descriptive in one possible meaning (para. 32). In the present case, in light of the goods and services and the relevant consumer perception, the application has been rightly found to be descriptive (Article 7(1)(c) CTMR). A decision concerning the alleged violation of Article 7(1)(b) CTMR is not necessary, as it is sufficient if one of the absolute grounds for refusal listed in Article 7 CTMR applies for the sign at issue not to be registrable as a Community trade mark (para. 40).

◆ [T-379/13](#); **NANO**, Judgment of 10 February 2015, *Innovation First, Inc. v OHIM* – EN. The applicant sought to register the word mark 'NANO' as a CTM, for goods and services in Classes 9, 28 and 41. The examiner rejected the CTM application for goods in Classes 9 and 28 on the ground of Article 7(1)(b) and (c) CTMR and the applicant filed an appeal. The BoA dismissed the appeal and upheld the contested decision. The BoA stated that consumers would perceive the word 'NANO' as 'extremely small', 'involving the use of nanotechnology' or as a mathematical prefix. It is not unusual that consumers associate this term with the extremely small size of the goods in question and, consequently, the mentioned term becomes a direct reference to that characteristic. Therefore, the term 'NANO' has a descriptive character within the meaning of Article 7(1)(c) CTMR. Concurrently, there is nothing vague or unusual about the word 'NANO' in relation to the goods for which registration is sought. This term is devoid of any distinctive character within the meaning of Article 7(1)(b) CTMR. The applicant filed an action before the GC relying on five pleas in law: (i) infringement of the right to be heard; (ii) infringement of the obligation to state reasons; (iii) breach of Article 76 CTMR insofar as the BOA decision was based on speculation; (iv) infringement of Article 7(1)(c) CTMR; and (v) infringement of Article 7(1)(b) CTMR. Concerning the fourth plea, as the BoA correctly found, the trade mark applied for refers to the 'extremely small size' of the goods at issue, but the applicant did not agree that this fact constitutes a descriptive indication within the meaning of Article 7(1)(c) CTMR. However, it is clear that the term 'NANO' is understood by the relevant public as referring to the size of the goods. It has acquired a meaning that diverges from its mathematically exact definition and, accordingly, from the reference to an 'extremely small size' and denotes, more generally, a 'small' size (para. 56). According to the GC, the BoA was entitled to base its findings on facts arising from practical experience generally acquired from the marketing of goods. The trade mark applied for may designate a characteristic of the goods at issue, which entails that it is descriptive of those goods, within the meaning of Article 7(1)(c) CTMR (paras 57-59). In those circumstances, there was not a need to assess the infringement of Article 7(1)(b) CTMR (the fifth plea) (para. 65). In the light of those facts, the GC upheld the contested decision.

◆ [T-72/14](#); **BATEAUX MOUCHES**, Judgment of 26 March 2015 – *Compagnie des bateaux mouches SA v OHIM* – FR. The IR holder sought to register the word mark 'BATEAUX MOUCHES' (river boats for sightseeing) as an IR designating the EU for services in Class 37. The examiner refused to register the mark on the basis of Article 7(1)(b) and (c) CTMR. The BoA dismissed the IR holder's appeal. The IR holder filed an action before the GC. On Article 7(1)(b) CTMR, the GC confirmed the analysis of the contested decision in relation to the relevant public and held that the services of Class 37 are addressed to a professional public who has a high level of attention. It also confirmed that since the sign was in French, the relevant public was the professional French-speaking public and not all foreign tourists as argued by the IR holder (paras 27 and 29). The GC also confirmed the meaning of the term *bateaux mouches* and its previous judgments on this point (see judgments of 10/12/2008, T-365/06,



EU:T:2008:559 and 21/05/2014, T-553/12, EU:T:2014:264). The fact that the company is the first to have used the term '*bateaux mouches*' as a mark does not change this finding. As regards Article 7(1)(c) CTMR, the GC confirmed the conclusion that was reached by the BoA that one ground is sufficient to justify the refusal of the mark.

◆ [T-188/14](#); **GENTLECARE**, Judgment of 21 January 2015, *Grundig Multimedia AG v OHIM* – EN. The applicant sought to register the word mark 'GentleCare' as a CTM for goods and services within Class 7. The examiner refused to register the word as a CTM based on Article 7(1)(b) and (c) CTMR with respect to part of the goods covered by the CTMA, namely 'machines for manufacturing, treating, scotching, tentering or washing fabrics, sewing machines and industrial robots with the same function as the machines referred to above; washing machines (laundry/dishwashing machines); electrical machines for cleaning floors and carpets, vacuum cleaners and their parts'. The BoA dismissed the applicant's appeal on the ground that the trade mark applied for was descriptive and devoid of any distinctive character. According to the BoA, the relevant public consisted of English-speaking consumers in the EU. The trade mark was composed of two words with a clear meaning in English. The characteristics described by the expression 'gentle care' were desirable with respect to the goods at issue, since the primary functions of the machines it designates are enhanced by the fact that they are carried out in a gentle manner. The applicant filed an action before the GC relying on two pleas in law i) infringement of Article 7 (1) (c) CTMR and ii) infringement of Article 7(1)(b) CTMR. As regards the first plea in law alleging an infringement of Article 7(1)(c) CTMR, the GC notes that the BoA correctly identified the English-speaking public as the relevant public, since the two words of the trade mark applied for are English (para. 22). The meaning of each of the words making up the expression 'gentle care' is clear and the juxtaposition of those two words is not particularly surprising or unusual (para. 23). Textiles, dishes, carpets and internal floors are, both at the stage of their manufacture and their maintenance, the subject of particular 'care' requiring a certain gentleness or attention. Thus, the public will expect the machines at issue to be capable of ensuring such care (para. 25-26). A direct connection between the expression 'gentle care' and the goods at issue has been therefore established (para. 30). Next, for application of Article 7 (1) (c), it is irrelevant whether the characteristics of the goods or services that are capable of being described by a sign are commercially essential or ancillary (para. 31). The expression 'gentle care' is not allusive but, on the contrary, contains direct information about the way the goods at issue operate (para. 35). Furthermore, contrary to the applicant's arguments, the Office is not obliged to prove that the sign for which registration as a CTM is sought is included in dictionaries. It is sufficient that the BoA applied the descriptiveness test, as interpreted by the case law, in order to reach its decision and it was not obliged to justify its action by the production of evidence (para. 41). Finally, the principles of equal treatment and sound administration must be consistent with respect for legality. For reasons of legal certainty and sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. Since the examination of the sign at issue in the light of that provision could not, in itself, lead to a different conclusion, the applicant's claims of a failure to take into consideration the registration of identical trade marks cannot succeed (paras 41-44). Based on the foregoing, the sign at issue was found descriptive. Since the application of one of the absolute grounds for refusal suffices for the sign at issue not to be registrable, it was not necessary to examine the second plea in law — infringement of Article 7(1)(b) CTMR (paras 46-47).



[T-292/14 and T-293/14](#); **XΑΛΛΟΥΜΙ / HALLOUMI**, Judgment of 7 October 2015, *Republic of Cyprus v OHIM* – EN. The CTM applicant sought to register the word marks 'XΑΛΛΟΥΜΙ' and 'HALLOUMI' for 'Cheese; milk and milk products' in Class 29. The examiner rejected the applications. The BoA dismissed the appeals. The CTM applicant filed an application before the GC for annulment of the decisions of the BoA. The finding of the BoA that the words 'HALLOUMI' and 'XΑΛΛΟΥΜΙ', in capital letters, refer to a speciality cheese from Cyprus and therefore directly describe, for the Cypriot public, the kind and geographical origin of the cheese, milk and milk products applied for must be upheld (paras 20-21). Certification marks could be registered as CTMs provided that there were no absolute grounds, within the meaning of Article 7(1) CTMR, preventing their registration. The applicant's argument that the BoA failed to mention that the CTMR did not preclude the registration of certification marks must, in any event, be rejected (para. 34). The fact that the applicant has been the proprietor of identical certification marks since 1992 has no bearing on the descriptive character of the signs at issue (para. 43). Even if some Cypriot consumers have for several years been perceiving the signs at issue as certification marks guaranteeing compliance with a specific set of legal requirements, that perception does not affect the descriptive character, for the purpose of Article 7(1)(c) CTMR, of the marks at issue for those consumers or, a fortiori, for other consumers who do not make the connection with the certification mark (para. 46). The general interest or public interest in keeping descriptive marks free for third parties to use is pre-established and presumed. It follows that, where the mark applied for is descriptive, it is sufficient for the BoA to make the finding of that descriptive character without, however, having to examine the question whether, notwithstanding its descriptive character, there is in fact a public interest in keeping the mark applied for free for third parties to use (para. 55).

◆ [T-374/13](#); **Moon**, Judgment of 4 February 2015, *KSR Kunststoff Rotation GmbH v OHIM* – DE. The contested trade mark was the registered CTM 'Moon' (word) (for 'lighting apparatus, in particular exterior and interior lights' (Class 11)). Both instances cancelled the CTM as being descriptive according to Article 7(1)(c) CTMR. The GC states that the submission of the intervener that the term, 'moon' would be descriptive outside of Germany is to be refused, since the evidence submitted during the administrative proceedings refers only to Germany. However the GC confirms that for the application of the absolute grounds of refusal it is sufficient if a sign is descriptive in only a part of the EU (para. 24). The GC states that the relevant point of time for the assessment in cases of cancellations based on absolute grounds for refusal is the filing date, however facts and circumstances after that moment may be taken into account if they give information on the situation at the relevant date (paras 28 and 29). In the case at hand there is evidence referring directly to the relevant date and also some evidence relating to a later moment but which confirms the descriptiveness of the term 'moon' at the relevant date (paras 30 and 31). The GC rejects the applicant's argument that the mark has been used as trade mark and not in a descriptive way. It makes clear that the fact that a sign is used as a mark does not mean that it is not descriptive in case of use in an isolated manner. The potential descriptive use of such a sign is enough for being considered as descriptive in the sense of Article 7(1)(c) CTMR (paras 42-44). The CTM system (Article 7(3) CTMR) provides for situations where a descriptive term is perceived as a trade mark because of the use made thereof. This Article has not been invoked by the applicant (para. 45). The GC makes clear that previous decisions are not binding and may not affect a decision that is well reasoned and in conformity with the law (paras 47-48).



◆ [T-648/13](#); **GLISTEN**, Judgment of 10 February 2015, *IOIP Holdings LLC v OHIM* – EN. The applicant sought to register the word mark ‘GLISTEN’ as a CTM for goods within Class 3. The examiner refused the registration on the ground that it did not comply with Article 7(1)(b) and (c) CTMR. The BoA confirmed the rejection. The applicant filed an action before the GC claiming an infringement of Article 7(1)(b) and (c) CTMR. As regards the descriptive character pursuant to Article 7(1)(c) CTMR of the word ‘glisten’, the BoA correctly noted that it means ‘to shine by reflecting light from a wet, oily or smooth surface’ and found that, rather than carrying out a grammatical analysis of the word ‘glisten’, consumers will focus on its meaning, which is unequivocal and which immediately informs them, without further reflection, of the purpose of the goods covered, namely to make objects shine. Thus, upon seeing the word ‘glisten’ associated with the various cleaning products covered by the mark applied for, the relevant public will understand that those cleaning products will be used to make objects being cleaned, such as dishwashers and microwave ovens, shine (paras 19 and 20). The fact that the mark applied for may have been registered in the USA is not capable of demonstrating that the BoA erred in the application of Article 7(1)(c) CTMR (para. 32). It is not necessary to examine the applicant’s second plea concerning the distinctive character of the mark applied for within the meaning of Article 7(1)(b) CTMR. It is clear from the wording of Article 7(1) CTMR that, if one of the absolute grounds for refusal listed in that provision applies, that suffices for the sign at issue not to be capable of registration as a CTM.

[T-448/13](#); **ESSENCE**, Judgment of 3 June 2015, *Bora Creations, SL, v OHIM* – EN. The word mark ‘ESSENCE’ was granted registration for a range of goods in Class 3. An application for invalidity filed on the grounds of Articles 7(1)(b) and (c) and 52(1)(a) was rejected by the CD. The BoA partially upheld the appeal and annulled the cancellation decision by declaring the CTM registration invalid for ‘hair colorants and hair tinters, soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for cleaning, care and beautification of the skin, scalp and hair, decorative cosmetics, nail varnishes, nail varnish removers and nail care products’ in Class 3. The CTM owner filed an appeal to the GC against the BoA’s decision as a whole. At the hearing, however, the owner limited the scope of its appeal to ‘decorative cosmetics and nail varnishes’. The GC dismissed the appeal. The GC confirmed the finding that the relevant public has an average level of attention. According to the dictionary definitions given by the BoA (in English and French), the word ‘ESSENCE’ refers to plant extracts which can be used as a scent or perfume and could also refer to a concentrate of such an extract. Thus, in its view, an ‘essence’ could be a more concentrated version of the main product (like a face cream), or a product consisting of a scent (like an eau de toilette), or could also be used in conjunction with a product that is scented and chosen on the basis of its scent, even though it may primarily serve other needs (like a soap). Furthermore, the word ‘essence’ is not an unusual or rarely used word and conveys a clear and unequivocal message concerning an attribute of the products in question (para. 26). The GC confirmed the case law according to which a sign may be refused registration on the basis of Article 7(1)(c) CTMR 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. In the present case, the goods concerned are cosmetic products and as such can contain or consist of extracts, in particular plant extracts, perhaps in the form of a concentrate or a perfume. Consequently, the BoA was entitled to hold that one of the possible meanings of the mark at issue would be a product manufactured on the basis of an essence or containing an essence, and that the connection between this meaning and the goods concerned is sufficiently direct and real to allow the relevant public to recognise directly, and without the need for further thought, the description of such a quality of the goods concerned, indeed of their nature (paras 31-32). More particularly, the BoA considered that for ‘decorative cosmetics’ the word ‘essence’ [was] descriptive not because those goods are necessarily scented but in the sense of it being a concentrate and that upon seeing these goods bearing the word



'essence', the public will perceive that they consist of a concentrated version of a cosmetic preparation or active ingredient (which usually also exists in an ordinary, non-concentrated form). As for 'nail varnishes', the BoA determined that they could also be produced from an extract that has the fundamental properties of a substance in concentrated form and that therefore the word 'essence' merely indicated the nature and content (an essential characteristic) of the product at issue (para. 35). Contrary to what the applicant stated, the mark at issue could be descriptive of 'decorative cosmetics' also in the sense that those products can be perfumed. Furthermore, it is to be noted that those goods represent a very broad category of products and not only those mentioned by the applicant during the hearing. In any event, 'decorative cosmetics and nail varnishes', as cosmetic goods, can contain or consist of extracts, in particular plant extracts, possibly in concentrated form, or be perfumed. This characteristic constituting a significant property, indeed quality, of the goods concerned, creates a direct real link between the mark at issue and the goods concerned (paras 39, 40). Therefore, the BoA did not err in finding that the mark at issue was descriptive of 'decorative cosmetics and nail varnishes' for the purpose of Article 7(1)(c) CTMR. As is evident from Article 7(1) CTMR, it is sufficient that one of the absolute grounds for refusal applies in order for the sign at issue not to be registrable as a CTM, there is no need to adjudicate on the second plea, alleging infringement of Article 7(1)(b) CTMR.

[T-140/14](#); **GEL NAILS AT HOME**, Judgment of 4 June 2015, *Bora Creations SL v OHIM* – DE. The applicant sought to register the word mark 'GEL NAILS AT HOME' as a CTM for goods and services within Classes 3, 8, 11 and 21. The examiner refused to register the word as a CTM on the ground of Article 7(1)(b) and (c) CTMR. The BoA dismissed the applicant's appeal. It found that the sign 'GEL NAILS AT HOME' as a whole was immediately understandable by the relevant public, who would perceive it as a description of the disputed goods intended for (gel) nail modelling at home. As a result, the BoA concluded that the sign was descriptive under Article 7(1)(c) CTMR and was devoid of distinctive character under Article 7(1)(b) CTMR. The applicant filed an action before the GC. With regards to the descriptive character of the sign, the GC considered that the combination of the two expressions 'gel nails' and 'at home' is generally understandable by the relevant English-speaking public (para. 22). The GC emphasised that the expression does not differ from general English grammar, is not a lexical invention and does not require any specific thinking to understand its meaning (para. 23.). As such, both the expressions taken apart and the sign taken as a whole are descriptive of the goods and services applied for (paras 23 and 25). As regards the goods and services applied for, the GC found that the BoA was right in considering that the message behind the sign in question concerned all the goods of the applicant, all of them being susceptible to be used to model nails at home or for care of gel nails at home (para. 28). Moreover, the argumentation of the applicant clearly proved that it understood that the ground of rejection of its CTMA applied to all the goods listed in the application (para. 29). Finally, as regards the claim of the applicant that the Office should be bound by its previous decisions, the GC dismissed it (paras 30-36). Since it is sufficient for the mark to be refused registration if one of the absolute grounds is applicable, the GC did not adjudicate on the second plea in law regarding Article 7(1)(b) CTMR (para. 39).

◆ [T-513/13](#); **SafeSet**, Judgment of 6 March 2015, *Braun Melsungen AG v OHIM* – DE. The applicant sought to register the word mark 'SafeSet' as a CTM for goods within Class 10 with a specification as follows: 'Medical infusion apparatus and instruments'. The examiner refused to register the word as a CTM on the ground of Article 7(1)(b) and (c) CTMR. The BoA dismissed the applicant's appeal finding the mark applied for descriptive and devoid of distinctive character. The applicant filed an action before the



GC. Regarding the claim on the infringement of Article 7(1)(c) CTMR, the GC confirmed that the relevant public is composed of English professionals in the health sector (para. 37). The term 'SafeSet' is a neologism resulting from the combination of two common English words, 'safe' and 'set'. This combination of words, formed by an adjective and a noun, is in compliance with English grammar rules and the very fact that there are no hyphens or spaces between the words 'safe' and 'set' will not prevent consumers from distinguishing these two words. Accordingly, there is no perceptible difference between the neologism 'SafeSet' and the mere sum of its parts (para. 38). Since the products in question are 'sets of sterile securely fastened elements or objects', it is clear that there is a sufficiently direct and specific relationship between the neologism 'SafeSet' and the products in question (para. 39). The GC also emphasised that it is not required that the mark applied for be in a dictionary or used in everyday language for it to be refused registration (para. 42). The registrability of a sign as a CTM must be assessed solely on the basis of the CTMR as interpreted by the EU judicature and not on the basis of a previous practice of the Office (para. 44). Since it is sufficient for the mark to be refused the registration if one of the absolute grounds is applicable, the BoA was not required to adjudicate on the claim regarding Article 7(1)(b) CTMR (paras 51-52).

◆ [T-593/13](#); **WINDER CONTROLS**, Judgment of 30 January 2015, *Siemag Tecberg Group GmbH v OHIM – DE*. The BoA confirmed the rejection of the word mark WINDER CONTROLS for goods and services in Classes 7, 9, 37, 41 and 42 pursuant to Article 7(1)(b) and (c) CTMR. The applicant filed an action before the GC. The GC dismissed the action. The request for the oral hearing in the application to the GC is inadmissible, as it must be made within one month after the closure of the written procedure, Rules of Procedure of the General Court (RPGC) (para. 13 et seq.). With regard to the alleged infringement of Article 7 (1)(b) CTMR, if all elements of the mark are descriptive, their combination is, in general, also descriptive, unless the overall impression of the mark differs from the mere sum of those elements (para. 28). The mark applied for consists of the words 'winder' and 'control', both being descriptive for the goods and services at issue (paras 35-36). The combination is not unusual (para. 37). The BoA did not infringe the duty to state the reasons. Even if the products in question are of different art, they can be all used with a 'winder control system' and therefore build a homogeneous group (para. 41). The mark is not distinctive, Article 7(1)(b) CTMR (para. 52 et seq.).

[T-137/13](#); **MEGARAIL**, Judgment of 28 April 2015, *Saferoad RRS v OHIM – DE*. The applicant sought to register the word mark 'MEGARAIL' as a CTM for goods and services in Classes 6, 19 and 37. The examiner refused the application in its entirety based on Article 7(1)(b) and (c) CTMR. The BoA partly annulled the examiner's decision, but upheld the decision for the majority of goods and services, namely all those related to 'crash barriers and guardrails'. For these goods and related services the CTMA was found to be descriptive and non-distinctive. The relevant consumers are undisputedly English-speaking professionals in the public sector, concerned with the acquisition of road security. 'MEGA' will be understood either as a particular size (of Greek origin) or in a meaning of 'big in importance or size', 'RAIL' refers to a track or fence. The composition 'MEGARAIL' in the context of the particular goods and services of road safety will be understood as denoting their size or high quality. It is descriptive and, thus, also devoid of distinctive character for the relevant goods and services. The applicant filed an action before the GC, claiming a violation of Article 7(1)(c) and (b) CTMR. With regard to the BoA's finding that 'MEGA' can be understood as 'particularly good', the GC confirmed that this meaning — despite belonging to informal 'slang' language — has become customary in trade and therefore will be understood by the relevant public with this meaning. This understanding is not in contradiction with the



technical nature of the goods and the conservative language expectations the public might generally have when safety products are at stake. Those expectations can only become relevant when specific technical features (e.g. the size) are concerned, but not if the element refers to the nature of the goods in a general way (para. 44). For Article 7(1)(c) CTMR to apply, it is not necessary that a specific technical feature of the goods is described, it is sufficient that the mark can serve to describe the nature of the goods (para. 48). The public will understand 'MEGARAIL' as a reference to particularly good crash barriers or guardrails (para. 51). As far as the applicant claims that the Office has previously accepted very similar marks, such as 'MEGARAILER', 'MAXIRAIL', 'EASYRAIL' or 'SUPERRAIL', the GC notes that the principle of equal treatment must be consistent with the principle of legality. For reasons of legal certainty and sound administration, the examination of any trade mark application must be stringent and full in each individual case (paras 57-61). That being said, the cases mentioned display a number of differences from the case at issue: 'MEGARAILER' contained further letters ('-ER'), which might have had an impact on the distinctiveness of the mark; furthermore the specification was different. The remaining cited signs were figurative marks and not word marks. Therefore, these cases are not comparable to the case concerned (paras 61-66). As one ground for refusal (Article 7(1)(c) CTMR) is sufficient for the refusal of the mark, it is not necessary to examine the second ground invoked by the applicant, namely Article 7(1)(b) CTMR (para. 68). Based on the foregoing, the action was dismissed.

[T-707/13](#) and [709/13](#); **BE HAPPY**, Judgment of 30 April 2015; *Steinbeck GmbH v OHIM* – DE. The applicant for invalidity requested the declaration of invalidity of two CTMs, both consisting of the expression 'BE HAPPY' (word) and covering goods in Classes 9, 11, 16, 18, 21, 28 and 30. The registration would have been in breach of Article 7(1)(b) CTMR. Both instances cancelled the CTMs as being devoid of distinctive character. The GC confirms the BoA in the sense that the sign conveys a clear message, namely 'to be happy', which will also be understood by the German-speaking public. Moreover, this expression is also customary in Germany and often used in trade (para. 27). The applicant's argument that the expression is unusual and does not say anything is therefore rejected as unfounded. The expression is grammatically correct and understood as an invitation to be happy and consequently is a promotional message to buy the goods covered by the mark (paras 30-31 and 33). The further argument that the expression would be original and short and as such remembered by the consumers as an indication of the origin of the goods is rejected by the GC. It is a laudatory phrase in common parlance that immediately refers to a positive feeling related to the goods (paras 39 and 40). The fact that the marks have been used as trade marks is irrelevant, since the assessment as to the absolute grounds for refusal is independent from the use of the sign (para. 52). The GC further confirms the approach taken by the BoA that the marks may be used by anyone in a descriptive manner, which means that the consumers will directly establish a link to the goods and not to the producer (para. 59). However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely to his or her 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 (paras 62-65).



◆♦[T-611/13](#); **HOT**, Judgment of 15 July 2015; *Australian Gold LLC v OHIM* – DE.



The applicant registered the figurative mark represented above as an IR designating the EU for goods in Classes 3 and 5. An application for invalidity was filed based on Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) and (c) CTMR. The CD partly upheld the application for invalidity. The BoA partly upheld the CTM proprietor's appeal. The invalidity applicant filed an action before the GC. On substance, the GC decided that the BoA correctly found that 'hot' describes, within the meaning of Article 7(1)(c) CTMR, the effect produced by massage oils, gels and lubricants for pharmaceutical use (paras 40-41). However, massage oils and gel form part of the CTM's specification, which reads in French: 'parfums, huiles essentielles, cosmétiques, notamment shampoings, gels pour la douche, lotions pour le corps, huiles de massage, gels, crèmes pour le visage.' According to the GC, the BoA therefore failed to draw the consequences of the CTM's descriptiveness as regards massage oils and gels for those remaining goods. The term 'notamment' refers to all the three preceding goods 'parfums, huiles essentielles, cosmétiques' since they are listed with a comma in between them rather than a semicolon which separates 'parfums' from the other preceding goods. In addition, there is a direct and specific link between these three goods in that 'parfums' and 'huiles essentielles' constitute 'cosmétiques' since the latter can be defined as products that come into contact with the body's surface in order to care for and to beautify it. This definition also applies for massage oils and gels. Therefore, according to the GC, the BoA erroneously dismissed the descriptiveness of the IR for 'parfums, huiles essentielles, cosmétiques, notamment shampoings, gels pour la douche, lotions pour le corps, huiles de massage, gels, crèmes pour le visage' (para. 42-48). By contrast, the IR does not describe the goods 'préparations pour blanchir et autres substances pour lessiver; savons' and 'produits pour compléter l'alimentation (à usage médical)' since they do not have a hot temperature in nature. They are also not characterised by being used in a hot temperature only since they may be used in colder temperatures as well, which consumers may actually prefer. Other possible meanings of 'hot', such as modern, attractive or sexy are not descriptive for these goods. Even if they convey positive connotations, these meanings remain too vague. Furthermore, the fact that the goods may be sold in sex shops is irrelevant for the descriptive character since this point of sale is not indicated in the goods' specification (paras 49-51). As regards the IR's distinctive character under Article 7(1)(b) CTMR, the claimed promotional character of 'hot' on its own is insufficient for this provision to apply (paras 53-58). According to established case law, national administrative and judicial decisions are not binding for the BoA. This is not put into question by Regulation No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters or by Article 109 CTMR. As follows from recital 15 of Regulation No 44/2001, this regulation merely seeks to avoid contradictory judicial decisions in two Member States and is thus not applicable for the Office. Article 109 CTMR prevents contradictory results in infringement proceedings as regards the effects of Community and national marks and thus does not concern the requirements for their protection. A national decision refusing protection for a national mark



corresponding to the CTM does not give rise to an application of an absolute ground of protection under Article 7(2) CTMR (paras 59-63).

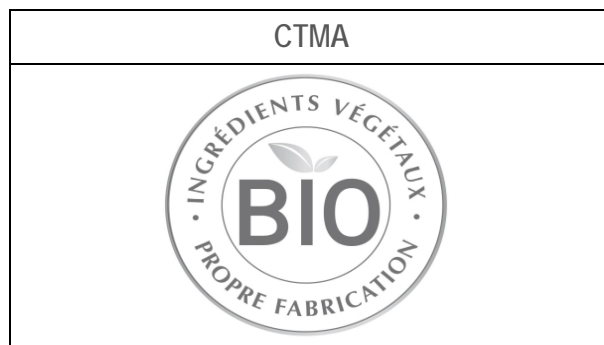
[T-822/14](#); **Cottonfeel**, Judgment of 23 October 2015, *Geilenkothen Fabrik für Schutzkleidung GmbH v OHIM* – DE. The applicant sought to register the word mark ‘Cottonfeel’ for the goods ‘protective clothing for rescue services, care services and disaster protection’ in Class 9. The examiner refused to register the word as a CTM on the ground that it indicates the comfort offered by the protective clothing, namely to feel like cotton. The BoA dismissed the applicant’s appeal, and so did the GC. The goods are directed at professionals with a high degree of attention. For the purpose of the assessment, the relevant public consist of the English-speaking part of the EU (para. 21). ‘Cottonfeel’, a simple juxtaposition of two easy to understand terms combined in accordance with rules of syntax and grammar (para. 34), will be understood as a reference to the protective clothing’s material, which is similar to cotton and feels like it (para. 26). Contrary to the applicant’s claim, the BoA did not base its finding on the fact that the protective clothing is actually made from cotton, which, incidentally, could be the case as shown by the applicants’ own website offering protective clothing made from cotton (para. 27). Protective clothing is worn instead of or complementary to normal clothing and must thus be equally comfortable and ergonomical, which is important during emergency operations that may last hours or even days (para. 29).

◆ [T-187/14](#); **FLEX**, Judgment of 7 October 2015, *Sonova Holding AG v OHIM* – EN. The applicant sought the registration of the word mark ‘FLEX’ for ‘hearing aids and hearing aids components; hearing aids accessories; parts and fittings for the aforesaid’ in Class 10. The examiner’s decision, rejecting the application for registration in its entirety based on Article 7(1)(c) and Article 7(2) CTMR, was confirmed by the BoA. The applicant filed an action before the GC alleging an infringement of Article 7(1)(c) and Article 7(2) CTMR. The GC confirmed the BoA’s decision and dismissed the appeal. The GC then refused the applicant’s complaint that the decision was in breach of the principles laid down in the Guidelines relating to procedures before the Office (Part B, Section 7, paragraph 7.3.1), according to which, in order to refuse abbreviations, ‘it is not only necessary for the examiner to show that the abbreviation is actually a composition of terms which on their own are purely descriptive, but in addition it must be shown that this abbreviation is commonly used or at least understood by the relevant specialists in the field, as an abbreviation identifying the goods as to their characteristics’. The GC held that according to the Guidelines it is not necessary to show common use of an abbreviation, but suffices that an abbreviation be understood by a not insignificant number of persons amongst the relevant public. Moreover, the Office Guidelines cannot prevail over the provisions of the Regulation and, finally, the question whether the Office Guidelines refer or do not refer to relevant GC judgments is irrelevant for the outcome of the present proceedings (paras 31-34). In reply to the applicant’s argument that the BoA has not shown that the term ‘flex’ was the short form of an adjective meaning ‘flexible’, the GC held that the question whether the term ‘flex’ is cited in dictionaries, as a short form or affix of the words ‘flexible’ or ‘flexibility’, is not relevant since it is not usual for abbreviations to be defined in dictionaries (para. 17). Neither is it necessary for the sign to be caught by the prohibition to be used correctly as regards its grammatical form or its spelling. It is sufficient that the relevant public understand, immediately and without the need of any particular intellectual effort, the word ‘flex’ as an abbreviation of the words ‘flexible’ or ‘flexibility’, even if such usage is unusual or grammatically or orthographically incorrect (para. 20). The GC found that the word ‘flex’ must be regarded as the root or fundamental part of the word ‘flexible’ and can also exist as a short form of the latter. As the BoA therefore rightly held, ‘flex’ will be perceived by the relevant anglophone public as meaning ‘flexible’ or invoking or making reference to



the concept of 'flexibility'. The consumer, presented with hearing aids, will attribute the meaning of 'flexible' or 'flexibility' to the word 'flex' and will understand it as a reference to the physical comfort and adjustable character, both as regards the physical shape and the volume, of those aids or of their accessories (paras 21-23). In relation to the applicant's argument that the refusal to register the mark applied for was incorrectly based on evidence drawn from American rather than English sources, the GC held that, first, the BoA is not obliged to prove that the mark applied for appears in the dictionary. The finding that the consumer, faced with the goods concerned, would logically associate that word with the terms 'flexible' or 'flexibility' was logical, is relevant and consistent and suffices, in itself, to demonstrate the concrete possibility that the mark sought could be understood as a description of the goods that it designates. Second, as the Office correctly observes, the fact that the term 'flex' is referred to as an abbreviation of the word 'flexible' in an American dictionary, is further evidence that it is possible that the word may be used in that sense by an anglophone public, including that made up of consumers from the United Kingdom, Ireland and Malta (paras 25-27).

[T-30/14](#); **BIO – INGRÉDIENTS VÉGÉTAUX – PROPRE FABRICATION**, Judgment of 10 September 2015; *Laverana GmbH & Co. KG v OHIM* – DE.



The applicant sought to register the figurative mark depicted above for, inter alia, goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7(1)(b) and (c) CTMR. Concerning Article 7(1)(c) CTMR, the GC states as to the meaning of the expression 'bio' that it refers clearly to a production with natural ingredients or to the respect of ecological values. See Cases T-586/08, 'BIOPIETRA', and T-427/11, 'BIODERMA' (para. 20). The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological, contain vegetal ingredients and are produced by the proprietor itself (para. 21). The GC rejects the plea of deficient reasoning, because the contested decision identified the different homogeneous groups with the goods and reasoned why the sign is descriptive for each of those categories (para. 22). As far as the applicant's plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not sufficiently attract the attention of consumers. Due to the meaning of the verbal elements, consumers will perceive the sign as descriptive (para. 23). The applicant's complaint that the BoA held the sign as being a quality emblem has been rejected, since the BoA did not categorise the sign as such, which in any case was not decisive for the assessment as a descriptive sign (para. 24). Concerning the previous decision to which the applicant refers, the following applies: However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her 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 (para. 25).

[T-568/14](#); **BIO – FLUIDE DE PLANTE – PROPRE FABRICATION**, Judgment of 10 September 2015, *Laverana GmbH & Co. KG v OHIM – DE*.

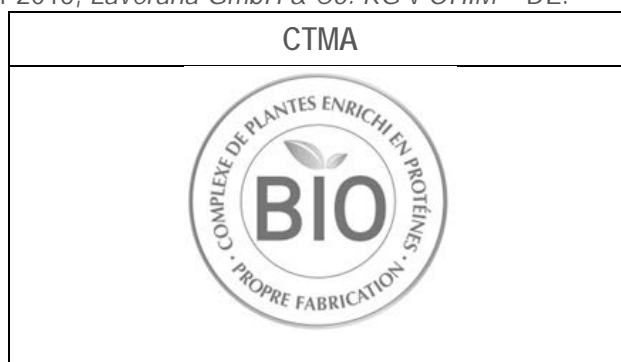


The applicant sought to register the figurative mark depicted above for, inter alia, goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7(1)(b) and (c) CTMR. Concerning Article 7(1)(c) CTMR, the GC states as to the meaning of the expression 'bio' that it refers clearly to a production with natural ingredients or to the respect of ecological values. See Cases T-586/08, 'BIOPIETRA', and T-427/11, 'BIODERMA' (para. 17). The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological, contain plant fluid and are produced by the proprietor itself (para. 18). The GC rejects the plea of deficient reasoning, because the contested decision identified the different homogeneous groups with the goods and reasoned why the sign is descriptive for each of those categories (paras 19 and 20). As far as the applicant's plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not sufficiently attract the attention of consumers. Due to the meaning of the verbal elements, the consumers will perceive the sign as descriptive (para. 20). The applicant's complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not categorise the sign as such, which in any case was not decisive for the assessment as descriptive sign (para. 21). Concerning the previous decision to which the applicant refers, the following applies: However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her 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 (para. 22). As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7(1)(c) CTMR serves the interest of the protection of competitors (para. 26)

T-569/14; **BIO – COMPLEXE DE PLANTES ENRICHI EN PROTEINES – PROPRE FABRICATION**, Judgment of 10 September 2015, *Laverana GmbH & Co. KG v OHIM – DE*.

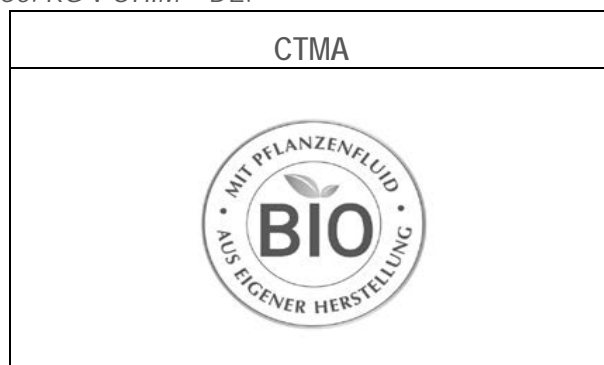


The applicant sought to register the figurative mark depicted above for, inter alia, goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7(1)(b) and (c) CTMR. Concerning Article 7(1)(c) CTMR, the GC states as to the meaning of the expression 'bio' that it refers clearly to a production with natural ingredients or to the respect of ecological values. See Cases T-586/08, 'BIOPIETRA', and T-427/11, 'BIODERMA' (para. 17). The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological, contain a plant complex with proteins and are produced by the proprietor itself (para. 18). The GC rejects the plea of deficient reasoning, because the contested decision identified the different homogeneous groups with the goods and reasoned why the sign is descriptive for each of those categories (para. 19). As far as the applicant's plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not sufficiently attract the attention of consumers. Due to the meaning of the verbal elements, consumers will perceive the sign as descriptive (para. 20). The applicant's complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not categorise the sign as such, which in any case was not decisive for the assessment as descriptive sign (para. 21). Concerning the previous decision to which the applicant refers, the following applies: However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her 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 (para. 22). As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7(1)(c) CTMR serves the interest of the protection of competitors (para. 26).

[T-570/14](#); **BIO – MIT PFLANZENFLUID – AUS EIGENER HERSTELLUNG**, Judgment of 10 September 2015, *Laverana GmbH & Co. KG v OHIM* – DE.



The applicant sought to register the figurative mark depicted above for, inter alia, goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7(1)(b) and (c) CTMR. The GC states as to the meaning of the expression 'bio' that it refers clearly to a production with natural ingredients or to the respect of ecological values. See Cases T-586/08, 'BIOPIETRA', and T-427/11, 'BIODERMA' (para. 17). The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological, contain plant fluid and are produced by the proprietor itself (para. 18). The GC rejects the plea of deficient reasoning, because the contested decision identified the different homogeneous groups with the goods and reasoned why the sign is descriptive for each of those categories (para. 19). As far as the applicant's plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not sufficiently attract the attention of consumers. Due to the meaning of the verbal elements the consumers will perceive the sign as descriptive (para. 20). The applicant's complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not categorise the sign as such, which in any case was not decisive for the assessment as descriptive sign (para. 21). Concerning the previous decision to which the applicant refers, the following applies: However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her 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 (para. 22). As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7(1)(c) CTMR serves the interest of the protection of competitors (para. 26).

[T-571/14](#); **BIO – PROTEINREICHER PFLANZENKOMPLEX – AUS EIGENER HERSTELLUNG**, Judgment of 10 September 2015, *Laverana GmbH & Co. KG v OHIM – DE*.



The applicant sought to register the figurative mark was depicted above for, inter alia, goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7(1)(b) and (c) CTMR. The GC states as to the meaning of the expression 'bio' that it refers clearly to a production with natural ingredients or to the respect of ecological values. See Cases T-586/08, 'BIOPIETRA', and T-427/11, 'BIODERMA' (para. 17). The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological contain plant fluid and are produced by the proprietor itself (para. 18). The GC rejects the plea of deficient reasoning, because the contested decision identified the different homogeneous groups with the goods and reasoned why the sign is descriptive for each of those categories (para. 19). As far as the applicant's plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not sufficiently attract the attention of consumers. Due to the meaning of the verbal elements, the consumers will perceive the sign as descriptive (para. 20). The applicant's complaint that the BoA held the sign as being a quality emblem has been rejected since the BoA did not categorise the sign as such, which in any case was not decisive for the assessment as a descriptive sign (para. 21). Concerning the previous decision to which the applicant refers, the following applies: However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her 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 (para. 22). As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7(1)(c) CTMR serves the interest of the protection of competitors (para. 26).

[T-572/14](#); **BIO – CON ESTRATTI VEGETALI**, Judgment of 10 September 2015; *Laverana GmbH & Co. KG v OHIM* – DE.

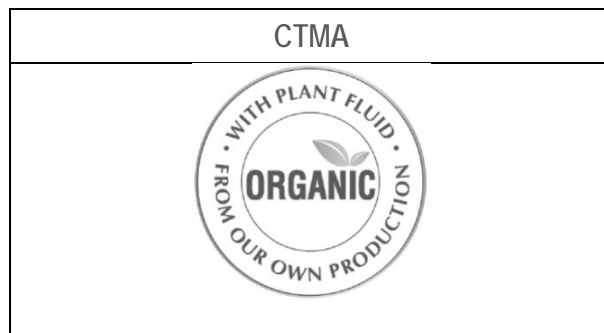


The applicant sought to register the figurative mark was depicted above for, inter alia, goods in Classes 3 and 5. Both instances refused registration of the mark according to Article 7(1)(b) and (c) CTMR. The GC states as to the meaning of the expression 'bio' that it refers clearly to a production with natural ingredients or to the respect of ecological values. See cases T-586/08, 'BIOPIETRA', and T-427/11, 'BIODERMA' (para. 17). The GC further points out that the BoA correctly assessed the meaning of the verbal parts with respect to the goods in the sense that they are ecological, contain a plant extract and are produced by the proprietor itself (para. 18). The GC rejects the plea of deficient reasoning, because the contested decision identified the different homogeneous groups with the goods and reasoned why the sign is descriptive for each of those categories (para. 19). As far as the applicant's plea that the figurative elements have not been taken into account is concerned, the GC notes that they are banal or merely reinforce the descriptive meaning of the verbal elements. Following the constant case law, these elements are not able to distract from the descriptiveness conveyed by the sign and will therefore not attract sufficiently the attention of consumers. Due to the meaning of the verbal elements the consumers will perceive the sign as descriptive (para. 20). The applicant's complaint that the BoA held the sign as being a quality emblem has been rejected, since the BoA did not categorise the sign as such, which in any case was not decisive for the assessment as descriptive sign (para. 21). Concerning the previous decision to which the applicant refers, the following applies: However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her 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 (para. 22). As to the alleged abuse of the discretionary power by refusing the registration based on considerations of unlawful competition, the GC states that this has not been substantiated and secondly the correct application of Article 7(1)(c) CTMR serves the interest of the protection of competitors (para. 26).

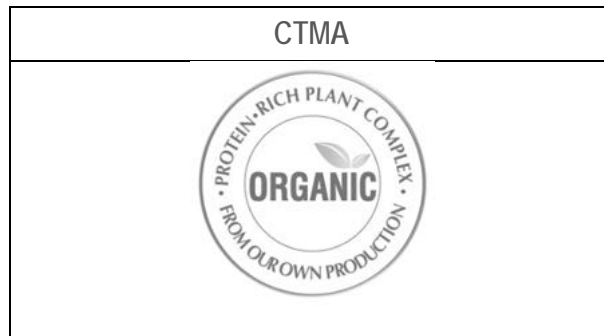
[T-608/14](#); **ORGANIC WITH PLANT FLUID**, Judgment of 10 September 2015; *Laverana GmbH & Co. KG v OHIM* – DE.



The BoA confirmed the decision of the examiner rejecting the registration of the CTM application represented above for goods in Classes 3 and 5 pursuant to Article 7(1)(b) and (c) CTMR. The word elements are descriptive and the figurative elements do not add to a distinctive character of the sign. The CTM applicant filed an action before the GC claiming the infringement of Article 7(1)(b) and (c) CTMR. The GC dismissed all arguments of the CTM applicant. The verbal elements have a clear semantic meaning related to characteristics of the goods (para. 17). The reasoning of the challenged decision addresses homogeneous groups of claimed goods (para. 19). The graphical elements cannot distract from the descriptive character of the verbal element (para. 20 with broad indications of further case law). The previous registrations on which the CTM applicant relies are not comparable and not binding for the Office. The GC referred to the case law of the CJ and its own case law and emphasised that there is no right to 'equality in injustice' (paras 22-23).

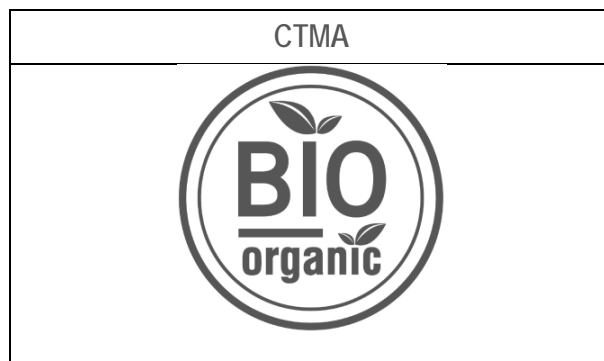


[T-609/14](#); **ORGANIC PROTEIN RICH PLANT COMPLEX**, Judgment of 10 September 2015; *Laverana GmbH & Co. KG v OHIM* – DE.



The BoA confirmed the decision of the examiner rejecting the registration of the CTM application represented above for goods in Classes 3 and 5 pursuant to Article 7(1)(b) and (c) CTMR. The word elements are descriptive and the figurative elements do not add to the distinctive character of the sign. The CTM applicant filed an action before the GC claiming the infringement of Article 7(1)(b) and (c) CTMR. The GC dismissed all the arguments of the CTM applicant. The verbal elements have a clear semantic meaning related to characteristics of the goods (para. 17). The reasoning of the challenged decision addresses homogeneous groups of claimed goods (para. 19). The graphical elements cannot distract from the descriptive character of the verbal element (para. 20 with broad indications of further case law). The previous registrations on which the CTM applicant relies are not comparable and not binding for the Office. The GC referred to the case law of the CJ and its own case law and emphasised that there is no right to 'equality in injustice' (paras 22-23).

[T-610/14](#); **BIO ORGANIC**, Judgment of 10 September 2015, *Laverana GmbH & Co. KG v OHIM* – DE.



The BoA confirmed the decision of the examiner rejecting the registration of the CTM application represented above for goods in Classes 3 and 5 pursuant to Article 7(1)(b) and (c) CTMR. The word elements are descriptive and the figurative elements do not add to the distinctive character of the sign. The CTM applicant filed an action before the GC claiming infringement of Article 7(1)(b) and (c) CTMR. The GC dismissed all the arguments of the CTM applicant. The verbal elements have a clear semantic meaning related to characteristics of the goods (para. 17). The reasoning of the challenged decision addresses homogeneous groups of claimed goods (para. 19). The graphical elements cannot distract from the descriptive character of the verbal element (para. 20 with broad indications of further case law).



The previous registrations on which the CTM applicant relies are not comparable and not binding for the Office. The GC referred to the case law of the CJ and its own case law and emphasised that there is no right to 'equality in injustice' (paras 22-23).

[T-707/14](#); **DetergentOptimiser**, Judgment of 25 September 2015, *Grundig Multimedia AG v OHIM* – EN. The applicant sought to register the word 'DetergentOptimiser' as a CTM for goods and services in Class 7. The OD rejected the application on the basis of Article 7(1)(b) and (c) and Article 7(2) CTMR. The BoA dismissed the applicant's appeal on the ground of Article 7(1)(c) CTMR. The applicant filed an application for annulment before the GC on the basis of infringement of Article 7(1)(b) and (c) CTMR. The GC dismissed the action. According to the judgment, the relevant public is the English-speaking public. The sign must have distinctive character throughout the EU in order to be registered as a CTM following its unitary character, a mark is not to be registered if it lacks distinctive character in a part of the EU. The sign is incompatible with the CTMR and it is descriptive for the goods concerned. The application could be dismissed without ruling on existence of an absolute ground of refusal under Article 7(1)(b) CTMR providing the sign is descriptive.

[T-563/14](#); **ELITEDISPLAY**, Judgment of 22 October 2015, *Hewlett Packard Development Company LP v OHIM* – EN. The applicant sought to register as a CTM the word 'ELITEDISPLAY' for the goods in Class 9. The examiner rejected the CTM application for all the goods. The BoA dismissed the applicant's appeal against the decision of the examiner. The applicant filed an action before the GC. The GC ruled that the relevant public is the English-speaking public of the EU (para. 23). The GC also held that in English — the simple combination of the components 'elite' and 'display', brought together in the mark applied for, did not constitute an unusual variation from a syntactic or semantic point of view, and that that combination would not result in a specific meaning different from that conveyed by the two components (para. 27). Furthermore, according to the GC, the word 'elite' refers to the notion of exclusivity and one of the possible meanings of the word 'display' calls to mind a computer screen or similar piece of equipment that shows information (paras 28-30). Therefore, the sign would present a sufficiently close link with the goods designated by the mark applied for, namely computer monitors and displays, for that sign to fall within the scope of the prohibition laid down in Article 7(1)(c) CTMR (para. 31). As regards the applicant's arguments relating to previous decisions of the Office accepting registration of marks containing the word 'elite', the GC referred to the established case law stating that, the question of whether a sign may be registered as a CTM must be assessed solely on the basis of the CTMR, as interpreted by the EU courts, and not on the basis of any previous practice of the BoA (para. 35).

[T-470/14](#); **ELITEPAD**, Judgment of 22 October 2015; *Hewlett Packard Development Company LP v OHIM* – EN. The applicant sought to register as a CTM the word 'ELITEPAD' for the goods in Class 9. The examiner rejected the CTM application for all the goods. The BoA dismissed the applicant's appeal against the decision of the examiner. The applicant filed an action before the GC. The GC ruled that the relevant public is the English-speaking public of the EU. (para. 20). The GC also held that in English, the simple combination of the components 'elite' and 'pad', brought together in the mark applied for, did not constitute an unusual variation from a syntactic or semantic point of view, and that that combination would not result in a specific meaning different from that conveyed by the two components (para. 24). Furthermore, according to the GC, the word 'elite' refers to the notion of exclusivity and one of the possible meanings of the noun 'pad' is panel or patch of material which is constructed so as to be



responsive to pressure or touch (paras 26-27). Therefore, the sign would be understood by the relevant public as referring to computers or computer hardware containing a panel which is responsive to pressure or touch and which is exclusive or has exclusive and special characteristics or which is of excellent quality (para. 28). Thus, it stated that the sign presents a sufficiently close link with the goods designated by the mark applied for for that sign to fall within the scope of the prohibition laid down in Article 7(1)(c) CTMR (para. 29). As regards the applicant's arguments relating to previous decisions of the Office accepting registration of marks containing the word 'elite', the GC referred to the established case law stating that, the question of whether a sign may be registered as a CTM must be assessed solely on the basis of the CTMR, as interpreted by the courts of the EU, and not on the basis of any previous practice of the BoA (para. 33).

[T-520/14](#); **RACE GTP**, Judgment of 25 November 2015; *bd breyton-design GmbH v OHIM* – DE. The applicant sought the registration of the CTM 'RACE GTP' (word) for goods in Class 12. The First Instance refused the application as being descriptive and without the necessary distinctive character (Article 7(1)(b) and (c) CTMR). The BoA upheld that decision. The GC states as to the relevant public and its attention, that the goods 'aluminium rims not for car races or for motor vehicles without approval for road service' (Class 12) are nowadays standard accessories of cars so that the target public are all consumers interested in cars. This category includes car fanciers, also those who like car racing and fanciers of car tuning. Moreover the goods are also directed at experts in the car market, in particular car producers and car suppliers, as well as professionals in the car tuning sector (para. 20). The GC clarifies that even for the public with an average knowledge of cars, and without being a professional, the attention will be high rather than average, as claimed by the applicant. The goods will not be acquired constantly, require a certain economic effort and have an aesthetic character. With more reason, the car fanciers and experts in the automobile sector will have an even higher degree of attentiveness (paras 22 and 23). With respect to the meaning of the applied for sign and on how the public will perceive it, the GC states that the term 'RACE' will be understood with respect to the goods as 'sportive driving or design' and as 'racing cars' in general (para. 28). The GC further concludes that the letters 'GT' denote 'Grand Tour' or 'Gran Turismo' in the field of automobiles. This meaning will be understood at least by the experts in the field and since this public is not an insignificant part of the relevant consumers, it is not necessary to further examine whether the other sectors of the public will also have the same understanding (para. 29). The abbreviation 'GTP' refers — as the BoA has stated — to 'Gran Turismo Prototype' and describes a certain type of racing car which has been used in a racing series in the USA between 1981 and 1993 (para. 30). The applicant contends that these races belong to the past and are therefore forgotten and secondly that these races were in the USA and not in the relevant market, namely the EU. The GC rejects these arguments, because those who like car races will know this racing series, even if it referred to the USA. These circles are not only interested in car races within the EU but also in others held outside the Internal Market (paras 31-35).

[T-636/13](#); **MovieStation**, Judgment of 23 October 2015, *TrekStor Ltd v OHIM* – DE. The CTM proprietor registered the word mark 'MovieStation' for products in Class 9. The invalidity applicant claimed that the mark was invalid. The CD upheld the application. The BoA dismissed the appeal. The CTM proprietor filed an application before the GC for annulment of the decision of the BoA. It is necessary to rely on the understanding of the public of the United Kingdom and Ireland, as the terms composing the sign are in English (para. 21). Given the meaning of term 'station' in the ordinary language and the fact that such a



term is already used in the English electronic language, in particular in the expression 'workstation', the term 'station', is commonly known in the technical and computer field as referring to a technical system as a whole, of a local apparatus or of a control centre carrying out or controlling important functions and procedure (para. 27). The combination of the terms 'movie' and 'station' will be understood as indicating an apparatus, a centre of control for films, that is for their display and management (para. 35). There is no perceptible difference between the expression 'moviestation' and the sum of its parts (para. 38). The sign is descriptive of the products covered by the mark as it can indicate their kind, intended purpose, way of functioning or quality. Indeed, the BoA correctly held that such products consist in apparatus (centres of control) for films or the display and management of films (para. 39). It is irrelevant whether the term 'station' could refer to a fixed or stationary entity, since it suffices that the sign is descriptive in at least one of its meanings (para. 42). It is irrelevant whether web surfers use the term 'MovieStation' as a search term in search engines, since it suffices that the expression 'moviestation' can be understood as a descriptive indication of the products. Likewise, it is irrelevant whether the signs composing the mark are actually used for descriptive purposes at the time of the TM application (paras 46-48). It is irrelevant whether the mark is descriptive only in respect of a small part of the products covered by the mark, since it suffices that the relevant products could be of such a nature as to read films (paras 51-52). Even if the CTM proprietor produced copies of its product sheets, screenshots of the search and query results of Google on the presumed behaviour of internet users, excerpts from the online encyclopedia Wikipedia and offers of similar products from other undertakings, it did not show how such documents would prove that the sign had acquired distinctive character through use (paras 61-63).

[T-649/13](#); **SmartTV Station**, Judgment of 23 October 2015, *TrekStor Ltd v OHIM* – DE. The CTM applicant sought registration of the word mark 'SmartTV Station' for products in Classes 9 and 28. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. It is necessary to rely on the understanding of the public of the United Kingdom and Ireland, as the terms composing the sign are in English (para. 22). The word 'smart' means 'seemingly intelligent, showing a certain autonomy' and is often used in the computer field to hint to the level of elaboration and intelligence of a program or of a machine. This is also true in the electronics field, which largely overlaps with the computer one (para. 27). The expression 'smarttv' is extremely common to indicate multifunction televisions offering complementary computer features (para. 28). Given the meaning of the term 'station' in the ordinary language and the fact that such a term is already used in the English electronic language, in particular in the expression 'workstation', the term 'station', is commonly known in the technical and computer field as referring to a technical system as a whole, of a local apparatus or of a control centre carrying out or controlling important functions and procedures (para. 32). The combination of the terms 'smarttv' and 'station' will be understood as indicating an apparatus or a multifunctional centre of control, highly developed on a technical level and intelligent, offering a television feature as well as complementary autonomous interactive computer features, including the possibility to surf the internet (para. 40). There is no perceptible difference between the expression 'smarttv station' and the sum of its parts (para. 43). The sign is descriptive of the products covered by the mark as it can indicate their kind, intended purpose, way of functioning or quality. Indeed, the BoA correctly held that such products consist either in interactive television terminals or in elements of such television terminals and of the network to which they are connected (para. 44). The term 'station' does not necessarily refer to a fixed or stationary entity (para. 42). It is irrelevant whether web surfers use the term 'smarttv station' as a search term in search engines, since it suffices that the expression 'smarttv station' can be understood as a descriptive



indication of the products. Likewise, it is irrelevant whether the signs composing the mark are actually used for descriptive purposes at the time of the TM application (paras 51-53). The mark is descriptive also in respect of magnetic data carriers, as they are necessary for the use of a television terminal such as that marketed by the CTM applicant under the name of 'SmartTV Station' (para. 60). Even if the CTM applicant produced copies of its product sheets, screenshots of the search results of Google, excerpts from the online encyclopedia Wikipedia, a list of products linked to the sign sold on the online shop and screenshots relating to products linked to the sign from the Amazon site, such documents do not suffice to prove that the sign had acquired distinctive character through use (paras 68-71).

◆ [T-264/14](#); **WIN365**, Judgment of 23 October 2015; *Robert Hansen v OHIM* – DE. The applicant sought to register the word mark 'WIN365' for, inter alia, services in Classes 36 and 41. Both instances refused registration for the above services according to Article 7(1)(b) CTMR. The applicant appealed before the GC alleging infringement of the above provision. As a preliminary remark, the GC states that the applicant's complaint that the BoA did not sufficiently explain the meaning of the number 365 as referring to the days of a calendar year is to be refused. The second element in the applied for sign, 'WIN', clearly indicates the obvious relation between the services and the possibility of winning. This possibility is the reason why the consumers are interested in those services (para. 23). The combination 'WIN365' as a whole merely makes reference to the possibility of winning every day in connection with the services in Classes 26 and 41 and consequently, the BoA was right to conclude that such a laudatory message is devoid of distinctive character (paras 24-25). Concerning the earlier registrations at national level, the GC confirms the case law that the Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it is self-sufficient and applies independently of any national system. Consequently, the registrability of a sign as a CTM must be assessed by reference only to the relevant Community rules. Accordingly, the Office and, if appropriate, the Community judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark (para. 30). Concerning the earlier CTM WIN3000 (No 4 919 148), the GC states that this mark is different because the number '3000' has no meaning as the number '365' in the case in question (para. 33). Concerning the earlier CTM WIN365 (No 5 928 346), the GC agrees with the Office that this mark has been accepted according to Article 7(3) CTMR after demonstrating the acquired distinctiveness in the relevant markets (para. 34). The GC further underlines that even if the decision in the above case were wrong, it has become final and may only be challenged in the framework of an invalidity action but not in the current proceedings (para. 37). However, the Office must take into account the decisions already taken in respect of similar applications and 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. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her advantage and in order to secure an identical decision, on a possibly unlawful act committed for the benefit of someone else.

◆◆ [T-591/14](#); **PerfectRoast**, Judgment of 25 September 2015, *BSH Bosch und Siemens Hausgeräte GmbH v OHIM* – DE. The applicant sought to register the word mark 'PerfectRoast' for, inter alia, goods in Classes 7 and 11. Both instances refused partially registration for the above goods according to Article 7(1)(b) and (c) CTMR. The applicant appealed before the GC alleging infringement of Article 7(1)(b) and (c) and Article 75 CTMR. The GC states as to the meaning of the applied for sign 'PerfectRoast' that the BoA was right in saying that it could be understood as a 'perfectly well elaborated roast' or in the sense of the activity of 'perfectly roasting'. This meaning is obvious irrespective of the



professional public as well as for the average consumers. As to the second meaning, the GC stresses that the relevant consumers also consist of those who do not understand the English language perfectly, so that they may also perceive the term 'roast' as a noun or as an adjective (para. 22). The GC further asserts that the goods for which registration has been refused may be grouped according to the degree of the connection to the activity of roasting or the preparation of a roast (para. 23). The goods in Class 7 consist of kitchen apparatus for the purpose of roasting as, for example, raclette grills. The BoA therefore correctly found a direct link between the meaning of the sign and those goods, as the mark informs in a laudatory way that these goods may serve for preparing a perfect roast (para. 24). The majority of the goods in Class 11 are — as the BoA said — all kind of cooking apparatus, which might have a different degree of connection with the activity of roasting. The GC stresses that in order to be descriptive, it is not relevant that these goods serve directly for roasting but it may be sufficient that they are in a sufficiently close relation to this activity. Indeed, these goods may serve for the preparation of a roast or for maintaining it or its ingredients warm or for preparing sauces. To this extent the sign describes a characteristic of these goods in the sense that they are specifically intended to be used in the context of the preparation of a perfect roast (paras 25 and 26). However, for the goods 'water heaters, immersion heater and egg cooker' (Class 11), the GC finds that the situation is different. For the first two categories of goods, the connection with roasts or the preparation thereof is not as strong as for the other goods mentioned in the preceding paragraphs. In addition, in relation to 'egg cookers', which are in principle used to boil water, the contested decision did not explain to which extent there would be a specific link with the cooking or preparation of a perfect roast. Consequently, for those three categories the BoA did not correctly apply Article 7(1)(c) CTMR (paras 29-31). For the goods 'water heaters, immersion heater and egg cooker' (Class 11) the GC also found that Article 7(1)(b) CTMR is not applicable, since the meaning of the sign applied for does not convey a direct connection to those categories resulting in a certain originality, so that consumers would require an interpretative effort in order to find any relation between the goods and the meaning of the sign (para. 46).

[T-321/14](#); **STREET**, Judgment of 10 September 2015, *Volkswagen AG v OHIM* – DE. The applicant sought to register the word mark 'STREET' as a CTM for the goods and services within Classes 12, 28 and 35. In accordance with Article 7(1)(b) and (c) CTMR, the examiner refused to register the word as a CTM for all the goods applied for. The BoA dismissed the applicant's appeal on the ground that the sign does not possess the necessary minimum degree of distinctiveness and is descriptive for all the goods and services in respect of which protection was sought. The applicant filed an action before the GC. The GC confirmed the BoA's analysis of the relevant public, as consisting both of the average consumer with an average level of attention and of professionals in the vehicle construction sector whose level of attention is higher due to the impact of the characteristics and the quality of the goods and services concerned on the range of items and facilities that they themselves offer. According to the judgment, the relevant public is the English-speaking public in the EU (paras 14-15). The GC carried out an exhaustive analysis of the goods and services for which registration was sought and ruled that the sign is descriptive for all of them (para. 19 et seq.). The GC made reference to the case law and confirmed the applicant's argument that the registration of marks which also are used as advertising slogans, indication of quality or incitements to purchase the goods and services is not excluded as such by virtue of such use. However, according to the GC, this argument is not sufficient for the applicant to demonstrate the distinctive character of the sign, which is a banal English word, not capable of performing its essential function for the goods for which registration was sought (paras 44-46). The GC ruled that the applicant cannot invoke the previous BoA decisions as, for reasons of legal certainty and sound administration, each trade mark



application has to undergo, individually, a stringent and full examination. Moreover, contrary to what may have been the case for certain earlier applications, the present application was caught by two of the grounds for refusal of Article 7(1) CTMR (paras 52-54).

♦ [T-633/13](#); **INFOSECURITY**, Judgment of 23 September 2015, *Reed Exhibitions Ltd v OHIM* – EN. The applicant sought to register the word mark 'INFOSECURITY' for goods and services in Classes 16, 35 and 41. The examiner refused to register the word as a CTM for most of them on the ground that it is descriptive and devoid of any distinctive character. The BoA dismissed the applicant's appeal, and so did the GC. The target public, both average consumers and professionals, have a sufficient knowledge of the English language even if they were not native English speakers, with the whole EU being the relevant territory (para. 26). The simple combination of the words 'info' and 'security', each of which is respectively descriptive of the content and subject matter of the goods and services concerned, is itself descriptive thereof. It is not uncommon in English to link abbreviations with nouns (para. 37). Having carried out an overall examination covering all the goods and services refused registration, the BoA was entitled to formulate a single conclusion based on the same ground for refusal covering all the goods and services concerned, without infringing its obligation to state reasons. The reasoning based on subject matter and content of the goods and services applies to all of them, because there is a sufficiently direct and specific link in that they are all media for the dissemination of information in writing (including in print or electronically) or orally (including organisation of conferences, fairs and exhibitions) (paras 47-48).

[T-558/14](#); **TRILOBULAR**; Judgment of 18 November 2015, *Research Engineering & Manufacturing, Inc. v OHIM* – EN. The applicant sought to cancel the word mark 'TRILOBULAR' for goods in Class 6. The CD's decision, rejecting the application for invalidity pursuant to Article 52(1)(a) in conjunction with Article 7(1)(b) and (c) CTMR, was annulled by the BoA and the contested CTM was declared invalid. The applicant appealed to the GC. The single plea in law, based on the infringement of Article 7(1)(c) CTMR was dismissed by the GC. Although the goods in question, 'metal threaded fasteners', are intended for professionals and general consumers, the former represent a larger part of the relevant public than the latter, insofar as they use those goods on a daily basis and those goods are a necessary part of the normal and regular course of their professional activity (para. 20). Therefore, the Office is entitled to take account of the presence, within the general public, of a narrower class, composed of persons for whom the goods or services covered by the mark for which registration is sought are particularly intended (para. 23). 'TRILOBULAR' could be understood not only by German-speaking professionals but also professionals from other Member States as describing the fact that the screw is made up of three lobes, and thus describes a quality or characteristic, which is, moreover fundamental, of those goods (para. 32). Even assuming that the general public pays a normal level of attention when purchasing the goods in question, the specialist public may demonstrate a higher level of attention when buying large quantities of such products, which might prove to be unusable if not properly selected (para. 37). The evidence put forward in support of the application for a declaration of invalidity establishes that, as early as 1982, the word 'trilobular' described the nature and the technical function of the goods in question, which is a more generic expression for screws (para. 43). Furthermore, it is not necessary that the signs and indications composing the mark that are referred to in Article 7(1)(c) CTMR actually be in use at the time of the application for registration in a way that is descriptive of the goods or services. It is sufficient that such signs and indications could be used for such purposes (para. 45). The GC clarifies that contrary to the applicant's interpretation of Case T-256/06, 'HONEYCOMB', namely that the lack of specific meaning on



the technical level of the trade mark for which registration was sought necessarily resulted in its lack of descriptive character, the lack of specific meaning in strictly technical terms was not relevant in the context of the assessment of the descriptive character. This, however, does not mean that the existence of a technical meaning cannot have as its result the existence of a descriptive character (para. 49).

[T-202/15](#); **WORLD OF BINGO**, Order of 20 November 2015, *Zitro IP Sàrl v OHIM* – ES.



The CTM applicant sought to register the figurative sign represented above for goods in Classes 9, 28 and 41. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. When a trade mark's verbal element is descriptive, the mark as a whole is descriptive if its figurative elements do not allow the public to detach from the descriptive message conveyed by the verbal element. The BoA correctly found that the expression 'world of bingo' is descriptive and that the figurative elements were not perceived as indicating commercial origin. The trade mark is therefore descriptive (para. 22). The trade mark being descriptive, there is no need to rule on the distinctiveness of the signs (para. 26).

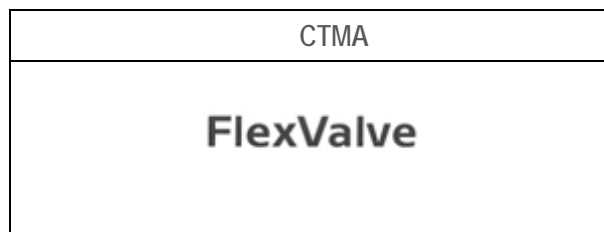
[T-203/15](#); **WORLD OF BINGO**, Order of 20 November 2015, *Zitro IP Sàrl v OHIM* – ES. The CTM applicant sought to register the word sign 'WORLD OF BINGO' for goods in Classes 9, 28 and 41. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The BoA correctly found that the expression 'world of bingo' is descriptive, as consumers will clearly perceive it as meaning that the marked products and services are related to the game of bingo (para. 18). The trade mark being descriptive, there is no need to rule on the distinctiveness of the signs (para. 23).

◆ [T-223/14](#); **VENT ROLL**, Judgment of 25 November 2015, *Ewald Dörken AG v OHIM* – DE. Upon request, the CD declared the CTM 'VENT ROLL' (applied for in 2004; registered in 2005) invalid for goods in Classes 6, 17 and 19, as the trade mark was deemed descriptive ('ventilation roll') and non-distinctive for the goods at issue. The BoA confirmed the decision. The applicant filed an action before the GC, claiming a violation of Article 7(1)(b) and (c) as well as a violation of Article 76 CTMR in several respects. At the outset, the GC confirmed that the relevant public consists of English-speaking specialists in the field of construction (para. 26). The GC went on by affirming that 'Vent' in combination with 'Roll'



has a descriptive connotation, as the neologism 'VENT ROLL' describes possible characteristics of the goods (air permeability; ridges produced in the form of rolls). The fact that the relevant public would not use the term 'VENT ROLL' to qualify air permeable ridges, but rather 'Ridge Vent' or 'Roll Ridge Vent', does not alter this finding. It is sufficient that a sign may in the future serve to describe possible characteristics of the goods. In this respect it is also irrelevant that the descriptiveness of the trade mark could not be proven with certainty for the time of application (2004) but only for a later point in time (a dictionary excerpt from 2011 was provided). A rejection according to Article 7(1)(c) CTMR is not dependent on the condition that the trade mark was actually used descriptively at the time of application. In addition, the inclusion of expressions in dictionaries is usually the consequence of frequent prior use of the expression over a longer period of time (paras 38-41).

◆ [T-588/14](#); **FlexValve**, Judgment of 23 September 2015, *Mechadyne International Ltd v OHIM* – DE.



The applicant sought to register the figurative mark represented above for various goods and services in Classes 7, 9, 12 and 42. The examiner largely refused this CTMA under Article 7(1)(b) and (c) CTMR. The BoA dismissed the appeal, holding that the sign refers to adaptable valves and thus describes the goods and services. The GC confirmed the BoA decision. The relevant public consists of English-speaking professionals who are technically versed (para. 23). The sign's font is similar to commonly used ones (para. 30). 'FlexValve' will be understood as meaning flexible, that is to say, an adaptable valve (paras 37-40). The goods are all technical in character and may contain valves. The engineering and consulting services may have valves as subject matter (paras 42-52).

[T-845/14](#); **HydroComfort**, Order of 30 November 2015; *August Brötje GmbH v OHIM* – DE. The CTM applicant sought to register the word sign 'HydroComfort' for 'hot water cylinders; heating buffer tanks' in Class 11. The examiner rejected the application. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The sign 'HydroComfort', making reference to comfort obtained by means of water, immediately informs consumers that the products at issue, 'hot water cylinders' and 'heating buffer tanks', work with water and provide a certain comfort. The sign is therefore descriptive of a quality of the products at issue, which are used to store hot water (para. 21). The trade mark being descriptive, there is no need to rule on the distinctiveness of the sign (paras 32-35). The action is therefore dismissed in its entirety (para. 36).

[T-529/14](#); **Multi Win**, Judgment of 2 December 2015, *adp Gauselmann GmbH v OHIM* – DE. The applicant sought to register the word mark 'Multi Win' for goods and services in Classes 9, 28 and 41, related in particular to game software, games, toys, rental of game devices for casinos, lotteries. The examiner refused to register the application under Article 7(1)(b) and (c) CTMR. The BoA dismissed the



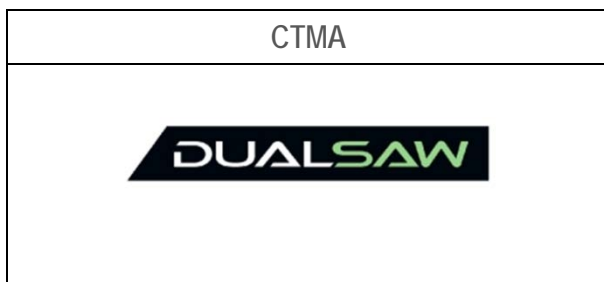
appeal holding that the sign will be understood as multiple prize or multiple prize opportunity. The GC confirmed the BoA decision based on Article 7(1)(c) CTMR. The BoA took account of English-speaking visitors to amusement halls, casinos and other entertainment sites as well as professionals running such places. 'Multi' can signify multiple, forming adjectives with the meaning 'more than one, several, many' (para. 29). The term 'win' is common in English and refers to 'to win' or 'prize' (T-258/09, BETWIN) (para. 30). In correct English, 'multi' is connected by means of a hyphen with the combined word or both are written in one word. However, the word order is correct, corresponding to terms such as 'multicapital', 'multimachine' or 'multi-disc', and the difference to the correct English structure is thus insufficient to give the sign a meaning that sufficiently departs from the sum of its parts (para. 32). Given that the goods and services form a homogeneous group related to entertainment, the BoA was entitled to apply the same reasoning to all of them (paras 33-35). 'Multi Win' constitutes a promotional but sufficiently descriptive term in relation to a main characteristic of the goods and services in that it evokes the idea of multiple prizes to be won by the gambler (para. 36).

[T-628/14](#); **FORTIFY**, Judgment of 3 December 2015, *Hewlett Packard Development Company LP v OHIM* – EN. The applicant sought the registration of the Community word mark 'FORTIFY' for the following goods in Class 9: 'software for analysing source code; software for detecting and describing vulnerabilities and associated mitigation techniques based on an analysis of source code; software for preventing hacking of or attacks on computer programs and software systems based on runtime analysis of software behaviour and use; computer software'. The examiner refused the trade mark application in respect of all the goods concerned, on the ground that the mark applied for was descriptive and devoid of any distinctive character under Article 7(1)(b) and (c) and Article 7(2) CTMR. The examiner's decision was confirmed by the BoA holding that the application had to be rejected in respect of all the goods in question under the absolute ground for refusal in Article 7(1)(c) CTMR. It held that there was no need to determine whether the mark applied for had also to be refused registration under Article 7(1)(b) CTMR. The applicant filed an action before the GC alleging an infringement of Article 7(1)(b) and (c) and Article 7(2) CTMR. The GC confirmed the BoA's decision and dismissed the appeal. The GC pointed out that the BoA was correct in finding that the term 'fortify' designated an intended purpose of the goods concerned, namely to strengthen or reinforce a computer system. Thus, by means of software dedicated, inter alia, to detecting vulnerabilities and preventing hacking of or attacks on computer programs and software systems, the operation or performance of a computer system is improved and that system may be regarded as 'fortified'. Therefore, when faced with the goods covered by the trade mark application, the relevant public will immediately and without further reflection perceive that the word 'fortify' refers to the intended purpose of those goods (paras 25-27). That conclusion is not called into question by the applicant's argument that since software does not alter computer systems, but only protects them from the outside, it is not capable of 'making them stronger'. Therefore, the relevant public would not directly and without further reflection establish a connection between the sign at issue and the meaning ascribed to it by the BoA, since a further mental step would be necessary (paras 28-29). The GC found that the distinction drawn by the applicant between fortifying a computer system through an alteration and protecting it from the outside has not been substantiated. As the Office has observed, those two actions have the same intended purpose, namely to improve in some way the operation or performance of a computer system. The fact that the interventions take place from the inside or from the outside of a computer system does not alter the fact that the sign at issue will be perceived as descriptive by the relevant public, consisting of average consumers. The further arguments of the applicant, that the fact that no descriptive use of the term 'fortify' has been established in practice in relation to the goods



concerned constitutes evidence that that term is not suitable for describing the goods in question, was also rejected by the GC. The GC recalled the case law, according to which it is not necessary that the sign actually be in use at the time of the application in a way that is descriptive of goods or of characteristics of them to be refused under Article 7(1)(c) CTMR. It is sufficient that such signs and indications could be used for such purposes, as in the present case. Therefore, the BoA did not have to look for actual use of the sign at issue in a descriptive way and the absence of such actual use cannot be regarded as evidence that the sign at issue is not descriptive (paras 28-32). Finally, the GC found that the applicant cannot successfully rely, for the purposes of casting doubt on the conclusion reached by the BoA, on the Office's previous decisions and, a fortiori, on the decisions of other courts. As regards this aspect, it recalled that according to the case law, the application of the principles of equal treatment and sound administration must respect the law. Moreover, the BoA duly gave its reasons for not following the previous decision-making practice relied on by the applicant (paras 33-37). As regards the second plea in law, the GC recalled that since according to settled case law it is sufficient that one of the absolute grounds for refusal listed in Article 7(1) CTMR applies for the sign at issue not to be registrable as a CTM, there is no need to give a ruling on the substance of the alleged infringement of Article 7(1)(b) and Article 7(2) CTMR.

[T-647/14](#); **DUALSAW**, Judgment of 3 December 2015, *Infusion Brands, Inc. v OHIM* – EN.



The applicant sought to register the above figurative mark for goods and services in Classes 7, 8 and 35. The Examination Division's (ED) decision, partially rejecting the CTM application based on Article 7(1)(b) and (c) and Article 7(2) CTMR, was confirmed by the BoA. The applicant appealed to the GC. The GC dismissed both pleas on which the action was based, namely the alleged infringement of Article 7(1)(b) and (c) CTMR. The BoA was right in that both words 'DUAL' and 'SAW' must be regarded as common, everyday words that may be understood by every English speaker. The mark as a whole covers specific cutting tools having a twofold, or double, character or nature. The services in Class 35 are merely wholesaling and retailing services in respect of the same goods (paras 22-23). The figurative elements and colour of the CTMA are in no way fanciful or arbitrary. The mark is completely unambiguous and contains no hidden meaning that could diminish the clearly descriptive message conveyed (para. 24). Although the sign consists of a single word element, the English-speaking public will immediately break it down into two words that they know, helped by the fact that 'dual' and 'saw' appear in different colours. Moreover, those words are common, everyday words, which are easily understood by the English-speaking public (para. 27). The argument that the sign applied for has a very highly figurative component that determines its overall impression and dominates the mark applied for as a whole is rejected (para. 31). The 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. 33). The argument relating to the registration by the USPTO of the figurative mark DUALSAW for several identical goods in the USA with no objection is rejected (para. 35). The CTM regime is an autonomous legal system which pursues objectives peculiar to it. It applies independently of any national system. The Office and, as the case may be, the EU judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. That is so even if such a decision was adopted in a country belonging to the linguistic area in which the word mark in question originated (para. 36).

[T-648/14](#); **DUALTOOLS**, Judgment of 3 December 2015, *Infusion Brands, Inc. v OHIM* – EN.



The applicant sought to register the above figurative mark for goods and services in Classes 7, 8 and 35. The ED's decision, partially rejecting the CTM application based on Article 7(1)(b) and (c) and Article 7(2) CTMR, was confirmed by the BoA. The applicant appealed to the GC. The GC dismissed both pleas on which the action was based, the alleged infringement of Article 7(1)(b) and (c) CTMR. The BoA was right in that both words 'DUAL' and 'TOOL' must be regarded as common, everyday words that may be understood by every English speaker. The mark as a whole covers tools having a twofold, or double, character or nature. The services in Class 35 are merely wholesaling and retailing services in respect of the same goods (paras 22-23). The figurative elements and colour of the CTMA are in no way fanciful or arbitrary. The mark is completely unambiguous and contains no hidden meaning that could diminish the clearly descriptive message conveyed (para. 24). Although the sign consists of a single word element, the English-speaking public will immediately break it down into two words that they know, helped by the fact that 'dual' and 'tools' appear in different colours. Moreover, those words are common, everyday words, which are easily understood by the English-speaking public (para. 27). The argument that the sign applied for has a very highly figurative component that determines its overall impression and dominates the mark applied for as a whole is rejected (para. 31). The 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. 33). The argument relating to the registration by the USPTO of the figurative mark DUALTOOLS for several identical goods in the USA with no objection is rejected (para. 35). The CTM regime is an autonomous legal system that pursues objectives peculiar to it. It applies independently of any national system. The Office and, as the case may be, the EU judicature are not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. That is so, even if such a decision was adopted in a country belonging to the linguistic area in which the word mark in question originated (para. 36).

◆ [T-766/14](#); **FoodSafe**, Order of 23 November 2015, *Actega Terra GmbH v OHIM* – DE. The invalidity applicant requested the invalidity of the word mark 'FoodSafe', registered for the following goods in Class 2: 'Lacquers, in particular for the graphics industry; All the aforesaid goods other than for use in



building' as being descriptive in the sense of Article 7(1)(c) CTMR. Both instances of the Office upheld the request and declared the CTM invalid. The CTM proprietor filed an appeal before the GC claiming an infringement of Article 52(1)(a) and Article 76(1) CTMR. The GC confirms the assessment of the BoA as to the relevant consumers, who are both specialists as well as general consumers (paras 18 and 19). The GC further points out that the BoA correctly defined the mark as a direct indication that the lacquers will not harm or affect any food as regards its smell or edibility. This may be in particular true for lacquers, which might be used for food-packaging. Consequently, the BoA correctly reached the conclusion that the mark is descriptive for the goods in the sense of Article 7(1)(c) CTMR.

[T-79/15](#); **3D**, Judgment of 17 December 2015, *Olympus Medical Systems Corp. v OHIM* – EN.



The applicant sought to register the figurative mark represented above as a CTM for the goods in Class 10. The examiner rejected the CTM application for all the goods. The BoA dismissed the applicant's appeal against the decision of the examiner. The applicant filed an action before the GC. The GC ruled that the relevant public in the present case is made up of medical professionals (para. 20). The GC also stated that the BoA carried out a full examination of the mark applied for and clearly explained, why that mark, when viewed as a whole, described one of the essential characteristics of the goods concerned, namely the fact that those goods made use of technology to obtain 3D images (para. 25). The GC refers to the established case law in confirming that when a sign has several meanings, it must be refused registration if at least one of its possible meanings designates a characteristic of the goods, a principle which applies in the same way to word signs and figurative signs (para. 26). In that regard, the GC pointed out that the figurative elements of the mark applied for either reinforce or do not change the descriptive meaning of its word element (para. 28). The GC also stated that even if the relevant public displays a high level of attention, the sign at issue will be no less subject to the absolute ground for refusal under Article 7(1)(c) CTMR (para. 30).

◆ [T-766/14](#); **FoodSafe**, Order of 23 November 2015, *Actega Terra GmbH v OHIM* – DE. The invalidity applicant requested the invalidity of the word mark 'FoodSafe', registered for the following goods in Class 2: 'Lacquers, in particular for the graphics industry; All the aforesaid goods other than for use in building' as being descriptive in the sense of Article 7(1)(c) CTMR. Both instances of the Office upheld the request and declared the CTM invalid. The CTM proprietor filed an appeal before the GC claiming an infringement of Article 52(1)(a) and Article 76(1) CTMR. The GC confirms the assessment of the BoA as to the relevant consumers, who are both specialists as well as general consumers (paras 18-19). The GC further points out that the BoA correctly defined the mark as a direct indication that the lacquers will not harm or affect any food as regards its smell or edibility. This may be in particular true for lacquers which



might be used for food-packaging. Consequently, the BoA correctly reached the conclusion that the mark is descriptive for the goods in the sense of Article 7(1)(c) CTMR.

[T-50/14](#); **Turbo Drill**, Judgment of 26 November 2015, *Demp BV v OHIM* – DE. The applicant sought the registration of the CTM ‘TURBO DRILL’ (word) for, inter alia, goods in Classes 6, 19 and 20. The First Instance refused the application in part as being descriptive and without the necessary distinctive character (Article 7(1)(b) and (c) CTMR). The BoA upheld that decision. ARTICLE 7(1)(c) CTMR. The GC states that the relevant public would include producers and users of drill and boring machines, and the public will immediately establish a connection between the goods and the meaning of the sign, which refers to powerful drills (paras 19 and 30). The GC ascertains that the sign covers large categories of goods that all contain some specific goods that are described by the applied for sign (para. 35). The GC further stresses that a mark gives to the proprietor the right to forbid its use in the market and consequently in the case in question, this right would mean that the owner of the mark could prohibit third parties to use the ‘TURBO DRILL’, which describes characteristics of specific goods in Classes 6, 19 and 20. This would go against the *ratio legis* of Article 7(1)(c) CTMR which guarantees undistorted competition on the market. (paras 36-40). An applicant is free to define the goods or services for which registration is sought and in the case in question, the large categories of goods include some specific ones that are described by the sign (paras 42 and 44). Consequently, the refusal for the above goods is justified (para. 45).

IV. Not descriptive

◆ [T-710/13](#); **TAFEL**, Judgment of 18 September 2015, *Bundesverband Deutsche Tafel e.V. v OHIM* – DE. The trade mark ‘TAFEL’ had been registered as a CTM in 2010 for services in Classes 39 and 45. The intervener filed a cancellation action pursuant to Article 52(1)(a) and Article 7(1)(b) and (c) CTMR, which was rejected by the CD. Upon appeal by the intervener the BoA annulled the CD decision and declared the CTM invalid, as it found ‘TAFEL’ to be descriptive for the services in question (e.g. collection and distribution of essential goods, including foodstuffs, for those in need). ‘TAFEL’ can have several meanings in German, namely ‘table’/‘festive meal’ on the one hand, or, on the other, a synonym for charity projects, particularly concerning the gathering of goods/foodstuffs for those in need. Understood in the first sense, ‘table’, the word merely describes that goods such as foodstuffs are collected and presented/served at a table. The descriptiveness of the term is confirmed by the second meaning, ‘charity projects’, which directly describes that the services of distribution of cheap foodstuffs, etc. will be rendered and received by those in need in the context of a charity action at a table. As the CTM is descriptive for the services in question, it is also non-distinctive. The CTM owner filed an action before the GC, claiming a violation of Article 7(1)(c) and (b) CTMR. At the outset, the GC underlined that the services in question concern everyday items and target general consumers. As the sign in question consists of a German word, the meaning is to be determined with regard to the German public (para. 21). It is acknowledged that ‘TAFEL’ can have several meanings. As is apparent from the contested decision, the BoA has based its decision on the descriptiveness of the term ‘TAFEL’ exclusively on the meaning of ‘table’, and not on the meaning of ‘charity project’. The second meaning was only mentioned subordinately in order ‘to confirm’ that the expression in its first meaning is descriptive (Paras 23-30).



However, 'TAFEL' understood in the sense of 'table' is not descriptive for the services in question. Even though the collection and distribution of foodstuff can take place at a table, this is not necessarily always the case. Furthermore, there is a discrepancy between 'table' as a synonym for a 'festive/solemn meal' and the actual nature of the services, which concern the supply of the most basic foodstuffs for those in need. For these reasons, the term 'TAFEL' cannot immediately be related without further thought to the services in question (paras 31-36). Consequently, regardless of what might have been decided on the basis of a different meaning of 'TAFEL', the BoA violated Article 7(1)(c) CTMR when finding that 'TAFEL' in the sense of 'table' is descriptive (para. 37). As the finding of a lack of distinctiveness was exclusively deduced from the — erroneous — belief that 'TAFEL' was descriptive for the services, the BoA also violated Article 7(1)(b) CTMR (paras 45-48). Based on the foregoing, the decision of the BoA was annulled.

◆ [T-133/13](#); **WET DUST CAN'T FLY**, Judgment of 22 January 2015, *Pro-Aqua International GmbH v OHIM* – EN. The applicant sought to cancel the CTM 'WET DUST CAN'T FLY' for goods and services in Classes 3, 7 and 37. The CD's decision, rejecting the application for invalidity based on Article 7(1)(b) and (c) and Article 52(1)(a) CTMR, was confirmed by the BoA. The cancellation applicant filed an action before the GC relying on two pleas in law. The GC dismissed both pleas on which the action was based, the alleged infringement of Article 7(1)(b) and (c) CTMR. On Article 7(1)(c) CTMR, the GC confirmed the BoA decision that the expression 'wet dust can't fly' does not describe the functionality or operation of the cleaning products and apparatus in Classes 3 and 7 or maintenance services in Class 37. The intended purpose is not to moisten dust in order to prevent it from dispersing, but to make the dirt disintegrate and disappear (paras 23-29). The applicant's argument that at least non-native English-speakers will perceive the mark in a descriptive way because they will not notice that 'moistened dust is no longer dust once it has become wet' is not substantiated and is contradictory in itself, all the more so since the applicant claims that the mark is composed of commonly used English words (para. 31). Considering that the mark is not descriptive of the goods and services and cannot be understood as a conventional way of describing the functionalities of cleaning appliances and cleaning tools, it is not necessary to ensure that that expression is made available to competitors (para. 33).

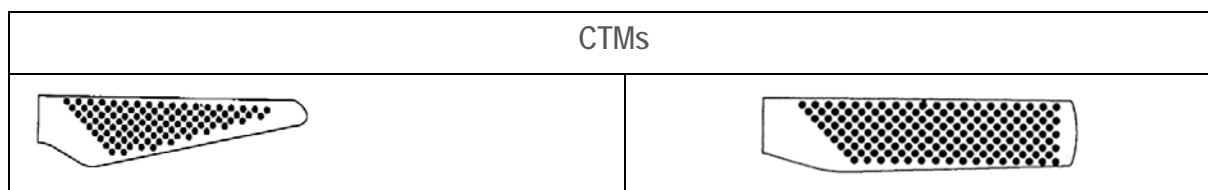
◆◆ [T-381/13](#) and [T-382/13](#); **DAISY / MARGARITAS**, Judgment of 16 December 2015, *Perfetti Van Melle SpA v OHIM* – IT. The applicant sought the registration of the word marks 'DAISY' and 'MARGARITAS' in relation to 'pastries and confectionaries, caramel, sweets, chewing gum, licorice, lollipops, toffee, sugar, chocolate, cocoa, coffee' in Class 30. The examiner refused the trade mark in relation to the abovementioned goods on the basis of Article 7(1)(b) and (c) and Article 7(2) CTMR in relation to the English- and Spanish-speaking consumers in the EU. The examiner found that that part of the public would perceive the signs as a description of the shape of the goods. The examiner then withdrew the objection raised the first time as far as it concerned 'caramel, sugar, chocolate, cocoa, coffee'. The BoA confirmed the examiner's decision in relation to the abovementioned goods. The BoA, however, found that the applications had to be rejected also in relation to 'caramel, sugar, chocolate, cocoa, coffee'. In that regard, the BoA found that, under Article 64(1) CTMR, it had to exercise the same competencies as the first instance. The applicant filed an action before the GC. According to the GC, the BoA correctly found that the words 'daisy' and 'margaritas' may be perceived as a reference to that flower, respectively, by the English- and Spanish-speaking part of the relevant public. The BoA was also right in finding that appearance is an essential characteristic of goods in the confectionery sector. Nevertheless, the GC



found that neither the word ‘daisy’ or the word ‘margaritas’ presented a sufficiently direct relationship with the characteristic of the goods in question, namely with their shape, in contrast to the requirements of Article 7(1)(c) CTMR. The contested decisions do not show that the words ‘daisy’ or ‘margaritas’ are used to designate the goods in question in one of the relevant languages (paras 59-63). The fact that the relevant goods can be made with the shape of a daisy flower, or that some goods with the appearance of a flower can be found in the relevant sector, are not sufficient to find that consumers will perceive immediately and without further reflection that there is a relationship between the signs in question and the shape of a pastry or confectionery product. In the absence of concrete evidence demonstrating that the shape of a daisy was used extensively or on a large scale in the relevant sector, it is not possible to conclude that that shape is a formalised or standardised shape of the products in question. Therefore, although occasionally consumers could have seen these products in the form of other flowers or even, for some, specifically in the form of a ‘daisy’, the existence of a relationship between the words ‘daisy’ or ‘margaritas’ and those goods is, merely hypothetical in the case in question (paras 66-69).

C. Articles 7(1)(e) and 52(1)(a) CTMR — shape

[T-331/10 RENV](#); **SHAPE OF SURFACE WITH DENTS** (Joined Cases T-331/10 RENV and T-416/10 RENV); *Yoshida Metal Industry Co. Ltd v OHIM*, Judgment of 21 May 2015 – EN.

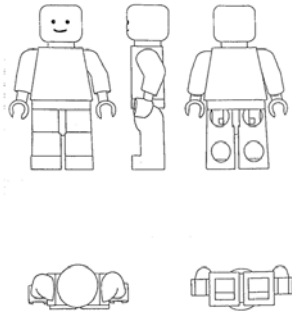
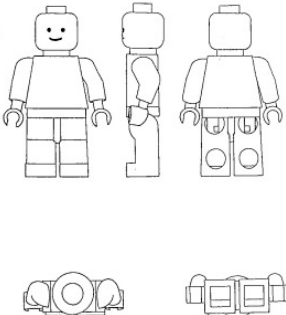


The CTM owner registered the figurative marks represented above as CTMs for goods within Classes 8 and 21. The CD rejected the applications for a declaration of invalidity based on Article 52(1)(a) CTMR. On appeal, the BoA declared the registrations invalid based on Article 7(1)(e)(ii) CTMR. The CTM owner appealed to the 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 and 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 the Office appealed to the CJ, alleging, inter alia, a breach of Article 7(1)(e)(ii) CTMR. The CJ set aside the GC’s judgments and referred the cases back to the GC, holding that the possibility afforded to the competent authority when examining a 3D 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. Furthermore, the requirements for the graphic representation 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. The CJ also recalled 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. Article 7(1)(e) CTMR does not define the signs that must be considered as shapes within the meaning of that provision, it may therefore apply also to 2D signs (para. 36). With regard to its wording and to the public policy interest it pursues, Article 7(1)(e)(ii) applies to any sign, whether two-



dimensional (2D) or 3D, where all the essential characteristics of the sign perform a technical function (para. 39). Regarding the identification of the essential characteristics, there is no hierarchy that applies systematically between the various types of elements of which a sign may consist (para. 43). The identification may be carried out by means of a simple visual analysis of the sign or, on the contrary, based on a detailed examination in which material relevant to the assessment is 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. 44). Thus, the BoA examined the essential characteristics of the signs correctly when taking into account the US and EU patents held by the CTM proprietor and the representations of its products to the extent that it was already marketing the goods under the sign in the EU market (para. 46). According to the GC, the essential elements of the signs are (i) the contour of the trapezium shape, and (ii) the arrays of black dots (para. 47). The GC states that it cannot be considered that the contour of the shape has merely an illustrative purpose and is aimed at showing how the array of dots will be affixed. First, the handle contours are not dot-printed, and, second, the application for registration contains no precise detail to that effect (para. 49). Regarding the black dots, it is clear from the material in the case file, in particular the representations of the applicant's products, that they actually represent dents (para. 50). There is no doubt from the various patents held by the CTM proprietor that those dents do seek to incorporate a technical solution, namely, a non-skid structure (para. 58). The GC did not consider significant the fact that the non-skid structure is not patentable or that it is a secondary characteristic of the patented product (para. 59). It is also irrelevant that the CTM proprietor filed its patent and trade mark registration applications at the same time (para. 60). The argument that the shape of the handle is capable of contributing — as much as or more than the array of dents — towards obtaining a non-skid effect cannot alter the fact that the array of dents is aimed at obtaining a technical result. It only confirms the functional character of the shape of the handle itself (para. 61). Furthermore, the fact that other knives fulfil a non-skid function by other means or that those dents are not necessarily incorporated into all kitchen knives is of no relevance (para. 62). The GC concluded that the registration of the signs at issue would improperly reduce the possibilities for competitors to bring to the market alternative product shapes incorporating the same non-skid technical solution (para. 64) and dismissed the actions.

◆ [T-395/14](#) and [T-396/14](#); **SHAPE OF A TOY FIGURE I and II (3D MARKS)**, Judgments of 17 June 2015, *Best-Lock (Europe) Ltd v OHIM – Lego Juris A/S* – EN.

Contested CTM in Case T-395/14	Contested CTM in Case T-396/14
	

The invalidity applicant applied for a declaration of invalidity of the 3D CTMs represented above for the



goods ‘Games and playthings; decorations for Christmas trees’ (Class 28), based upon Article 52(1)(a) in conjunction with Article 7(1)(e)(i) and (ii), and Article 52(1)(b) CTMR. The CD rejected the request as it found that none of the grounds of invalidity invoked by the invalidity applicant were met. The BoA dismissed the appeal. As requested by the Office (and the intervener), the GC dismissed the action for annulment of the BoA’s decision as inadmissible for failure to comply with Article 44(1)(c) RPGC, which provides that an application ‘shall state the subject matter of the proceedings and a summary of the pleas in law on which the application is based’. As regards Article 7(1)(e)(i) CTMR, the GC found that the invalidity applicant had merely asserted that the contested CTMs consist of a shape determined by the nature of the goods themselves, but neither put forward any argument to support that assertion nor provided any reasoning to show that the BoA’s findings in that regard were incorrect. Therefore, the minimum requirements of Article 44(1)(c) RPGC were not met. As regards Article 7(1)(e)(ii) CTMR, the GC observed that the invalidity applicant had only submitted general assertions and not put forward any argument in its application for annulment specifically contesting the BoA’s detailed assessments that formed the basis for its finding that the applicant had not shown that any technical result could be attributed to that shape. Therefore, the GC found that the invalidity applicant had not validly contested the BoA’s interpretation or application of Article 7(1)(e)(ii) CTMR for the purposes of a judicial review under Article 65 CTMR. In addition, the GC observed *ad abundantiam* that the action based upon Article 7(1)(e)(ii) CTMR was, in any event, unfounded — confirming the BoA’s finding that the contested CTMs do not consist exclusively of the shape of goods which is necessary to obtain a technical result. On the one hand, the GC confirmed the BoA’s finding that the contested CTMs’ essential characteristics — that is to say, those necessary to give to the shaped toy figures a human appearance — are the head, body, arms and legs. However, no technical result is connected to or entailed by the shape of those elements, which do not, in any event, allow the figure to be joined to interlocking building blocks. However, the GC noted that the toy figures’ hands, the protrusion on its heads and the holes under its feet and inside the backs of its legs do not, per se and a priori, reveal any technical function — and, if so, what that function is. In any event, even assuming that they may have such a function, namely that of enabling them to be joined to other elements, in particular interlocking building blocks, those elements were not considered to constitute an essential characteristic of the shapes in question. Finally, the GC approved the BoA’s finding that the ‘result’ of that shape is simply to confer human traits on the figure in question, and the fact that the figure represents a character and may be used by a child in an appropriate play context is not a ‘technical result’.

D. Articles 7(1)(f) and 52(1)(a) CTMR — public policy/morality

[no entry]

E. Articles 7(1)(g) and 52(1)(a) CTMR — deceptive

[no entry]



F. Articles 7(1)(h) and (i) and 52(1)(a) CTMR — emblems, etc.

[no entry]

G. Articles 7(1)(j) and (k) and 52(1)(a) CTMR — geographical indications for wines and spirits — agricultural products and foodstuffs

[T-55/14](#); **LEMBERGERLAND**, Judgment of 14 July 2015, *Genossenschaftskellerei Rosswag-Mühlhausen eG v OHIM* – DE. The applicant sought to register the word mark ‘LEMBERGERLAND’ as a CTM for goods within Class 33. The examiner refused to register the word as a CTM based on Article 7(1)(j) CTMR. The BoA dismissed the appeal, finding that the mark applied for contained the geographical indication (GI) ‘Lemberg’, protected in the EU for wines originating from South Africa under the Agreement between the European Community and the Republic of South Africa on trade in wine (the Agreement between the Community and the Republic of South Africa), whilst the wine subject of the mark applied for did not originate from that place of provenance. The applicant filed an action before the GC. The GC observed that ‘Lemberg’ (as an estate) is a protected GI within the territory of the EU for wines originating from South Africa under the provisions of the Agreement between the Community and the Republic of South Africa (para. 16). In accordance with the definition of GI under Article 22(1) TRIPS, there is no reason to conclude that a ‘locality’ within the meaning of that provision could not be constituted by a wine-growing estate or that such a ‘locality’ must be limited to a territory based on its size or its formal administrative division (para. 18). Regarding the argument that the CTMA is a new fanciful term, the GC recalls that it suffices that the mark applied for contains or consists of elements that enable the GI in question to be identified with certainty. The sign applied for ‘Lembergerland’ is a word consisting, inter alia, of the protected GI ‘Lemberg’ that is clearly identifiable within that sign (para. 22-23). Article 7(1)(j) CTMR applies without it being necessary to consider whether the mark for which registration is sought is liable to deceive the public or not, or whether it leads to a likelihood of confusion regarding the origin of the product (para. 26). The additional letters contained in the sign applied for do not confer a fanciful character on the GI ‘Lemberg’, insofar as the term ‘Lemberger’ is, in the German language, an adjective that comes from the word ‘Lemberg’ and the term ‘Land’ means ‘region, territory’, in that language, which means that it is possible to interpret the sign applied for as a reference to a ‘region of Lemberg’ or a ‘territory of Lemberg’. Therefore, the mark applied for does not have its own autonomous meaning that would significantly distinguish it from the GI ‘Lemberg’ (para. 28). The fact that the mark applied for has been registered in Germany does not call into question the legality of the contested decision (paras 32-33). The principle of equal treatment, of which infringement has been claimed by the applicant, must be consistent with respect for the principle of legality (paras 35-36). The applicant cannot reasonably rely, for the purposes of undermining the conclusion reached by the BoA in the contested decision, on the Office’s previous decisions concerning the registration of signs containing the elements ‘fisch’ or ‘sonne’ as CTMs (para. 38). Regarding the argument that the protection of the South African GI ‘Lemberg’ has not prevented the Austrian vineyard St. Magdalena am Lemberg from also being protected as a GI under the Agreement between the Community and the Republic of South Africa, the GC confirms BoA’s conclusion that the purported legal problem did not in any way form the subject matter of the proceedings in question (paras 39-40).

◆ [C-622/13 P](#); **CASTEL / Castell**, Order of 30 April 2015, *Castel Frères SAS v Fürstlich Castell’sches Domänenamt Albrecht Fürst zu Castell-Castell and OHIM* – EN. The applicant registered the word mark



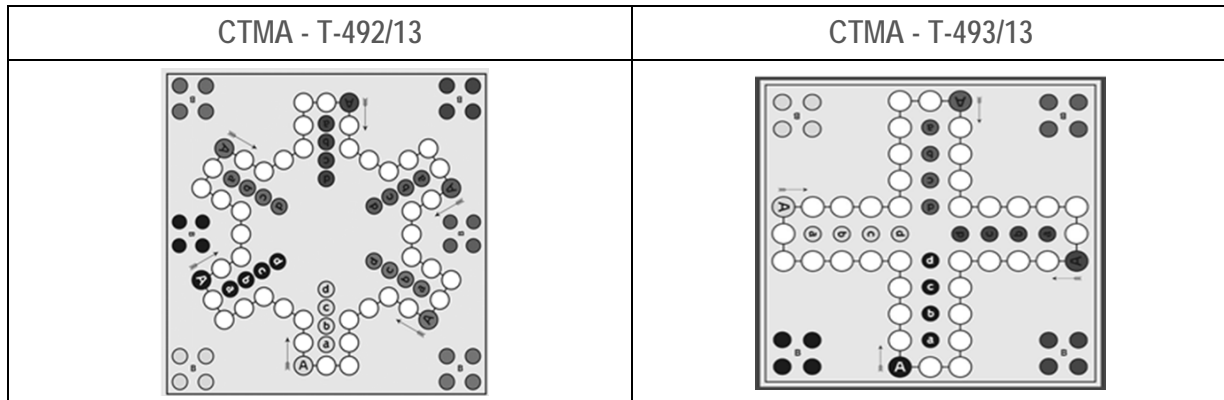
'CASTEL' as a CTM for goods in Class 33. An application for invalidity was filed based on indication of geographical origin 'Castell', protected for wines in Germany, France, Greece, Italy and Spain. The CD dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal after finding that 'Castell' was an indication of geographical origin relating to wines produced in Germany and was perceived as such by the relevant public. The spelling difference was likely to create some distance and a conceptual difference between the terms at hand. The invalidity applicant filed an action before the GC based on six pleas in law. The GC rejected the BoA's finding that the spelling difference would be sufficient, from the relevant public's point of view, to outweigh the resemblance of the disputed mark to the earlier GI. The GC held that the relevant public, which is aware of the earlier GI and, therefore, of the existence of the wine-producing municipality of 'Castell' in Germany, will, when confronted with goods bearing the disputed mark, namely, 'CASTEL', think immediately, without further thought, that what they have in front of them is a wine which comes from that wine-producing municipality. The applicant lodged an appeal before the CJ. The applicant has failed to demonstrate in law that the relevant criteria when assessing descriptiveness, established by the case law in the context of marks resulting from a combination of elements established in *Procter & Gamble v OHIM*, C-383/99 P, and in *Koninklijke KPN Nederland*, C-363/99, do not apply when the mark for which registration is sought is composed of a single word (paras 67-72). It follows from the contested judgment that the GC properly examined the perception by the relevant consumer of the sign in question and ruled explicitly on the way that the consumer actually interprets that sign (para. 77). As regards the inapplicability of the bilateral treaties referred to by the GC in the judgment, the GC was correct in finding that the inapplicability of those treaties might be relevant for the purpose of establishing the scope of the legal protection relating to the earlier GI, but is not relevant when what is at issue is establishing that the relevant public is familiar with the wine-producing municipality of 'Castell' and the degree of that familiarity (para. 81). Finally, as regards the relationship of Article 7(1)(c) and (j) CTMR, since the term 'CASTEL' by itself does not designate the origin or GI of a wine, the GC cannot be criticised for failing to apply the specific provisions of Article 7(1)(j) CTMR (paras 83-85).

H. Articles 7(3) and 52(2) CTMR — distinctiveness acquired through use

◆ [T-72/14](#); **BATEAUX MOUCHES**, Judgment of 26 March 2015 – *Compagnie des bateaux mouches SA v OHIM* – FR. The IR holder sought to register the word mark 'BATEAUX MOUCHES' (river boats for sightseeing) as an IR designating the EU for services in Class 37. The examiner refused to register the mark on the basis of Article 7(1)(b) and (c) CTMR. The BoA dismissed the IR holder's appeal. The IR holder filed an action before the GC. On the application of Article 7(3) CTMR, the GC held that the BoA correctly assessed the existence of distinctiveness acquired by use and could refuse the evidence filed by the applicant as it did not demonstrate such acquired distinctiveness. The GC noted that most of the documents produced to show acquired distinctiveness were those filed by the applicant to demonstrate the acquired distinctiveness for the services of Classes 39, 41 and 43 in the previous cases before the GC (para. 70). The fact that the applicant succeeded in obtaining registration on the basis of Article 7(3) CTMR for services in Classes 39, 43 and 41 (CTM No 10 270 321) for the verbal sign 'BATEAUX MOUCHES' did not have an effect on the claim for services in Class 37 (para. 78).

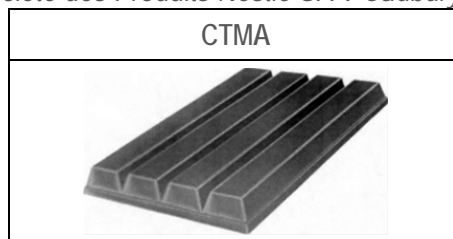


◆◆[T-492/13](#) and [T-493/13](#); **DEVICES OF BOARD GAMES**, Judgment of 3 March 2015, *Schmidt Spiele GmbH v OHIM* – DE.



The applicant sought to register the figurative signs depicted above for goods and services in Classes 9, 16, 28 and 41. The examiner rejected the trade marks applied for as being devoid of any distinctive character (Article 7(1)(b) CTMR). The BoA dismissed the appeals. The signs applied for would represent a depiction of the board of a game and consequently represents the outer appearance of the goods. The alleged acquired distinctiveness according to Article 7 (3) CTMR has not been shown. **INFRINGEMENT OF ARTICLE 7(3) CTMR:** The GC confirmed the contested decision to the extent that the applicant did not show any acquired distinctiveness which does not only refer to the German-speaking Member States but in general to the entire EU (para. 59). However the GC concluded that for some of the goods and services, the decisions are not well reasoned under Article 7(1)(b) CTMR (paras 44-54).

◆◆[C-215/14](#); **SHAPE OF A FOUR FINGER CHOCOLATE-COATED WAFER (3D MARK)** Preliminary ruling of 16 September 2015, *Société des Produits Nestlé SA v Cadbury UK Ltd* – EN.




Nestlé sought to register the 3D shape of the 'Kit Kat' four-finger chocolate-coated wafer (see above) in the UK as a national 3D trade mark. The National Office rejected the application. Nestlé appealed the decision to the EWHC and Cadbury filed a cross-appeal. The EWHC made a reference to the CJ for a preliminary ruling asking: 1) In order to establish that a trade mark has acquired distinctive character following the use that had been made of it within the meaning of Article 3(3) of Directive 2008/95 ..., is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant Class of persons recognise the mark and associate it with the applicant's goods in the sense that, if they were to consider who marketed the goods bearing that mark, they would identify the applicant; or must the applicant prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trade marks which may also be present) as indicating the origin of the goods. 2) Where a shape consists of three essential features, one of which results from the nature



of the goods themselves and two of which are necessary to obtain a technical result, is registration of that shape as a trade mark precluded by Article 3(1)(e)(i) and/or (ii) of Directive 2008/95 ...? 3.) Should Article 3(1)(e)(ii) of Directive 2008/95 ... be interpreted as precluding registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured as opposed to the manner in which the goods function?' (2) The grounds for refusal of registration laid down in Article 3(1)(e) operate independently of one another (para. 46). Hence, registration may be refused only where at least one of those grounds is fully applicable to the sign at issue (para. 48) Therefore, Article 3(1)(e) of Directive 2008/95 must be interpreted as precluding registration as a trade mark of a sign consisting of the shape of goods where that shape contains three essential features, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, provided, however, that at least one of the grounds for refusal of registration set out in that provision is fully applicable to the shape at issue (para. 51). (3) By literal interpretation, the ground for refusal provided for in Article 3(1)(e)(ii) of Directive 2008/95 is restricted to the manner in which the goods function rather than to a particular method of manufacturing the shape in question (para. 54). From the consumer's perspective, the manner in which the goods function is decisive and their method of manufacture is not important (para. 55) Moreover, the manufacturing method is not decisive in the context of the assessment of the essential functional characteristics of the shape of goods either. The registration of a sign consisting of a shape attributable solely to the technical result must be refused even if that technical result can be achieved by other shapes, and consequently by other manufacturing methods (para. 56). It follows that Article 3(1)(e)(ii) of Directive 2008/95 does not preclude registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured. (1) Acquisition of distinctive character may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. However, in consequence of such use, the relevant class of persons must actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking (para. 64). Hence, for the purposes of the registration of the mark itself, the trade mark applicant must prove that that the relevant Class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company (para. 66-67) (emphasis added).

◆ [T-633/13](#); **INFOSECURITY**, Judgment of 23 September 2015, *Reed Exhibitions Ltd v OHIM* – EN. The applicant sought to register the word mark 'INFOSECURITY' for goods and services in Classes 16, 35 and 41. The examiner refused to register the word as a CTM for most of them, on the ground that it is descriptive and devoid of any distinctive character. The BoA dismissed the applicant's appeal, as did the



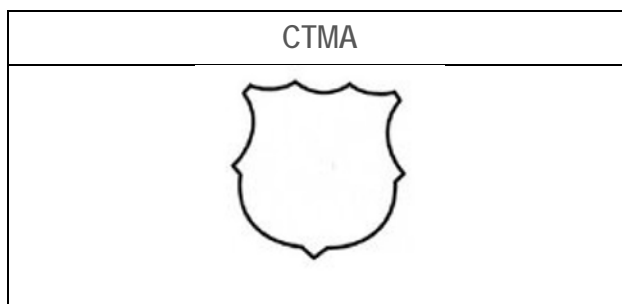
GC. In relation to the actual use  , the addition of the element 'europe' to the element 'infosecurity' alters how the mark applied for, as a mark, is perceived by the relevant public, since its association with the term 'infosecurity' may be perceived as a reference to the European edition of the Infosecurity exhibition, and not as a trade mark (para. 82). The applicant cannot reasonably claim that use of the mark applied for as a trade name may lead to the acquisition of distinctive character. The applicant cannot rely on the mark applied for having acquired distinctive character as a result of its use as a trade name while disputing, in the case in point, the existence of such use (para. 86). Even if that use did take place, such use as a trade name does not suffice on its own to establish that a significant proportion of the relevant public perceives a link between the services delivered under the sign at issue and a particular undertaking. Indeed, unlike a trade mark, the purpose of a trade name is not, of itself, to



distinguish goods or services (paras 88-89). The fact that an exhibition is successful does not mean that its title is perceived as a trade mark in the sense that it would enable the relevant class of persons immediately to identify the undertaking behind that exhibition and to dissociate that exhibition from exhibitions of other undertakings on identical subjects. That is a fortiori the case where the title of the exhibition is directly descriptive of its content (para. 93). As regards the two statements filed, the fact that they were signed after the application for registration was filed does not mean that they are devoid of evidential value for the purposes of assessing the acquisition of distinctive character through use as at the date when the application for registration of the contested mark was filed. Similarly, as regards the BoA's objection as to the absence of spontaneity on the part of those making the statements and the applicant's role in the drawing up of the statements submitted, it is important to point out that — contrary to what is suggested in the contested decision — the fact that those statements were made following a request by the applicant and that the applicant may have coordinated the preparation of those statements does not, in itself, cast doubt on their content and evidential value. However, it is clear that the BoA was correct in regarding those two statements as insufficient '[a]s sole evidence of the relevant public's actual perception of the mark'. Regardless of the circumstances in which they were drawn up and, in particular, of their date, they express an opinion only as to how the sign is perceived by professionals, whereas the relevant public also includes final consumers. In those circumstances, they do not establish that the mark applied for acquired distinctive character through use for average consumers, who form part of the relevant public (para. 101). The reference made by the applicant, in the form of a summary, to the 'evidence' claimed to have been provided during the administrative proceedings must be dismissed as unsubstantiated insofar as it is supported only by a general and implicit reference to evidence submitted in the administrative proceedings (para. 112). In any event, even if the evidence to which the applicant refers could be taken into account, it would not be sufficient for the mark applied for to be regarded as having acquired distinctive character through use. In the first place, the applicant's possible position as leader on the market in question, even if it were established, does not necessarily lead to the relevant public identifying the commercial origin of the Infosecurity exhibition because of its title, as it might do because of a trade mark, particularly where the sign 'INFOSECURITY' may be used as a trade name or in order to designate the title of an exhibition. The same is true of the evidence relating to attendance at the Infosecurity exhibition (paras 113-114). In the second place, the applicant's advertising and marketing investments are allocated to specific sectors such as the information security sector, but also to the banking, finance and government administration sectors. That does not prove that the average consumer, who also forms part of the relevant public, is — like the professional public — also targeted by that advertising. Moreover, as regards the sums invested by the applicant, it is impossible in the present case to measure the relative significance of the applicant's advertising investments in the absence of data that make it possible to compare them with the overall volume of advertising on the market for the goods and services at issue in the EU (para. 115). Insofar as the applicant relies on ownership and management of websites (www.infosecurity.be, www.infosecurity.nl and www.infosecurity.co.uk), it is clear that since the mark applied for corresponds to a domain name, the fact that internet users visit the site on which the goods and services are offered does not suffice to prove that that mark has been 'used' within the meaning of Article 7(3) CTMR (para. 117).



◆ [T-615/14](#); **DEVICE OF A SHIELD**, Judgment of 10 December 2015; *Fútbol Club Barcelona v OHIM – ES*.



The applicant sought to register the figurative mark represented above as a CTM for goods and services in Classes 16, 25 and 41. The examiner refused to register the mark as a CTM on the ground of Article 7(1)(b) CTMR and took the view that the conditions of Article 7(3) CTMR were not fulfilled. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC confirms that Article 7(3) CTMR is not applicable. The sign appears in the evidence in combination with other marks (namely, with the proper shield of FC Barcelona). However, this evidence is not relevant, because the CTMA cannot be clearly differentiated from the other marks (paras 61-62), contrary to the situation in 'Have a break... have a Kit Kat', where 'have a break' could be clearly differentiated from the other part of the mark in combination with which it had been used (paras 61-62).

◆ [T-359/12](#); **CHEQUERBOARD PATTERN I**, Judgment of 21 April 2015, *Louis Vuitton Malletier v OHIM – EN*.

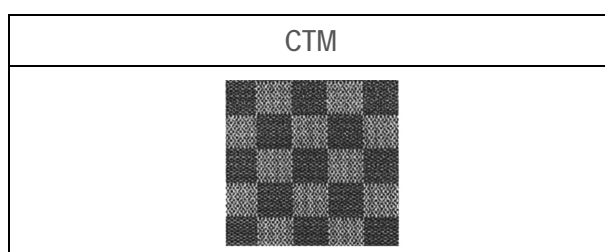


The CTM holder registered the above figurative mark for a range of goods in Class 18. The invalidity applicant sought the cancellation of the contested CTM on the grounds of Article 52(1)(a) and Article 7(1)(b), (c), (d), (e)(iii) and (f) CTMR. The CD upheld the invalidity request on the basis of Article 7(1)(b) in conjunction with Article 52(1)(a) CTMR, and Article 7(3) in conjunction with Article 52(2) CTMR. On appeal, the BoA confirmed the CD's decision. The BoA found that the chequerboard pattern, as represented in the contested trade mark, was a basic and banal feature composed of very simple elements and that it was well-known that that feature had been commonly used with a decorative purpose in relation to various goods, including those falling within Class 18. As to the claim of acquired distinctiveness through use, the GC recalled the settled case law to the effect that for Article 7(3) CTMR to be successfully invoked it is necessary to establish the acquisition of distinctive character through use in all the territory in which the mark did not, *ab initio*, have such character (para. 85), in this case the whole of the EU. The GC added, referring to the previous judgment, that it would be paradoxical to



accept, on the one hand, that a Member State has to refuse to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other hand, that that same Member State has to respect a Community trade mark relating to that sign for the sole reason that it has acquired distinctive character in the territory of another Member State (para. 86). The CTM proprietor failed to demonstrate that the contested mark had acquired distinctive character in consequence of the use that had been made of it in Denmark, Portugal, Finland and Sweden (paras 101-117).

◆ [T-360/12](#); **CHEQUERBOARD PATTERN II**, Judgment of 21 April 2015, *Louis Vuitton Malletier v OHIM* – EN.



The CTM proprietor registered the above figurative mark for a range of goods in Class 18. The invalidity applicant sought the cancellation of the contested CTM on the grounds of Article 52(1)(a) and Article 7(1)(b), (c), (d), (e)(iii) and (f) CTMR. The CD upheld the invalidity request on the basis of Article 7(1)(b) in conjunction with Article 52(1)(a) CTMR, and Article 7(3) in conjunction with Article 52(2) CTMR. On appeal, the BoA confirmed the CD's decision. The BoA found that the chequerboard pattern as represented in the contested trade mark was a basic and banal feature composed of very simple elements and that it was well-known that that feature had been commonly used with a decorative purpose in relation to various goods, including those falling within Class 18. As to the claim of acquired distinctiveness, the BoA found that it had not been established that the contested trade mark had acquired distinctive character through the use that had been made of it in a substantial part of the relevant territory, namely in Bulgaria, Denmark, Estonia, Latvia, Lithuania, Malta, Poland, Portugal, Slovenia, the Slovak Republic, Finland and Sweden, either at its filing date or after its registration. The GC dismissed the appeal and confirmed the BoA's findings. As to the claim of acquired distinctiveness through use, the GC recalled the settled case law to the effect that for Article 7(3) CTMR to be successfully invoked, it is necessary to establish the acquisition of distinctive character through use in all the territory in which the mark did not, *ab initio*, have such character (para. 85), in this case the whole of the EU. The GC added, referring to a previous judgment, that it would be paradoxical to accept, on the one hand, that a Member State has to refuse to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other, that that same Member State has to respect a Community trade mark relating to that sign for the sole reason that it has acquired distinctive character in the territory of another Member State (para. 86). The CTM proprietor failed to demonstrate that the contested mark had acquired distinctive character in consequence of the use that had been made of it in Bulgaria, Denmark, Estonia, Latvia, Lithuania, Malta, Poland, Portugal, Slovenia, the Slovak Republic, Finland and Sweden (paras 101-117).



III. Relative Grounds for Refusal/Invalidity

A. Articles 8(1)(a) and 53(1)(a) CTMR — identical signs/goods and services

[no entry]

B. Articles 8(1)(b) and 53(1)(a) CTMR — likelihood of confusion

I. *Likelihood of confusion (LOC)*

[T-685/13](#); **BLUECO / BLUECOAT**, Judgment of 21 January 2015, *Copernicus-Trademarks Ltd v OHIM – DE*. The CTM applicant sought to register the mark 'BLUECO' for goods in Class 9. An opposition based on the earlier mark 'BLUECOAT', registered for identical goods in Class 9, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC confirmed the BoA's finding of an average to high degree of attention of the relevant consumers of the respective goods in Class 9 (para. 27). Furthermore, the GC made clear that the evaluation of the visual similarity of two word marks has to take into account the presence of letters in the same order. The contested trade mark application is fully contained in the earlier mark, which is an important indicator for the similarity of the marks (para. 33). Furthermore, the differing, additional element 'at', positioned at the end of the earlier mark, plays only a subordinate role in the overall perception of the mark (para. 35). The marks are aurally highly similar for the English consumers due to the same letter string 'BLUECO'. The GC rejected the applicant's argument that the consumers would phonetically double the middle vowel 'E' within the earlier mark, allegedly leading to a three syllable pronunciation 'BLUE ECO'. Since the word 'BLUE' is part of common English vocabulary, there is no reason to assume that the consumers will actually perform this exercise (para. 40). Furthermore, the respective endings 'CO'/'COAT' are phonetically not that far apart for English consumers. Conceptually, the marks are similar with regard to the basic English word 'Blue', indicating a colour. The applicant has not demonstrated that 'BLUE' has any descriptive connection with any of the goods in Class 9. Therefore, the distinctiveness of the earlier mark is of an average degree (para. 51). The argument of the applicant that in the present case the likelihood of confusion is ruled out due to the fact that the earlier mark has a clear and common meaning must be dismissed. It is true that under certain circumstances conceptual differences can neutralise visual and phonetic similarities, if at least one of the signs has a clear meaning for the relevant consumers. However, in the present case, both marks share the same concept with regard to the identical initial element 'BLUE' (para. 54). Therefore, the mere fact that the earlier mark has a clear meaning for English consumers is not sufficient to rule out a likelihood of confusion in light of the visual, conceptual and high aural degree of similarity between the marks and the identity of the goods (para. 55). Based on the foregoing, the action was dismissed. **LOC**.




◆ [T-33/13](#); *bonus&more / bonus net*, Judgment of 5 February 2015, *Türkiye Garanti Bankasi AS v OHIM* – EN.

CTMA	Earlier mark
	

The CTM applicant sought to register the above sign as a CTM for, inter alia, services in Classes 35, 36 and 42. The opponent (applicant before the GC) based its opposition on Article 8(1)(b) CTMR using the earlier IR as depicted above, registered for services in Classes 35, 36 and 42. The OD partially upheld the opposition. The BoA upheld the appeal from the CTM applicant and found that the signs are overall dissimilar. The opposition has consequently been rejected in its entirety. The opponent appealed to the GC, arguing an infringement of Article 8(1)(b) CTMR. The GC annulled the contested decision for the following reasons: Comparison of the signs: Visually both marks bear at their beginnings the term 'bonus', which occupies the first position in both signs and cannot be considered as negligible (paras 29 and 30). Although there are also visual differences as stated in the contested decision, these differences may not counteract the visual similarities rendering the marks visually different. A certain degree of visual similarity cannot be denied (paras 31-32). Phonetically, the first two syllables, which are identical, create an average degree of aural similarity. The conclusions of the contested decision according to which the aural differences in the ending parts of the signs create an overall aural difference are not upheld by the GC (paras 33-34). From a conceptual point of view, the GC underlines that the term 'bonus' will be understood by a significant part of the relevant public and will create a certain conceptual link between the signs. The elements that follow the term bonus in each mark will complement the meaning of bonus but not — as the BoA stated — counteract it. The fact that the meaning of 'bonus' is weak does not alter this finding (paras 40-42). Consequently, the signs are not overall dissimilar — as concluded in the contested decision — but to the contrary have a certain degree of similarity overall. Consequently, the Office should carry out a comparison of the services and make an overall assessment on likelihood of confusion (paras 42 and 47). **LOC**



◆ [T-377/12](#); **OLEOSPA / SPA**, Judgment of 27 February 2015; *Spa Monopole, compagnie fermière de Spa SA/NV & Olivar Del Desierto, SL v OHIM* – FR.

CTMA	Earlier marks
	SPA

The intervener sought to register the figurative sign 'OLEOSPA' represented above as a CTM for Classes 3, 35 and 39. An opposition based on two Benelux marks 'SPA', covering goods in Classes 3 and 32 was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR for the second mark. The OD upheld the opposition on the basis of Article 8(1)(b) CTMR, finding that there was a likelihood of confusion between the marks for all the challenged goods and services. The BoA annulled the OD decision and considered that the signs were similar to a low degree and that the common element 'SPA' was weak for products in Class 3; on the Article 8(5) CTMR grounds, it held that although the reputation of the mark was established for products in Class 32, the conditions of Article 8(5) CTMR were not met. The GC took note that the applicant did not challenge the decision of the BoA on the relevant public, who are the Benelux public, and that their level of attention is average (para. 24). The conclusion that the cosmetic products are identical was also confirmed (para. 25). On the visual similarity, the GC confirmed the BoA's assessment that the contested mark presents visual differences with the earlier mark. Although the signs share the term 'SPA', which is visually highlighted in the contested sign, the BoA was correct when it held that the signs are visually similar to a low degree (para. 30). On the phonetic comparison, the GC approved the assessment that the signs are phonetically similar to a low degree (para. 31). On the conceptual similarity, the BoA was correct to hold that the term SPA for cosmetic products evokes places devoted to hydrotherapy and relaxation. The term *oleo* was correctly assessed as referring to oil because of its Latin origin (para. 33). However, the BoA contradicted itself when it held that although the signs refer to a centre where balneotherapy and relaxation services are provided, it concluded that there was a weak conceptual similarity. The conceptual similarity is strong (para. 35). On the overall assessment, the GC held that the BoA erred in the evaluation of the distinctiveness of the earlier mark; the BoA's conclusion on this paragraph was based on the wrong assessment that as the term 'SPA' evokes a centre for relaxing and beauty care, the term was weak for cosmetic products (para. 41). The GC referred to its case law, which establishes that the distinctiveness of a sign must be determined in relation to the goods and services. A term may be descriptive for certain goods and services and distinctive for others (para. 41). On this paragraph, the GC quoted its previous case law on the mark 'SPA' (judgments of 25/03/2009, T-109/07, SPA Therapy, EU:T:2009:81, paras 24 and 28; 25/03/2009, T-21/07, SPALINE, EU:T:2009:80, para. 31), where the term was considered distinctive for cosmetic products (para. 42). Because it has a normal distinctive character, the term 'SPA' will play a distinctive autonomous role within the contested sign (para. 44). In conclusion, as the goods are identical, the earlier signs enjoy a normal distinctiveness and taking into account the autonomous position of the terms 'SPA' in the earlier sign, there is a risk of confusion (para. 45); the BoA erred in concluding that there was no risk of confusion (para. 46). As the opposition succeeds on the Article 8(1)(b) CTMR ground, there is no need to decide on Article 8(5) CTMR (para. 48). **LOC**



◆ [T-123/14](#); **AQUAPERFECT / WATERPERFECT**, Judgment of 28 January 2015, *BSH Bosch und Siemens Hausgerate GmbH v OHIM* – EN. The applicant sought to register the word mark ‘AquaPerfect’ as a CTM for a range of goods in Class 7, including pumps other than machine or motor parts, namely hydrophores, water pumps (electro pumps, motor pumps), pumps for heating installations; electric apparatus used in the kitchen for chopping, grinding, crushing, mixing and crumbling, namely mixers, blenders, kitchen robots, electric knives, meat-grinding machines, garbage disposal machines; dishwashers, washing machines and dryers in Class 7. An opposition was based on the earlier word mark ‘waterPerfect’, registered, inter alia, for electrical household and kitchen machines and apparatus (included in Class 7), in particular electrical kitchen machines and apparatus including grinders/crushers, mixing and kneading devices, fruit pressing machines, de-juicers, juice centrifuges, grinding machines, cutting devices, electrically powered tools, in Class 7. The opposition was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition for all the contested goods. The BoA annulled the decision of the OD. The BoA found that there was no likelihood of confusion because the earlier mark had a low degree of distinctiveness, the level of attention of the relevant public was higher than the average, the only common element between the signs was the laudatory element ‘perfect’, and the signs had only a low degree of visual and phonetic similarity. The applicant filed an action before the GC arguing, an infringement of Article 8(1)(b) CTMR. The GC upheld the appeal. The GC firstly found that, although the BoA’s finding that the relevant public had a higher level of attention was not disputed, there were also some daily consumer goods (household products) to be taken into account for which the consumers’ level of attention was normal (paras 21-23). The identity and similarity of the goods was not challenged and was confirmed. In relation to the similarity of the signs, the GC found that, visually, the signs are similar in length, that the common element is longer than the different elements ‘aqua’ and ‘water’. Furthermore, the different elements are, despite their differences, equivalent in terms of length. Therefore, the similar elements prevail globally over the dissimilar elements and the degree of visual similarity is average and not low (para. 32). At the phonetic level, the GC confirmed that the signs differ in their first two syllables. However, the signs have the same number of syllables (four), and they share their last two syllables. Furthermore, the signs have the same length and, in both cases, the vowel ‘a’ is followed by an occlusive unvoiced consonant, ‘t’ and ‘q’, respectively. Consequently, the signs at issue must be considered phonetically similar, to an average degree. The fact that the dissimilar elements are positioned at the beginning of the signs, which in general is the part with greater weight, is not significant in this case because the similar elements between those signs prevail globally over the dissimilar elements (para. 33). Conceptually, the EU consumer may be assumed to know that the element ‘aqua’ of the mark applied for has the meaning of ‘water’. The same conclusion is valid for the element ‘water’ of the earlier mark and for the common element ‘perfect’, being part of the basic vocabulary of the English language (para. 34). The word ‘perfect’ will be perceived as a synonym for ‘great quality’ and thus as a laudatory adjective by the relevant public. Consequently, for a large part of the relevant public, the signs at issue have the same semantic content: they are both alluding to the idea that the goods in question are made in order to obtain excellent water, or are high quality waterproof products or are excellent products that use water (paras 35-38). The GC recalled that, according to settled case law, a linguistic difference between signs that requires the consumer to make a translation may prevent the relevant public, at least to some degree, from making an immediate conceptual comparison. The GC found however that in the present case, the term ‘aqua’ is a common Latin term, the meaning of which may be assumed to be known by consumers of the European Union. Moreover, all the elements of the signs will be understood by a large part of the general public, even the non-English-speaking part. Consequently, the signs at issue do have some conceptual similarity. Therefore, the signs are similar overall to an average degree (paras 39-41). In relation to the weakness of the common element ‘perfect’, the GC found that, while that



element may indeed be considered to have a weak distinctive character, the fact remains that none of the other elements making up the same signs can be considered to have a greater distinctive character or be dominant. The elements 'aqua' and 'water' also have a weak distinctive character owing to the fact that the relevant goods all involve, in one way or another, water. Accordingly, the fact that the element 'perfect' has a weak distinctive character and that it is positioned at the end of the signs, while their dissimilar elements are at the beginning, has no consequence on the overall impression of the signs at issue (para. 42). The GC also found that the argument concerning the weak distinctive character of the earlier mark is not directly relevant in the comparison of the signs and it will, if necessary, be taken into account in the global assessment of the likelihood of confusion (para. 43). The GC concluded that, in the light of the identity or the similarity of the goods covered by the signs at issue, their average similarity, particularly at the visual and phonetic level, and the normal level of attention of a part of the relevant public, the BoA was incorrect to find that there was no likelihood of confusion between the marks at issue (para. 49). That conclusion is not called into question by the finding that the earlier mark has a weak distinctive character. Without it even being necessary to rule on the validity of that finding, such a finding would not prevent a likelihood of confusion being found in the present case. Therefore, although the distinctive character of the earlier mark must be taken into account in assessing the likelihood of confusion, it is only one factor among others involved in that assessment. In the present case, notwithstanding the assessment of the distinctive character of the earlier mark, the existence of a likelihood of confusion may be established in the light of the similarity of the signs at issue and the identity or similarity of the goods in question, account being taken of the level of attention of a part of the relevant public (para. 50). **LOC**

[T-388/13](#); **SAMSARA / SAMSARA**, Judgment of 26 February 2015, *Costa Crociere SpA v OHIM* – EN. The applicant sought to register the word mark 'SAMSARA' as a CTM for a range of services in Class 44, namely: spas, Turkish baths, sauna services, health spa services, all provided on board cruise ships. An opposition was based on the earlier word mark 'SAMSARA', registered for soaps, perfumery, essential oils, cosmetics, hair lotions, and dentifrices in Class 3. The opposition was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD upheld the opposition for all the contested services on the basis of Article 8(1)(b) CTMR. The BoA confirmed the decision of the OD. The BoA found that the goods in Class 3 and the services in Class 44 at issue were similar to an average degree and that the signs were identical and that, consequently, there was a likelihood of confusion. The applicant filed an action before the GC arguing an infringement of Article 8(1)(b) CTMR. The GC dismissed the appeal. The GC firstly held that the goods and services at issue share the same overall purpose, which is beauty and health care. In particular, soaps, cosmetics, perfumes and other goods in Class 3 and spas, Turkish baths and sauna services in Class 44 are both used to wash, purify and keep the human body in good condition or make it more attractive. The earlier mark's services often include cosmetic treatments requiring the use of soaps, fragrances, oils and other beauty products. The establishments that provide such services may also offer for sale beauty and health products bearing their mark. Therefore, the distribution channels might overlap and the targeted public is identical. There is also some complementarity between those goods and services: the treatments in spas, Turkish baths, etc. are usually followed by the application of body lotions and moisturising creams. The fact that the applicant provides its services on board cruise ships does not in any way alter their overall purpose. There is nothing in the file to indicate that the applicant's services exclusively serve a curative purpose. On the contrary, the fact that the services are provided on board cruise ships confirms that the public does not consist solely of persons who need medical treatment. Consequently, the claim relating to the



dissimilarity of the goods and services at issue must be rejected (paras 25-34). The GC found then that the actual circumstances of use of the earlier mark are not relevant since the applicant had not requested proof of use of the earlier mark (para. 36). In relation to the applicant's argument that the word 'SAMSARA' lacks, or has a low degree of distinctiveness, and it is descriptive of the services it covers in Class 44, the GC found first that the great majority of consumers will not associate any meaning with that word since they do not know that it means 'eternal cycle of life' in Sanskrit. Secondly, even if some of the consumers know the meaning of that word, the BoA was entitled to find that the abovementioned meaning was not descriptive of either the goods for which the earlier mark enjoys protection or the services covered by the trade mark application (para. 38). It follows from the foregoing that the BoA did not err in finding that, given the average degree of similarity of the goods and services at issue and the identity of the signs, there was a likelihood of confusion in respect of all the contested services. **LOC**




◆◆[T-611/11](#); **MANEA SPA / SPA**, Judgment of 17 March 2015, *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM* – FR. The CTMA 'MANEA SPA' (word mark), in Classes 3, 24, 25, 43 and 44, was opposed on the basis of, inter alia, two earlier Benelux registrations of the word 'SPA' in Classes 3 and 32. Enhanced distinctiveness and reputation were claimed in respect of mineral water. The grounds of the opposition were Article 8(1)(b) and Article 8(5) CTMR. The OD upheld the opposition in respect of the goods and services in Classes 3 and 44 (beauty and wellness services, hammam, spa services etc.) Both parties lodged an appeal. The BoA upheld the CTM applicant's appeal and dismissed the opposition under both Article 8(1)(b) and Article 8(5) CTMR. It found in substance that the signs were dissimilar given that the word 'SPA' is descriptive of hydrotherapy services. The BoA also dismissed the claim that the earlier word mark in Class 32 had acquired reputation given that the vast majority of the evidence related to a figurative mark that is the object of a separate registration and in which the logo of a clown was found to surpass the word element in importance. The BoA relied for that purpose on the guidance of the CJ in *Bainbridge* (C-234/06 P, EU:C:2007:514). Even if the parties concentrated their submissions before the BoA on Article 8(5) CTMR, the BoA was called to adjudicate on Article 8(1)(b) CTMR because the appeals lodged by the parties concerned both grounds. It follows that the opponent is not altering the subject matter of the dispute by contesting before the GC the way Article 8(1)(b) CTMR was applied by the BoA (paras 31-35). Further to the substance of the case (Article 8(1)(b) CTMR), the goods in Class 3 are identical and the services in Class 44 are similar to the Class 3 goods (para. 49). The BoA did not make any express statement in respect of the services in Class 43 (restaurant services (food); temporary accommodation; bars; hotel services; catering services; hotel room reservations) but it implicitly considered these services to be similar to the beverages in Class 32. The GC however confirms that the services in Class 43 are similar to the beverages in Class 32 in view of their complementarity (para. 52). The signs are visually and aurally similar to a low degree (paras 61-62). Conceptually, the signs coincide in the reference to hydrotherapy centres (para. 65). The overall similarity is not weak, given that the earlier mark is fully reproduced in the CTMA, the two components of which do not form a 'unitary whole' (para. 66). The word mark 'SPA' is normally distinctive in respect of cosmetics in Class 3 (para. 71). As to the conclusion on likelihood of confusion, there was a likelihood of confusion in respect of the goods and services in Classes 3 and 44 given the identity/similarity of the goods, the similarity of the signs and the average degree of distinctiveness of the earlier mark. There was a likelihood of confusion in Class 43 given the enhanced degree of distinctiveness of the earlier mark in Class 32 and the complementarity of the goods and services. The CTMA is thus refused in respect of the goods and services in Classes 3, 43 and 44. **LOC**



◆ [T-78/13](#); **BULLDOG / BULL**, Judgment of 5 February 2015, *Red Bull GmbH v OHIM* – EN. An opposition was filed against the CTM application 'BULLDOG' (word mark) for goods in Classes 32 and 33 based, inter alia, on earlier IR designating the EU 'BULL' (word mark) covering goods in Class 32. The opposition was based on Article 8(1)(b) and Article 8(5) CTMR. The OD upheld the opposition based on Article 8(1)(b) CTMR. The BoA reversed the First Instance decision. It considered in particular that the conceptual differences would neutralise the visual and aural similarities rendering the signs dissimilar overall. Consequently, it dismissed the opposition. The opponent (applicant before the GC) filed an appeal, arguing an infringement of Article 8(1)(b) CTMR. The goods were found identical (undisputed) (para. 25). The consumers are held to be the general public with an average degree of attention (para. 24). Comparison of the signs: With regard to the visual comparison, the GC found that the earlier mark is fully included in the beginning of the contested mark. The four letters 'BULL' also constitute the majority of the seven letters of the contested application. Since the beginnings of the marks are in principle more important than the endings of the signs, there is a medium degree of visual similarity and not a low degree as stated in the contested decision (para. 31 and 32). Similarly, the GC considered that the fact that the earlier mark is fully contained in the pronunciation of the first syllable of the contested sign is sufficient to rule out the assessment of the BoA, which held the marks to be aurally similar to a low degree. However, the second syllable of the application may not be neglected, as claimed by the applicant. The goods are not only sold in noisy ambiances such as bars, but also in supermarkets and retail stores. Consequently, there is an average degree of phonetic similarity (paras 37-39). The most important aspect in this case refers to the conceptual comparison of the signs. The BoA found that for the public who will understand at least the meaning of the term 'BULLDOG', this meaning will neutralise the visual and aural similarities and avoid any likelihood of confusion. The GC had a very different approach. First of all, it distinguished — as the BoA did — between the English-speaking public who will understand the meaning of both signs, 'BULL' and 'BULLDOG' and the non-English-speaking public, who will only understand the meaning of 'BULLDOG' (para. 47). For the latter group of consumers, there cannot be any conceptual comparison of the marks because one of the signs has no meaning (para. 48). For those consumers that understand the meaning of both marks and despite the fact that they denote two different animals, the GC held that they convey the image of animals with a concentrated force, a great muscular force, often expressing itself aggressively towards others. Therefore, it concluded that for those consumers there would be a low degree of conceptual similarity (para. 50). Overall assessment on likelihood of confusion: the different approach taken by the GC in the conceptual comparison had a direct impact on the overall assessment of LOC. Since for one part of the public the conceptual comparison has no impact and for another relevant part the signs are conceptually even similar to a low degree, the conceptual comparison cannot neutralise the visual and aural similarities any more, as found by the BoA. Since the marks are similar and the goods identical, the GC found that there is a likelihood of confusion (para. 60). **LOC**




[T-395/12](#); **SOLID FLOOR** The professional's choice / **SOLID FLOOR** et al., Judgment of 11 February 2015, *Fetim BV v OHIM*, – EN.

CTMA	Earlier Mark
	 

The applicant sought to register the figurative mark 'Solidfloor The professional's choice' shown above as a CTM, for goods within Class 19 ('building materials, not of metal, parquet flooring of plastic and wood, flooring of wood, cork and laminate, subfloors, transportable floors, not of metal'). The opponent based an opposition on Article 8(1)(b) CTMR using the earlier figurative trade mark 'SOLID floor', represented above, registered in the United Kingdom for goods and services in Class 19 ('solid wood flooring, wooden parquet flooring') and in Class 37 ('installation of wood flooring'). The OD rejected the opposition and the applicant filed an appeal. The BoA upheld the appeal, annulled the OD decision and rejected the CTM application in its entirety, because it found that the trade mark applied for and the earlier trade mark were highly similar overall and the goods and services in question were partially identical and partially similar. The applicant filed an action before the GC. Concerning Article 8(1)(b) CTMR, the GC further stated that the attentiveness of relevant public was average and confirmed the BoA finding of partial identity and partial similarity of the goods and services at issue (paras 22-23). Contrary to the applicant's conclusion, the GC found that word element 'solid floor' constitutes the dominant element of both the mark applied for and of the earlier mark. In accordance with the GC's ruling in Case T-134/06 (13/12/2007, T-134/06, Pagesjaunes.com, EU:T:2007:387) it was pointed out that the weak distinctive character of the word element 'solid floor' cannot automatically prevent the perception of this element as a dominant one. Consequently, it was necessary to take into account the word element when the trade marks at issue were compared (paras 29, 32-33). The GC also confirmed the conclusions of the BoA regarding the word element 'The professional's choice', which is not particularly striking and would not be perceived as a badge of origin (para. 34). On that basis, the GC considered that the trade marks at issue are visually similar (paras 35-36). These marks are also highly similar from the phonetic point of view, because consumers pay greater attention to the beginning of the marks — in this case the dominant word element 'solid floor', which both contain (paras 37-38). Conceptually, it is clear that a high level of similarity also exists there, because consumers would perceive the terms 'solid' and 'floor' in the trade marks at issue identically (paras 39-40). In light of those facts, the GC upheld the BoA finding that there was a likelihood of confusion and, in addition, the fact that the earlier mark has a weak distinctive character does not preclude a finding of likelihood of confusion (paras 45 and 46). There is no infringement of Article 8(1)(b) CTMR. LOC




[T-596/13](#); *NAEL / McNEAL*, Judgment of 26 March 2015, *Emsibeth SpA v OHIM* – IT.

CTMA	Earlier mark
	<p>Mc Neal</p>

The applicant sought to register the figurative mark as a CTM for a range of goods in Class 3, namely: soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for colouring and decolouring hair; shampoos. An opposition was based on the earlier word mark 'Mc Neal', registered for soaps, perfumery, essential oils, cosmetics, hair lotions and dentifrices in Class 3. The opposition was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition on its entirety. The BoA upheld the appeal and annulled the OD decision. The applicant filed an action before the GC arguing an infringement of Article 8(1)(b) CTMR. The GC firstly held that, notwithstanding the applicant had not disputed the identity of part of the goods at issue before both the OD and the BoA, its arguments against the finding of identity of part of the contested goods are admissible before the GC (paras 32-36). As far as the relevant public is concerned, the BoA was right in finding that it is the general public. Firstly, when the contested goods and services are destined for the public as a whole, the relevant public is composed of the average consumer. Secondly, even though cosmetics, perfumes and goods for hair care in Class 3 can also be purchased by professionals, they are goods that target the public as a whole. Therefore, the level of attention of the consumers is average (paras 25-28). As regards the similarity of signs, the GC held that, visually, the element 'Neal' will have a greater impact on the public's attention because of its length. On the contrary, the element 'mc' will be perceived, by the part of the consumers that do not understand the English language, just as the combination of two letters devoid of any meaning. Therefore, the element 'Neal' has a distinctive and dominant position in the earlier mark. The figurative elements of the contested mark, although minimal, are not negligible. Therefore, the BoA erred in finding that the marks are visually highly similar. On the contrary, they are visually similar to an average degree (paras 46-47). Phonetically, the GC confirmed the BoA's finding that because of the similarity of the letters 'ea' and 'ae', there is a low degree of phonetic similarity between the marks at issue in German, Spanish and French (para. 49). On the conceptual similarity, the GC found that the English-speaking part of the public will identify 'Mc Neal' as a Scottish surname. 'Nael' is a personal name very rare in France and it means 'nail' in Estonian. It follows that only the persons that know both Estonian and English or English and French may compare the marks conceptually. Since those consumers do not represent a significant part of the relevant public, and for the vast majority of the public the signs are devoid of any concept, a conceptual comparison is not possible (para. 50). On the overall assessment, the GC referred to the case law, according to which the visual similarity is more important for goods such as the ones at issue that are purchased directly by the consumer, to the extent that the image of the mark as affixed on the product is the most important factor in the consumer's choice (paras 52-53). In light of the above, and according to the interdependence principle between the degree of similarity of the goods and services and that of the signs, there is a likelihood of confusion between the marks at issue. Therefore, the only claim of the applicant has to be dismissed. **LOC**





[T-505/14](#); **SEVEN FOR ALL MANKIND / ZEVEN et al**, *Seven For All Mankind LLC v OHIM*, Order of 23 February 2015 – EN.

CTMA	Earlier marks (CTM & IR)
SEVEN FOR ALL MANKIND	

An application for a CTM for goods in Classes 14 and 18 was filed. An opposition pursuant to Article 8(1)(b) CTMR was filed based on a figurative mark for goods also in Classes 14 and 18. After judgments of the GC and the CJ, the case was reverted back to the BoA, which found a likelihood of confusion between the signs. The applicant challenged the findings which are now res judicata (para. 27), or which are irrelevant. The single plea in law is rejected. LOC

◆◆[T-581/13](#); **POLO CLUB / BEVERLY HILLS POLO CLUB**, Judgment of 26 March 2015, *The Royal County of Berkshire Polo Club Ltd. v OHIM* – EN.



CTMA	Earlier marks
	

The applicant sought to register the above figurative mark as a CTM for a range of goods in Classes 9, 14, 18 and 25. An opposition was lodged based on the earlier figurative mark shown above, registered for goods falling within, inter alia, Classes 9, 14, 18 and 25. The opposition was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition in its entirety. The BoA partially annulled the OD's decision and rejected the contested mark for all the goods of Classes 9, 14, 18 and 25, while rejecting the opposition in respect of the goods in Classes 16 and 28. Importantly, the BoA held that the image of the polo player and the words 'polo club' in the two signs in question had an inherent enhanced distinctiveness in relation to the goods in Classes 9, 14, 18 and 25 covered by the signs. The applicant filed an action before the GC arguing an infringement of Article 8(1)(b) and Article 75 CTMR. As to the merits of the case, the GC confirmed that the level of attention of the relevant public is normal (para. 35) and that the goods covered by the marks at issue and falling within Classes 9, 14, 18 and 25 are identical (para. 37). The BoA's finding relating to the enhanced inherent distinctiveness of the image of a polo player and the words 'polo club' cannot be upheld in its entirety: in that respect, the GC held that that image and those words have (i) weak inherent distinctiveness in relation to 'whips, harness and saddlery' in Class 18, given their close connection to the playing of polo; (ii) normal inherent distinctiveness in relation to 'articles of clothing, footwear and headgear' in Class 25, given that they can be used for polo



playing, although there is nothing in their description to the effect that they relate to goods specifically designed for that purpose; (iii) inherent distinctiveness that is more enhanced, and at the very least normal, in relation to the other goods in Classes 9, 14 and to 'leather goods; imitation leather goods; trunks, travel bags, umbrellas, parasols, walking sticks' in Class 18, given that they have no connection with the playing of polo (para. 49). As to the comparison of the signs, the GC upheld the BoA's conclusion that there is some visual similarity between the signs, finding that they both display the figure of a polo player astride a galloping horse and that the images of the polo player occupy a central position in each of the signs (paras 54-55). The aural similarity is relatively low, and the signs have a high degree of conceptual similarity, insofar as each refers to a polo club and displays a device of a polo player, and those devices are similar (paras 53-68). However, given that when assessing the similarity of signs, account must be taken of their distinctive and dominant components, the overall similarity of the signs is lower where the marks are used in relation to 'whips, harness, saddlery' in Class 18 (para. 73). With regard to the goods not directly related to polo playing, the BoA was right in concluding that there was a likelihood of confusion in the mind of the relevant public, whose level of attention is not particularly high (paras 78-79). LOC

[T-384/13](#); COLA / COCA-COLA *et al*, Judgment of 18 March 2015, *Intermark Srl. v OHIM* – EN.


CTMA	Earlier marks
	<p>1)</p>  <p>2) COCA-COLA</p>

The applicant sought to register the mark displayed above for goods and services in Classes 32 and 35. The opponent filed an opposition based on the earlier marks displayed above, registered, inter alia, for goods and services in Classes 32 and 35. The opposition was based on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD upheld the opposition in its entirety. The BoA dismissed the appeal, finding in essence that there was a likelihood of confusion (Article 8(1)(b) CTMR), given the reputation of the earlier marks for the goods in Class 32, the identity of the goods and services and the similarity of the signs at issue. It also took the view that it was not necessary to analyse Article 8(5) CTMR. The CTM applicant brought an action before the GC, putting forward a single plea in law, alleging infringement of Article 8(1)(b) CTMR. The GC pointed out at the outset, that, due to its size and position, the element 'COLA' is the dominant element in the contested CTMA and the further element 'Rienergy' plays a subsidiary — even though not negligible — role (para. 34). Even though 'COLA' might be descriptive for some beverages made from cola nuts, it is not descriptive for the services in Class 35. The weak distinctive character of an element of a composite mark does not necessarily imply that that element cannot constitute a dominant element, since it may, inter alia, because of its position in the sign or its size, make an impression on consumers and be remembered by them (para. 35). Within the earlier marks, the element 'COLA' is a non-negligible, or even a distinctive element. With regard to the visual comparison between the CTMA and the earlier figurative mark, the BoA, inter alia, was right to find a



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

◆ [T-587/13](#); cat & clean / CLEAN CAT, Judgment of 21 January 2015, *Miriam Schwerdt v OHIM* – DE.


CTMA	Earlier Mark
	<p>CLEAN CAT</p>

The applicant sought to register the figurative mark represented above as a CTM for goods within Class 31. An opposition based on earlier Spanish word mark 'Clean Cat', registered for goods in Class 31, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. BoA dismissed the applicant's appeal finding a likelihood of confusion between the marks. According to the BoA, the goods were identical; the signs were visually and phonetically similar, despite the occurrence of the figurative element of the CTMA and the different word order. Except for the Spanish consumers, the marks shared the same concept. The opponent filed an action before the GC relying on three pleas in law. In respect of the plea of infringement of Article 8(1)(b) CTMR, the GC recalled that if the mark is composed of verbal and figurative elements, the verbal elements prevail (para. 24). The marks were found visually similar. The verbal elements in the contested mark are not negligible; to the contrary, they are highly visible. The two word elements are identical. The inversion of the words itself as well as the presence of element '&' in the CTMA cannot lead to absence of visual similarity. Taking into account the goods at issue, the distinctiveness of the representation of a cat is weak (paras 25-27). The GC finds also a certain level of phonetic similarity. Even though the pronunciation defers because of the inversion of the word elements and the presence of '&', two out of three verbal elements in the CTMA are identical to the sole two elements of the earlier mark (para. 29). The marks share the same concept, except for the non-English-speaking Spanish public, for whom no common concept exists (para. 31). The marks are



therefore globally similar, even if no conceptual similarity is found. There is a likelihood of confusion (paras 32-33). As regards the distinctive character of the earlier mark, the GC recalls that it is only one of the factors to be taken into account and even in the case of weak distinctiveness of the earlier mark, a likelihood of confusion can still exist (para. 36). **LOC**

[T-551/13](#); **AKTIVAMED / VAMED**, Judgment of 26 March 2015, *Michael Radecki v OHIM* – DE.

CTMA	Earlier mark
AKTIVAMED	

The applicant sought to register the word mark 'AKTIVAMED' as a CTM for goods and services in Classes 5, 11 and 44. An opposition based on the earlier figurative mark represented above, registered for goods and services in Classes 5, 10, 11 and 44, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA upheld the opponent's appeal. The applicant filed an action before the GC. The relevant Austrian public consisting of general consumers and professionals in the medical and agricultural sector displays at least an average degree of attention. Contrary to the applicant's contention, the attention as regards disinfectants and the goods in Class 11 is not necessarily enhanced (paras 25-28). The medical goods in Class 5 and the medical and veterinary services in Class 44 are similar, and the remaining conflicting goods in Class 11 and the conflicting services in Class 44 are identical (paras 32-37). Even if part of the relevant public understands the suffix 'med' as a reference to medicine, in the combination of the signs in question, it cannot be considered to be of minor importance for the comparison of the signs (paras 44-46). The earlier mark's figurative element, which can be perceived as the initial of the word element 'VAMED' underneath, appears as an addition to this word. The signs are visually similar to a low degree (paras 50-55). Aurally the signs are similar to an average degree, despite the different length, structure and rhythm of the signs arising from the first two syllables of the CTMA (paras 58-59). The signs are fanciful and thus do not allow for a conceptual comparison (para. 60). Given the similarity and identity of the goods and services, the average degree of distinctiveness of the earlier mark and the signs' visual and aural similarity, the BoA did not commit an error in finding a likelihood of confusion (para. 66). Even for a highly attentive public, it is not excluded that the marks are perceived to refer to the same commercial origin (para. 67). **LOC**

[T-717/13](#); **SHADOW COMPLEX / BusinessShadow**, Judgment of 29 April 2015, *Chair Entertainment Group LLC v OHIM* – EN. The applicant sought to register the word mark 'SHADOW COMPLEX' as a CTM for goods in Class 9. An opposition based, inter alia, on the earlier Community word mark 'BusinessShadow', registered for goods and services in Classes 9 and 42, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition and the BoA dismissed the appeal. The GC confirmed the existence of likelihood of confusion between the conflicting marks. The contested 'computer game software for personal computers and home video games consoles' not only target a young public, but also the general public of the EU (para. 26). The degree of attention is normal and not higher (para. 27). The heading of the Class 9 goods covered by the earlier mark, 'computer software




(recorded)', is sufficiently clear and precise (para. 33). The approach taken in Communication No 2/12 is intended to draw the appropriate conclusions from the 'IP Translator' judgment and is not contrary to the principles of the said judgment as claimed by the applicant (para. 37). The goods covered by the earlier mark include those covered by the contested application (para. 38). The general public will not understand the earlier mark 'BusinessShadow' as being a single word but will recognise in it at least the term 'business', signifying economic activity (para. 43). 'Business' and 'complex' are weak in relation to the goods in question for a large part of the relevant public (para. 45). 'Shadow', meaning 'comparative darkness,' is the most distinctive element of each mark (para. 47). Since both marks contain 'shadow', they are visually similar to an average and not only to a low degree (para. 49). The phonetic similarity is low, since the common element occupies a different position in each of the marks (para. 52). The marks are conceptually similar for the part of the public understanding the word 'shadow' (paras 55 and 57). The general public will not understand 'shadow' in the technical meaning of 'shadow copy' (para. 56). Given the identity of the goods and that the element 'shadow' is the most distinctive part of each mark, a likelihood of confusion exists at least for the English-speaking part of the EU. **LOC**

◆ [T-41/12](#): **L'Wren Scott / LOREN SCOTT**, Judgment of 27 February 2015, *LS Fashion, LLC v OHIM – EN*. The applicant sought to register the word mark 'L'Wren Scott' as a CTM, inter alia, for goods within Class 25. An opposition based on the earlier Spanish word mark 'LOREN SCOTT', registered for goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the applicant's appeal, finding the genuine use of the earlier mark sufficiently proven, the goods identical or similar and the signs visually and aurally similar to an average degree. According to the BoA there was a likelihood of confusion between the signs. The applicant filed an action before the GC. Regarding the alleged failure in the assessment of a likelihood of confusion the GC found that the goods covered by the signs are identical or similar (para. 59). Visually, the signs differ only in the fact that the second letter of the earlier mark is 'o', whereas the mark applied for contains the element 'w' (para. 62). By finding a medium degree of similarity, the differences have been taken into account (para. 63). The pronunciation of the signs at issue coincides inasmuch as the common element 'scott' will be pronounced in an identical manner. The pronunciation of the first element of the signs at issue will only be slightly different for the Spanish consumer, even in situations where that consumer might hesitate over the pronunciation of the element 'l'w' (para. 65). The degree of aural similarity is average (para. 67). The words do not make reference to any concept (para. 69). Even if it was established that Ms L'Wren Scott was known to certain celebrities, the documents submitted do not show that Ms L'Wren Scott herself had celebrity status in Spain for the relevant public, with the consequence that the relevant public would perceive the mark applied for as forming an autonomous conceptual unit (para. 73). Since the applicant has failed to establish the notoriety of the mark applied for, the mark must, in the absence of any other evidence to support its being highly distinctive, be regarded as being devoid of such distinctive character, since it amounts merely to the combination of two elements, namely 'l'wren' and 'scott', which contains slight differences as compared with the combination of the elements 'loren' and 'scott' (para. 81). **LOC**





[T-282/13](#); **IGLOTEX / IGLO**, Judgment of 23 April 2015, *Iglotex SA v OHIM* – EN.

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

The CTM applicant sought to register the figurative mark depicted above for goods in Classes 29 and 30. The opponent based its opposition on Article 8(1)(b) and Article 8(5) CTMR using, inter alia, the earlier CTM shown above, registered for goods in Classes 29 and 30. The opposition was directed against all the goods covered by the application. The OD upheld the opposition on Article 8(1)(b) CTMR. The BoA dismissed the appeal, finding that the goods to be compared are identical or similar and the signs similar overall. The opponent appealed to the GC, arguing an infringement both of Article 8(1)(b) CTMR. The applicant's statement that the goods would be dissimilar or slightly similar has been rejected as inadmissible, because this plea was not substantiated. Consequently, Article 44 RPGC, which states that an application has to be clear and precise to enable the defendant to prepare his defence and the GC to rule on the action, has not been observed (para. 31-33). Article 8(1)(b) CTMR, likelihood of confusion. The GC confirms the BoA's finding that the level of attention is normal, if not low (para. 27). The GC further considers that the comparison of goods carried out by the BoA is correct, and that the goods are identical or highly similar (paras 35-38). Concerning the comparison of the signs, the GC points out that the BoA rightly took the view that the figurative elements in the application are not dominant and that the verbal part 'IGLOTEX' is clearly visible and as a verbal element is, in principle, more distinctive than the figurative parts (paras 52-54). The GC holds that — contrary to the submissions of the applicant — the BoA took into account the overall impression of the marks and that the reference to the independent distinctive role of 'IGLOTEX' in the sign applied for has as such not led to any relevant conclusion in the decision (paras 55-56). Visually, the GC states that due to the fact that the earlier mark, consisting of the term 'IGLO' is fully included at the beginning of the verbal element in the contested mark IGLOTEX and having regard to the part 'TEX' is a short suffix, there is a certain degree of visual similarity, in spite of the figurative elements in the application (paras 65-68). Phonetically, the GC confirms the BoA's assessment that the first two syllables of the application reproduce the earlier mark entirely, which leads to an aural similarity. The argument of the applicant, that the phonetically 'powerful' letter 'x' at the end of the application influences the aural similarity has been dismissed (paras 70-77). Conceptually, the GC endorses the findings of the BoA to the extent that the public, or at least part of it, will recognise the concept of an 'igloo' in both marks. The expression 'IGLOTEX' in the opposed mark will be broken down into the elements that have a meaning to the public and therefore they will see therein the concept of an igloo, as in the earlier mark (paras 84-86). Moreover, the penguin and the snowflake would also reinforce the same idea of cold, snow and winter as the concept of 'igloo', therefore conceptually the signs are also similar (paras 87-88). As far as the overall assessment is concerned, the GC stresses that the certain degree of visual similarity, which might be more important for the goods in question that will be displayed in supermarkets and on shelves, might still be sufficient for the finding of likelihood of confusion (paras 97-100). The visual differences in the case in question are attenuated by the identity of high similarity of the goods and the average or even low degree of attention of the public (paras 101-102). The GC found that the earlier mark's meaning of 'igloo' is linked to a descriptive meaning of the goods in the sense that they are frozen or refrigerated, leading to a weak distinctive character (para. 107). However, even as a weak mark, the overall assessment of the case points to a likelihood of confusion as has been stated correctly by the BoA (para. 109). **LOC**




◆♦ [T-715/13](#); *Castello / Castelló, Castelló y Juan S.A.*, Judgment of 5 May 2015, *Lidl Stiftung & Co. KG v OHIM & Horno del Espinar, S L* – EN.

CTMA	Earlier mark
	

The CTM applicant sought to register the figurative sign 'Castello' represented above as a CTM for goods in Classes 29, 30, 31. An opposition based on an earlier Spanish figurative sign 'Castelló', for services in Class 35, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition in its entirety. The BoA dismissed the appeal. The opponent brought an action before the GC, relying on three pleas in law: (i) infringement of the second sentence of Article 75 CTMR; (ii) infringement of Article 79 CTMR; and (iii) infringement of Article 8(1)(b) CTMR. Concerning the third point, namely the infringement of Article 8(1)(b) CTMR, the GC rejected the plea and confirmed the BoA's assessment. The GC confirmed the assessment of the BoA, according to which the relevant public was the Spanish public at large and the level of attention was lower than average, considering that the goods and services covered by the signs at issue were foodstuffs intended for mass consumption, purchased frequently and at a modest price (para. 26). The GC held that the BoA was fully entitled to conclude that the goods covered by the mark applied for and the services covered by the earlier mark were similar to a low degree. The BoA highlighted that even if the consumers concerned thought that the goods offered for sale by a retailer were generally made by third-party undertakings and not by the retailer, it nevertheless remains the case that those consumers might think that liability for the manufacture of the goods offered for sale by that retailer falls on that retailer where there is a similarity between the mark covering those goods and that of the retailer and where the latter mark covers retail services relating to the same goods (paras 31-35). Regarding the comparison of the signs, firstly, the GC stated that the BoA correctly found that the words 'castelló' and 'castello' constitute, respectively, the dominant components of the earlier mark and the mark sought (para. 38). The GC held that the BoA was fully entitled to conclude that the signs were similar. With regard to the visual similarity, it considered that the font and the presence of the accent on the letter 'o' in the earlier mark were negligible differences (paras 39-41). In respect of the phonetic similarity, the GC highlighted that the presence of the accent and the pronunciation of the phrase 'castelló y juan s.a.' and the word 'dulces' were not sufficient to lead to the conclusion that the signs are not similar (paras 42-44). Concerning the conceptual similarity, the GC noted that the signs would be perceived by the relevant public as referring to a family name and that the presence of the words 'dulces' and 'y juan s.a.' in the earlier mark is not liable to call into question the BoA's conclusion (paras 45-47). The GC confirmed the overall assessment made by the BoA, highlighting that it did not make any error in concluding a likelihood of confusion (paras 49-52). In any event, regarding the remaining pleas in law, namely the plea alleging an infringement of the second sentence of Article 75 CTMR, and the plea alleging an infringement of Article 79 CTMR as concerns the failure to notify the evidence of renewal of the earlier mark, these pleas were upheld by the GC (paras 88-92) and the contested decision was annulled. **LOC**



[T-423/12](#); *Skype / SKY*, Judgment of 5 May 2015, *Skype Ultd. v OHIM* – EN.

CTMA	Earlier mark
	<p>SKY</p>

An application was filed for the figurative mark shown above for a range of goods and services in Classes 9, 38 and 42. An opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) CTMR based on, inter alia, the earlier CTM ‘SKY’ for a range of goods and services in Classes 9, 38, 41 and 42. The OD upheld the opposition in respect of all the goods and services in question, on the basis of Article 8(1)(b) CTMR. The BoA dismissed the appeal. The GC dismissed the appeal. It found that the relevant public consists of the public at large and professionals (para. 22). The average consumer of the contested peer-to-peer communication services, although choosing those services with care, will have an average degree of attention (paras 23-24). The services are identical (paras 26-27). The impact of the figurative element of the mark applied for is minimal, in that it merely highlights the word element, specifically on account of the fact that it appears as a border that closely traces the contours of the word ‘skype’ (para. 30). The signs are visually and phonetically similar to a medium degree and they are also similar on a conceptual level, since the possibility cannot be ruled out that the relevant public will recognise the term ‘sky’ in the mark applied for (paras 39-45). The earlier mark ‘SKY’ has an enhanced distinctiveness in the United Kingdom for ‘apparatus for recording, transmission or reproduction of sound and images’ in Class 9, ‘telecommunications’ in Class 38 and ‘entertainment’ in Class 41 (paras 50-51). The alleged ‘secondary meaning’ of the contested mark ‘skype’ (i.e. a link that would be established by consumers between that sign and the namesake applicant’s provision of the services) does not translate into a conceptual content that could offset the existing similarities. However, in the event that the term ‘SKYPE’ had actually acquired a meaning of its own for identifying the services covered by the mark applied for, it would be a generic term, and therefore a descriptive one, for that type of service (para. 55). The GC recalled the established case law to the effect that the (possible) recognition of the mark applied for cannot be taken into account when determining whether there is a likelihood of confusion between two marks (para. 56). With regard to the alleged ‘dilution’ of the earlier ‘SKY’ mark, the GC noted that the applicant limited itself to general and unsubstantiated allegations and that it referred merely in an abstract way to the ‘evidence’ it provided. The GC stressed that it is not for the GC to research and identify which documents within the case file could serve as the basis of the applicant’s arguments (para. 60). Even if it were accepted that the earlier mark ‘SKY’ is inherently weakly distinctive for television broadcasting services and for goods in Class 9 directly related to those services, this limited distinctiveness would be overridden by its acquired enhanced distinctiveness for those same goods and products, on account of its recognition by the relevant public (para. 61). The applicant’s argument based on a supposed peaceful coexistence between the marks was rejected (paras 66-69). The GC confirmed the existence of a likelihood of confusion for the relevant public in the United Kingdom, even taking into account a higher level of attention on the part of the relevant public (paras 71-72). **LOC**

◆ [T-604/13](#); *101 / 501*, Judgment of 3 June 2015; *Levi Strauss & Co. v OHIM* – DE. The applicant sought to register the word mark ‘101’ inter alia, for goods in Class 25 ‘clothing, footwear, headgear’. The opponent filed an opposition based on the earlier Community word mark ‘501’ registered, inter alia, for identical goods in Class 25. The opposition was based on the grounds of Article 8(1)(b) CTMR and




Article 8(5) CTMR and directed only against the goods in Class 25. The OD rejected the opposition in its entirety. Despite finding the marks visually and aurally similar insofar that they coincide in the numerals '01', a likelihood of confusion or encroachment was ruled out, even assuming an enhanced distinctiveness/reputation of the earlier mark. The BoA dismissed the appeal, but with a different reasoning. It found that the signs are dissimilar overall. Visually, the coincidences in the two numerals '01' are counteracted by the differing first numeral and the 'symmetric' impression of the CTMA, which does not have any counterpart in the 'asymmetric' earlier mark. The differing first numeral also leads to a different aural impression. As numbers as such do not have a concept, the marks are not conceptually similar. Even if numbers were assumed to have a concept, the concept of 501 and 101 would be different. As the signs are dissimilar overall, it is immaterial whether the earlier mark possesses enhanced distinctiveness/reputation. If the signs are dissimilar overall, Article 8(1)(b) or Article 8(5) CTMR cannot succeed, regardless of identical goods and/or enhanced distinctiveness/repute of the earlier mark. The owner of the earlier mark filed an application before the GC, based on a claimed violation of Article 8(1)(b) and Article 8 (5) CTMR, requesting annulment of the BoA's decision. The GC pointed out at the outset that the relevant public consists of reasonably informed and circumspect average end consumers and that it is also undisputed that the goods at issue are identical. With regard to the visual comparison, the GC stressed that, with regard to two signs consisting of three numerals each, dissimilarity in one numeral cannot lead to a different overall impression without Furthermore, special circumstances. The mere difference in the first numeral cannot be seen as such a special circumstance, which would — without further analysis of the specifics of the differing number — lead to a different overall impression. The contested decision contains nothing that would allow the conclusion that the difference in the first numeral would clearly be perceived as a different structure ('symmetric' v 'asymmetric') and as such lead to a different visual overall impression. The BoA committed an error in considering the signs visually dissimilar overall. Rather, the signs have a certain degree of similarity (paras 35-40). **LOC**

[T-562/14](#); **YOO / YO**, Judgment of 4 June 2015; *Yo holdings Ltd v OHIM*, – EN. The applicant sought to register the word mark 'YOO' as a CTM for services within Class 43. An opposition based on the earlier word mark 'YO', registered in Germany for goods in Classes 29, 30, 32 was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA annulled in part the OD's decision and refused the trade mark applied for the following services: 'restaurant services; bar services; café, cafeteria, canteen, snack bar and catering services; lounge and bar services; services for providing food and drink'. The applicant filed an action before the GC. The GC affirmed that there was a likelihood of confusion in the EU. It was not disputed by the parties that the relevant public was the general public whose level of attention is not higher than the average in the EU and Germany. The assessment of the BoA regarding the comparison of goods and services, the comparison of the signs and the existence of a likelihood of confusion was disputed. Regarding the comparison of the goods, the GC found, as the BoA did, that the goods of the earlier mark in Classes 30 and 32, namely 'pastries, chocolate products and non-alcoholic beverages', were complementary to the services in Class 43, as such goods are used and offered in the context of restaurant, catering, bar, café, cafeteria, canteen and snack bar services. Those goods are therefore closely related to those services. In the same way, it commonly occurs that pastries are offered for sale in places that provide food and drink (para. 25-27). The goods and services are therefore similar to a certain degree. Regarding the comparison of the signs, the applicant considers that the BoA had overestimated the similarity of the signs at issue. The GC however confirmed the findings of the BoA that the signs were visually highly similar, phonetically very similar and that the conceptual



comparison was irrelevant except for the Spanish- and the English-speaking public. As regards the likelihood of confusion, the GC has concluded that given the certain degree of similarity between the goods and services and high degree of similarity of the signs at a visual and phonetic level, a likelihood of confusion exists. **LOC**

♦ [T-254/13](#); **STAYER**, Judgment of 4 June 2015, *Stayer Ibérica, SA v OHIM* – EN.


CTM	Earlier mark
	<p style="text-align: center;">STAYER</p>

The relevant territory is Germany. Having regard to the goods in question in Classes 7 and 8, the relevant public comprises both the general public and professionals in, for example, the construction sector, and that public has a relatively high degree of attention (paras 71 and 74-76). The similarity of the signs was not called in question by the invalidity applicant and the GC upholds the BoA's decision (para. 79). Regarding the similarity of the goods, the 'PU hand float trowels' in Class 8 covered by the earlier trade mark can be described as tools. Accordingly, they are identical to the 'equipment and tools' in Class 7 covered by the contested trade mark (para. 84). **LOC**

[T-227/13](#); **INTERFACE / Interfog**, Judgment of 27 February 2015, *Bayer Intellectual Property GmbH v OHIM* – EN. The applicant sought to register the word mark 'INTERFACE' as a CTM for goods within Class 5. An opposition based on the earlier word mark 'Interfog', registered for goods in Class 5, was filed on the grounds of Article 8(1)(a) and (b) and Article 8(5) CTMR. The OD upheld the opposition affirming the likelihood of confusion. The BoA dismissed the applicant's appeal. The CTM applicant filed an action before the GC claiming an infringement of Article 8(1)(b) CTMR. The GC dismissed the action confirming the likelihood of confusion. The relevant public is that of the EU (para. 20), and the level of attention is high, as the goods concerned may contain toxic substances (para. 22). The goods covered by the marks at issue are identical. The 'fungicides' and 'herbicides' covered by the earlier mark fall into the broader category of 'preparations for destroying plants' covered by the mark applied for (para. 27). The marks have an average degree of visual and phonetic similarity. The earlier mark does not have any clear and defined meaning (para. 41), the mark applied for is composed of the English word 'interface', which is a technical term used particularly in the field of information technology and has a semantic content not only in English but also in other EU languages (para. 42). The BoA ought to have concluded that there is a certain conceptual difference between the marks at issue (para. 43). The overall comparison of the marks at issue reveals certain similarities between them that cannot be ignored and cannot be invalidated by the error, vitiating the BoA's reasoning with regard to the conceptual comparison of the marks at issue. The conceptual difference that exists between the marks at issue is liable to escape the attention of the relevant public. Consequently, it must be held that the conceptual content of the mark applied for is not such as to neutralise the visual and phonetic similarities that exist between the marks at issue (paras 47-48). **LOC**




[T-453/13](#); *Klaes / Klaes*, Judgment of 12 February 2015, *Horst Klaes GmbH & Co. KG v OHIM* – DE.

CTMA	Earlier mark
Klaes	

The applicant sought to register the word mark ‘Klaes’ as a CTM for goods and services, inter alia, within Class 42 with a following description: ‘updating of computer software; user management and authorisation on computer networks; consultancy in the field of computers; computer system analysis; software design services; design of computer systems; computer programming; electronic data security; design and development of computer software; computer animation (programming); computer programming; hardware and software consultancy; implementation of computer programs on networks; installation of computer programs; configuring computer networks by means of software; conversion of computer programs and data (other than physical alteration); duplication of computer programs; maintenance and installation of software; server administration; rental of computer software; restoration of computer dates; recovery of computer data the ‘contested goods’. An opposition based on the earlier figurative mark represented above was filed on the grounds of Article 8(1)(b) CTMR in relation to services registered in Class 42 with the following description: ‘scientific and technological services and design and engineering relating thereto in the field of the development and manufacture of goods of plastic, and tool development relating thereto’. The OD upheld the opposition. The BoA dismissed applicant’s appeal finding a high degree of similarity between the signs and a complementary link between the goods at issue. The applicant filed an action before the GC. As regards the substance, the GC finds that the earlier mark is composed of the same word element as the contested mark and that the figurative elements of the earlier mark would not be considered original. Therefore, the marks are visually almost identical. Phonetically, they are identical and, since the word element has no meaning, a conceptual comparison is not possible. Overall, the marks are similar to a high degree (paras 25-26). Within the assessment of the similarity of the services covered, the GC confirms existence of complementarity between them and thus certain similarity. The GC finds that while the disputed services are distinct in nature, the fact remains that there is no reason, in the absence of evidence to the contrary, to exclude the fact that the tasks set by the signs in question can enter the range of services that can be provided by the same type of business. It cannot be excluded that a company specialising in technology services and tools in the development and manufacturing of plastic products can also have expertise in creating new software and software updates. In the absence of evidence to the contrary, the services at issue can be matched by their destination and use (para. 34). A likelihood of confusion was found despite enhanced attention of the specialised public (para. 37). **LOC**



◆ [T-566/13](#); *HostelTouristWorld.com / HOSTELWORLD.COM*, Judgment of 29 April 2015; *Hostel Tourist World, S.L. v OHIM – ES*.


CTM	Earlier mark
 HostelTouristWorld.com	HOSTELWORLD.COM

The applicant registered the figurative mark represented above as a CTM for services within Classes 35, 39 and 43. An application for invalidity was filed based, among other earlier rights, on IR word mark 'HOSTELWORLD.COM', registered for services in Classes 39 and 43. The CD dismissed the application for invalidity and the invalidity applicant filed an appeal. The BoA partly upheld the invalidity applicant's appeal, namely for the services in Classes 39 and 43. The CTM proprietor filed an action before the GC. The BoA's findings on the relevant public and of partial identity and partial high similarity of the services involved, although not contested, were confirmed by the GC; a degree of attentiveness ('neither particularly low nor particularly high') is inferred from the BoA's mere reference to a well informed and reasonably observant and circumspect consumer (paras 45-47). COMPARISON OF THE SIGNS: None of the elements of the CTM (figurative/verbal) are insignificant (para. 52). The verbal elements of the marks are descriptive for the services in Class 43 and slightly distinctive for the services in Class 39; the same conclusion is applicable to the figurative element (paras 57-58). The descriptive character of the verbal component of a sign does not lead to a higher relevance of the figurative element when the figurative element is also descriptive or slightly distinctive (see in this regard para. 58). The signs are found to be visually and phonetically similar to an average degree and conceptually identical (paras 59-65). The low degree of distinctiveness of the earlier IR does not impede the existence of a likelihood of confusion, taking into account the degree of similarity between the services and between the signs (para. 71). **LOC**

◆ [T-100/14](#); *TECALAN / TECADUR*, Judgment of 30 April 2015; *Tecalan GmbH v OHIM – DE*. The applicant sought to register the word mark 'TECALAN' as a CTM for goods within Class 17. An opposition based on the earlier word mark 'TECADUR', registered for goods in Class 17, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC claiming an infringement of Article 8(1)(b) CTMR. The GC dismissed the action. It affirmed the likelihood of confusion. The relevant public is that of the whole EU (para. 19), consisting of professionals as well as general consumers and showing a high or above average level of attention (para. 24). The goods are identical or similar (para. 43). The marks are visually and phonetically similar (paras 52 and 54). The conceptual comparison is not possible, as none of the marks have a meaning (para. 56). The fact that the CTM application corresponds to the name of the company and has been used since 1962 is not relevant for the assessment of the likelihood of confusion (para. 65). The decision of the German Patent Office, which rejected an opposition based on a mark 'TECA' against the mark 'TECALAN', is not relevant, as, firstly, the Community trade mark system is autonomous from the national systems and, secondly, the marks involved are different (para. 66). **LOC**



[T-713/13](#); **9flats.com / 50flats**, Judgment of 26 February 2015, *9Flats GmbH v OHIM* – DE.

CTMA	Earlier mark
9flats.com	

The OD partly upheld the opposition against the CTMA (Classes 36, 39 and 43) based on the earlier Spanish mark (Class 43). The BoA partly upheld the applicant's appeal. The applicant filed an action before the GC. On substance, for the likelihood of confusion assessment, the relevant public is confined to Spain even though the earlier Spanish mark's services are rendered via the internet and also target an English-speaking public outside Spain (paras 23-25). The GC confirms the BoA finding concerning the identity and similarity of the conflicting services (paras 27-36). Visually and aurally, the signs are similar on account of the common elements 'flats' (paras 41-45). Conceptually, 'flats' has no meaning for the relevant Spanish public. The element 'com' of the CTMA is insufficient to convey a specific meaning for this sign. The fact that both signs consist of a different number placed directly in front of 'flats' even contributes to their similarity (paras 49-50). The signs are thus similar overall (para. 51). Contrary to the applicant's contention, in line with established case law, the earlier Spanish mark does not lack any distinctiveness, since it is a registered national mark and thus has at least a minimum degree of distinctiveness (paras 57-60). The applicant failed to show that contrary to the BoA finding the relevant public in Spain understands the English term 'flat'. It does not belong to basic English vocabulary (paras 62-63). Given the relevant public's average attentiveness, the similarity and identity of the services, the similarity of the signs and the normal degree of distinctiveness of the earlier sign, there is a likelihood of confusion (para. 67). **LOC**

◆ [T-366/11 RENV](#); **ZEBEXIR / ZEBINIX**, Judgment of 3 March 2015; *Bial-Portela & Ca SA v OHIM, Isdin, SA (intervener)* – EN. The applicant sought to register a CTM for the word mark 'ZEBEXIR' for goods in Classes 3 and 5. The opponent challenged the application on the grounds of a likelihood of confusion with the previously registered word mark 'ZEBINIX' covering, inter alia, goods in Classes 3 and 5. The OD found no likelihood of confusion and rejected the opposition. Subsequently, the BoA dismissed the appeal, holding that the dissimilarity of the signs is sufficient to exclude a likelihood of confusion, even for identical goods. The GC annulled the decision of the BoA, finding an average degree of visual similarity, being, however, of particular importance as regards all the goods in Class 3 and most of the goods in Class 5, because they are marketed in a way that requires visual examination by the consumer. In its appeal the applicant raised several pleas in law before CJ. The opponent lodged an appeal. The CJ found a failure to state reasons in the GC's judgment with regard to the finding of a likelihood of confusion relating to certain goods designated by the marks at issue. The contested judgment was set aside and the case referred back to the GC. The relevant public is composed of the average consumer in the EU. The disputed goods are mostly directed at the general public, partially at a professional public. As the general public is considered to be less informed and observant than the professional public, it is the level of attention of the former that must be taken into account (para. 30). The disputed goods are identical (para. 31). Contrary to the BoA's finding, the visual differences created by the central and end parts of the signs at issue, namely, the groups of letters 'inix' in the earlier mark and 'exir' in the mark applied for, are




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

[T-184/13](#); **SKYPE / SKY**, Judgment of 5 May 2015; *Skype Ultd. v OHIM* – EN. An application was filed for the word mark 'SKYPE' for a range of goods and services in Classes 9, 38 and 42. An opposition was filed pursuant to Article 8(1)(b) and Article 8(4) and (5) CTMR based on, inter alia, the earlier CTM 'SKY' for a range of goods and services in Classes 9, 38, 41 and 42. The OD upheld the opposition. The BoA dismissed the appeal. The GC dismissed the appeal. It found that the relevant public consists of the public at large and professionals (para. 22). The average consumer of the contested peer-to-peer communication services, although choosing those services with care, will have an average degree of attention (paras 23-24). The services are identical (paras 26-27). The signs are visually and phonetically similar to a medium degree (paras 34-38). They are also similar on a conceptual level, since the possibility cannot be ruled out that the relevant public will recognise the term 'sky' in the mark applied for (para. 39). The earlier mark 'SKY' has enhanced distinctiveness in the United Kingdom for 'apparatus for recording, transmission or reproduction of sound and images' in Class 9, 'telecommunications' in Class 38 and 'entertainment' in Class 41 (paras 45-46). The alleged 'secondary meaning' of the contested mark 'SKYPE' (i.e. a link that would be established by consumers between that sign and the namesake applicant's provision of the services) does not translate into a conceptual content that could offset the existing similarities. However, in the event that the term 'SKYPE' had actually acquired a meaning of its own for identifying the services covered by the mark applied for, it would be a generic term, and therefore a descriptive one for that type of service (para. 49). The GC recalled the established case law to the effect that the (possible) recognition of the mark applied for cannot be taken into account when determining whether there is a likelihood of confusion between two marks (para. 50). With regard to the alleged 'dilution' of the earlier 'SKY' mark, the GC noted that the applicant limited itself to general and unsubstantiated allegations and that it referred merely in an abstract way to the 'evidence' it provided. The GC stressed that it is not for the GC to research and identify which documents within the case file could serve as the basis of the applicant's arguments (para. 54). Even if it were accepted that the earlier mark 'SKY' is inherently weakly distinctive for television broadcasting services and for goods in Class 9 directly related to those services, this limited distinctiveness would be overridden by its acquired enhanced distinctiveness for those same goods and products, on account of its recognition by the relevant public (para. 55). The applicant's argument based on a supposed peaceful coexistence between the marks was rejected (paras 57-64). The GC confirmed the existence of a likelihood of confusion for the



relevant public in the United Kingdom, even taking into account a higher level of attention on the part of the relevant public (paras 65-66). LOC


◆ [T-85/14](#); *DINKOOL / DIN et al*, Judgment of 10 February 2015; *Infocit – Prestacao de Servico, Comercio e Industria, Ltd v OHIM – EN*.

CTMA	Earlier Marks
DINKOOL	1.)  2.) DIN

The CTM applicant sought to register the mark represented above for goods in Class 7, 9 and 11. An opposition was filed on the grounds of Article 8(1)(b) and Article 8(4) and (5) CTMR, based on the following earlier rights represented above: a) IR, protected in several Member States including Germany for identical, similar and dissimilar goods in Classes 1-34; reputation was claimed for 'printed matter' in Class 16; b) earlier non-registered sign, used in the course of trade in Germany for the 'development of norms, standards and technical rules as a service to industry, the State and Society as a whole'. The OD found that there was no likelihood of confusion, nor sufficient evidence for the claimed reputation and consequently rejected the opposition based on Article 8(1)(b) and Article 8(5) CTMR. The opposition was also rejected with regard to Article 8(4) CTMR, as the OD found that the conditions of § 15 German Trade Mark Law were not fulfilled. The BoA annulled the OD's decision and refused the CTM application in its entirety. It found a likelihood of confusion with regard to the identical and similar goods. With regard to the dissimilar goods, the BoA upheld the opposition based on Article 8(4) CTMR in conjunction with § 15(3) German Trade Mark Law. The applicant filed an action before the GC. The GC confirmed the BoA's finding that the degree of attention of the relevant public (general public/professionals in Germany) for the respective goods in Class 7, 9 and 11 is slightly higher than average (para. 28). The different degree of similarity of the goods found by the BoA (identical, similar and dissimilar) was not contested by the applicant. Visually and aurally, the marks have a certain degree of similarity, due to the identical word element 'DIN' positioned at the beginning of the respective marks (paras 36-44). Conceptually, the CTMA is a fanciful word in German. Nonetheless, the average consumer will break the word 'DINKOOL' down into elements which, for him, have a meaning. 'KOOL' will be understood as a misspelling of the common English word 'cool', which is often used in colloquial German in a sense of 'good', 'excellent', 'perfect'. 'DIN' may be perceived as either meaningless or as a reference to the opponent's name (*Deutsches Institut für Normung e.V.*) of which it is an acronym. In the latter case, there is also a certain degree of conceptual similarity between the signs (paras 46-51). In this context, the applicant has not sufficiently explained its assertion that 'DIN' will only be perceived as a reference to the opponent's name when used in isolation. In light of the visual, aural, and — for some consumers — conceptual similarities, the BoA was right to conclude that a likelihood of confusion (Article 8(1)(b) CTMR) exists with regard to identical and similar goods (paras 56-58). Based on the foregoing, the action was dismissed. There is a likelihood of confusion. LOC




♦ [T-621/14](#); **DINKOOL / DIN** et al., Judgment of 24 June 2015, *Prestação De Serviços, Comércio Geral e Indústria, Lda. v OHIM – EN*.

CTMA	Earlier marks
DINKOOL	1.)  2.) DIN

The CTM applicant sought to register the word mark 'DINKOOL' for goods in Classes 1, 2, 3, 6, 7, 12, 16, 20 and 21. An opposition was filed, based on the earlier international trade mark 'DIN' (fig. mark) as represented above, protected in several Member States (including Germany) for goods in Classes 1 to 34. The opposition was further based on the non-registered sign 'DIN', used in the course of trade in Germany for the development of norms, standards and technical rules. The opposition was based on Article 8(1)(b) CTMR and Article 8(4) CTMR. The OD rejected the opposition. The BoA annulled the decision, found a likelihood of confusion and, based on Article 8(1)(b) CTMR, rejected the CTMA in its entirety. The applicant filed an action before the GC. The BoA rightly considered the relevant territory to be Germany and the relevant public to be the reasonably well-informed, observant and circumspect general public as well as a professional public with a higher level of attention. The GC confirmed the BoA's findings of a visual similarity between the signs due to the identity of the word element 'DIN'. Furthermore, the element 'DIN' is the only element of the earlier mark and is the first element of the mark applied for, to which the consumer normally attaches more importance (paras 42-45). Phonetically, there is a limited degree of similarity, as the signs present differences in terms of the number of syllables and letters, and slight differences in rhythm and intonation. Conceptually, 'DIN', will either be perceived as a fantasy word or as a reference to the activities of the opponent. In the first scenario there is no conceptual similarity between the marks, whereas there is in the second scenario (paras 50-53). In light of the identity and similarity of the goods and the visual, phonetic and (for part of the relevant public) conceptual similarities, the BoA was right to conclude in its overall assessment that a likelihood of confusion exists (paras 58-61). Based on the foregoing, the action was dismissed. **LOC**

♦ [T-521/13](#); **A ASTER / A-STARS**; Judgment of 7 July 2015; *Alpinestars Research Srl v OHIM; Kean Tung Cho, and Ling-Yuan Wang Yu – EN*.

CTMA	Earlier mark
	A-STARS

The Interveners filed an application for the figurative sign shown above for products in Classes 18 and 25. An opposition based on the earlier mark shown above and registered as a CTM for goods in



Classes 18 and 25 was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition, the applicant filed an appeal. The BoA dismissed the appeal. ON THE COMPARISON OF SIGNS: The GC held that visually in the contested sign the word element 'aster' is the dominant element, since it has characteristics that enable it to make an immediate impression on the relevant public and that the decorative element in the shape of an arrow, which is less distinctive than that word element, is, on account in particular of its size and its white colour, which is less visible than that of that word element, and is negligible, with the result that it is the element 'aster' that the relevant public will remember. By contrast, as regards the earlier mark, which is a word mark, in spite of the link made between the initial letter 'a' and the element 'stars' by a hyphen, the sign cannot be broken down visually into two elements (paras 25-26). Although the marks contain five and six letters respectively, the GC regarded them as being similar in length. Although the differences at the end of the earlier mark preclude the signs from being held to be identical, the fact nonetheless remains that the part which is common to the signs gives rise to a visual similarity between the word elements, particularly because the public generally pays more attention to the initial part of word marks (para. 28). Therefore, contrary to the assessment of the BoA, the GC held that the similarity between the signs at issue is not capable of being offset to a significant extent by the fact that the word element 'aster' in the mark applied for is written in black in a stylised font, is in bold, slopes slightly to the right and has a decorative element placed above it, whereas the earlier sign consists only of the word element 'a-stars' (para. 29). The GC therefore takes the view that there is an average degree of visual similarity between the signs at issue, in spite of the differences between them and not a low degree as stated by the BoA (para. 31). Phonetically, the GC disagreed with the BoA and concluded that it is unlikely that the consumer will repeat the vowel 'a' in the mark applied for in order to pronounce the sign as 'a-aster'. It must therefore be held that the mark applied for will be pronounced as two syllables and not three. As regards the pronunciation of the earlier mark, the hyphen between the letter 'a' and the word 'star' must indeed be taken into account with regard to the part of the relevant public who has some knowledge of English and English pronunciation. The earlier mark will thus be pronounced as two elements that may easily be identified by that part of the relevant public. By contrast, it cannot be ruled out that for the non-English-speaking part of the relevant public, the presence of the hyphen will have no effect and the earlier mark will be pronounced as two syllables that are difficult to perceive, with the 'a' being pronounced in the same syllable as the initial letter 's' of the element 'stars'. As regards the phonetic stress, it may be placed, both in respect of the earlier mark and the mark applied for, on the first or second syllable depending on the language spoken by the consumer (paras 36 and 37). The GC decided that contrary to what the BoA held, the signs at issue are highly similar phonetically, at least for the non-English-speaking part of the relevant public (para. 41). Finally on the conceptual comparison, the GC decided that the BoA was wrong to conclude that there was some conceptual similarity. The GC found that given the various possible meanings of the elements 'stars' and 'aster' and the remote conceptual link between them, there is no conceptual similarity between the signs at issue (para. 53). ON THE LIKELIHOOD OF CONFUSION: The conclusion of the GC is that the goods at issue are identical, that there is an average degree of visual similarity between the signs at issue for the whole of the relevant public and a high degree of phonetic similarity between the signs at issue for at least the non-English-speaking public. Furthermore, there is no conceptual similarity between the marks at issue for the relevant public (para. 61). In that regard, the GC recalled that although the marks at issue have been held to be conceptually different, for conceptual differences between two signs to be capable of counteracting phonetic and visual similarities between the marks at issue, it is also necessary for at least one of those signs to have a clear and specific meaning for the relevant public, so that that public is capable of grasping it immediately (see judgment of 18/12/2008 in *Les Éditions Albert René v OHIM*, C-16/06 P, EU:C:2008:739, para. 98 and the case law cited) (para. 62). The GC concludes that the




earlier mark is not capable of directly conveying a clear meaning to the relevant public, with the result that the conceptual dissimilarity between the marks at issue cannot in the present case suffice to counteract the average degree of visual similarity and the high degree of phonetic similarity which the GC has held to exist (see to that effect, judgment of 15/07/2011 in *Ergo Versicherungsgruppe v OHIM — Société de développement et de recherche industrielle* (ERGO), T-220/09, EU:T:2011:392, para. 39 and the case law cited). Consequently, the GC held that there is a likelihood of confusion in the present case, at least for part of the relevant public (para. 64). LOC

[T-352/14](#); **HAPPY TIME / HAPPY HOURS**, Judgment of 15 July 2015, *The Smiley Company SPRL v OHIM / The Swatch Group Management Services AG* – EN. The CTM applicant filed an application for registration of the word mark 'HAPPY TIME' as a Community trade mark for goods and services in, inter alia, in Classes 14 and 35. A notice of opposition was filed in respect of all the goods and services applied for. The opposition was based on the earlier IR designating the EU of the word mark 'HAPPY HOURS' for the following services: Class 35: 'retailing of timepieces and jewellery; retailing of timepieces and jewellery via global computer networks (internet)' and Class 37: 'repair and maintenance of timepieces and jewellery'. The grounds relied on in support of the opposition were those set out in Article 8(1)(b) CTMR. The OD partially upheld the opposition in relation to the goods applied for in Class 14. The BoA dismissed the appeal filed by the CTM applicant. The BoA stated that for the purposes of assessing the likelihood of confusion, it would consider 'the natural meaning of the goods and services specified in the application' for registration. Thus, the BoA did not rule on the likelihood of confusion concerning, in particular, auctioneering services and it pointed out that neither party had presented any arguments in that respect. The BoA found that there was a likelihood of confusion between the two marks at issue because of the similarity of the signs and the identity and similarity of the goods and services in question. The CTM applicant filed an action before the GC, alleging the infringement of Article 8(1)(b) CTMR. The GC confirmed the existence of a likelihood of confusion between the conflicting marks. In relation to the comparison of the goods and the services, it confirmed the finding of the BoA that there is some similarity between the contested 'goods in precious metals or coated therewith, not included in other classes; jewellery; horological and chronometric instruments' in Class 14 and the services 'retailing of timepieces and jewellery; retailing of timepieces and jewellery via global computer networks (internet)' in Class 35 of the earlier mark. The GC recalled its case law that goods or services are complementary where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (see judgment of 22 January 2009 in *Commercy v OHIM — easyGroup IP Licensing (easyHotel)*, T-316/07, EU:T:2009:14, paragraph 57 and the case law cited). The GC found in particular that that close connection exists between the goods and services in question: the goods that are the subject of the retail services covered by the earlier mark are identical to the goods covered by the mark applied for; the services at issue are generally offered in the same places as those in which the goods covered by the mark applied for are offered for sale. Finally, the GC found that, even if the consumers concerned believed that the goods sold by a retailer were generally made by third-party undertakings and not by the retailer, it nevertheless remains the case that those consumers might believe that liability for the manufacture of the goods sold by that retailer falls on that retailer where, first, there is a similarity between the mark covering those goods and the retailer's mark and, second, the latter mark covers retail services relating to the same goods (paras 26-32). As far as the signs are concerned, the GC further found that there is a certain degree of visual similarity and a low degree of phonetic similarity between the signs. Conceptually, the BoA correctly stated that both of the signs refer to a state of being happy over an



unspecified period. Therefore, the BoA was entitled to conclude that there is a very strong conceptual similarity between those signs (paras 34-44). Following the foregoing, the GC held that, given that the goods and services display some similarities and that there is an overall similarity between the marks at issue, the BoA did not err in finding that there was a likelihood of confusion. Therefore, the ground plea alleging infringement of Article 8(1)(b) CTMR was dismissed. **LOC**

◆ [T-172/13](#); **AFRICAN SIMBA / Simba**, Judgment of 22 January 2015, *Novomatic AG, v OHIM* – DE.



CTMA	Earlier mark
AFRICAN SIMBA	

The CTM applicant sought to register the word mark 'AFRICAN SIMBA' for goods and services in Classes 9, 28 and 41. The opponent based its opposition, inter alia, on Article 8(1)(b) CTMR using inter alia the earlier German figurative mark as depicted above, registered for goods in Class 28. The opposition was directed against all the goods and services covered by the CTMA. The OD upheld the opposition partially for the contested goods in Classes 9 and 28. The BoA dismissed the applicant's appeal, finding that there was likelihood of confusion (for the goods in Classes 9 and 28), taking into account, the identity of the goods and the similarity of the signs. The CTM applicant appealed to the GC, arguing an infringement of Article 42(2) and (3), Article 75 and Article 8(1)(b) CTMR. **INFRINGEMENT OF ARTICLE 8(1)(b) CTMR.** Concerning the comparison of the goods in Class 28, the contested decision stated that the goods covered by the application, namely 'lottery game machines' are encompassed in the broad category of 'games and plaything except plush toys' (German: 'Spielwaren, ausgenommen weichgestopfte Spieltiere') covered by the earlier German mark. To this extent, the GC states that the contested goods do not fall within the natural meaning of the earlier goods. Furthermore, the use of some of the headings does not comply with the criteria of 'IPT' to consider that the earlier mark covers all the goods included in the alphabetical list. This applies even more, taking into account that the earlier goods exclude plush toys. (paras 85-88). Consequently, the goods in Class 28 are not identical (para. 89). The GC proceeds with its examination to see if this error has an impact on the outcome of the contested decision (para. 90). The GC concludes that the goods under comparison have the same purpose of entertaining, although the contested goods achieve this aim in a different way because of the chance to win money. Secondly there is a certain 'fluid transition' between the slot machines as toys and the real slot machines, so that a clear distinction between these goods cannot be made. Also the material out of which the goods can be made is the same. Consequently, the goods are similar to a certain degree (paras 94-101). Similarly, the contested goods in Class 9 are also similar to the earlier goods, although only to a low degree (para. 112). Concerning the comparison of the signs, the GC stresses that both the verbal element, 'SIMBA', as well as the figurative element, 'the depiction of the elephant', are equally distinctive. However, the word element, which is in the first position, is stylised and constitutes a fantasy term, will attract the consumer's attention (paras 130-131). The contested sign bears the term 'African', which is not descriptive but still evokes an African origin of the latter term 'SIMBA', which as a fantasy term will attract the consumer's attention more than the first word element (paras 137 to 142). The signs have therefore, as the BoA correctly stated, visual and aural similarities. Conceptually, the term 'Simba' has no concept in German and the applicant has not shown that the relevant public will consider this term




as the 'lion' (meaning in Swahili (para. 151). In the examination of the overall assessment the GC concludes that the target public for the case at hand is the general public who buy the earlier games and playthings and use the contested slot machines. The attentiveness will therefore be average (paras 161 to 163). Since the word element has an independent role within the contested mark reinforcing the similarity between the marks, there is likelihood of confusion taking all the relevant factors into account (paras 170 to 172). Consequently, the error in the comparison of the goods in the contested decision does not affect the outcome and does not lead to its annulment (para. 173). **LOC**

◆ [T-193/12](#); H / H, Judgment of 22 January 2015, *MIP Metro v OHIM* – DE.

IR designating the EU	Earlier mark
	

The applicant sought to register the figurative mark represented above as an IR designating the EU, inter alia, for goods within Class 32. The opposition based on the earlier German mark represented above and registered for goods in Class 32 was upheld and confirmed by the BoA. The IR holder filed an action before the GC claiming the infringement of Article 8(1)(b) and Article 75 CTMR. The GC dismissed both pleas in law. With regard to Article 8(1)(b) CTMR, the identity of the goods 'beers' is not under dispute (para. 24). The marks are visually similar. The contested mark takes over the part of the earlier mark that contains a word element (paras 29 and 39). For the public that pronounce only the word element in the marks, those are phonetically identical (para. 44). The marks are conceptually similar, due to their heraldic connotations (para. 45). There exists a likelihood of confusion (para. 58). The BoA listed all the factual and legal arguments for its decision (para. 63). **LOC**

◆ [T-544/12](#) and [T-546/12](#); pensa / PENTASA and PENZA PHARMA / PENTASA, Judgment of 3 June 2015, *Pensa Pharma, SA v OHIM* – EN.

CTMAs	Earlier mark
<p data-bbox="368 1693 584 1727">PENSA PHARMA</p> 	<p data-bbox="1019 1753 1150 1787">PENTASA</p>

The CTM owner registered the word mark 'PENSA PHARMA' and the figurative mark represented above as a CTM for goods and services within Classes 3, 5 and 44. The invalidity applicants filed first



oppositions which were afterwards withdrawn. After registration of the contested marks, applications for invalidity based on the earlier word mark 'PENTASA' registered for goods in Class 5, namely 'pharmaceutical preparations', in several Member States, were filed on the grounds of Article 8(1)(b) CTMR. The list of contested goods was restricted to Classes 5 and 44. The CD upheld the applications for invalidity. The BoA dismissed the CTM owner's appeals, finding that the goods and services at issue were identical or similar and that the marks were also similar. The visual differences between the marks were not sufficient to rule out a likelihood of confusion in view, inter alia, of the highly distinctive character acquired through use of the earlier rights. Neither the CTM owner's arguments relating to the invalidity applicants' consent to the registration of the contested marks may be taken into consideration for the purposes of assessing whether there is a likelihood of confusion. The CTM owner filed an action before the GC. The GC first decided on the inadmissibility of documents submitted for the first time before the GC (para. 25) and of arguments put forward for the first time at the hearing (para. 31) referring to settled case law. SECOND PLEA IN LAW — ARTICLES 8(1)(b) AND 53(1)(a) CTMR: The relevant public consists of consumers from the Benelux countries and French consumers respectively and, having regard to the nature of the goods and services, the level of attention of that public, which consists of the general public and of health professionals, was higher than average (paras 69-70). As regards the visual comparison of the word marks 'PENTASA' and 'PENSA PHARMA', the GC stated that the relevant public will not be able to disregard the element 'pharma' in 'PENSA PHARMA'. Furthermore, the weak distinctive character of one element of a mark does not necessarily mean that that element will not be taken into consideration by the relevant public. The addition of the word 'pharma' to the word 'pensa' in the contested mark necessarily gives rise to a visual difference between it and the word 'pentasa'. That is *a fortiori* the case because the element 'pharma' has a greater number of letters than the element 'pensa' (paras 75-78). However, it is important to bear in mind the distinctive and dominant elements of the marks at issue in the overall impression created by them. The visually dominant element in the mark 'PENSA PHARMA' is the element 'pensa' (para. 81). The sequence of letters 'ta' in the middle of the earlier mark does not make it possible to disregard any visual similarity between the marks at issue. However, the word 'pensa' and the word 'pentasa' have the same letters occupying a similar position at the beginning and the end of the words and they have the same first part, which is likely to catch the consumer's attention more than the parts that follow (para. 83). Thus there is a certain degree of similarity between the marks at issue (para. 84). As to the applicant's arguments, the protection which results from the registration of a word mark relates to the word mentioned in the application for registration and not to any specific graphic or stylistic elements that that mark might have (para. 88). Regarding the figurative mark 'pensa', the positioning and the shape of the figurative element cannot differentiate it sufficiently from the earlier mark, inasmuch as that element consists only of a circular shape surrounding the first letter and a font in a different colour (para. 95). Regarding the phonetic comparison, the consumer generally pays more attention to the beginning of a sign (para. 102). The public will focus its attention on the element 'pensa' in the contested mark and presumably not the word 'pharma', inasmuch as that word is superfluous because of the nature of the goods and services covered by the contested mark (para. 107). On a conceptual level, the GC rejected the argument of the applicant that 'pentasa' will be understood by the relevant public as derived from Greek word 'penta', since the suffix 'asa' has no conceptual meaning that might clearly be linked to a concept related to the number 5 (paras 114-117). While providing a summary chart of case law, the applicant failed to explain to what extent each of the judgments would be capable of showing that there is no likelihood of confusion in the present case (paras 123-125). The comparison of the goods must relate to the description of the goods covered by the earlier mark and not to the goods for which the trade mark is actually used unless, following a request for proof of genuine use of the earlier mark, such proof is furnished only in respect of some of the goods or services for which the



earlier mark is registered (para. 128). In addition, the Office may only take account of the list of goods applied for as it appears in the trade mark application concerned, subject to any amendments thereto (para. 130). The medical services and consultancy in the field of pharmacy in Class 44 are complementary to the pharmaceutical preparations in Class 5 (para. 136). The goods and services at issue are identical or similar (para. 137). Under the global assessment, the GC finds that the low degree of visual similarity between the signs at issue is offset by the identity or similarity of the goods or services that they cover and the highly distinctive character of the earlier trade mark (para. 148). Furthermore, even if the relevant public consists of persons whose level of attention may be considered to be high, in the present case that is not sufficient, given the similarity between the goods and the signs at issue, to exclude the possibility that that public might believe that those goods come from the same undertaking or, as the case may be, from economically linked undertakings. That is particularly so if the earlier mark is highly distinctive (para. 152). Based on the foregoing, the second plea was rejected. **LOC**

[C-400/14 P](#); **basic / BASIC**, Order of 16 July 2015, *Basic AG Lebensmittelhandel v OHIM & Repsol YPF SA* – EN.

CTMA	Earlier mark
	

The CTM applicant sought to register the figurative sign indicated above. An opposition was filed based on Article 8(1)(b) CTMR. The OD upheld the opposition for part of the contested services in Classes 35 and 39. The opponent based its opposition in Classes 35, 37 and 39 filed an appeal against the OD's decision. The BoA partially upheld the appeal. The CTM applicant filed an application for annulment before the GC, which dismissed the action as unfounded. The CTM applicant filed an action before the CJ. The ground of appeal is the infringement of Article 8(1)(b) CTMR. The CJ, pursuant to Article 181 RPCJ, dismissed the appeal, stating that none of the arguments put forward by the CTM applicant can succeed. First of all, the CJ found that the CTM applicant misunderstood the judgment of the GC and that there was no need to define the scope of distribution services restrictively: the GC correctly defined the scope of 'distribution services' before assessing the similarity of the services (paras 49-51). Secondly, the CJ rejected as manifestly inadmissible the reference of the CTM applicant to the definition of retail services given by the CJ in the 'Praktiker' case: the CTM applicant confined itself to repeating arguments that had already been submitted before the GC and did not take a position on the reasoning of the CJ (paras 54-56). Furthermore, the CJ rejected the argument that the GC did not take into account the explanatory note to Class 39 of the Nice Classification, highlighting that it was based on a manifestly incorrect reading of the judgment of the GC. **LOC**

[T-323/12](#); **ECOSE / ECOSEC FACHADAS**, Judgment of 15 July 2015, *Knauf Insulation Technology v OHIM* – EN. The applicant sought to register the word mark 'ECOSE' as a CTM for goods and services within Classes 1, 2, 3, 16, 17, 19, 20 and 40. An opposition based on earlier Spanish word mark 'ECOSEC FACHADAS' registered for goods in Classes 17 and 19 was filed on the grounds of Article 8(1)(b) CTMR. The OD partly rejected the opposition in respect of the goods and services in Classes 1, 2, 3, 16, 20 and 40, and partly upheld it in respect of the goods in Classes 17 and 19. The





BoA partly upheld the appeal of the applicant and annulled the decision of the OD insofar as it had rejected the application for registration in respect of 'rubber, gutta-percha, gum, asbestos and mica' in Class 17. Given the similarity between the conflicting signs and the identical nature or similarity between the goods at issue, the BoA found a likelihood of confusion between the marks at issue with respect to the identical or similar goods. The applicant filed an action before the GC. The GC confirms that the relevant public is made up of professionals in the building sector in Spain, as well as of do-it-yourself enthusiasts (part of the general public), and that that public has a high level of attention (paras 21-22). Also, the BoA's assessment that the goods at issue are partly identical and partly similar is upheld (Paras.25-32). Regarding the visual similarity, the GC endorses the BoA's observations that the sign sought is entirely contained in the first word of the earlier mark, the only two differences being the additional letter 'c' at the end of the first word of the earlier mark and the additional word 'fachadas' contained in the earlier mark. Consumers would attach greater visual importance to the first part of the earlier mark, namely the word 'ecosec', and would consider the second word 'fachadas' as being of secondary importance, inter alia, due to its descriptive character. The signs are thus, as a whole, visually similar (paras 35-40). On the phonetic level, since the words 'ecose' and 'ecosec' are not part of Spanish vocabulary, it is not possible to determine their rhythm or intonation with absolute certainty (para. 42). The first two syllables 'e' and 'co' of the marks at issue would both tend to be construed as an abbreviation of the Spanish words as 'ecológico' (ecological) or 'económico' (economical). It would thus be logical to stress the words 'ecose' and 'ecosec' in an identical manner (para. 44). The word 'fachadas' was relegated to a secondary position due to its descriptive nature (para. 45). There exists a vague conceptual similarity between the conflicting signs in that they could be linked to the rather allusive concepts of 'ecological' or 'economical' (para. 49). Even though when perceiving a word sign, the consumer will break it down into elements which, for him or her, suggest a concrete meaning or which resemble known words, in the present case, given that the applicant itself puts forward two possible interpretations of the element 'eco', that element does not suggest a concrete meaning and does not resemble words known to the average consumer. It is accordingly highly unlikely that the relevant public will examine the earlier mark by breaking it down into two parts. The earlier mark has thus normal distinctiveness (paras 58-59). Based on the foregoing, likelihood of confusion exists between the marks at issue (para. 60). As to the national decisions relied on by the parties, registrations already made in the Member States are merely a factor which, without being given decisive weight, may be taken into consideration for the purposes of registering a CTM (para. 61). The Office's earlier decision-making practice cannot bind the courts of the EU (para. 62). A CTM applicant cannot rely to his or her advantage on a possibly unlawful act committed to the benefit of someone else (para. 63). LOC

[T-89/11](#); **NANU / NAMMU**, Judgment of 9 July 2015, *Nanu-Nana Joachim Hoepf GmbH & Co. KG v OHIM & Vincci Hoteles SA* – EN. The CTM applicant sought to register the word sign 'NANU' as a CTM for goods in Classes 3, 4, 6, 9, 16, 18, 20, 21, 24, 26 and 35. An opposition based on an earlier word CTM 'NAMMU', covering goods and services in Classes 3, 32 and 44, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition in respect of some goods and services. The BoA partially upheld the appeal. In its action before the GC, the opponent alleged infringement of Article 8(1)(b) CTMR. In the meantime, the CTM applicant had filed an application for revocation of the earlier CTM and requested that the proceedings before the BoA be stayed pending a decision on the application for revocation. Following the decision of the BoA, in which it dismissed the CTM applicant's appeal against the decision of the CD rejecting its request for a declaration of invalidity, the proceedings were resumed. The GC rejected the plea alleging infringement of Article 8(1)(b) CTMR. The GC confirmed the assessment of the BoA, according to which the relevant public was the general public in



the Member States of the EU, who have a normal degree of attentiveness (para. 32). The GC confirmed that ‘toothbrushes’ and ‘dentifrices’ display a degree of similarity and that consumers could expect those goods to be produced by the same undertakings (paras 38-39). Furthermore, the BoA did not err in finding similarity (complementarity) between retail and mail order services in the field of ‘perfumery’ and the ‘perfumery goods’ covered by the earlier mark (paras 40-45). As to the comparison of the signs, firstly, the GC confirmed the visual similarity of the words ‘NANU’ and ‘NAMMU’ (paras 55-60). In respect of the phonetic similarity, the differences in pronunciation of the consonants ‘M’ and ‘N’ are not capable of calling into question the high degree of phonetic similarity between the two signs at issue (paras 62-63). Furthermore, the GC confirmed the lack of conceptual similarity of the marks found by the BoA, which was not challenged by the parties (paras 66-67). Finally, the GC confirmed that, taking into account the ‘principle of imperfect recollection’ and the principle of interdependence of factors, the significant similarities between the marks at issue were such as to lead to a likelihood of confusion for goods in the field of perfumery (paras 68-74). LOC

[T-333/13](#); *bambinoLÜK / BAMBINO*, Judgment of 15 July 2015, *Westermann Lernspielverlag GmbH v OHIM & Diset, SA* – EN.

CTMA	Earlier mark
	


The CTM applicant sought to register the figurative sign ‘bambinoLÜK’ for goods in Classes 9, 16, 28. An opposition based on an earlier figurative CTM, ‘BAMBINO’, covering goods and services in Classes 16, 28 and 41, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition in respect of some goods and services. The BoA partially upheld the appeal. The opponent brought an action before the GC, alleging infringement of Article 8(1)(b) CTMR. In support of that plea in law, the applicant asserts (i) the lack of distinctive character of the word element ‘bambino’ of the earlier CTM, (ii) the lack of similarity between the signs at issue and (iii) the lack of a likelihood of confusion between those signs. The GC confirmed that the goods covered by the signs at issue in respect of which registration was refused are identical or similar (para. 19). Regarding the comparison of the signs, the GC confirmed a visual similarity between the signs, as the differences (the figurative element in the form of a stylised child and the independent stylised word element ‘lük’) cannot outweigh the similarity between the signs arising from their common, dominant and distinctive element ‘bambino’ (paras 20-28). Moreover, the GC endorsed the BoA’s finding that there was a phonetic similarity between the signs due to the presence of the identical word element ‘bambino’ at the beginning of the signs (paras 29-32). Finally, the GC found that there was a conceptual similarity between the signs, which cannot be called into question by the allegedly weak distinctive character of the element ‘bambino’ of the earlier trade mark (paras 33-40). The GC confirmed the overall assessment made by the BoA: the degree of similarity between the signs at issue and the degree of similarity between the goods covered by those signs are sufficiently high to establish a likelihood of confusion (paras 41-47). The GC rejected the CTM applicant’s argument that the term ‘bambino’ is descriptive in the relevant territory in respect of the goods in question and, therefore, that the figurative element in the form of a stylised child and the independent stylised word element ‘lük’ in the trade mark applied for serve to prevent any likelihood of confusion between the signs at issue: the GC highlighted that, according to case law, even if the distinctive character of the earlier mark is weak,



that does not preclude a finding that there is likelihood of confusion (paras 48-51). Furthermore, the GC rejected the CTM applicant's argument that the rejection of its action would lead to a monopolisation of the term 'bambino' for the goods in question (paras 54-58). **LOC**

[C-343/14 P](#); **MARINE BLEU / BLUMARINE**, Order of 7 May 2015, *Adler Modemärkte AG v OHIM – DE*. The GC confirmed the contested decision of the BoA in T-160/12 and affirmed the likelihood of confusion between the contested CTM application for the word mark 'MARINE BLEU' and the earlier word mark 'BLUMARINE' and goods in Classes 18 and 25, which it considered similar or identical. The CTM applicant filed an appeal before the CJ claiming an infringement of Article 8(1)(b) CTMR. The CTM applicant (appellant before the CJ) claimed an infringement of Article 8(1)(b) CTMR, on the one hand in the assessment of the similarity of the signs and, on the other, in the global assessment of the likelihood of confusion. Both claims were dismissed by the CJ. The CJ did not see any error in law in the assessment of the similarity of the signs. With regard to the argument that the descriptive character of the earlier mark influence prevents conceptual similarity the CJ recalled, that the conceptual similarity between the signs at issue must be assessed independently of their degree of distinctiveness (para. 39). With regard to the assessment of the likelihood of confusion, the CJ rejected the CTM applicant's claim that the distinctive character of the earlier mark was not taken into consideration by the GC. The CTM applicant's approach would have the effect of disregarding the factor of the similarity of the marks in favour of that based on the distinctive character of the earlier national mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the signs in question. Such a result would not, however, be consistent with the very nature of the global assessment pursuant to Article 8(1)(b) CTMR (para. 61). **LOC**

[T-363/12](#); **CLEANIC natural beauty / CLINIQUE**, Judgment of 13 May 2015, *Harper Hygienics S.A. v OHIM – PL*.


CTMA	Earlier mark
	<p>CLINIQUE</p>

The OD upheld the opposition pursuant to Article 8(1)(b) and Article 8(5) CTMR based on the earlier CTM represented above and registered for products in Classes 3, 14, 25 and 42 and rejected the CTMA for goods in Classes 3, 5 and 16. The CTM applicant filed an action before the GC claiming the infringement of Article 8(1)(b) and Article 8(5) CTMR. The GC confirmed the finding of likelihood of confusion pursuant to Article 8(1)(b) CTMR. The goods target average consumers (para. 26). The goods are identical or similar (para. 47). The dominant element of the CTMA is the word 'CLEANIC' (para. 57). The signs are similar visually to a low degree (para. 65) and phonetically to a high degree (para. 72). The conceptual comparison is not possible, as one of the marks do not have a meaning (para. 76). With regard to the alleged infringement of Article 8(5) CTMR, the GC confirmed the findings that the earlier mark is reputed




and the use of the CTM would be equal to unfair advantage of its distinctive character. It rejected the CTM applicant's argument regarding the coexistence of the marks, as it was claimed only for Poland, whereas the earlier mark is protected in the whole territory of the EU. **LOC**

[T-363/13](#); **CLEANIC intimate / CLINIQUE**, Judgment of 13 May 2015; *Harper Hygienics S.A. v OHIM – PL*.

CTMA	Earlier mark
	<p>CLINIQUE</p>

The OD upheld the opposition pursuant to Article 8(1)(b) and 8(5) CTMR based on the earlier CTM represented above, registered for products in Classes 3, 14, 25 and 42, and rejected the CTMA for goods in Classes 3, 5 and 16. The CTM applicant filed an action before the GC, claiming the infringement of Article 8(1)(b) and Article 8(5) CTMR. The GC confirmed the finding of likelihood of confusion pursuant to Article 8(1)(b) CTMR. The goods target average consumers, who, however, will pay extra attention as far as pharmaceutical products are concerned (paras 25-26). The goods are similar partially to a high degree, partially to a low degree (para. 46). The dominant element of the CTMA is the word 'CLEANIC' (para. 55). The signs are similar visually to a low degree (para. 63) and phonetically to a high degree (para. 70). The conceptual comparison is not possible as one of the marks does not have a meaning (para. 74). With regard to the alleged infringement of Article 8(5) CTMR, the GC confirmed the finding that the use of the CTM would be equal to unfair advantage of the distinctive character of the earlier CTM. It rejected the CTM applicant's argument regarding the coexistence of the marks, as it was claimed only for Poland, whereas the earlier mark is protected in the whole territory of the EU. **LOC**

[T-364/12](#); **CLEANIC Kindii / CLINIQUE**, Judgment of 13 May 2015, *Harper Hygienics S.A. v OHIM – PL*.



CTMA	Earlier mark
	<p>CLINIQUE</p>

The OD upheld the opposition pursuant to Article 8(1)(b) and Article 8(5) CTMR based on the earlier CTM represented above, registered for products in Classes 3, 14, 25 and 42, and rejected the CTMA for goods in Classes 3, 5 and 16. The BoA confirmed the decision. The CTM applicant filed an action before the GC claiming the infringement of Article 8(1)(b) and Article 8(5) CTMR. The GC confirmed the finding of



likelihood of confusion pursuant to Article 8(1)(b) CTMR. The goods target average consumers, who, however, will pay extra attention as far as pharmaceutical products are concerned (paras 25). The goods are identical or similar (para. 46). The figurative element of the CTMA is purely decorative (para. 52). The signs are similar visually to a low degree, because the word 'CLEANIC' in the CTMA and the earlier mark share several letters in the same sequence (paras 54-55) and phonetically to a medium degree (para. 58). The conceptual comparison is not possible as one of the marks does not have a meaning (para. 60). With regard to the alleged infringement of Article 8(5) CTMR, the GC confirmed the finding that the use of the CTM would be equal to unfair advantage of the distinctive character of the earlier CTM. It rejected the CTM applicant's argument regarding the coexistence of the marks, as it was claimed only for Poland, whereas the earlier mark is protected in the whole territory of the EU (para. 81). The reputation of the CTMA does not have any relevance for the opposition (para. 82). **LOC**

[C-249/14 P](#); *QTA S. JOSÉ DE PERAMANCA / PÊRA-MANCA et al.*, Judgment of 9 July 2015, *Pêra-Grave — Sociedade Agrícola, Unipessoal Lda v OHIM & Fundação Eugénio de Almeida* – EN.


CTMA	Earlier marks
	

The CTM applicant sought to register the figurative sign 'QTA S. JOSÉ DE PERAMANCA' in Class 33. An opposition based on three earlier Portuguese figurative trade marks 'VINHO PÊRA-MANCA TINTO', 'VINHO PÊRA-MANCA BRANCO' and 'PÊRA-MANCA', covering the same goods, was filed namely on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition, as the identity of the goods was offset by the very low degree of similarity between the signs at issue. The BoA upheld the appeal, considering that a likelihood of confusion could not be excluded, as the low degree of similarity between the signs at issue was compensated for by the identity of the goods covered. The GC rejected the applicant's action, finding that there was a likelihood of confusion with the third earlier mark. The CTM applicant appealed the GC's judgment, alleging infringement of Article 8(1)(b) CTMR. The CJ stated that although the use, by way of conclusion, of expressions such as 'is not capable of being ruled out' and 'it cannot be ruled out' in the judgment under appeal is not unambiguous, it is nevertheless clear from the reasoning that the GC carried out a global assessment of whether there was a likelihood of confusion between the signs at issue and established that a likelihood of confusion existed (paras 27-30). Since the GC pointed out an inconsistency in the appellant's arguments as regards the meaning of the word 'peramanca' (para. 43) and this point has not been disputed in the appeal (para. 49), it is not possible to claim the applicability of the 'Picaro/Picasso' (12/01/2006, C-361/04 P, Picaro, EU:C:2006:25) case law on the counteraction of visual and phonetic similarities when at least one of the signs has a clear and specific meaning for the relevant public (para. 39), or of the 'Chiemsee' (4/05/1999, C-108/97 and C-





109/97, Chiemsee, EU:C:1999:230) case law on the link the relevant consumers might, in the future, make between the geographical name 'peramanca' and the goods at issue. **LOC**

◆◆[T-323/14](#); *Bankia / BANKY*, Judgment of 17 September 2015; *Bankia, SA v OHIM* – EN.

CTMA	Earlier mark
	<p>BANKY</p>

The applicant sought to register figurative sign 'Bankia' represented above as a CTM for the goods and services in Classes 9, 16, 35, 36, 38, 41 and 45. An opposition was filed based on the basis of the earlier national word mark 'BANKY', which covers services in Class 36, against the registration of the sign in respect of the services in Class 36. The OD partially upheld the opposition for most of the services in Class 36. Both the applicant and the opponent filed an appeal before the BoA. The BoA dismissed the applicant's appeal and upheld the opposition in respect of 'real estate services' in Class 36. The applicant filed an application for annulment before the GC on the basis of infringement of Article 8(1)(b) CTMR. The contested decision was annulled to the extent that it upheld the appeal of the opponent concerning the 'real estate services' covered by the Community trade mark application in Class 36. The GC concluded that the relevant public is made up of the general public and professionals with a high level of attention. According to the GC, the mark possesses a certain degree of visual and conceptual similarity and a high degree of phonetic similarity. Despite the fact that the two signs in question are not purely descriptive of the services at issue, the relevant public will associate them with the same concept. The GC upheld the applicant's plea in law to the extent that the BoA wrongly found that there was a likelihood of confusion for part of the services in Class 36, 'real estate services' and therefore wrongfully upheld the appeal of the opponent. The GC dismissed the remainder of the action. **LOC**

◆◆[T-195/14](#); *PRIMA KLIMA / PRIMAGAZ*, Judgment of 24 September 2015, *Compagnie des gaz de Pétrole Primagaz SA v OHIM* – DE.

CTMA	Earlier mark
	

The CTM applicant sought to register the figurative trade mark 'PRIMA KLIMA', displayed above, for goods and services in Classes 11 and 42 (e.g. lighting, heating drying apparatus; R&D in the field of lighting, heating, drying). The opponent (applicant before the GC) filed an opposition based, inter alia, on




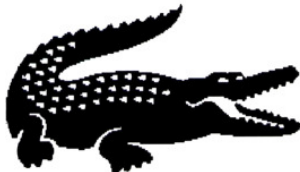
the earlier figurative CTM 'PRIMAGAZ' as displayed above, registered, inter alia, for identical goods in Class 11. The opposition was based on Article 8(1)(b) CTMR and directed against all the goods and services in Classes 11 and 42. The OD found no likelihood of confusion (no LOC) and rejected the opposition in its entirety. The BoA dismissed the appeal. It found that the R&D-services are directed at a professional public with an enhanced degree of attentiveness, whereas the goods are directed at the public at large, who will nevertheless also be attentive to an above average degree, due to the relatively expensive goods with a long life span. With regard to the contested services in Class 42, the opposition already fails, because these services are dissimilar to the goods in Class 11 of the earlier mark. With regard to the goods in Class 11, which are identical/highly similar, the opposition fails, because the marks are not sufficiently similar to conclude a likelihood of confusion (visually dissimilar, aurally lowly similar, conceptually dissimilar for those consumers who perceive the meaning of 'KLIMA' and 'GAZ'). Taking into account that the marks only coincide in a non-dominant, descriptive and non-distinctive element ('PRIMA') and considering that all the word elements are descriptive and non-distinctive, the consumers will rather focus on the marks' figurative elements. The opponent filed an application before the GC, based on a claimed violation of Article 8(1)(b) CTMR, requesting annulment of the BoA's decision. With regard to the comparison of the goods in Class 11 with the services in Class 42, the GC confirmed the BoA's finding of dissimilarity. It pointed out that they target a different public and are not complementary either, as the goods are not indispensable or important for rendering the (R&D) services (paras 31-37). With regard to the distinctiveness and dominant character of the individual elements of the signs, the BoA erred in several aspects. First: When composite marks are compared, the word elements are usually considered more distinctive than the figurative elements, in particular if the figurative elements — as in the present case — are rather banal (paras 46-47). Second: Even though it is true that 'KLIMA' and 'GAZ' are of a low degree of distinctiveness (as they refer to 'Climate' and 'Gas', para. 51), the same cannot be said about the word 'PRIMA', which has only a clearly laudatory meaning in German and Dutch, but not in other relevant languages (e.g. French or Italian (para. 48)). Third: Even if 'PRIMA' were considered to be laudatory/weak, this would not automatically mean that this element can be disregarded in the comparison, particularly due to its size and positioning within the signs (para. 49). With regard to the possible meaning of 'PRIMA', the BoA has basically stated that it will be perceived as laudatory in all languages, as it derives from the Latin word 'Primus' (the first) and has similar equivalents in most languages (French: 'Primaire'; English: 'primary'; Italian: 'prima'). The GC does not share this view. 'Primus' (female form: 'prima') is primarily an ordinal number, which does not convey an immediate image of high quality. Furthermore, for instance, in Italian 'GAZ' and 'CLIMA' are masculine words, and the public will note the wrong declination and grammatical inconsistency in combination with the 'feminine' adjective 'PRIMA' (instead of 'Primo'). Similar considerations apply with regard to French consumers. In light of what has been said above, the marks do not merely raise the concept of an 'extraordinary gas/climate'. Therefore, the conceptual comparison performed by the BoA was incomplete and erroneous, as the signs display a certain degree of conceptual similarity, at least for the Italian and French consumers (paras 61-71). With regard to the visual comparison, the BoA has erroneously stripped the element 'prima' completely of its importance in the overall appearance of the signs, which is not to be neglected, at least for the Italian and French public. As the marks share at least a low degree of visual similarity, the BoA's finding of visual dissimilarity was incorrect (paras 72-78). As regards the overall assessment, the BoA erroneously referred to the 'earlier trade mark's non-distinctive character'. A minimum degree of distinctiveness of the earlier mark is to be assumed in opposition proceedings and can only be challenged in cancellation proceedings. Even assuming that the BoA wanted to refer (merely) to a weak distinctive character of the earlier mark, it is to be noted that the distinctive character of the earlier mark is only one factor in the overall assessment (paras 95-97). Finally, due to the fact that the



element 'PRIMA' is of normal distinctiveness for the Italian/French part of the public, who perceive the combination of 'PRIMA' with 'GAZ'/'PRIMA' as unusual, the earlier mark enjoys a normal degree of distinctiveness for this part of the public. In light of what has been said above, the identity of the goods and the high degree of consumer attention, the contested decision of no likelihood of confusion is annulled for the goods found to be identical/highly similar in Class 11, however the finding of no likelihood of confusion is confirmed for the remaining services in Class 42 (para. 100). **LOC**

T-720/13; KARIS / CARYX et al., Judgment of 30 September 2015, *GAT Microencapsulation GmbH v OHIM* – EN. The applicant sought to register the word mark 'KARIS' as a CTM for goods and services in Classes 1, 5 and 35. An opposition was filed based on the following earlier rights: the previous word CTM 'CARYX', registered for goods in Classes 1 and 5; the previous international word mark 'CARYX', designating countries within the EU, registered for goods in Classes 1 and 5 and three previous national word marks 'AKRIS', registered for goods in Class 5. Following the opposition, the applicant amended the application by inserting restrictions to the list of goods and services excluding the goods and services for which the earlier marks were registered. The OD partially upheld the opposition on the ground of a likelihood of confusion between the CTM application and the CTM 'CARYX' and rejected the application for part of the goods and services. The applicant filed an appeal before the BoA. The BoA allowed the appeal in part and annulled the OD's decision to the extent that it upheld the opposition in respect of some of the goods and in Class 5. For reasons of procedural economy, the other opposing earlier rights were not examined. The applicant filed an application for annulment before the GC on the basis of infringement of Article 8(1)(b) CTMR. The GC considered that the relevant public are professionals and consumers with a level of attention that is at least average or may be enhanced. The GC affirmed that the goods and services applied for are similar to the goods and services for which the earlier CTM was registered. The applicant expressly excluded some of the goods of the heading which correspond to the goods the earlier mark was registered for. However, the GC ruled that such exclusion made by the applicant did not preclude a finding that the rest of the goods are similar. The applicant failed to demonstrate how the nature and the purpose of the goods applied for differ from the goods and services the earlier mark was registered for. There is a similarity of signs according to the GC. There is no coexistence of the marks in the view of the GC, as the applicant submitted descriptive and administrative documents which failed to demonstrate any actual coexistence of the marks. Therefore there is a likelihood of confusion and the action was dismissed. **LOC**

♦ **T-364/13; KAJMAN / DEVICE OF A CROCODILE et al.**, Judgment of 30 September 2015; *Eugenia Mocek, Jadwiga Wentka KAJMAN Firma Handlowo-Uslugowo-Produkcyjna v OHIM* – EN.


CTMA	Earlier mark
	

The applicant sought to register the figurative sign represented above as a CTM for goods and services in Classes 18, 20, 22, 25 and 36. An opposition was filed against the registration on the basis, inter alia,



of the earlier figurative CTM represented above, which covers, inter alia, goods and services in Classes 18, 20, 24 and 25. The OD rejected the opposition. The BoA annulled the decision of the OD in part. The BoA considered there was a likelihood of confusion between the marks at issue in respect of goods in Classes 18 and 25. The applicant filed an application for annulment and the opponent filed an application for annulment in part and alteration before the GC. The GC confirmed the conclusion of the BoA that the relevant public are the consumers with an average level of attention and that the goods and services were identical or similar (paras 28 and 30). In relation to the signs the GC made the following conclusions: the degree of visual similarity is low, it cannot be concluded on the phonetic similarity as the earlier mark is lacking a word element, and there is conceptual similarity between the signs. The GC concluded that the CTM possesses a high distinctive character for leather goods, in particular ‘bags’ in Class 18 and for ‘clothing and footwear’ in Class 25 acquired by use. Therefore there is a likelihood of confusion for the goods and services in Classes 18 and 25. **LOC**

◆ [T-642/13](#); she / SHE, Judgment of 15 October 2015, *Wolverine International, LP v OHIM* – EN.


Contested IR designating the EU	Earlier marks
	<p>SHE</p>

The owner of several earlier German trade marks, ‘SHE’, filed a request for invalidity (Articles 53(1)(a) and 8(1)(b) CTMR) against the figurative IR designating the EU (as displayed above). All the trade marks are registered for identical goods, namely clothing, footwear, headgear. The IR holder requested the invalidity applicant to prove use (PoU) of its earlier marks. The CD— without examining the submitted evidence for PoU for reasons of procedural economy — found a low degree of visual and phonetic and no conceptual similarity and denied a likelihood of confusion. Consequently, the invalidity request was rejected. The BoA annulled the CD’s decision. With regard to PoU, the BoA found genuine use of the earlier marks for clothing and footwear. As regards the comparison of signs, the BoA found the marks phonetically identical and visually and conceptually similar. In view of all those factors and the identity and similarity of the goods, the BoA found LoC despite a low degree of distinctive character of the earlier marks. The IR holder filed an application before the GC, requesting annulment of the BoA’s decision. The application was based on two pleas of law, namely a claimed infringement of Article 57(2) and (3) and Article 8(1)(b) CTMR. With regard to the alleged infringement of Article 8(1)(b) CTMR, the GC confirmed the BoA’s finding of an average degree of attentiveness of the relevant public when purchasing clothing items. The applicant’s argument that the end consumer is generally very observant and circumspect when buying clothes or shoes was not corroborated by any evidence in this regard (paras 45-46). With regard to the comparison of the signs, the GC endorsed the BoA’s finding of visual and conceptual similarity and phonetic identity, and thus an overall similarity. It rejected the applicant’s claim that the contested mark is a compact and homogeneous sign and held that rather it is clearly divided into two parts: an initial element consisting of a curved line and a second element consisting of the word ‘she’ in a classic typeface. Even though a part of the relevant public would analyse the curved line as the stylised script of the element ‘cu’, that is not true for all of the public, in particular, as the word ‘cushe’ does not exist in German (paras 56-57). As regards the global assessment of likelihood of



confusion, the BoA's findings are not undermined by the fact that the visual aspect admittedly plays an important role when purchasing clothes, as the marks, in any event, were correctly deemed visually similar (para. 71). The correct finding of LOC is not called into question by the applicant's argument that the earlier marks 'SHE' have a low degree of distinctiveness. The distinctiveness of the earlier marks is just one factor among others in the global assessment and does not automatically exclude LOC (paras 74, 75). In light of the identity/similarity of the goods and the degree of similarity of the signs, the BoA correctly concluded LOC (para. 72). Based on the foregoing the action was dismissed. **LOC**


[T-641/14](#); **LEXDELL / DELL et al.**, Judgment of 24 September 2015, *Alexandra Dellmeier v OHIM* – EN.

CTMA	Earlier mark
LEXDELL	

The applicant sought to register the sign 'LEXDELL' as a CTM for the goods and services in Classes 16, 25, 41 and 45. The OD upheld the opposition in respect of some of the goods and services, partly on the basis of Article 8(5) CTMR and partly on the basis of Article 8(1)(b) CTMR. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for the partial annulment of the decision of the BoA. The GC finds a certain degree of visual similarity between the marks at issue, notwithstanding the fact that the mark applied for differs from the earlier mark in its first syllable, and irrespective of whether the relevant public attributes a meaning to the word 'lex' (paras 16-17). There is a low degree of phonetic similarity between the marks (para. 18). The presence of the word 'LEX' within the mark applied for does not create a conceptual difference capable of counteracting the visual and phonetic similarities. Moreover, partial conceptual similarity results from the fact that the marks at issue have in common the word 'del', meaning 'small, wooded hollow' in English (para. 19). The mark applied for does not reproduce the applicant's name word for word, but only a part of that name. Therefore, this does not amount to a due cause for the use of that mark (para. 27). The plea alleging infringement of Article (8)(1)(b) CTMR and regarding the absence of similarity between the goods and services concerned is not sufficiently precise and intelligible, as it refers to the services for which registration was refused pursuant to Article (8)(5) CTMR (para. 30). The applicant's pleas are rejected and the action dismissed. **LOC**





[T-227/14](#); *Trecolore / FRECCHE TRICOLORI et al.*, Judgment of 7 October 2015, *CBM Creative Brands Marken GmbH v OHIM* – EN.

CTMA	Earlier marks
Trecolore	<p style="text-align: center;">1. FRECCHE TRICOLORI</p> <div style="text-align: center;">  </div> <p style="text-align: center;">2.</p>

The CTM applicant sought to register the sign 'Trecolore' as a CTM for goods and services in Classes 18, 25 and 35. The OD rejected the opposition. The BoA annulled the OD's decision insofar as it had rejected the opposition with regard to the goods in Classes 18 and 25 covered by the mark applied for, and thus upheld the opposition to that extent. The CTM applicant filed an application before the GC for partial annulment of the decision of the BoA and full rejection of the opposition. The degree of attentiveness of consumers when purchasing goods in Classes 18 and 25 is no more than average (para. 27-28). The fact that the word 'frecce' has a distinctive character in view of its meaning for the Italian public (arrows) and that the word 'tricolori' is merely an adjective supplementing the description of the main element is not a sufficient basis for holding that the first of those terms is the dominant element of the earlier trade mark and that the second is negligible (para. 36). There is a certain degree of visual similarity between the signs in question, since the single word which constitutes the mark applied for comprises seven of the nine letters of the second word of that earlier trade mark, including, in particular, the first two letters. Furthermore, there is a significant similarity between the terms 'trecolore' and 'tricolori' that is not undermined by the visual difference between the vowels (paras 41-42). Concerning phonetic similarities, the absence of the word 'frecce' in the mark applied for has no impact on the assessment of the degree of phonetic similarity, given the similarity between the phonetic impression resulting from the pronunciation of the mark applied for and that resulting from the pronunciation of the second element of the earlier trade mark. Therefore, there is an average level of phonetic similarity between the signs in question (paras 46-47). According to the applicant, the expression 'frecce tricolori' refers to the acrobatic demonstration team of the Italian Air Force and, accordingly, the earlier trade mark will certainly be associated — at least by the Italian public — with that group. Such a finding permits the assumption that — at least for that public — the earlier trade mark will be associated with the Italian flag which is also (in a stylised form) an element thereof. As regards the mark applied for, 'Trecolore', the applicant does not challenge the BoA's assessment that the Italian public may perceive that mark as the result of a misspelling of the Italian expression 'tre colori' and thus as indirectly referring to a flag, more specifically that of Italy. Therefore, there is a conceptual similarity between the signs in question (paras 51-52). The BoA was right to conclude that there was a likelihood of confusion between the marks at issue and, accordingly, the action must be dismissed in its entirety as unfounded (paras 60-61). LOC



[T-365/14](#); **TRECOLORE / FRECCHE TRICOLORI** et al., Judgment of 7 October 2015, *CBM Creative Brands Marken GmbH v OHIM* – EN.

CTMA	Earlier marks
	<p>1. FRECCHE TRICOLORI</p>  <p>2.</p>

The CTM applicant sought to register the above figurative trade mark as a CTM for goods and services in Classes 18, 25 and 35. The OD rejected the opposition. The BoA annulled the OD’s decision insofar as it had rejected the opposition with regard to the goods in Classes 18 and 25 covered by the mark applied for, and thus upheld the opposition to that extent. The CTM applicant filed an application before the GC for partial annulment of the decision of the BoA and full rejection of the opposition. The degree of attentiveness of consumers when purchasing goods in Classes 18 and 25 is no more than average (para. 28-29). The BoA erred in its assessment of the similarity between the goods and services by holding that the services in Class 35 covered by the mark applied for were similar to a low degree to the goods in Classes 9, 14, 18 and 25 covered by the earlier trade mark, when they are in fact similar (para. 34). As the applicant has not shown that the word elements of the earlier figurative trade mark would be read as forming a single expression or that that expression would be likely to dominate the overall impression conveyed to the relevant public by that mark, it does not appear to be possible to apply the case law according to which the element situated at the beginning of a sign will be immediately perceived and thus more likely to attract the consumer’s attention (paras 39-40). There is a certain degree of visual similarity between the signs in question, since the single word element which the mark applied for contains comprises seven of the nine letters of the second word of that earlier trade mark, including, in particular, the first two letters. Furthermore, there is a significant similarity between the terms ‘trecolore’ and ‘tricolori’ that is not undermined by the visual difference between the vowels (para. 48). However, the BoA should have taken into account not only the near-total identity of the second word element of the earlier trade mark and the single word element of the mark applied for, the absence in the mark applied for of the representation of a bow and arrow and the first word element of the earlier trade mark, and the presence in the signs in question of three similar geometric shapes, but also the differences between the backgrounds of the signs in question in terms of their colour. There is, at best, a certain degree of visual similarity between the signs in question (para. 52). Despite the absence of the word ‘frecche’ in the mark applied for, the signs in question produce a similar phonetic impression, having regard to the nearly identical pronunciation of the mark applied for and the second word element of the earlier trade mark (para. 59). The three stylised geometric shapes included in the earlier trade mark are green, white and red in colour, appearing in that order, and the word element ‘tricolori’, a reference to the Italian expression ‘il tricolore’ designating the Italian flag, also appears in the earlier figurative mark. The fact that the mark applied for does not refer to the aerobatic demonstration team of the Italian Air Force named ‘Frecche Tricolori’ has no effect, since the contested decision bases the conceptual similarity of the signs in question, on the reference to the Italian flag and, more broadly, Italy. Hence there is a conceptual



similarity between the signs in question (paras 63-69). The BoA was right to conclude that there was a likelihood of confusion between the marks at issue and, accordingly, the action must be dismissed in its entirety as unfounded (paras 75-76). LOC

[T-228/14](#); **TRECOLORE / FRECCIE TRICOLORI** et al., Judgment of 7 October 2015, *CBM Creative Brands Marken GmbH v OHIM* – EN.


CTMA	Earlier marks
	<p>1. FRECCIE TRICOLORI</p>  <p>2.</p>

The CTM applicant sought to register the above figurative trade mark as a CTM for goods and services in Classes 18, 25 and 35. The OD upheld the opposition in part for the goods in Classes 18 and 25 and for certain services in Class 35. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for partial annulment of the decision of the BoA and full rejection of the opposition. The degree of attentiveness of consumers when purchasing goods in Classes 18 and 25 is no more than average (paras 28-29). The BoA erred in its assessment of the similarity between the goods and services by holding that the services in Class 35 covered by the mark applied for were similar to a low degree to the goods in Classes 9, 14, 18 and 25 covered by the earlier trade mark, when they are in fact similar (para. 34). As the applicant has not shown that the word elements of the earlier figurative trade mark would be read as forming a single expression or that that expression would be likely to dominate the overall impression conveyed to the relevant public by that mark, it does not appear to be possible to apply the case law according to which the element situated at the beginning of a sign will be immediately perceived and thus more likely to attract the consumer's attention (paras 38-39). There is a certain degree of visual similarity between the signs in question, since the single word element which the mark applied for contains comprises seven of the nine letters of the second word of that earlier trade mark, including, in particular, the first two letters. Furthermore, there is a significant similarity between the terms 'trecolore' and 'tricolori' that is not undermined by the visual difference between the vowels (para. 46). Moreover, notwithstanding the differences between the three stylised shapes appearing in the mark applied for and those present in the earlier trade mark, the impression which emerges therefrom is one of similarity, since they are all three-pronged shapes laid out in the same precise sequence of colours against a dark background (para. 48). Concerning phonetic similarities, the absence of the word 'freccie' in the mark applied for has no impact on the assessment of the degree of phonetic similarity, given the similarity between the phonetic impression resulting from the pronunciation of the mark applied for and that resulting from the pronunciation of the second element of the earlier trade mark. Therefore, there is an average level of phonetic similarity between the signs in question (paras 54-55). The three stylised geometric shapes included in the earlier trade mark are green, white and red in colour, appearing in that order, and the word element 'tricolori', a reference to the Italian expression 'il tricolore' designating the



Italian flag, also appears in the earlier figurative mark. The fact that the mark applied for does not refer to the aerobatic demonstration team of the Italian Air Force named 'Frecce Tricolori' has no effect, since the contested decision bases the conceptual similarity of the signs in question, on the reference to the Italian flag and, more broadly, Italy. Hence there is a conceptual similarity between the signs in question (paras 58-64). The BoA was right to conclude that there was a likelihood of confusion between the marks at issue and, accordingly, the action must be dismissed in its entirety as unfounded (paras 68-69). **LOC**

◆ [T-489/13](#); **VIÑA ALBERDI / VILLA ALBERTI**, Judgment of 30 June 2015, *La Rioja Alta, S.A. v OHIM – ES*.

CTMA	Earlier mark
VIÑA ALBERDI	

On 26 November 2004, the word sign 'VIÑA ALBERDI' was registered as a CTM for the goods and services in Classes 30, 32 and 33. On 5 November 2009 a request for a declaration of invalidity of the CTM against the goods in Class 33, 'alcoholic beverages (except beers)', was filed on the basis of the earlier German figurative trade mark represented above. The CTM proprietor requested proof of use of the earlier mark and put forward that the challenged CTM claims a Spanish seniority from a well-known trade mark and claimed that the cancellation applicant has tolerated the coexistence of the marks in dispute. The CD declared the registration of the challenged CTM invalid for the contested goods. The BoA confirmed the decision of the CD and considered there was a likelihood of confusion between the marks at issue in respect of the contested goods despite the fact that the CTM proprietor limited its list of goods to 'alcoholic beverages (except beers) and except wines from Italy'. The CTM proprietor filed an application for annulment before the GC. The GC dismissed the action. The GC confirmed the conclusion of the BoA that the relevant public is the German public at large with an average level of attention. The GC concurs with the finding of the BoA that the relevant goods for the appreciation of the LOC are limited by the CTM proprietor in Class 33 on the one hand and the goods 'wines from Italy' of the earlier mark on the other. The GC concluded there is an average level of similarity between the goods compared. According to the judgment, the compared signs possess a certain degree of visual, aural and conceptual similarity, as the figurative element possesses distinctive character. The GC endorsed the finding of the BoA that the earlier mark has an average degree of inherent distinctiveness (para. 73). The GC dismissed the coexistence between the trade marks in the relevant territory alleged by the CTM proprietor (para. 89) as the CTM proprietor was unable to prove this argument. The GC also made reference to the case law, stating that as the marks have been a subject of dispute, the alleged coexistence has not been peaceful (para. 82). Therefore there was LOC (para. 90). **LOC**

[T-273/14](#); **LITHOFIX / LITHOFIN**, Judgment of 3 July 2015, *Lithomex ApS v OHIM – EN*. The CTM owner registered the word mark for goods in Classes 19 and 31. The CD dismissed the invalidity applicant's application, which was based, inter alia, on its earlier German mark 'LITHOFIN', registered for goods in





Class 1, holding that the goods were different. The BoA annulled the CD's decision, considering that the goods were similar with the goods in Class 19, that the earlier mark had an average level of distinctiveness, and that the strong visual and phonetic similarity of the signs led to a likelihood of confusion. The CTM owner appealed to the GC, claiming an infringement of Article 53(1)(a) in conjunction with Article 8(1)(b) CTMR. The relevant public is German consumers, who, taking into account the technical nature of the products at issue, consist mainly of professionals, but also DIY enthusiasts, and will have a higher level of attention than average (para. 21). The goods are similar, given their complementarity. As to the obligation for an examination of the grounds for refusal to be carried out in relation to each of the goods and services covered by the earlier mark, the Court indicates that where two marks are similar, it is sufficient for there to be a likelihood of confusion between the goods covered by the contested mark and part of the goods covered by the earlier mark in order for registration of the contested mark to be refused (paras 22 and 24). The marks are visually and aurally similar as they only differ in their last letter (para. 44). Conceptually, the comparison is either neutral or similar depending on the part of the public that understand the meaning of the prefix litho-, which refers to stone (para. 45). In view of the similarity of the goods in question, the strong similarity of the marks in question and given the average distinctiveness of the earlier mark, there is a likelihood of confusion between the marks at issue (para. 51). **LOC**

◆ [T-684/13](#); **BLUECO / BLUECAR**, Judgment of 25 September 2015, *Copernicus Trademark Ltd v OHIM* – DE. The CTM applicant sought to register the word mark 'BLUECO' for, inter alia, goods in Class 12. The opponent based its opposition on Article 8(1)(b) CTMR using the earlier CTM word mark 'BLUECAR', registered, inter alia, for goods in Class 12. The opposition was directed against the goods in Class 12. The OD upheld the opposition for the contested goods. The BoA dismissed the applicant's appeal. The CTM applicant filed an action before the GC, arguing an infringement of Article 8(1)(b) CTMR. The GC confirms that since the goods covered by the trade marks at issue are highly priced products (vehicles and parts thereof), the target public consisted of final consumers exercising a high level of attention to the comparison of the goods (para. 40). As a consequence of the common element 'BLUE' at the beginning of the confronted marks, the GC finds (at least for the English-speaking public) the marks as being visually, aurally and also conceptually similar (paras 44-58). The GC upholds the finding of the BoA as to the average distinctive character of the earlier mark (para. 66). Finally, the GC concludes that in spite of a higher degree of attention of the target public, the likelihood of confusion may not be ruled out given the identity of the goods and the overall similarity between the signs (paras 69 and 70). **LOC**





◆ [T-78/14](#); Genuß für Leib & Seele KLOSTER Andechs SEIT 1455 / ANDECHSER NATUR SEIT 1908 et al., Judgment of 8 October 2015, *Benediktinerabtei St. Bonifaz Körperschaft des öffentlichen Rechts v OHIM* – DE.

CTMA	Earlier mark
	

The applicant sought to register the figurative mark shown above, inter alia, for ‘milk and milk products’ in Class 29. The opponent based an opposition on Article 8(1)(b) CTMR, directed against said goods, relying on the earlier figurative CTM represented above, registered for identical goods. The OD upheld the opposition because it found that there was a likelihood of confusion between the CTMA and the earlier CTM. The BoA dismissed the appeal. The applicant filed an action before the GC. The relevant public consists of average consumers in the EU, paying average attention (para. 36). Visually, the letters ‘Andechs’ stand out in both signs (complemented by the letters ‘ER’ in part of the earlier mark). In addition, the signs have the word ‘SEIT’ in common. However, the relevant public will pay little attention to it. The remaining elements are dissimilar but insufficient to counterbalance said similarity. The CTMA’s scenery is decorative and common for agricultural products. The other word elements have a minor role due to their positioning and smaller size. In the earlier mark, only the element ‘NATUR’ has a similar size but it will be perceived as a common term in relation to foodstuffs in the EU. Overall, the signs are visually similar (paras 43-49). The aural similarity is higher regardless of the exact pronunciation of ‘Andechs(er)’ (para. 50). A conceptual comparison cannot be made for those parts of the relevant public who do not speak German (para. 51-54). Only a minor part of the relevant public will recognise ‘ANDECHSER’ as a term indicating a geographical origin. Moreover, there is no apparent connection between the goods and such origin. Hence, it is not descriptive (contrary to the applicant’s principle claim). Overall, there is therefore a likelihood of confusion (paras 60-70). LOC

[T-254/14](#); NEW MAX / MAX, Judgment of 3 September 2015, *Warenhandelszentrum Ltd v OHIM* – DE.

CTMA	Earlier mark
	




The applicant sought to register the figurative mark 'NEW MAX' as a CTM for the goods 'washing preparations; bleaching preparations; soaps; shampoos for pets; cosmetics; cosmetic preparations for animals; fabric softeners; preparations for shaving; shaving soaps; shaving stones (antiseptic); after-shave; cleaning, polishing, scouring and abrasive preparations; cleaning preparations; cosmetics' in Class 3, 'animal washes, in particular lotions for dogs and dog washes' in Class 5 and 'laundrying' in Class 37. An opposition based on the earlier Community figurative mark was filed on the grounds of Article 8(1)(b) CTMR. The earlier mark is registered for the services 'retail services in relation to goods in the field of substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, pharmaceutical and veterinary preparations, sanitary preparations for medical purposes' in Class 35. The OD dismissed the opposition. The BoA upheld the opponent's appeal finding that there is likelihood of confusion between the conflicting marks. The applicant filed an action before the GC. The goods in Classes 3 and 5 are similar to the 'retail services' in Class 35 related to such goods because they are indispensable when rendering the services (paras 28-29, 31-33). The services 'laundrying' in Class 37 are similar to 'retail services in relation to goods in the field of substances for laundry use' in Class 35 on account of their clear connection (para. 34). Visually, the signs are characterised by their word element 'MAX'. Aurally, the signs are highly similar since the term 'NEW' marks only a slight difference. In relation to the goods, 'MAX' will be primarily understood as 'maximal' or 'maximum' in both signs. 'New' is a mere addition. Thus the signs are conceptually similar. Overall, the signs are similar (paras 39-44). Therefore, the BoA was right to conclude that there is a likelihood of confusion within the meaning of Article 8(1)(b) CTMR. **LOC**

[T-193/14](#); **AERONAUTICA / NAUTICA et al.**, Judgment of 23 September 2015, *Cristiano di Thiene SpA v OHIM* – EN. The applicant sought to register the word mark 'AERONAUTICA' as a CTM for goods and services within Classes 9, 18, 20, 25, 35, 42 and 43. An opposition based, inter alia, on the earlier word marks 'NAUTICA' and 'NAUTICA BLUE' registered for goods and services in Classes 8, 9, 18, 20, 25 and 35 was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition partially in respect of part of the goods and services in Classes 9, 18, 20, 25, 35 and 42. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC ruled that the element 'aero' is a differentiating element, however the difference created is insignificant in comparison with the length of the common element 'nautica' and the important position occupied by the latter element in the signs in question (para. 25). According to the judgment there is an average degree of visual and phonetic similarity between the signs and the short element 'blue' does not alter this (para. 26). The GC emphasised that the finding of a likelihood of confusion cannot be made conditional upon the overall impression produced by the composite sign being dominated by the part of that sign which consists of the earlier trade mark and this is not dependant on whether the distinctive character of the common element is weak or average (paras 27-28). The GC found that for a non-negligible part of the relevant public, who does not know the term 'nautica', the conceptual comparison of the signs remains neutral (para. 35 et seq). With regard to the LOC, the applicant submits that the BoA wrongly held that the earlier trade mark 'NAUTICA' was of an average distinctive character, even though that term is inherently weak (para. 41). However, the GC ruled that even if it were necessary to accept the applicant's arguments based on the weak distinctive character of the earlier trade mark, the identity or similarity of the goods in question and the visual and phonetic similarities between the signs at issue are in any event sufficient grounds in the case in question for concluding that there is a LOC (para. 45). The GC dismissed the action. **LOC**



[T-369/14](#); **SEQUOIA CAPITAL / SEQUOIA**, Judgment of 30 September 2015, *Sequoia Capital Operations LLC v OHIM* – EN. The application for a declaration of invalidity was based on the Community word mark ‘SEQUOIA’ registered in respect of goods and services in Classes 9, 16 and 36, and directed against the Community word mark ‘SEQUOIA CAPITAL’ registered for services in Classes 35 and 36. The CD found a likelihood of confusion for all contested services. The BoA dismissed the appeal. The proprietor of the contested CTM filed an action before the General Court. The relevant public consists of business customers and private and institutional investors with some expertise in the financial field and companies needing capital, and a high level of attention, situated in the EU (paras 22-23). There is a certain degree of similarity between, on the one hand ‘business advice relating to financial re-organisation’ in Class 35 and ‘venture capital services; venture capital management services; venture capital fund management; venture capital funding services to start-up and emerging companies; providing financing to start-up and emerging companies; financing services for the securing of funds in respect of ventures; venture capital financing; project capital investment services; private equity fund services; operation and management of investment funds; advisory services relating to the above service’ in Class 36, and, on the other hand, ‘futures and options trading services, brokerage services, trading bureau services, investment advisory services in respect of the foregoing services’ in Class 36 (paras 25-35). The element ‘CAPITAL’ will be perceived as ancillary. The element ‘SEQUOIA’ is common to both of the marks at issue, which are therefore phonetically and visually similar to a high degree and convey the same conceptual content. A sizeable part of the consumers will understand that element as describing a huge coniferous tree of the west coast of the United States (paras 39-40). The highly specialised nature of the services at issue cannot rule out the likelihood of confusion (para. 43-45). **LOC**

◆ [T-186/14](#); **NOxtreme / X-TREME**, Judgment of 7 October 2015, *Atlantic Multipower Germany GmbH & Co. OHG v OHIM* – DE.

CTM	Earlier mark
NOxtreme	

The invalidity applicant requested the invalidity of the CTM ‘NOxtreme’ (word), registered for goods in Classes 5, 29 and 32. The invalidity application was based on Article 53(1) CTMR in conjunction with Article 8(1)(b) CTMR using, inter alia, the earlier CTM shown above, registered for goods in Classes 5, 29 and 32. Both instances at the Office upheld the application for invalidity. The CTM proprietor appealed to the GC, arguing an infringement of Article 57(2) and (3) CTMR in conjunction with Article 42(2) and (3) CTMR, as well as Article 53(1) CTMR in conjunction with Article 8(1)(b) CTMR. With respect to the relevant public the applicant claimed that the target public would be consumers interested in specific nutrition for the purpose of building muscles. This would lead to an increased attentiveness (para. 42). The GC dismisses this argument stating that on the one hand the goods are normal consumer goods, such as ‘milk’, etc. (Class 29) or ‘mineral water’, etc. (Class 32) and are not intended for sports nutrition. However, the goods covered by the contested mark are so broad that they are not only consumed by those who practice sports. Consequently, the attentiveness of the public will be in general average (paras 42-44). The applicant did not challenge the assessment of the BoA that the goods are identical, very similar and similar (para. 45). Concerning the comparison of the marks, the GC states that the part




'xtreme' is contained in both marks and that the figurative element of the earlier mark as a basic geometrical shape does not have a dominant and distinctive character. Moreover a common prefix, such as the element 'NO' of the contested mark, does not attract the consumer's attention. The conclusion that the marks are visually similar is correct (paras 48-52). Aurally the marks are similar too, since the earlier mark is fully included in the contested mark, which has at its beginning a further syllable (paras 53 to 55). For the English-speaking consumers the signs are conceptually similar to the extent that both refer to the concept 'extreme' (para. 57). The GC dismisses the applicant's statement that the term 'xtreme' would be descriptive for the goods in the sense that the nutrition would be appropriate for extreme sport. The term 'xtreme' alone without any additional information only gives a general impression, without referring to any characteristics. Consequently, the distinctiveness of the term is average (paras 64 and 65). The GC confirms the global assessment of the BoA and its finding of a likelihood of confusion (para. 66). **LOC**

[T-714/14](#); **ATHEIST / athé**, Judgment of 15 October 2015, *David Bonney v OHIM* – EN. The applicant filed an application for registration of a CTM for the word 'ATHEIST' in Classes 18, 25 and 35 of the Nice Classification. An opposition based on the French mark 'athé' was upheld for the goods and services referred to in Classes 18, 25 and 35. An appeal against this decision was rejected. The BoA decided that the earlier mark had been put to genuine use in France for 'bags' and 'handbags' in Class 18 and for 'clothing' and 'footwear' in Class 25 and confirmed the likelihood of confusion. The applicant filed an action before the GC claiming the infringement of Article 8(1)(b) CTMR. The GC dismissed the action, affirming the likelihood of confusion pursuant to Article 8(1)(b) CTMR. The similarity or identity of the goods was not disputed (para. 19). Since the only difference between the signs at issue is the absence of that accent and the presence of the letters 'l', 's' and 't' at the end of the mark applied for, the signs at issue were similar to a medium degree in their overall visual impression (para. 22). As regards the phonetic comparison of the signs, a French-speaking consumer would pronounce the common parts of those signs in the same way, despite the lack of an accent on the letter 'e' of the mark applied for. Therefore, the signs at issue were similar to a medium degree in their overall phonetic impression (para. 23). As regards the conceptual comparison of the signs, the earlier mark will be perceived as meaning 'athée' ('atheist' in English), as the pronunciation of that word is identical to the earlier mark and the words are visually very similar. As for the mark applied for, which has no direct meaning in French, it could also be perceived by French consumers who do not understand English or by those who do not realise that it is an English word, as a reference to the French word 'athée', which would undoubtedly be strengthened by the similarity between the mark applied for and the French word 'athéiste', whose meaning is the same as the word 'athée'. Finally, French consumers who understand the meaning of the English word 'atheist' are bound to perceive the signs at issue as being very similar conceptually. The signs at issue are very similar conceptually (paras 24 and 25). Account being taken of the identity or similarity of the goods and services, of the average similarity of the marks at issue visually and phonetically and their high similarity conceptually, the relevant public might believe that the goods and services in question were supplied or provided by the same undertakings. In particular, it is not inconceivable that the relevant public might perceive those marks as being related marks, designating different product lines, insofar as the earlier mark is entirely contained in the mark applied for, although without an accent on the letter 'e' (para. 31). **LOC**



[T-664/13](#); **PETCO / PETCO**, Judgment of 21 October 2015, *Petco Animal Supplies Stores, Inc. v OHIM – EN*.

CTMA	Earlier mark
PETCO	

The applicant sought to register the word ‘PETCO’ as a CTM for goods and services, inter alia, in Classes 31 and 35. An opposition based on the earlier figurative CTM represented above, registered for goods and services, inter alia, in Classes 31 and 35, was filed on the grounds of Article 8(1)(a) and (b) CTMR. The OD upheld the opposition in part. The BoA annulled the OD’s decision to the extent that the decision refused registration of the mark applied for in respect of the ‘retail services and online store services connected with the sale of ... sports and sporting goods’ in Class 35, and dismissed the appeal as to the remainder. The BoA found that the request of the applicant for suspension of the proceedings on the basis of an application for a declaration of invalidity of the earlier mark is not appropriate. The applicant filed an action before the GC. The GC rejected the applicant’s plea in law alleging that the BoA’s refusal to stay the proceeding is unlawful. The GC stated that if this plea in law were upheld, the contested decision would have to be annulled in its entirety and, consequently, inasmuch as the GC has been seized only of a claim for partial annulment, it would have to rule *ultra petita* (para. 30). Furthermore, the GC ruled that even if the second plea were admissible, the BoA has a broad discretion to suspend proceedings or not, thus suspension remains optional for the BoA, which restricts the judicial review on the merits to ascertaining that no manifest error of assessment or misuse of powers has occurred (paras 31-32). The GC further stated that the BoA carried out, inter alia, a prima facie analysis of the likelihood that the application for a declaration of invalidity would succeed, which resulted in a finding that that likelihood was slight. Therefore, the weighing of the parties’ interests necessarily tends in favour of the opponent’s legitimate interest in obtaining, without delay, a decision on the opposition (paras 33-34). As a consequence, even if the second plea was admissible, it would have to be rejected as unfounded as it has not been established, that there was any manifest error of assessment as regards the BoA’s decision (para. 36). The GC ruled that the relevant public consist of professionals whose level of attention is high (para. 47) and the services are identical (para. 51). As regard to the visual similarity of the signs, they are visually similar to an above average degree, as the term ‘petco’ in the earlier mark is the dominant and distinctive element and the remaining figurative elements are ornamental (paras 57-58). The signs are phonetically identical and do not have any meaning, therefore the conceptual comparison is impossible (paras 59-60). However, the GC stated that the word element ‘petco’ might be understood by section of the English-speaking public as an invented word which refers to the English word ‘pet’ (paras 60-62). As a consequence of the above, in the view of the GC there is a likelihood of confusion (para. 64). The GC ruled that in the light of all the foregoing considerations, the action must be dismissed in its entirety and it was not necessary to stay the proceedings (para. 66). **LOC**


[T-309/13](#); **ELMA / ELMEX**, Judgment of 22 October 2015; *Enosi Mastichoparagagon Chiou v OHIM – EN*. The applicant sought to register the word ‘ELMA’ as a CTM for goods in Class 5. The OD upheld the



opposition on the basis of Article 8(1)(b) CTMR. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The commercial choices made or which may be made by the proprietors of the marks at issue are factors that cannot affect the relevant public to be taken into account when assessing whether there is a likelihood of confusion. As regards the assessment of the likelihood of confusion, the public with the lowest attention level must be taken into consideration. Thus, even if it were accepted that the goods covered by the mark applied for are also purchased by certain consumers who select them with particular care, for medical reasons, that does not alter the fact that they are intended for all consumers, the great majority of whom display only an average level of attention when purchasing such goods (paras 29-31). The goods covered by the mark applied for contain Chios mastic, a resin produced by the mastic tree, which grows on the island of Chios and possesses properties suitable for oral and dental hygiene. However, notwithstanding their medicinal properties, these goods contribute, to the same degree as those covered by the earlier mark (inter alia, pharmaceutical and hygienical products and preparations; products and preparations for buccal and dental care) to dental and oral hygiene and care. Plus, although these goods are, according to the applicant, sold mainly in specialist shops known as 'mastihashops', they may also be sold alongside other goods that do not contain Chios mastic, in particular in supermarkets, drugstores and pharmacies, and do not require a prescription. Accordingly, it must be concluded that the goods in question are likely to share the same distribution channels. It follows that Chios mastic must be considered a basic ingredient of the contested goods, which does not change their intended purpose, use or distribution channels and which, therefore, has no effect on the assessment of the similarity between goods. The fact that that chewing gum has protected designation of origin (PDO) status cannot affect the assessment of its similarity to the goods covered by the earlier mark. PDO merely designates the geographical origin of a product and must therefore be considered irrelevant to the assessment of similarity between the goods. Thus the BoA was right to conclude that the goods in question are highly similar (paras 43-50). The signs are relatively short words, the first parts of which are visually identical, and the difference between the end letters is not sufficient to counterbalance that identity. Thus there is an average degree of visual similarity (paras 58-59). Phonetically, the marks at issue are similar insofar as they have two syllables and share the same first syllable. Furthermore, the second syllable of each mark starts with the letter 'm', which is pronounced in the same way for both marks. The fact that the common syllable, 'el', appears at the start of the words increases the phonetic, while the difference in the endings of the words is not sufficient to outweigh that similarity. In addition, it is not possible to establish how the relevant public will pronounce the word 'elmex', which constitutes the earlier mark. Thus, from a phonetic perspective, the marks display an average degree of similarity (paras 60-62). Given that the word 'elmex' has no meaning, it is not possible to make a conceptual comparison of the signs. The fact that the word 'elma' corresponds to the Greek abbreviation 'ΕΛΜΑ', which derives from the expression 'Ελληνική μαστίχα' meaning 'Greek mastic' presupposes that the relevant public not only knows the Greek alphabet but also recognises that abbreviation. Since that alphabet is known outside Greece and Cyprus only by a more erudite category of consumers, most European consumers will not be in a position to establish such a connection. Hence, the conceptual comparison of the marks is not possible (paras 64-66). **LOC**



[T-96/14](#); *VIMEO / meo et al.*, Judgment of 23 October 2015, *Vimeo LLC v OHIM* – EN.

CTMA	Earlier mark
VIMEO	

The CTM applicant sought to register the word mark 'VIMEO' as a CTM for goods in Classes 38, 41 and 42. An opposition based, inter alia, on the earlier figurative mark above, registered for goods in Classes 9, 16, 35, 37, 38, 41 and 42, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The GC confirmed the BoA's finding, uncontested by the parties, that the goods and services were partly identical and partly similar (paras 23-24). It also confirmed the BoA's uncontested finding that the goods at issue were aimed at and frequently purchased by the public at large, as well as business customers with specific professional knowledge or expertise in the telecommunications sector; the level of attention of the relevant public therefore varying from average to high (paras 24-26). As for the visual similarity of the signs, according to the GC, while it is true that the relevant public will perceive that the signs at issue differ visually due to the stylised typeface of the earlier sign, the figurative elements of the earlier sign, and the greater number of letters and the group of letters 'vi' in the mark applied for, that public would also perceive that the said signs share the element 'meo'. As a result of that common element, that public will perceive a certain visual similarity between the marks at issue. However, the figurative elements of the earlier mark will be perceived by the relevant public as secondary vis-à-vis the verbal elements. As a matter of fact, although the first component of word marks may be more likely to catch the consumer's attention than the components which follow, in the present case the GC found that the element 'vi' in the mark applied for did not attract the relevant public's attention more than the element 'meo'. All the more so, given that the mark applied for was composed of only three syllables and ends with the letter 'o' (paras 33-35). Likewise, the marks at issue were found to have a certain phonetic similarity due to the fact that the earlier mark contained the group of letters 'meo', which was entirely contained within the mark applied for. The relevant public would pronounce the mark applied for as a whole and the group of letters 'meo' in the mark applied for would be pronounced in the same way as in the earlier mark (para. 39). No conceptual comparison could however be made between the marks at issue (para. 42). The CTM applicant tried to establish that the marks at issue had peacefully coexisted in such a way as to rule out any likelihood of confusion. Nonetheless the GC found that neither the extracts from the VIMEO website, nor the copies of articles published between 2008 and 2010 in *The Guardian*, nor the fact that it was clear that the opponent had used its mark in the field of telecommunications and broadcasting since at least 2006, showed sufficiently conclusively that the consumers of the goods or services covered by each of the marks at issue did not confuse those marks. That evidence did not give any indication as to the perception by the relevant consumer and still less an indication of the perception by that consumer of those signs as referring to two distinct undertakings or associations. More particularly, the witness statement provided by the applicant's president, in which he stated that the applicant had not been informed of any instance of confusion between the mark applied for and the earlier mark, was not considered to be sufficient evidence to establish the peaceful coexistence of the marks but as merely one factor which, moreover, did not emanate from consumers of the goods and services at issue (paras 47-59). The GC concluded that the overall impression produced by the marks at issue could lead the public to believe that the goods and services at issue come, at the





very least, from undertakings that are economically linked. In this respect, it held that even though the group of letters ‘meo’ making up the mark applied for did not have an independent distinctive role within the mark applied for, it contributed in a significant way to the overall impression produced by that mark insofar as it makes up two fifths of the sign. Moreover, even if the anglophone part of the relevant public was found to associate the mark applied for, VIMEO, with the term ‘video’, where it is used for online video sharing services, which is not the case, the fact remains that the overall impression produced by the marks at issue could lead to a likelihood of confusion (paras 67-71). The CTM applicant’s action was therefore dismissed in its entirety (para. 72). **LOC**

◆ [T-21/14](#); **SANDTER 1953 / SANDER**, Judgment of 29 October 2015, *NetMed Sàrl v OHIM – DE*. The CTM applicant sought to register the word mark ‘SANDTER 1953’ for goods in Classes 3, 5 and 10. An opposition was filed on the grounds of Article 8(1)(b) CTMR, based on the earlier German word mark ‘SANDER’, registered for goods in Classes 5, 10 and 25. Upon request of the CTM applicant, the owner of the earlier mark provided evidence to prove genuine use of its mark. The OD found genuine use proven for ‘Fingerlinge’ [‘rubber protection for fingers’] for medical purposes’, belonging to the category of ‘bandages’ in Class 10. The signs were held to be confusingly similar and, consequently, the CTMA was partly rejected for the goods deemed to be similar/identical to ‘bandages’. The BoA confirmed the OD’s decision. The CTMA applicant filed an application before the GC, claiming infringement of Article 42 and Article 8(1)(b) CTMR. With regard to Article 8(1)(b) CTMR, the applicant’s claim is to be rejected that the goods at issue in the medical field (Class 10) are obviously exclusively addressed to a specialised, highly attentive public. Certain medical goods, and particularly ‘bandages’ are also bought by the general public with an average degree of attentiveness and are available not only in pharmacies, but also in drugstores or department stores (e.g. blood pressure equipment) (paras 71-73). ‘Bandages’ are similar to ‘First-aid kits’, ‘Plasters’ ‘disinfectants’ etc., as they are either contained in these kits or are used with the same purpose of health protection/treatment of diseases (paras 80-85). With regard to the similarity of signs, the BoA’s assessment of low distinctiveness of the element ‘1953’ is to be confirmed. Four-digit numbers, which begin with 20, 19, 18..., will usually be perceived as a reference to a year (in particular to the founding year of the company), if they are used in connection with other elements such as a company name and are positioned behind the company name (paras 91-96). Overall, the signs are confusingly similar. This is not put into question by the claimed peaceful coexistence of the marks, as it was not sufficiently demonstrated how the public was confronted with the marks at issue and for which goods the marks were used (paras 101-103). Based on the foregoing, the action was dismissed. **LOC**





[T-256/14](#); CREMERIA TOSCANA / la Cremeria et al., Judgment of 29 October 2015, *Andrea Giuntoli v OHIM* – EN.

CTMA	Earlier mark
	

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 30, 35 and 43. An opposition based on the earlier IR represented above and which has effect throughout the EU was filed. The IR covered, inter alia, goods in Class 30. The OD partially dismissed the opposition in relation to the services covered by Classes 35 and 43 and upheld the opposition in respect of the rest of the goods and services. The opponent filed an appeal. The BoA partially upheld the appeal and partially annulled the decision of the OD. The BoA considered that there was a likelihood of confusion also for the ‘food sector services’ in Classes 35 and 43. The applicant filed an action before the GC. As preliminary observations, the GC stated that the word ‘Toscana’, which refers to the region of Tuscany in Italy, has close equivalents in all the languages of the European Union and therefore the inherent distinctive character of that element is slightly below average (para. 39). The GC also ruled that the element ‘cremeria’ has a weak distinctive character in respect of the Italian public and that the same is true in respect of the Spanish and French public (para. 35). However, the distinctive character of that element is normal for the section of the relevant public that does not speak a Romance language (para. 36). According to the GC, it is sufficient to compare the signs at issue on the basis of the perception of the relevant public that does not speak a Romance language, since, for this public, the common element ‘cremeria’ carries greater weight in the comparison (para. 42). The signs at issue have an average degree of visual and phonetic similarity (para. 43 et seq. and para. 53 et seq.), but there is a degree of conceptual difference between the signs at issue as the mark applied for contains the element ‘Toscana’, which can be interpreted by the relevant public, while the earlier mark does not conjure up any image on the part of the relevant public that does not speak a Romance language (para. 61). However, according to the GC the ‘toscana’ element from which the difference derives has a slightly below average distinctive character and has little ability to indicate the commercial origin of the goods and services covered, while, as regards the public that does not speak a Romance language, the element ‘cremeria’ has a normal degree of distinctiveness and is capable in itself of indicating that commercial origin (para. 65). With regard to the level of attention of the relevant public, the GC concluded that it is at most average in respect of the goods in Class 30 and the food sector services in Class 43, while that level of attention is higher than normal with regard to the food sector services in Class 35. The goods and services covered by the signs at issue are partly identical and partly highly similar (para. 65). In conclusion, the GC ruled that there is likelihood of confusion in part of the territory of the European Union between the signs at issue, in respect of the goods in Class 30 and the food sector services (para. 66). The GC dismissed the action. **LOC**





♦ [T-449/13](#); **WISENT / ZUBROWKA BISON BRAND VODKA**, Judgment of 12 November 2015, *CEDC International sp. z o.o. v OHIM* – EN.

CTMA	Earlier mark
	

A cancellation action was filed against the registration of the figurative mark represented above for goods within Classes 32 and 33 based on, inter alia, the earlier Polish trade mark represented above and protected for goods in Class 33. The CD allowed the cancellation pursuant to Articles 53(1)(a) CTMR in conjunction with Article 8(1)(b) and Article 8(5) CTMR. The BoA overturned this decision and denied the similarity of the signs. The cancellation applicant filed an action before the GC claiming an infringement of Article 8(1)(b) and Article 8(5) CTMR, and an infringement of Article 75 and Article 76(1) and (2) CTMR. The GC upheld the claim of the infringement of Article 8(1)(b) CTMR due to an erroneous comparison of the signs. First, the GC responded to the applicant challenging the methodology of the trade mark comparison and confirmed the methodology used by the BoA (para. 55 et seq.) It recalled the settled case law that the global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant elements (para. 55). However, contrary to what the applicant claims, the BoA was not required to take into consideration, when comparing the marks at issue, elements such as the similarity of the goods in question, the high reputation, the renown, or the enhanced distinctiveness of the marks, or the existence of a family of marks (para. 66). Within the trade mark comparison the BoA erred in taking the view that the figurative element of the contested mark, consisting of a representation of a bison, was less distinctive than the verbal element 'wisent' of that mark (para. 84). The contested decision is vitiated by errors in the assessment of the visual similarity and of the conceptual similarity of the marks at issue (para. 130). **LOC**



◆ [T-450/13](#); *WISENT VODKA / ZUBROWKA et al.*, Judgment of 12 November 2015, *CEDC International sp. z o.o. v OHIM* – EN.

CTMA	Earlier mark
	

An opposition was filed against the CTM application of the figurative mark represented above for goods within Classes 32 and 33, based on, inter alia, the earlier Polish trade mark represented above, protected for goods in Class 33. The OD allowed the opposition pursuant to Article 8(1)(b) and Article 8(5) CTMR. The BoA overturned this decision and denied the similarity of the signs. The cancellation applicant filed an action before the GC claiming an infringement of Article 8(1)(b) and Article 8(5) CTMR, and an infringement of Article 75 and Article 76(1) and (2) CTMR. The GC upheld the claim of the infringement of Article 8(1)(b) CTMR due to an erroneous comparison of the signs. First, the GC responded to the applicant challenging the methodology of the trade mark comparison and confirmed the methodology used by the BoA (para. 55 et seq.) It recalled the settled case law that the global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant elements (para. 56). However, contrary to what the applicant claims, the BoA was not required to take into consideration, when comparing the marks at issue, elements such as the similarity of the goods in question, the high reputation, the renown, or the enhanced distinctiveness of the marks, or the existence of a family of marks (para. 67). Within the trade mark comparison the BoA erred in taking the view that the figurative element of the contested mark, consisting of a representation of a bovine animal and a representation of a coat of arms, was less distinctive than the verbal element ‘wisent’ of that mark (para. 86). The contested decision is vitiated by errors in the assessment of the visual similarity and of the conceptual similarity of the marks at issue (para. 139). **LOC**




[T-248/14](#); masafi juice / masafi, Judgment of 25 November 2015, *Masafi Co. LLC v OHIM* – EN.

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

The applicant sought to register the figurative sign represented above as a CTM for goods and services within Class 32. An opposition based on the earlier national word mark represented above, registered for goods in Class 32, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The ground of opposition based on Article 8(5) CTMR was withdrawn in the course of the proceedings before the OD. The OD upheld the opposition. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC ruled that the relevant public as consisting of the general public of the United Kingdom (para. 19). On the comparison of goods, the GC stated that so far as concerns the 'mineral and aerated waters' covered by the mark applied for and the 'soft drink colas' covered by the earlier mark, while it is true that those goods are not identical, they are still at least of average similarity (para. 24). On the comparison of signs, the GC found that the term 'masafi' constitutes the dominant element of the mark applied for (para. 28 et seq.), the stylisation of that term is not particularly high (para. 34) and the English term 'juice', written in grey characters on the left side of the mark applied for is descriptive of the goods covered by that mark (para. 35). The elements in characters that are indecipherable for the relevant public would not, according to the GC, specifically draw that public's attention and that the representation of the leaf would be perceived as a secondary figurative element (para. 35). The GC held that there is identity or similarity of the goods, the high degree of visual and phonetic similarity, the average distinctiveness of the earlier mark and presence in both of the signs at issue of the element 'masafi', therefore there is a likelihood of confusion (para. 39 et seq.). The GC dismissed the action. **LOC**



[T-249/14](#); *Masafi / masafi*, Judgment of 25 November 2015, *Masafi Co. LLC v OHIM* – EN.

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

The applicant sought to register the figurative represented above as a CTM for goods and services within Classes 29 and 32. An opposition based on the earlier national word mark represented above, registered for goods in Classes 29, 30 and 32, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition in part and authorised registration for part of the goods in Class 29. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC ruled that the relevant public as consisting of the general public of the United Kingdom (para. 19). On the comparison of goods, the GC stated that there is a high degree of similarity between part of the goods and at least an average degree of similarity between another part of the goods (para. 26 et seq.). On the comparison of signs, the GC found that the term 'masafi' constitutes the dominant element of the mark applied for (para. 31 et seq.), the stylisation of that term is not particularly high (para. 37) and the elements in characters that are indecipherable for the relevant public would not, according to the GC, specifically draw that public's attention and the other figurative elements, namely the leaves, would be perceived as secondary figurative elements (para. 38). The GC held that there is identity or similarity of the goods, the high degree of visual and phonetic similarity, the average distinctiveness of the earlier mark and presence in both of the signs at issue of the element 'masafi', therefore there is a likelihood of confusion (para. 43 et seq.). The GC dismissed the action. **LOC**

[T-763/14](#); *SOPRAPUR / Sopro*, Judgment of 25 November 2015, *Holding Soprema v OHIM* – FR. The IR holder obtained the IR designating the EU for the word mark 'SOPRAPUR' for goods in Classes 1, 3, 17 and 19. An opposition was filed, based, in particular on the earlier CTM 'Sopro', for goods and services in Classes 1, 2, 3, 6, 17, 19, 24, 27, 37 and 39. The opposition was based on Article 8(1)(b) CTMR. The OD upheld the opposition for all the contested goods. The BoA dismissed the IR holder's appeal and confirmed the decision, found a likelihood of confusion and, based on Article 8(1)(b) CTMR, rejected the IR (EU) in its entirety. The IR holder filed an action before the GC. The GC noted at the outset that the BoA had rightly considered the relevant territory to be the EU and confirmed that the public consisted in the reasonably well-informed, observant and circumspect general public for goods in Class 3, as well as a professional public with a higher level of attention for the remaining contested



goods. The GC found that the BoA rightly stated that the German part of the public was an important part, while correctly defining the relevant public as the public of the EU. The GC concluded that there was no lack of reasoning in the BoA's focus on the German part of that relevant public. The BoA correctly differentiated the various categories of goods targeting different consumers and rightly discerned different degrees of attention (para. 23). The GC considered that when referring to the OD's line of reasoning regarding the conceptual comparison, the BoA recognised that the signs were not conceptually similar and implicitly considered that the element 'pur' held a conceptual connotation that was not sufficient to outweigh the visual and phonetic similarities (para. 25). Consequently, the legal considerations were clearly set out in the contested decision. The latter informed the applicant of the justification for the contested decision and enabled the GC to exercise its power to review the legality of the decision (para. 26). The GC endorsed the BoA's definition of the public and considered well founded that the BoA assessed the existence of a likelihood of confusion on the important part of the public that understands the word 'pur' as a reference to the purity of the goods, such as the German-speaking public. The BoA adopted the OD's conclusion regarding the comparison of goods, which were either identical, highly similar or similar to the earlier goods (paras 37-38). This conclusion, which was not contested by the applicant, is confirmed by the GC. Regarding the sign 'SOPRAPUR', an important part of the German-speaking public will identify the German word 'pur'. It is therefore correct to assess the likelihood of confusion on this significant part of the public. The element 'pur' is descriptive of part of the products as it refers to the purity of the products or to their purpose (to give to objects or surfaces their pure cleanliness) and is weakly distinctive for the other part as it consists in a laudatory term to promote a superior quality of a given product. The beginning 'sopra' has a normal distinctive character thus has more weight than 'pur' in the perception of the German-speaking part of the public. However, this does not mean that 'pur' will be neglected in the overall impression. The BoA did a correct assessment of the overall impression and took account of all the elements of the signs, even though it did not specifically identify the degree of visual, phonetic and conceptual similarity and only stated that the signs were similar globally (para. 53). Consumers pay more attention to the beginning of the sign, which may have a stronger impact than the rest of the sign (para. 54). The fact that the earlier trade mark begins with a capital letter 'S' followed by lower case letters has no impact on the visual comparison, given that a word mark is protected for the word, not for its graphic or stylised aspects (para. 56). Phonetically, a weakly distinctive element of a complex mark has only a limited impact on the phonetic similarity (para. 61). The element 'sopra' will attract more attention than the element 'pur' (para. 62 in fine). 'Sopro' and 'sopra' are highly similar visually and aurally. The element 'pur', although not negligible, is not sufficient to substantially diminish the strong similarity of the element 'sopra' with the earlier mark. The element 'pur' is descriptive of part of the products or weakly distinctive for the other part and thus will only have a limited impact on the phonetic similarity. Based on imperfect recollection, the signs are visually and phonetically similar to at least an average degree. Conceptually, the signs are not similar. 'SOPRAPUR' does not carry a clear concept per se. In its overall assessment, in light of the identity and similarity of the goods and the visual and phonetic similarities, the BoA was right to conclude that a likelihood of confusion existed. The action was dismissed. **LOC**

[T-181/14](#); **Nordschleife / Management by Nordschleife**, Judgment of 26 November 2015, *Nürburgring GmbH v OHIM* – DE. The CTM applicant sought to register the word mark 'Nordschleife' for goods and services in, inter alia, Classes 9, 16, 25, 28 and 41. The opponent filed an opposition based on the earlier German trade mark 'Management by Nordschleife', registered for identical and similar goods. The opposition was based on Article 8(1)(b) CTMR and directed against all the goods and services of the





CTMA. The OD found a likelihood of confusion with respect to all the identical/similar goods and services. The BoA dismissed the appeal and found LOC as well. It found the signs to be visually and aurally similar at least to an average degree. Conceptually, the comparison could at best be considered neutral. The BoA further held that the element 'Management by' of the earlier mark was only of reduced distinctiveness, while the fully distinctive element 'Nordschleife' dominated the earlier sign. The CTM applicant filed an application before the GC, based on a purported violation of Article 8(1)(b) CTMR, requesting annulment of the BoA's decision. The GC confirmed the BoA's reasoning that 'Nordschleife' is the dominant element of the earlier mark. The basic English word 'Management' will be understood by the relevant German public as referring to a way of organising/administering; the further element 'by' points towards the entity that is responsible for the organisation/administration — in the present case 'Nordschleife'. Therefore, 'Management by' will be understood as a general reference to the origin of the respective goods and services and to the responsibility for their production or rendering. The distinctiveness of these elements is therefore limited in comparison to the further element 'Nordschleife', which dominates the earlier sign (paras 31-36). With regard to the visual and aural comparison, the BoA was right to assume (at least) an average degree of similarity. The signs coincide in their most distinctive element, 'Nordschleife', which is the only element of the CTMA. The fact that the CTMA is fully incorporated in the earlier mark and that this element is the most distinctive element of the earlier mark suffices to conclude an average degree of visual and aural similarity (paras 49-62). Conceptually, the signs share at least a low degree of similarity, due to the identity in the most distinctive element 'Nordschleife', regardless of whether the relevant public associates a special management method with the earlier sign or not (paras 64-70). In light of an average visual/aural degree of similarity, low conceptual similarity, identity and similarity of the goods and services and a normal degree of distinctiveness of the earlier mark as a whole, the BoA was right to conclude a likelihood of confusion (paras 71-78). Based on the foregoing, the action was dismissed. **LOC**

[T-751/14](#); **HIKARI / HIKARI**, Judgment of 11 December 2015, *Hikari Miso Co. Ltd v OHIM* – EN. The BoA annulled the OD's decision, which had found no likelihood of confusion on the basis that earlier Class 29 'rice' and contested Class 29 'Instant or pre-cooked miso soup' and Class 30 'Miso (soya bean paste [condiment])' were dissimilar. The BoA found a low degree of similarity between the goods. The GC upheld the BoA's finding that the goods in question were similar. In doing so, it confirmed that the degree of similarity of the goods is a matter of law that must be assessed *ex officio* by the Office, even if the parties do not comment on it. There are clear links between the goods in question, since they are both food products; they may have the same distribution channels; they may, in some circumstances, be available close to each other in supermarkets, and they both form part of Japanese cuisine — miso and miso soups as Japanese specialities, and rice as a basic element of Japanese cuisine. Those factors constitute a similarity between the goods in question. It should be added, moreover, that those goods are also complementary, since a Japanese meal including miso soup is also likely to include rice (para. 48). The GC stressed that the proof of use of a mark for some categories of goods, on the one hand, and the analysis of the similarities of goods in the context of opposition proceedings, on the other, are two different issues that give rise to different challenges and are based on analysis criteria specific to each issue. It cannot therefore be maintained that the goods in question in the present case are not similar because the use of the earlier CTM for one of those goods was not found to constitute use of that mark for the other (para. 50). **LOC**



[T-526/14](#); *Matratzen Concord / MATRATZEN et al.*, Judgment of 19 November 2015; *Matratzen Concord GmbH v OHIM – DE*. The applicant sought to register the word ‘Matratzen Concord’ as a CTM for goods in Classes 10, 20, 24, 35. The OD partially upheld the opposition on the basis of Article 8(1)(b) CTMR. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The relevant public is the Spanish public at large (para. 24). The nature of the contested goods (inter alia, mattresses) and the earlier sign’s services (retailing of furniture) is dissimilar, as the first are easily exchangeable, while the latter are not. Their purpose is also different, as a service provided within the context of retail services takes place prior to the actual sale of the product as it concerns the activity carried out by the operator with a view to encouraging the conclusion of the sales process of said product. Their use is different, as using a sleeping piece of furniture for sleeping is different from using a sale service for obtaining information before making a purchase. Their channels of distribution can, however, be the same. Likewise, products are necessary, or in any case important, for the provision of the service: it follows that there is complementarity between them. The contested goods are therefore similar to a certain degree to the earlier mark’s services (para. 30-36). Even if the word element ‘Concord’ diminishes the degree of visual and phonetic similarity between the signs, the difference created by this element is a marginal one, taking into consideration the visual and phonetic identity of the only word element of the earlier mark and of the first of the two word elements of the contested mark, to which consumers generally pay more attention. Hence, there is visual and phonetic similarity between the signs taken as a whole (para. 44). The conceptual comparison is irrelevant, as neither mark has any meaning for the relevant public (para. 45). **LOC**

♦ [T-525/14](#); *XKING / X et al.*, Judgment of 8 December 2015; *Compagnie générale des établissements Michelin v OHIM – EN*.

CTMA	Earlier mark
	

The CTM applicant sought to register the figurative mark ‘XKing’ for goods in Class 12 (tyres). The opponent filed an opposition based on, inter alia, the earlier figurative French mark ‘X’, registered for identical and very similar goods in Class 12. The opposition was based on Article 8(1)(b) and Article 8(5) CTMR and directed against all the goods of the CTMA. The OD upheld the opposition and found a likelihood of confusion pursuant to Article 8(1)(b) CTMR. The BoA found the appeal to be well founded, annulled the OD’s decision and rejected the opposition in its entirety. It found the element ‘King’ of the contested CTMA — in this particular context with the letter ‘X’ — to be distinctive and not laudatory, as no such thing as a ‘King/best of X’ exists. The signs were considered visually similar only to a low degree and phonetically similar to a degree below average. As single letters do not convey a concept, the marks were deemed not to present any conceptual similarities. The opponent could not sufficiently prove enhanced distinctiveness, the inherent distinctiveness of the earlier mark was considered low, as single letters are frequently used in the tyre industry to denote characteristics of the goods. In light of the differing stylisations of the letter ‘X’ and the previously mentioned factors, the BoA found no LOC.



Article 8(5) CTMR was discarded, as the evidence could not satisfactorily prove the reputation of the earlier mark. The owner of the earlier mark filed an application to the GC, based on a claimed violation of Article 8(1)(b) CTMR and Article 8(5) CTMR and requested annulment of the BoA's decision. With regard to the distinctiveness of the element 'KING' of the CTMA, the GC stated — contrary to what the BoA had held — that this basic English word would be perceived by the French public as meaning 'king' or 'the best', and thus, as a laudatory term for the goods in question. The fact that 'X' has no meaning will not prevent consumers from perceiving that laudatory message. It follows that, contrary to what was held by the BoA, the word 'king' in the CTMA is weakly distinctive and the letter 'X' will be perceived as the dominant element of the CTMA (paras 32-34). With regard to the visual comparison, the letter 'X' as the dominant element of the CTMA carries more weight than the further element 'KING', although this further element is not negligible. The letters 'X' in both marks are both white and outlined in black and therefore similar. Overall, there is an average, not only low, degree of visual similarity (paras 37-44). Since the marks at issue share the same first syllable, the marks are phonetically similar to an average, not below average, degree. As the earlier mark 'X' has no meaning, a conceptual comparison is not possible (paras 46-51). LOC

◆ [T-583/14](#); **FLAMINAIRE / FLAMINAIRE**, Judgment of 8 December 2015, *Giand Srl v OHIM* – IT. The CTM applicant sought to register the word mark 'FLAMINAIRE' as a CTM for goods in Classes 16 and 34. An opposition based on earlier Spanish word mark 'FLAMINAIRE', registered for goods in Classes 16 and 34, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The GC also confirmed the BoA's finding of similarity between the marks, recalling that the comparison should be made between the signs as registered and not as used (paras 55-58). As for the comparison of the goods, the BoA was right in finding an identity or a similarity between the contested goods and the earlier mark's goods. In particular, the earlier mark's 'lighters and gas recharges for lighters' also target smokers, and not only 'housewives and cooks', as claimed by the CTM applicant: such goods are therefore similar to the contested goods in Class 34 (paras 59-65). It follows that there is a likelihood of confusion between the marks at issue (para. 66). The action was therefore dismissed (para. 70). LOC

[T-262/14](#); **BIONECS / BIONECT**, Judgment of 26 November 2015, *Bionecs GmbH v OHIM / Fidia farmaceutici SpA* – EN. Bionecs GmbH, (applicant before the GC or applicant), filed an application for registration of the word 'BIONECS' as a CTM for, inter alia, the following goods in Class 5: 'pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use; dietary supplements for humans and animals; plasters, materials for dressings'. *Fidia farmaceutici SpA*, (the other party before the GC), filed a notice of opposition to registration of the mark applied for in respect of all the goods and services applied for. The opposition was based on the earlier IR of the word mark 'BIONECT' effective in the Czech Republic, Austria and Poland, designating the following goods in Class 5: 'pharmaceutical preparations used in tissular repair'. The grounds relied on in support of the opposition were those set out in Article 8(1)(b) CTMR. The OD upheld the opposition in respect of all the contested goods. The BoA dismissed the appeal. The applicant filed an action before the GC, alleging infringement of Article 8(1)(b) CTMR. The GC confirmed the existence of a likelihood of confusion between the conflicting marks. The GC found in particular that the relevant public consists of both medical professionals that display a high degree of



attentiveness when prescribing medicines and end consumers. With regard to the latter, it can be assumed that, even where pharmaceutical products are sold without a prescription, the consumers interested in those products are reasonably well informed, observant and circumspect, since those products affect their state of health, and they are less likely to confuse different versions of such products. Therefore, in the present case, the relevant public should be regarded as likely to display a higher than average degree of attentiveness, even with regard to pharmaceutical products that can be purchased without prescription (paras 17-20).

COMPARISON OF THE GOODS: The GC confirmed the finding of the BoA that there is also similarity between 'dietetic food and substances adapted for medical or veterinary use and dietary supplements for humans and animals' covered by the mark applied for, and 'pharmaceutical preparations used in tissular repair' covered by the earlier mark. In that regard, the GC found that the goods covered by the mark applied for, as well as the 'pharmaceutical preparations used in tissular repair', covered by the earlier mark, fall within the field of health, being in general intended to improve health. Moreover, it should also be noted that the ingredients of all those goods are chemical materials and plant extracts. Therefore, the 'dietetic food and substances adapted for medical or veterinary use' and the 'dietary supplements for humans and animals', covered by the mark applied for, and the 'pharmaceutical preparations used in tissular repair', covered by the earlier mark, are similar in the light of the same nature and purpose of those goods and partial identity of their distribution channels, without there being any need to consider whether those goods are complementary (paras 23-33).

COMPARISON OF THE SIGNS: As far as the signs are concerned, the GC found that the element 'bio', which is common to the signs at issue, alludes to life and is often used as a prefix in the names of organic foods. Therefore, it is descriptive of the goods referred to (paras 40-44). However, although the element 'bio' is descriptive, the fact remains that, according to the case law, the weak distinctive character of an element of a mark does not necessarily mean that it will not be taken into consideration by the relevant public. Despite its weak distinctive character, an element of a trade mark that is descriptive is likely to attract the attention of the relevant public because of its length and position at the beginning of those marks. In the case at issue, the common element 'bio' determines, to a significant extent, the overall impression produced by the two signs at issue: that element represents three of the seven letters of the marks at issue; furthermore, it is situated at the beginning of the two signs, the part which is in principle more likely to catch the public's attention. Moreover, the signs at issue have in common the letters 'b', 'i', 'o', 'n', 'e' and 'c' and, in the second part of the signs, which is fully distinctive as regards the goods at issue, three out of four letters, 'n', 'e' and 'c', are identical in both signs. In the light of those considerations, it is necessary to uphold the BoA's finding that there is a high degree of visual similarity between the signs at issue (paras 47-52). Phonetically, the only phonetic difference would be made up of the last letters, respectively 't' and 's'. That phonetic difference is not sufficiently important to alter the overall impression of similarity. Therefore, the signs at issue displayed a high degree of phonetic similarity (paras 57, 58). As regards the conceptual aspect, the GC confirmed that the relevant public interprets the element 'bio' of the signs at issue as referring to life, living beings or biology. On the contrary, it would not understand the element 'nect' as an abbreviation of the English word 'connect'. Given the absence of other identifiable conceptual content in the marks at issue, the descriptive character of that element does not exclude a conceptual similarity between them, contrary to what the applicant claims. It follows that the signs at issue have a certain degree of conceptual similarity (paras 59-66). Since the relevant public does not attribute any meaning to the element 'nect', or to the earlier mark BIONECT, as a whole, and perceives it rather as a fanciful sign, the earlier mark has a normal level of distinctiveness (para. 71). Following the foregoing, the GC held that the BoA did not err in finding that there was a likelihood of confusion between the signs in question. Therefore, the plea alleging infringement of Article 8(1)(b) CTMR was dismissed. **LOC**



[T-356/14](#); *Kerashot / K KERASOL*, Judgment of 16 December 2015, *CareAbout GmbH v OHIM* – EN.

CTMA	Earlier mark
Kerashot	<p style="text-align: center;">K KERASOL</p>

The applicant sought to register the word mark ‘Kerashot’ as a CTM for goods and services within Classes 1, 3 and 21. An opposition based on the earlier figurative national mark represented above, registered for goods in Class 3 corresponding to the following description: ‘hair lotions’ on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA partly upheld the opponent’s appeal and annulled the decision of the OD insofar as the opposition was rejected for the goods concerned in Classes 3 and 21. The applicant filed an action before the GC. The GC ruled that the relevant public for the purposes of assessing the likelihood of confusion is the Spanish general public with a level of attention that is average (para. 26). On the comparison of the goods at issue, the GC stated that they are at the very least, similar, some of those goods being, however, identical or highly similar to the ‘hair lotions’ claimed by the mark applied for (para. 38); regarding the degree of distinctive character and the relative weight of the elements of which the mark is composed, the GC emphasised that the element ‘k’ possesses a weak distinctive character and plays a secondary role in the earlier mark, the dominant element of which is the word ‘kerasol’, which has an average distinctive character. The element to which the consumer would pay the most attention is the element ‘kera’ (paras 39-52). The conceptual comparison between the signs at issue will remain neutral even for consumers who understand English as they do not deconstruct the word ‘kerashot’. The consumers who do not understand the word ‘shot’ will not see, in the sign applied for, any reference to a particular concept, which excludes any possibility of a conceptual similarity between that mark and the mark applied for (paras 56-57). On the phonetic comparison of the signs, the GC concluded that for the category of Spanish consumers who speak English, there is an above average degree of phonetic similarity, for the Spanish consumers who do not speak English, the degree of phonetic similarity will, a fortiori, be even higher (paras 62-63). The degree of visual similarity between the signs at issue will be no more than average for the Spanish consumers with knowledge of English and above average for Spanish consumers who will not understand the word ‘shot’ (paras 65-71). Therefore, the GC confirmed that there was a LOC even as regards those of the goods at issue that are merely similar (para. 81). Although the BoA did not distinguish Spanish consumers who understand English from those who do not understand it, this is not able to lead to annulment of the contested decision, since Spanish consumers who do not speak English are a significant part of the relevant public (para. 82). **LOC**





II. *No likelihood of confusion (NO LOC)*

◆ [T-368/13](#); **ANGIPAX / ANTISTAX**, Judgment of 10 February 2015, *Boehringer Ingelheim International GmbH v OHIM* – FR. The applicant sought to register the word mark ANGIPAX as a CTM for goods within Class 5 (Class heading). An opposition based on the earlier Community word mark ANTISTAX, registered for ‘pharmaceutical products’ in Class 5, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The GC found that, even assuming that the opponent did not present observations on the comparison of the goods before the BoA or even implicitly accepted the similarity of some of the goods, its arguments before the GC are admissible. Those matters were part of the factual and legal framework before the BoA. All of those matters were dealt with by the OD in its decision, in response to the arguments of the parties or of its own motion, since those issues necessarily had to be resolved in order to rule in the opposition proceedings. Accordingly, the BoA necessarily based, or should have based, its decision on all the matters of fact and of law that led to the decision contested before it. Such matters may therefore be debated as to their merits before the GC (paras 49-55). The GC confirmed the BoA’s finding that the degree of attention of the relevant public for all of the goods in Class 5 is higher than average because of their medical nature, including for ‘food for babies’ (paras 31-47). The GC confirmed that the ‘dietetic substances for medical use; disinfectants; plasters and materials for dressings’ and ‘pharmaceutical products’ are similar (para. 60); and that ‘food for babies’ are similar to a low degree to ‘pharmaceutical products’ (para. 61). Visually, despite some undeniable similarities, the use of the different letters and the structure of the words allow one to consider that there are differences between the signs (para. 69). Phonetically, none of the parties nor the BoA divided the earlier mark into the syllables ‘an’, ‘tis’, ‘tax’, which would be the traditional way of breaking down words into syllables, which emphasises that in the public’s mind the earlier mark is composed of two elements, namely ‘anti’ and ‘stax’ (para. 72). Despite the identity in the first syllable of the signs ‘an’ and the last two letters ‘ax’, the signs are not highly similar (para. 72). The second and third syllables are phonetically different (para. 74). The BoA found that conceptually none of the signs had a clear meaning and then analysed the signs by dividing them in accordance with the case law (para. 81). It correctly found that ‘anti’ refers to the notion of ‘against’ (para. 83). The element ‘angi’ may be perceived by some consumers as the abbreviation for angina and ‘pax’ as a reference to peace, so that the public may consider that the product is aimed at calming angina (para. 84). In dividing the signs, it cannot be concluded to the existence of a conceptual similarity (para. 85). The BoA only referred to well-known facts in the pharmaceutical sector, in which the GC already found that it is not unusual for producers to refer to chemical or molecular compounds in order to emphasise the alleged effectiveness of a pharmaceutical product that is for sale (para. 91). Even though the signs have some elements in common, they are not sufficient to conclude a global similarity, taking into account the higher than average degree of attention of the public (para. 94). Even if the degree of attention of the public were considered normal, given the degree of similarity of the signs, it can be excluded that the public would attribute the same commercial origin to the products bearing the signs in conflict (para. 95). **NO LOC**



◆ [T-76/13](#); **QUARTODIMIGLIO et al / LONGINES et al**, Judgment of 12 February 2015, *Compagnie des montres Longines, Francillon SA, Staccata Srl, v OHIM* – EN.

CTMA	Earlier marks
	




The intervener sought to register the figurative sign represented above as a CTM for Classes 9, 14. An opposition based on several international figurative registrations for goods in Classes 9 and 14 was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The opposition was directed against all the goods of the CTM. The OD rejected the opposition based on the ground that there was no likelihood of confusion. The BoA confirmed the OD's decision. It concluded that there was no likelihood of confusion between the signs, even for identical goods. On the relevant public and the level of attention, having regard to the broad descriptions of the categories of goods in Classes 9 and 14, which are referred to in the trade mark application and are identical to the goods on which the opposition is based and that those categories mostly include goods that may be purchased by anyone, that is to say, even by consumers who are members of the general public, the GC held that even as regards a number of categories of goods which are aimed, more specifically, at certain professionals or at a scientific public, it cannot, in principle, be ruled out that those categories include goods purchased by the general public. However, that general consideration cannot be applied to categories of goods such as '... surveying, ... signalling, checking (supervision), ... apparatus and instruments', 'apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity' or 'automatic vending machines and mechanisms for coin-operated apparatus; cash registers' in, inter alia, Class 9. The goods in those categories are generally, if not exclusively, purchased by a public that consists of professionals or by scientists. In relation to goods purchased by those professionals and scientists, it must be held that the level of attention will be high, on account of the technical nature and the cost of those goods. As regards the other goods, which are purchased by consumers who are members of the general public, it has already been held that, if they are goods which are not purchased regularly and are generally bought through a salesperson, the average consumer's level of attention must be taken to be higher than usual, and therefore fairly high (see, to that effect, judgment of 12/01/ 2006 in *Devinlec v OHIM — TIME ART (QUANTUM)*, T- 147/03, EU:T:2006:10, para. 63). The fact remains that that is not true of all the relevant goods in the present case, since certain horology goods, chronometric instruments, items of costume jewellery or calculating machines may be purchased without consumers even paying particular attention to them, in particular when they are 'inexpensive' goods. Consequently, the GC concluded that the BoA could not reasonably restrict the relevant public solely to the general public which generally has a level of attention that is 'higher than usual and therefore fairly high'. On the visual comparison of signs, first, it cannot be held that the graphic element, consisting of extended wings, is dominant either in the mark applied for or in the earlier composite marks. In the former case, it is necessary to point out the particularly significant impact of the letters 'q' and 'm', which are situated in the middle of the mark applied for, and the fact that the word 'quartodimiglio' is situated at the top of that mark and has the same breadth




as the mark. In the latter case, in both of the earlier composite marks, the word 'longines' is also situated at the top of the marks and is written in sufficiently broad and easily legible characters to be capable of being easily remembered by the relevant consumers. Although it is true that in the earlier international registration No 298 063, the element consisting of a 'winged hourglass' covers a larger part of that mark than the word 'longines', it must, however, be stated, first, that that word is still easily legible and memorisable and, secondly, that the enlarged graphic element enables consumers to perceive clearly the representation of an hourglass, which also facilitates the differentiation of that mark from the mark applied for (para. 49). Secondly, the GC took the view that the BoA was right to carry out a meticulous comparison of the representations of the wings in the mark applied for and in the earlier marks and to find that there was a significant difference in the forms of stylisation of those wings (para. 51). Thirdly, added to those differences is the presence of the word 'quartodimiglio' in the mark applied for, a word which, as the BoA rightly stated, is also perceived by consumers and distinguishes that mark even more both from the purely figurative earlier marks, which do not contain any word elements, and from the composite earlier marks, in which it is a different word, namely 'longines', which will be remembered by consumers (para. 52). Therefore there is a very low degree of visual similarity between the marks at issue (para. 54). In relation to the conceptual comparison, the GC concluded that it cannot be held that there is a high degree of conceptual similarity between the marks due to the fact that all the marks at issue contain representations of wings. Confirming the findings of the BoA, in particular in paragraph 26 of the contested decision, even though there is a certain semantic analogy between the mark applied for and the earlier marks, it is only to a low degree, since the stylisations of the wings refer to different types of birds. Moreover, the conceptual differences between the marks at issue are marked for the consumers who perceive and pay attention to the hourglass in the earlier marks and for Italian-speaking consumers, for whom the word 'quartodimiglio' in the mark applied for will have a meaning. The BoA erred in finding, in the contested decision, that the signs do not share a conceptual similarity (para. 54). On the enhanced distinctiveness, the GC found that the applicant has not put forward any evidence or argument capable of substantiating the conclusion that the earlier marks have a high degree of inherent distinctiveness. In those circumstances, it is necessary to take into account a normal degree of inherent distinctiveness, inasmuch as it is not, moreover, apparent from the analysis of those marks that there are specific reasons for taking the view that the degree of inherent distinctiveness is low, for example as a result of the presence of elements which are descriptive of the goods at issue. Even though the BoA certainly found that the earlier composite mark containing the word 'longines', in addition to the graphic element, and corresponding to IR No 610 902, was highly distinctive because of the recognition of that mark on the market, the BoA, by contrast, also rightly found, in view of the evidence provided by the applicant, that the earlier marks that consisted solely of the representation of a 'winged hourglass' did not have such a high degree of distinctiveness. The applicant cannot therefore invoke the enhanced distinctiveness of its earlier marks which do not include the word 'longines' (para. 62). As regards the likelihood of confusion or association, the GC held, in the light of an overall assessment of the visual and phonetic differences between the marks under comparison, that the BoA was right to rule out, irrespective of a certain conceptual similarity, any likelihood of confusion or association, even where the goods are identical (para. 76). **NO LOC**



◆ [T-543/13](#); **PRANAYUR / AYUR** et al., Judgment of 5 March 2015, *Three-N-Products & Munindra Holding v OHIM* - EN.

CTMA	Earlier marks
PRANAYUR	<p>AYUR</p>   



The CTM application for the word mark 'PRANAYUR' was filed for products in Classes 5 and 30. An opposition based on the earlier CTMs shown above for goods in Classes 5 and 30 was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition and the opponent filed an appeal. The BoA dismissed the appeal. On the earlier word mark 'AYUR', the GC took note that this word mark was cancelled by the Office and that that cancellation was confirmed by the GC in its judgment (*AYUR*, EU:T:2013:583, para. 11) and, on appeal, by the CJ in its order in *Three-N-Products v OHIM*, (C-22/14 P, EU:C:2014:2078, para 11). Accordingly, the GC held that there is no longer any need to adjudicate on the

plea in law concerning the risk of confusion with that mark. On the earlier figurative sign , the GC confirmed the BoA's assessment that despite the existence of a common word element in the marks at issue, the presence of another word element which is at least equally important as that common element, the different lengths of the signs and the difference in the initial letters and the presence in the earlier figurative mark of additional figurative elements gives rise to an overall visual impression of the marks at issue that is different (para. 34). Phonetically, the GC held that the BoA was right to find a low degree of phonetic similarity between the marks at issue, because only the last syllable of the two signs is identical. The presence of an additional word element at the beginning of the sign applied for can also only help to differentiate the marks at issue phonetically (para. 35). On the conceptual similarity, the GC referred to the cases in which the GC has already had occasion to point out that the relevant public will not easily make the connection between the element 'ayur' and the word 'ayurveda' designating a form of traditional Hindu medicine (judgment in T-313/10, *Ayuuri Natural*, EU:T:2011:653, para. 47) and that, although a conceptual comparison could be made by a part of the relevant public, made up of those most specialised in matters of alternative medicine, no conceptual comparison appears possible for the general public (see, to that effect, T-313/10, *Ayuuri Natural*, EU:T:2011:653, para 53) (para. 36). The conclusion of the GC is that the two marks are fanciful terms, not referring to any concept known by the most significant part of the relevant public. Therefore the BoA was correct to conclude that it was impossible to make a conceptual comparison (para. 37). On the overall assessment, the GC concluded that the signs are different visually, slightly similar phonetically and no conceptual comparison is possible between them. The elements of differentiation outweigh the common word element 'ayur' to such an extent that the overall impression of the two marks is different and therefore the signs are different. As one of the cumulative conditions required by the case law is not satisfied, the GC held that without there being any need to rule on the distinctive character of the earlier mark, it must be concluded that, despite the partial



identity of the goods at issue, there is no likelihood of confusion between the figurative mark 'Ayur' and the mark applied for (paras 38 -39). Finally, on the other earlier figurative signs the GC concluded that this second plea in law must be declared inadmissible under Article 44(1)(c) RPGC, since the applicant does not present any legal analysis regarding the existence of a likelihood of confusion with those other marks. Accordingly it rejected the second plea in law, and the action in its entirety as no infringement of Article 8(1)(b) CTMR has been established. **NO LOC**

[T-372/12](#); *APRO / B-PRO et al.*, Judgment of 4 February 2015, *El Corte Inglés, SA v OHIM* – EN.

CTMA	Earlier mark/sign
	 PRO MOUNTAIN PRO OUTDOOR

The applicant sought to register the figurative mark represented above as a CTM for goods in Class 12. An opposition based on the earlier figurative and word marks and applications represented above, registered for goods in Class 12 was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA dismissed the applicant's appeal, finding that in the view of the low degree of visual and phonetic similarity between the signs and the higher than average level of attention of the relevant public, there is no likelihood of confusion. The applicant filed an appeal before the GC. **COMPARISON WITH THE EARLIER MARK 'B-PRO BY BOOMERANG'**: Visually, in the context of the overall impression created by the earlier Spanish mark, the word element 'by Boomerang' cannot be regarded as negligible. It is still of a size that enables the relevant public to decipher and read it easily, particularly as the relevant public's level of attention will be higher than average. The assessment of the similarity of the signs at issue cannot be made solely on the basis of the dominant element 'b-pro' (para. 33). The insertion of a hyphen is an important difference, given that B-PRO is a short sign. The shorter the sign is, the more easily the public will be able to perceive each of its different components. The presence of the element 'by Boomerang' in the earlier mark will be perceived by the relevant public as an additional element of dissimilarity between the signs at issue (para. 34). Phonetically, the first syllables will be pronounced differently and the differences between the signs at issue will be accentuated by the presence of the element 'by Boomerang' in the earlier Spanish mark (para. 36). Conceptually, only the earlier Spanish mark could be associated with the concept of 'advantage, benefit; in favour of' and with the concept of 'professional'. Additionally, the element 'by Boomerang' is likely to accentuate the conceptual difference between the signs at issue, since the relevant public will perceive that element as an indication of the origin of the goods at issue (para. 38). The BoA was entitled to examine the conceptual implications that the relevant public might infer from the component 'pro' of the element 'b-pro' because the presence of the hyphen confirms that the element is composed of two separate components (para. 39). The GC found therefore a low degree of similarity and confirmed the BoA's decision that no likelihood of confusion exists between the signs (paras 41 and 45). **Comparison with 'PRO MOUNTAIN' and 'PRO OUTDOOR'**: The same conclusion was held in the case of the other earlier marks where the GC found either weak or very weak similarity because of the considerable differences between the signs owing to the presence of the elements 'mountain' and 'outdoor' (para. 49). **NO LOC**



[T-195/13](#) **CAMEA / BALEA**, Judgment of 14 January 2015; *dm drogerie markt GmbH & Co. KG v OHIM*, – HU. The applicant sought to register the word mark ‘CAMEA’ as a CTM for goods in Classes 3, 5 and 16. An opposition based on the earlier word mark ‘BALEA’, registered for goods in Classes 3, 5 and 8, was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA dismissed the opponent’s appeal and confirmed the OD’s decision. The opponent filed an action before the GC. It alleges an infringement of Article 8(1)(b) CTMR and the highly distinctive character of the earlier mark. The relevant consumer is the average consumer (not disputed). The opponent argues that all of the goods at issue in Class 3 are identical. The GC rejected this argument because the global assessment of the likelihood of confusion was not based on the differences between the goods in conflict (para. 24). The GC emphasised that the marks are visually not similar, considered in their entirety. The differences are also very noticeable phonetically, there is only a low degree of phonetic similarity. The signs may be perceived as meaningless, or they are conceptually different, there is a lack of conceptual similarity. The signs at issue are globally dissimilar. There is no likelihood of confusion. Likelihood of confusion presupposes that the signs are identical or similar. This conclusion cannot be affected by the fact that the earlier mark has a highly distinctive character. The identity or similarity between the marks at issue is not met in the present case and the reputation of the earlier mark cannot invalidate this finding. **NO LOC**

◆ [T-558/13](#); **FSA K-FORCE / FORCE-X**, Judgment of 4 March 2015, *FSA Srl v OHIM* – EN. The applicant registered the word mark ‘FSA K-FORCE’ as a CTM for goods within Classes 9 and 12. An application for a declaration of invalidity based on the earlier word mark ‘FORCE-X’, registered for goods in Classes 9 and 12, was filed on the grounds of Article 8(1)(b) CTMR. The CD declared the registration of the CTM invalid. The BoA dismissed the CTM proprietor’s appeal finding that there exists a likelihood of confusion between the two marks, since the goods covered by them were identical and the signs were similar to a low degree visually, and to a certain degree phonetically as well as conceptually, for the part of the public understanding the meaning of the word ‘force’. The CTM proprietor filed an action before the GC. Firstly, the GC stated that the attention of the relevant public in respect of bicycle helmets must be classified as higher than average, since the product at issue concerns consumer safety (para. 26). As regards the goods in Class 12, the relevant public, whether professional or the final consumer, will pay particular interest to the choice of a bicycle or its spare parts and accessories used in its assembly, owing to the technical and aesthetic characteristics of those goods, therefore the level of attention must also be considered to be higher (para. 27). As regards the similarity of the signs, the GC pointed out that the word ‘force’ can describe one of the characteristics of the goods concerned and for some of the goods in Class 12 it may also designate one of their purposes (para. 38). Even though the word ‘force’ has a weak distinctive character, it cannot be disregarded completely for the purposes of the comparison of the signs at issue (para. 42). Visually, the marks at issue have the element ‘force’ in common. The other elements, namely ‘fsa-k’ for the contested mark and ‘x’ for the earlier mark, are different. The element ‘force’, however, has a weak distinctive character in respect of the goods concerned. Consequently, it must be held that the marks at issue give a different overall impression (para. 46). Phonetically, the pronunciation of the marks differs in length and the word ‘force’ has a weak distinctive character for the goods concerned, therefore the marks at issue must be held to be phonetically similar to a low degree (para. 49). The conceptual similarity of the marks for a not inconsiderable part of the relevant public, resides in the element with a weak distinctive character. Consequently, the conceptual similarity of the marks at issue must be characterised as low (para. 52). Since (i) the relevant public’s level of attention in the present case is higher than average, and (ii) the word ‘force’, due to its descriptive character and its banality, inter alia, on the European market, has a weak distinctive character in respect of the goods




concerned, the marks at issue, taken as a whole, have only a low degree of similarity (para. 55). Consequently, despite the identity of the goods covered by the marks at issue, there is no likelihood of confusion between those marks (para. 56). **NO LOC**

[T-665/13](#); **SPIN BINGO / ZITRO SPIN BINGO**; Judgment of 29 January 2015, *Zitro IP Sàrl v OHIM* – EN.

CTMA	Earlier mark
	<p>ZITRO SPIN BINGO</p>

An application for a figurative mark in Classes 9, 41 and 42 was filed. An opposition pursuant to Article 8(1)(b) CTMR was filed based on an earlier word mark for goods in Classes 9, 28 and 41. The OD partially upheld the opposition for all the identical or similar goods. The BoA annulled that decision and rejected the opposition in its entirety. It found a low degree of visual, aural and conceptual similarity between the signs, despite the fact that they contain the expression ‘spin bingo’, descriptive of an essential characteristic of the goods and services. The GC confirms the descriptive character of the expression ‘SPIN BINGO’ (paras 31-33). The public is often confronted with terms, expressions or acronyms regarded as descriptive even if their exact meaning is not grasped (HTML, Wi-Fi, ISDN... and also SPIN). They will not be perceived as an indication of commercial origin of the goods and services (para. 38). The action is dismissed. **NO LOC**

◆◆[T-581/13](#); **POLO CLUB / BEVERLY HILLS POLO CLUB**, Judgment of 26 March 2015, *The Royal County of Berkshire Polo Club Ltd. v OHIM* -EN.

CTMA	Earlier marks
	

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



merits of the case, the GC confirmed that the level of attention of the relevant public is normal (para. 35) and that the goods covered by the marks at issue and falling within Classes 9, 14, 18 and 25 are identical (para. 37). The BoA's finding relating to the enhanced inherent distinctiveness of the image of a polo player and the words 'polo club' cannot be upheld in its entirety: in that respect, the GC held that that image and those words have (i) weak inherent distinctiveness in relation to 'whips, harness and saddlery' in Class 18, given their close connection to the playing of polo; (ii) normal inherent distinctiveness in relation to 'articles of clothing, footwear and headgear' in Class 25, given that they can be used for polo playing, although there is nothing in their description to the effect that they relate to goods specifically designed for that purpose; (iii) inherent distinctiveness that is more enhanced, and at the very least normal, in relation to the other goods in Classes 9, 14 and to 'leather goods; imitation leather goods; trunks, travel bags, umbrellas, Parasols, walking sticks' in Class 18, given that they have no connection with the playing of polo (para. 49). As to the comparison of the signs, the GC upheld the BoA's conclusion that there is some visual similarity between the signs, finding that they both display the figure of a polo player astride a galloping horse and that the images of the polo player occupy a central position in each of the signs (paras 54-55). The aural similarity is relatively low, and the signs have a high degree of conceptual similarity, insofar as each refers to a polo club and displays a device of a polo player, and those devices are similar (paras 53-68). However, given that when assessing the similarity of signs, account must be taken of their distinctive and dominant components, the overall similarity of the signs is lower where the marks are used in relation to 'whips, harness, saddlery' in Class 18 (para. 73). With regard to 'whips, harness and saddlery' in Class 18, the similarity between the signs at issue is reduced significantly by the fact that their common elements have low inherent distinctiveness in relation to those goods, and the earlier marks must be regarded as having low inherent distinctiveness in relation to those goods (paras 82-83). Since these goods are more likely to be purchased by the relevant public with the help of a specialised seller to whom the purchaser may speak, with the result that the aural similarity of the signs, which in the present case is relatively weak, will gain in importance, there is no likelihood of confusion in relation to 'whips, harness, and saddlery' (paras 84-85). **NO LOC**

◆ [T-608/13](#); *easyAir-tours / airtours Ticket Factory*, Judgment of 13 May 2015, *easyGroup IP Licensing Ltd, & Tui AG v OHIM* – EN.


CTMA	Earlier marks
	

The applicant sought to register the figurative sign 'easyAir-tours' represented above as a CTM for Classes 16, 36, 39 and 43. An opposition based on several German, international and CTM marks



represented above, covering services in Classes 35, 36, 38, 39, 41, 42 and 43 was filed on the grounds of Article 8(1)(b) CTMR. The CTM applicant requested that the opponent file proof of use of those earlier marks, which was done. The 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 products in Class 16 and certain services in Classes 36, 39 and 43. The BoA dismissed the appeal. As regards the earlier marks, it took the view that it was ‘appropriate’, for reasons of procedural economy, to examine the question of a likelihood of confusion on the basis of the earlier German mark referred to as ‘airtours Ticket Factory’, as that mark was ‘the strongest’ earlier mark and was not ‘liable to proof of use’. Contrary to the contested decision, the GC held that the overall impression that each of them conveys to the relevant public is different. The average, or even rather low, degree of phonetic similarity and the low, or even very low, degree of conceptual similarity between them are offset and cancelled out by the overall impression of visual dissimilarity established, particularly because the marks at issue are both figurative and not word marks. In that regard, the GC echoed the applicant’s claim that the earlier mark is a figurative mark and, therefore should not enjoy the same scope of protection as a mark that consists only of the word ‘airtours’. Whereas a word mark usually covers any type of representation, a figurative mark by definition includes a specific representation, which, unless it is totally negligible, must, even if it is dominated by a word element, nevertheless be taken into account in the overall assessment of the similarity between the signs, with the result that such a figurative mark cannot, in principle, be given a scope of protection that is strictly identical to that of a word mark that consists only of its dominant word element (para. 61). The figurative nature of the two marks at issue — which have in common only one word element, which is, moreover, not dominant in one of them, whereas their figurative elements are completely different — thus tends to reinforce the finding that they are dissimilar (para. 63). Since the signs at issue are, considered as a whole, dissimilar in the overall impressions that they convey to the relevant public, the GC held that the BoA erred in finding that they were similar (para. 64). The GC concluded that since the signs are, considered as a whole, dissimilar in the overall impressions that they convey to the relevant public, it may be deduced from that lack of similarity between the signs that any likelihood of confusion between the marks at issue is precluded, without it being necessary first to apply the principle of interdependence and, in particular, to examine any highly distinctive character of the earlier mark in the course of a global assessment of the likelihood of confusion (para. 66). **NO LOC**

◆ [T-55/13](#); F1H2O / F1 et al., Judgment of 21 May 2015, *Formula One Licensing BV v OHIM & Idea Marketing SA* – EN.



CTMA	Earlier marks
F1H2O	F1 

The applicant sought to register the word mark ‘F1H2O’ as a CTM for goods and services within Classes 9, 25, 38 and 41. An opposition based on earlier registrations (at national, international and Community level) concerning the word mark ‘F1’ (‘the earlier word mark’) and the figurative marks



represented above ('the earlier figurative marks'), registered for goods in the same classes, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD rejected the opposition. The BoA dismissed the CTM applicant's appeal. The applicant filed an action before the GC, alleging two main pleas in law: infringement of Article 8(1)(b) CTMR and infringement of Article 8 (5) CTMR. The GC confirmed the decision of the BoA. First of all, it rejected the first plea in law as unfounded. The GC stated that the BoA had correctly defined the relevant public (paras 31-32) and noted that the BoA's finding as to the identity of the goods and services was not disputed by the parties (para. 33). As to the comparison of the word signs, the GC confirmed the BoA's finding. On the visual comparison, the relevant public would not split the mark applied for into two distinct elements: the length of the mark applied for and the equal position that the elements 'F1' and 'H2O' occupy in that mark imply a weak visual similarity between the marks at issue (paras 35-39). On the phonetic comparison, the GC confirmed that there was a weak similarity: the fact that the beginning of the mark applied for is pronounced in the same way as the earlier word marks is not sufficient to offset the difference in length and the composition of the marks at issue (para. 40). On the conceptual comparison, the GC endorsed the BoA's finding that the signs were conceptually different. The mark applied for has no clear meaning, but it will be perceived either as a sequence of letters and figures or as a chemical formula: the fact that the mark applied for contains the well-known chemical formula for water ('H2O') strengthens this conclusion. Moreover, contrary to the applicant's argument, this is not contradictory, since the fact that consumers recognise the chemical formula for water does not prevent them from perceiving the mark applied for as a chemical formula of which water forms part (paras 41-44). Moreover, the GC found that the BoA was correct in analysing the evidence and finding that the earlier word marks enjoyed neither a reputation, nor an enhanced distinctiveness, but had a weak level of distinctiveness: in the case at issue, F1 does not play a 'predominant or even significant' role (paras 45-47). The GC therefore confirmed the BoA's findings that there was no likelihood of confusion (paras 48-51). As to the comparison with the earlier figurative signs, the GC found that there are no visual and conceptual similarities, but only a weak phonetic similarity and concluded that there was no likelihood of confusion (paras 52-57). **NO LOC**

[T-56/14](#); *nuru / DURU*, Judgment of 21 May 2015; *Evyap Tag Gliserin Sanayi ve Ticaret A.S. v OHIM – EN*.


CTMA	Earlier mark
	

The applicant registered the figurative mark 'nuru' represented above as a CTM for goods and services within Class 3. An opposition based on the earlier figurative mark 'DURU' registered for goods in Class 3, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition in its entirety. The applicant filed an appeal before the BoA, which dismissed the request of the applicant for a limitation of the goods and dismissed the action. The BoA held that the marks at issue viewed as a whole were dissimilar. The applicant filed an action before the GC relying on a single plea in law. In its single plea in law, the applicant raised two complaints, the first alleging that the BoA exceeded its discretion and the second alleging an error of assessment of the likelihood of confusion between the marks at issue (para. 15). With regard to the first complaint, the applicant claims that the BoA exceeded its discretion by



considering that the mark applied for was a figurative mark and not the mark 'nuru' in stylised letters (para. 17). The GC rejected this argument stating that, where it determines the relevant public's perception of the mark applied for, the BoA is by no means bound by the explanations given by the parties. It further noted that it is for the BoA to make its own interpretation of the marks at issue (para. 21). With regard to the second complaint, when assessing likelihood of confusion the applicant claimed that the BoA erred in finding that the mark applied for '[was] composed as a wiggly line divided into four stylised elements', which would not be perceived by the public as the sequence of letters 'n-u-r-u' written in a stylised font. Instead, the applicant claims that it should have taken into account that the mark applied for would be perceived by the relevant public as a stylised version of the letters 'n', 'u', 'r' and 'u' (para. 24). The GC found that in view of the goods concerned and for the mark applied for, the relevant public's attention cannot be regarded as low, even when the goods are for mass consumption (para. 32). With respect to the visual comparison of the signs, the GC found that the BoA correctly found that the mark applied for would be generally perceived as a whole as a mark composed of four figurative elements devoid of meaning, as well as a figure forming a wiggly line and not as a sequence of letters forming a word (para. 35). Moreover, the earlier marks are composed of a single word 'duru', which is not divided into several elements (para. 37). Furthermore, it was held that the marks at issue present similarities in the sense that the second and last figurative elements of the mark applied for resemble the letter 'u' present in the earlier marks. However, those similarities cannot offset the overall visual differences in the conflicting marks (para. 38). In this light, the GC found that the marks have a low degree of visual similarity, even in a situation where the relevant public would perceive the mark applied for as a sequence of letters (para. 39). As regards the aural comparison of the marks, the GC found that for the part of the relevant public that will seek to interpret the mark applied for, there will be some similarity with the earlier mark (para. 40). It was found that the signs have a low degree of aural similarity (para. 41). With regard to the conceptual comparison, the GC found that there was no evidence filed that could call into question the BoA's conclusion that the mark applied for is devoid of meaning for the relevant public which would perceive it as being composed of several figurative elements. Therefore, owing to the lack of meaning of the marks in conflict, a conceptual comparison of the marks is not possible (para. 42). In this light, the GC found that the BoA's assessment of likelihood of confusion between the signs at issue should be examined (para. 43). The GC pointed out that the goods at issue are sold over the counter in supermarkets and customers can choose themselves, which leads to the choice of the products in question being made visually. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion. The GC concluded that the BoA was right in finding that there was no likelihood of confusion, even if the goods at issue were identical (para. 47). **NO LOC**

[T-662/13](#); *M / dm*, Judgment of 25 June 2015, *dm-drogerie markt GmbH & Co. KG v OHIM* – EN.

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

The applicant sought to register the figurative sign represented above as a CTM for goods within Class 14. An opposition based on the earlier word mark 'dm', registered for goods inter alia in Class 14,




was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal, finding that the mark applied for would most probably be perceived as representing a highly stylised capital letter 'M', whereas the earlier mark consisted of the combination of the letters 'd' and 'm' without any stylisation, and that there were no visual, phonetic and conceptual similarities between the marks at issue and thus NO LOC. The opponent filed an action before the GC. The goods are aimed both at professionals and at general public in the EU. The level of attention is either rather high, as the goods in question tend generally to be expensive, or, where the goods are produced and sold in rather cheap variations, average, since such goods are purchased to embellish the appearance of the human body (paras 18-21). As regards the comparison of the signs, the parties agree on the fact that the mark applied for may be perceived as at least including a stylised representation of an upper case letter 'M'. The GC confirmed that the relevant public will not perceive the contested mark as a stylised representation of the upper case letters 'D' and 'M', in which the first of those letters is interlinked with the second (paras 34-38). Inter alia, the opponent cannot claim that the mark applied for will be perceived by the relevant public as consisting of the letters 'd' and 'm' on the ground that those letters represent the initials of the trade name 'Diseños Mireia'. That claim is based primarily on the premise that the relevant public will associate that mark directly with that trade name. However, this premise was not in any way substantiated, in particular by showing that that mark and that trade name are widely known (para. 39). Also, the opponent cannot argue that the applicant uses its mark together with a reference to its trade name, since the comparison must be based on the contested sign as registered or as it appears in the application for registration (para. 40). Visually, the very specific graphic form of the contested mark has the effect of counteracting to a large extent the point of similarity relating to the fact that that contested mark may be understood as a reference to the letter 'm' written as an upper case letter, which is one of the two letters of which the earlier mark consists. Therefore the marks are visually dissimilar (para. 46). Phonetically, on account of the very specific graphic form of the contested mark, the relevant public will tend to describe it and not to pronounce it, therefore the marks are phonetically dissimilar (para. 47). As regards the distinctive character of the earlier mark, the GC confirmed that having found that there was no similarity between the marks at issue, the BoA could rightly conclude that there was no likelihood of confusion, irrespective of the alleged enhanced distinctive character of the earlier mark (para. 54). In any event, the opponent's claim regarding the enhanced distinctiveness was not substantiated by any evidence, since it cannot be deduced merely from the fact that a mark has a certain reputation in respect of retail services that that reputation extends automatically to all goods sold under that mark (para. 56). The GC confirmed that there cannot be held to be any likelihood of confusion in the present case, regardless of the degree of distinctive character of the earlier mark and regardless of the identity or similarity of the goods at issue (para. 61). **NO LOC**

[T-169/14](#); **Koragel / Choragon**, Judgment of 13 May 2015; *Ferring BV v OHIM* – EN. The BoA confirmed the rejection of the opposition against the CTM application 'Koragel' for goods in Class 5, which was based on the earlier CTM 'Choragon', registered for 'pharmaceutical products and substances'. The BoA held that the goods designated by the mark applied for were identical to the 'pharmaceutical products and substances' protected by the earlier mark as regards the 'pharmaceutical preparations' and similar to them as regards the 'veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical use, plasters, materials for dressings, disinfectants and also material for stopping teeth and dental wax'. In contrast, it ruled out any similarity with the goods designated by the earlier mark as regards 'preparations for destroying vermin, fungicides and herbicides', on the one hand, and 'food for babies', on the other. As regards the comparison of the marks, the BoA found them visually similar to a low degree, and phonetically to a higher degree. It ruled out the conceptual comparison. The



opponent filed an action raising a single plea in law, an infringement of Article 8(1)(b) CTMR. The GC confirmed the finding that there is no likelihood of confusion and dismissed the action. According to settled case law, for a CTM not to be registered, it suffices that a relative ground for refusal for the purposes of Article 8(1)(b) CTMR exists only in part of the territory considered (para. 28). In the present case, therefore, the merits of the applicant's single plea should be examined particularly with regard to German-speaking consumers, since the applicant claims that there is a likelihood of confusion 'at least' in the minds of those consumers and concentrates its arguments on that part of the relevant public (para. 29). The level of attention of the relevant public for all the goods at issue will be at least above the average, as they are 'pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides' (para. 40). The applicant does not dispute the BoA's findings concerning the similarity with the goods designated by the earlier mark of goods other than 'preparations for destroying vermin, fungicides and herbicides and food for babies'. Unlike 'herbicides, preparations for destroying vermin and fungicides', they cover a large spectrum of goods that is not restricted to goods intended for the protection of plants. Thus, in the light of the intended purpose of part of the 'preparations for destroying vermin', their complementary nature in relation to 'pharmaceutical or veterinary preparations' and their distribution channels, it must be held that there is a low degree of similarity of that category with the goods covered by the earlier mark (para. 51). For similar reasons, it must be held that there is a low degree of similarity between 'fungicides' and the goods covered by the earlier mark (para. 54). In the light of a certain connection between some 'foods for babies and pharmaceutical products and substances' in respect of their intended purpose, their method of use and their distribution channels, it must be held that there is a low degree of similarity between those goods (para. 58). The visual similarity is low and the aural similarity is above average for the German-speaking public. The conceptual comparison is not possible (paras 64, 66 and 69). The specific features of the conditions for the marketing of the goods at issue do not justify giving more importance in the present case to the aural comparison than to the visual comparison (paras 79 et seq.). **NO LOC**

[T-197/14; GREEN'S / AMBAR GREEN](#), Judgment of 21 May 2015, *La Zaragozana, S.A. v OHIM* – EN.

CTMA	Earlier mark
	<p style="text-align: center;">AMBAR GREEN</p>

The applicant filed an opposition against the registration of the CTM application 'GREEN'S' (fig.) filed for a list of goods in Class 32 and the existence of likelihood of confusion. It was based on the Spanish trade mark registration 'AMBAR GREEN' for goods also in Class 32. The OD upheld the opposition for all the contested goods. The applicant filed an appeal and the BoA annulled the OD's decision. It found that the signs were visually similar to a below average degree and phonetically slightly similar. Conceptually, it considered that the relevant Spanish consumer would associate the term 'GREEN' with the notion of organic and environmental friendly, and consequently, would see this element as descriptive and the earlier mark as an ecological line of 'AMBAR beers'. The element 'GREEN'S' would be identified by this public as denoting possession from someone called 'GREEN' due to the intensive use of the possessive



form (an apostrophe followed by the letter 's') in trade. The relevant public is composed of average consumers from the general public who are reasonably observant with a level of attention from normal to low. The GC endorses the definition of the relevant public by the BoA (paras 32-33). The goods in dispute are identical. Signs: with complex trade marks, the figurative part might occupy an equivalent position to the verbal part (para. 31). Highly similar verbal elements do not necessarily imply visual similarity because the specific manner of a figurative part can affect the overall impression so as to render them different (para. 32). The signs are visually similar to a low degree. The phonetic differences are located at the initial part of the signs, the one on which consumers tend to focus. The signs have a different number of syllables, their rhythm and intonation differ (para. 38) and present only a low degree of phonetic similarity. Conceptually, 'GREEN' is used in the current language of the food market in order to denote organic products (para. 42). The use by the applicant of the house mark 'AMBAR' with other signs supports the notion that consumer would identify 'AMBAR' as the principal element and 'GREEN' as indicating a type of beer (paras 44-45 and 55). GREEN'S would not be identified by part of the Spanish public as denoting possession; some people have very little knowledge of English (para. 47). However, it is likely that average consumers see this element as having an Anglo-Saxon origin without any meaning but the figurative part conveys the idea of a traditional public house. It is unlikely that the Spanish public would attribute the same organic meaning to the application (para. 48). Consequently, the signs are not conceptually similar. Conceptual differences might counteract visual and phonetic similarities when at least one of the signs has a clear meaning. In view of the differences located in the initial part and the different ideas conveyed by the signs, a likelihood of confusion is safely excluded even when applied to identical goods. **NO LOC**

◆ [T-420/14](#); **Wine in Black / NOVAL BLACK**, Judgment of 21 May 2015, *Wine in Black GmbH v OHIM – EN*. The applicant sought to register the word mark 'Wine in Black' as a CTM for 'alcoholic beverages, (except beers), in particular: wines, brandy'. An opposition based on the earlier CTM 'NOVAL BLACK', registered for 'alcoholic beverages, (except beers)' was filed on the grounds of Article 8(1)(b) CTMR. The OD accepted the opposition in its entirety. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The relevant public consists of average European consumers who are English-speaking or who are deemed to have an elementary knowledge of English, with a reasonable level of attention in respect of wines and other alcoholic beverages. As regards the comparison of the goods they are identical. The signs at issue, insofar as they are composed of a different number of words and are distinguishable because of their initial parts, are visually similar to a low degree only and there is only a low degree of phonetic similarity. Conceptually, while the common word 'black' constituted an element that could give rise to similarity, the signs had to be considered as a whole. The BoA did not so with the contested mark. Even if the word 'wine' by itself was weakly distinctive (not descriptive) in respect of the goods covered, the words 'Wine in black' had an imaginative and evocative character. An expression meaning 'Wine in black' must be regarded as being capable, as a whole, of surprising the public and conveying to it the idea of a wine of elegance and distinction, like a person dressed in black, rather than suggesting to it the simple concept of a wine that is dark in colour. This was not the case with 'NOVAL BLACK', where the word 'black' was not accompanied by a preposition and a word with a clear meaning, but only by the meaningless word 'noval', which might at most be perceived as a company name. Accordingly the marks had no conceptual similarity, despite their common element 'black'. The word 'black' simply qualifies either an element that is completely fanciful or the name of a company and thus does not give rise to an expression which, considered as a whole, may be associated with the same ideas as those with respect to the mark applied for. Accordingly, it must be held that the signs at issue, each examined as a whole, have no conceptual similarity, despite their common element 'black'. The




signs are conceptually different. There is no likelihood of confusion, particularly so given that the opponent did not argue an enhanced distinctiveness. There is no need to consider the admissibility or the merits, relating in particular to the alleged weak distinctive character of the earlier mark, due to the existence of many word marks comprising the word 'black' preceded by another word. **NO LOC**

◆ [T-657/13](#); **ALEX / ALEX**, Judgment of 2 July 2015, *BH Stores BV v OHIM* – EN. The applicant sought to register the word mark 'ALEX' as a CTM for goods in Classes 16, 20 and 28. An opposition based, inter alia, on the earlier word mark 'ALEX', registered in Germany for goods in Class 28, was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA confirmed the OD's decision and dismissed the appeal. The BoA found, in particular, that the contested 'children's bath toys and children's educational and developmental activity toys' covered by the mark applied for are not similar to 'sporting articles' covered by the earlier marks. The BoA relied upon that finding of dissimilarity of the above goods in the judgment of 4 June 2013, in T-514/11 (*BETWIN*). As a consequence, the BoA found that there was no likelihood of confusion between the signs at issue. The opponent filed an action before the GC, alleging two pleas in law: the infringement of the obligation to state reasons, provided for in Article 75 CTMR and the infringement of Article 8(1)(b) CTMR. The GC dismissed the appeal. The GC found that, as far as the NATURE of the goods is concerned, the fact that the 'sporting articles' covered by the earlier marks and 'toys' covered by the mark applied for may be composed of the same materials is not in itself sufficient to establish that the goods are similar, given the wide variety of goods that can be made of leather, plastic, wood or metal. The same material can be used to manufacture a wide range of totally different goods (para. 58). Secondly, contrary to what the applicant claims, the existence of a simplified form and a reduced size for 'children's educational and developmental activity toys' makes it possible precisely to distinguish them from, and not to confuse them with, 'sporting articles'. In the present case, 'children's educational and developmental activity toys' are aimed at relatively young children and can be distinguished from 'sporting articles' (even if they imitate them) by a lower level of technicality, a different appearance (reduced size, light weight), safety appropriate for children in accordance with Directive 2009/48/EC of the European Parliament and of the Council of 18 June 2009 on the safety of toys (OJ L 170, 30.6.2009, p. 1-37) and a generally lower price. That reasoning applies a fortiori to 'children's bath toys' which have no sporting equivalent (para. 59). Thirdly, as can be seen from the 'KNUT' judgment, in principle there is NO RELATIONSHIP OF SUBSTITUTABILITY OR COMPLEMENTARITY between, on the one hand, 'gymnastic and sports articles not included in other classes' in Class 28 and, on the other, 'toy dolls, games; toys; stuffed plush animals' in the same class, in that the goods in question have a DIFFERENT PURPOSE. While 'gymnastic and sports articles' are intended specifically for physical fitness, the function of 'games, like toys', is in principle to entertain. The fact that one purpose (for example, physical exercise) does not exclude another purpose (for example, entertainment) and that both purposes may be 'interconnected' in a product, does not rule out the possibility of identifying a dominant, or in other words 'PRIMARY' PURPOSE OF A PRODUCT: The term 'use' means the generally intended use of the product and not any diverted or occasional use. A 'FLUID TRANSITION' or an area of overlap between two categories of goods with essentially different purposes does not mean that all the goods concerned by those categories of goods are similar (paras 63-65). Furthermore, since the nature and intended purpose of the goods covered by the marks at issue are different, they are NOT INTERCHANGEABLE and are therefore NOT COMPETING (para. 74). Although sometimes, depending on the circumstances, there may be some interchangeability between the goods at issue, this occurs only in one sense, that is to say only the consumers of some toys covered by the mark applied for are likely to resort to the corresponding 'sporting articles' covered by the earlier marks in the event of an increase in the price of those toys. The overlap in the consumers of the goods at issue,



namely children and adults, is not sufficient in itself to establish a similarity between goods, since all goods which are AIMED AT THE SAME CONSUMERS are not necessarily identical or similar (paras 78-79). With regard to the MANUFACTURE AND DISTRIBUTION CHANNELS of the goods covered by the marks at issue, the GC found that these are different. Although it is possible that 'sporting articles', on the one hand, and 'children's bath toys and children's educational and developmental activity toys' on the other, are produced by the same undertakings and offered through the same distribution channels, such phenomena are marginal and cannot, without other evidence in support, lead the GC to take the view that those two categories of goods share the same distribution channels. Finally, the fact that the goods in question may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant, since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (paras 88-83). As regards the opponent's argument that the BoA failed to take into account the Office's consistent practice, confirming that there is a similarity, at least tenuous, between 'sporting articles and toys, games and playthings', the GC found that the decisions put forward by the parties reveal only the existence of a not entirely consistent decision-making practice on the part of the Office. The GC recalled the case law, according to which the Office is under a duty to exercise its powers in accordance with the general principles of EU law, such as the principles of equal treatment and sound administration. Therefore, the Office must take into account the decisions already taken in respect of similar applications and consider with special care whether it should decide in the same way or not. Those two principles must however be reconciled with the principle of legality. Consequently, no party to proceedings before the Office may rely, to his or her advantage and in order to secure an identical decision, on an unlawful act committed to the benefit of someone else. Furthermore, the examination of any trade mark application must be stringent and full, and must be undertaken in each individual case. Therefore, the BoA did not err in finding that the goods at issue were different. (paras 89-91). In relation to the opponent's argument that the national trade mark offices within the EU, (more specifically the German Federal Patents Court) relied on the judgment in 'KNUT' and found those goods similar, the GC reminded that the Community trade mark regime is an autonomous system that applies independently of any national system. In addition, the reasoning based on the judgment in 'KNUT' cannot be transposed to the present case (paras 92-93). In the light of above, The GC concluded that in the contested decision it was rightly found that the goods at issue were different, thereby stating clearly that there was no similarity between them. Therefore, the BoA was fully entitled to find that there could be no likelihood of confusion, even taking into account the identity of the signs, since an essential condition for the application of Article 8(1)(b) CTMR, that is to say the identity or similarity of the goods, was not met (para. 97). **NO LOC**

◆ [T-254/13](#); **STAYER**, Judgment of 4 June 2015, *Stayer Ibérica, SA v OHIM* – EN.

CTM	Earlier mark
	<p style="text-align: center;">STAYER</p>

The relevant territory is that of Germany. Having regard to the goods in question in Classes 7 and 8, the relevant public comprises both the general public and professionals in, for example, the construction sector, and that public has a relatively high degree of attention (paras 71, 74-76). The similarity of the




signs was not called into question by the invalidity applicant and the GC upholds the BoA's decision (para. 79). Other goods in Class 7 covered by the contested trade mark are essentially power-driven machines and components thereof, whereas the relevant goods covered by the earlier trade mark are hand-operated. It infers from this that, although those goods are tools that can be offered to consumers through the same channels, their nature and method of use are different. Those goods are also likely to be manufactured by different companies (para. 94). The fact that goods are part of the same construction process does not permit a finding that there is a close connection between them: the BoA did not explain how the goods in question covered by the contested trade mark were indispensable or important for the use of the goods covered by the earlier trade mark, or vice versa. The GC further observes that the goods in question are not part of the same stage of a construction process and they will not be found in the same sections of a DIY store (para. 97). The goods at issue cannot be regarded as capable of belonging to a single tool family (para. 98). The points of dissimilarities between the goods in question outweigh the similarities. Thus, the 'parts of cutting and polishing diamond machines; bits and cutting wheels for the following industries: marble, granite, stone, clay, slabs, tiles and brick, and, in general terms, cutting tools as parts of the equipment included in Class 7' and 'hand held abrasive items (wheels and grinding wheels)' in Class 8 covered by the contested trade mark are neither complementary to nor in competition with the 'PU hand float trowels' in Class 8 covered by the earlier trade mark, nor are they interchangeable with those goods (para. 102). Since one of the essential conditions for applying Article 8(1)(b) CTMR has not been satisfied regarding part of the contested goods, the BoA decision was partially annulled (paras 105-107). **NO LOC**

[T-514/13](#); **AGRI.CAPITAL / AgriCapital et al.**, Judgment of 10 June 2015, *AgriCapital Corp. v OHIM – EN*. The applicant sought to register the word mark 'AGRI.CAPITAL' as a CTM for services, inter alia, within Class 36 corresponding to the following description: 'building promoter services, namely in particular in connection with installations for generating and distributing electrical and thermal energy from renewable energy sources; development of usage concepts (facility management contracting); management of buildings; management of land; real estate management and brokerage, rental and leasing of real estate (facility management); real estate affairs; leasing of farms; The aforesaid services not in connection with publishing and/or published products'. An opposition based on the earlier word CTMs 'AgriCapital' and 'AGRICAPITAL', both registered for services in Class 36, the first mark corresponding to 'financial services, financial consultancy', the second to 'consulting and investment banking services for companies in the agricultural sector', was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA dismissed the appeal of the opponent based on the dissimilarity of the services concerned. The opponent filed an action before the GC. Regarding the admissibility of a document submitted to the GC at the oral hearing, the GC recalls that it is not its function to review the facts in the light of documents produced for the first time before it (para. 18). The GC confirms findings of the BoA in that the services designated by the marks at issue are intended for an average consumer in all the Member States of the EU, but that he or she is likely to exercise a higher degree of attention in view of the considerable sums of money involved in financial or real estate transactions (para. 27). **THE LACK OF SIMILARITY BETWEEN 'real estate management and brokerage services' AND 'financial services'**: Financial services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are provided by financial institutions for the purposes of the management of their clients' funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of a property (para. 38). Regarding the distribution channels



real estate services are not, in principle, provided on the same premises as financial services (para. 42). THE LACK OF SIMILARITY BETWEEN ‘building promoter services’ and ‘financial services’: Building promoter services involve the seeking of finance by the building promoter for the purpose of the acquisition of buildings or land. However, seeking financing cannot be considered to be a financial service directly provided by the building promoter to its clients, equivalent to brokerage (para. 54). Although it is common for building promoters to offer their clients advice regarding the financing of their purchase in the context of the marketing of building programmes, such advice cannot be assessed as being financial advice, such as that covered by the applicant’s earlier marks. Such advice is akin to that which any seller of property of a certain value might set out for clients regarding the financial interest that they could have in acquiring the property in question (para. 55). Regarding complementarity, in a market economy, a substantial portion of activities require financing or investment, with the result that financial services might, by their nature, be associated with the majority of those activities and not only with the activities of a building promoter (para. 61). The link between building promoter services and financial services is not, in itself, sufficiently close to lead the relevant public to think that those services are provided by the same undertaking (para. 62). In the absence of arguments specific to the services of ‘development of usage concepts’, the GC finds that the applicant has failed to demonstrate that the BoA had erred in law in finding that there was no similarity between those services and the ‘financial services’ (para. 69). The lack of similarity between the services covered by the earlier marks and those in respect of which registration of the mark ‘AGRI.CAPITAL’ is sought cannot be offset for the purposes of the assessment of the likelihood of confusion by the similarity, even if that were of a high degree, between the marks at issue (para. 75). Thus there could not be a likelihood of confusion between the marks at issue (para. 76). **NO LOC**

◆ [T-548/12](#); **REDROCK / ROCK et. al.**, Judgment of 8 July 2015, *Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM – CS*.


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

The applicant registered the figurative mark represented above as a CTM for goods and services within Classes 1, 2, 17, 19 and 37. An application for invalidity was filed on the grounds of Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR. It was based on the earlier word marks represented above, registered for goods and services in Classes 1, 6, 7, 8, 17, 19, 37 and 42. The CD dismissed the application for invalidity. The BoA dismissed the invalidity applicant’s appeal. The invalidity applicant filed an action before the GC. According to the previous final judgment, T-146/08, there is no likelihood of confusion between REDROCK and ROCK (para. 16). The degree of attention of the relevant public will be high (para. 24). Concerning the signs REDROCK v KEPROCK, the common element ‘ROCK’ has a low degree of distinctiveness (para. 49). Despite a low degree of visual similarity and an average degree of aural similarity, there is no likelihood of confusion (para. 80). Regarding the remaining earlier trade



marks, there is at most a low degree of visual, aural and conceptual similarity. The differences between the marks are sufficient to avoid a likelihood of confusion (para. 88). **NO LOC**

♦ [T-324/12](#); **ECOSEC TECHNOLOGY / ECOSEC FACHADAS**, Judgment of 15 July 2015, *Knauf Insulation Technology v OHIM* – EN.

CTMA	Earlier mark
	<p style="text-align: center;">ECOSEC FACHADAS</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 1, 2, 3, 16, 17, 19, 20 and 40. An opposition based on the earlier Spanish word mark ‘ECOSEC FACHADAS’ registered for goods in Classes 17 and 19 was filed on the grounds of Article 8(1)(b) CTMR. The OD partly upheld the opposition in respect of ‘paints’ in Class 2 and the goods in Class 17 (apart from ‘rubber, gutta-percha, gum, mica; flexible pipes, not of metal; pipe muffs (not of metal)’ and Class 19. The applicant and the opponent lodged appeals. The BoA dismissed the applicant’s appeal and upheld, whilst dismissing it as to the remainder, the opponent’s appeal insofar as it sought annulment of the OD’s decision dismissing the opposition in respect of ‘flexible pipes, not of metal; pipe muffs (not of metal)’ in Class 17. Given the similarity between the conflicting signs and between the goods at issue, the BoA found a likelihood of confusion between the marks at issue. The applicant filed an action before the GC. The GC confirms that the relevant public is made up of professionals in the building sector in Spain, as well as of do-it-yourself enthusiasts (part of the general public), and that that public has a high level of attention (paras 21-22). As regards the comparison of the goods, the contested decision contains a reasoned explanation only for part of the goods. Yet it is clear from a reading of the contested decision that the BoA endorsed the OD’s decision also in respect of the other goods concerned. Therefore, as the OD’s decision is part of the context in which the contested decision was adopted, it contains a sufficient statement of reasons and must be taken into account in the review of the merits of the BoA’s findings on the comparison of the goods (para. 29). After a brief analysis, the GC upholds the BoA’s assessment that the goods at issue are partly identical and partly similar (paras 31-40). Regarding the visual similarity, it is true that the word elements ‘ecose’ and ‘ecosec’ do bear a certain similarity. Nevertheless, that similarity is not decisive for the overall visual impression that the relevant public will retain from those marks, including the mark for which protection is sought (para. 45). The figurative elements contained in the mark sought must be regarded as being fairly original and more than simply decorative. The earlier mark as a word mark does not contain any element resembling the figurative elements of the mark sought. Thus the marks are clearly distinguishable from each other (paras 47-48). Given that, first, the conflicting signs are similar in terms of the word elements ‘ecose’ and ‘ecosec’; secondly, they differ with respect to the figurative elements, including the green colour and the slight inclination towards the right of the mark sought; and thirdly, the word elements ‘technology’ and ‘fachadas’ are different but of secondary importance due to, inter alia, their descriptive character, the conclusion must be that there is only a low degree of visual similarity between the conflicting signs (para. 50). On the phonetic level, since the words ‘ecose’ and ‘ecosec’ are not part of the Spanish vocabulary, it is not possible to determine their rhythm or intonation with absolute certainty (para. 52).



The first two syllables 'e' and 'co' of the marks at issue would both tend to be construed as an abbreviation of the Spanish words as 'ecológico' (ecological) or 'económico' (economical). It would thus be logical to stress the words 'ecose' and 'ecosec' in an identical manner (para. 54). The words 'technology' and 'fachadas' were relegated to a secondary position due to their descriptive nature (para. 55). There exists a vague conceptual similarity between the conflicting signs in that they could be linked to the rather allusive concepts of 'ecological' or 'economical' (para. 58). Even though when perceiving a word sign, consumers will break it down into elements which, for them, suggest a concrete meaning or which resemble words that they know, in the present case, given that the applicant itself puts forward two possible interpretations of the element 'eco', that element does not suggest a concrete meaning and does not resemble words known to the average consumer. It is accordingly highly unlikely that the relevant public will examine the earlier mark by breaking it down into two parts. The earlier mark has thus normal distinctiveness (paras 70-71). The GC concludes that there is only a very low degree of visual similarity between the conflicting signs, they are phonetically similar, although that similarity is limited to the word elements, there is no direct conceptual similarity and, therefore, the relevant public, having a high level of attention, will perceive the conflicting signs as having only a low degree of similarity. Thus, despite the fact that the goods concerned are partly identical and partly similar, there will not be a likelihood of confusion (paras 73-74). As to the national decisions relied on by the parties, registrations already made in the Member States are merely a factor which, without being given decisive weight, may be taken into consideration for the purposes of registering a CTM (para. 75). The Office's earlier decision-making practice cannot bind the courts of the EU (para. 76). A CTM applicant cannot rely to his or her advantage on a possibly unlawful act committed to the benefit of someone else (para. 77).

NO LOC

◆ [T-229/14](#); **Yorma Eberl / NORMA**, Judgment of 16 June 2015, *Norma Lebensmittelfilialbetrieb Stiftung & Co. KG v OHIM* – DE. The applicant sought to register the word mark 'Yorma Eberl' as a CTM for goods and services within Classes 3, 5, 21, 24, 25, 28 to 36, 40 and 43. An opposition based on several earlier word marks 'NORMA', registered for goods and services in Classes 3, 5, 8, 9, 11, 16, 18, 21 to 23, 24, 25, 28 to 36, 38, 39, 41 and 42 was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA rejected the appeal. In the overall impression the BoA considered that given the average distinctive character of the earlier marks and the below average degree of visual and phonetic similarity between the signs, there was no risk of confusion, including for identical products and services. The opponent filed an action before the GC. Based on the earlier CTMs and German marks, the relevant public is the public in EU and Germany and consists of final consumers, and a specialised public (para. 18). The majority of the goods and services are identical and the rest are similar (para. 22). Visually, the signs differ in the first letter of the word elements 'NORMA' and 'Yorma'. Furthermore, the mark applied for contains the element 'eberl' and both elements ('Yorma' and 'Eberl') are of equal importance. The GC also highlights that the mark applied for is two times longer than the earlier mark (para. 28). Phonetically, the mark for which registration is sought consists of four syllables, while the earlier mark has two, which distinguishes the marks in length, rhythm and accentuation (para. 29). A conceptual comparison is not possible (para. 30). The applicant argues that as that the mark consists of the uncommon first name 'Yorma' which is located in first place and occupies a distinctive position, and the popular surname 'Eberl', the first name must be considered autonomous from the last name; this argument is rejected, since it is not shown that the family name 'Eberl' is a common name. Even if the element 'Yorma' was considered a first name and despite being placed in first position in the mark applied for, it cannot be regarded as being more distinctive than the 'Eberl' element. The mark is thus



composed of two elements of equal importance and the term 'Eberl' cannot be regarded as negligible. Therefore, the GC rejects the argument that only the elements 'Norma' and 'Yorma' should be compared (paras 34-36). As regards the period from which the evidence on the distinctive character of the earlier trade mark is to be submitted, the relevant date for assessing the merits of the opposition is the filing of the trade mark application against which it is directed (para. 44). The GC recalled that the recognition of the distinctive character of the earlier marks based on information from Wikipedia must be rejected, since, being based on an article from a collective encyclopaedia established on the internet, the content can be changed at any time and, in some cases, by any visitor, even anonymously, such a finding is based on uncertain information (para. 47). Other evidence concerning the information on internet proves to be an advertising effort of the opponent in order to increase the public's awareness of it. However, it is not this effort that is decisive but the actual knowledge of the public that results from this effort (para. 49). The evidence provided by the opponent can attest the length of use of the earlier mark and a certain market share, however, the probative value of these documents is relative, taking into account how old they are in relation to the filing date of the CTM application. Moreover, the distinctiveness has not been clearly established to an accurate and specific degree for the relevant goods and services (paras 51-52). LOC was not found (para. 55). **NO LOC**

[T-436/12](#); *Rock & Rock / Rock et al.*, Judgment of 8 July 2015, *Deutsche Rockwool Mineralwoll GmbH & Co. OHG, v OHIM – Ceramicas del Foix, SA* – EN.



CTM	Earlier marks
	MASTERROCK, FIXROCK, FLEXIROCK, COVERROCK, CEILROCK

The applicant, *Deutsche Rockwool Mineralwoll GmbH & Co. OHG*, filed an application seeking a declaration of invalidity of the contested trade mark under Article 52(1)(a) of Regulation No 40/94 (now Article 53(1)(a) of Regulation No 207/2009). The application for invalidity was based on the following marks covering goods and services in Classes 6, 17, 19 and 37. The CD dismissed the application for invalidity. The BoA confirmed the CD's decision and dismissed the appeal. The invalidity applicant filed an action before the GC. The GC upheld the BoA's finding that some of the goods covered by the signs at issue are similar and the rest are either remotely similar or dissimilar. The GC also confirmed the finding that the relevant public's level of attention is particularly high in relation to building materials (paras 21-24). The GC recalled that, according to the case law, (see the judgment 'REDROCK', T-146/08, paras 51-53). The relevant German public would identify the element 'ROCK' as an understandable word, along with the elements 'MASTER', 'FIX', 'FLEXI' and 'COVER', which are part of basic English vocabulary. In that regard, the GC reminded that English is a global language that is also used in the building industry (paras 30-46). As a consequence, the GC found that the shared element 'ROCK' is largely descriptive and/or laudatory of the goods and services covered by the signs at issue, with the result that it has only a weak inherent distinctiveness (paras 38-41). For the same reasons, the earlier marks FLEXIROCK, FIXROCK, MASTERROCK and COVERROCK are only weakly distinctive (para. 92). In relation to the comparison of the signs, the GC concluded that the BoA correctly held that



overall, there is only a low degree of visual, phonetic and conceptual similarity between the signs at issue (para. 76). In relation to the family of marks, the GC rejected the arguments put forward by the applicant based on the broader protection granted to a series or family of marks having the common element 'ROCK'. The GC recalled in particular the case law according to which the broader protection provided to a family of marks could not be granted when the shared element of the earlier marks is largely descriptive of the goods and services covered. Since, as correctly found by the BoA, the element 'ROCK' is largely descriptive and/or laudatory of the goods and services covered by the earlier marks, it is not capable of being the shared core of a family of marks (paras 79-86). Furthermore, according to the case law, protection for a family of marks does not apply when the shared element of the earlier serial marks is used in the mark applied for with a different semantic content. In the present case, the semantic content of the element 'ROCK' in the contested mark 'Rock & Rock' is different from that in the earlier marks: it refers to a style of music in the context of a play on words, whereas in the earlier marks it alludes to a 'stone', a 'rock', or to mineral wool, with the elements 'FIX', 'FLEXI' and 'COVER' giving details of the physical characteristics or the intended use thereof (paras 87-88). In light of the above, the visual, aural and conceptual differences between the signs at issue are sufficient to prevent a likelihood of confusion on the part of the average relevant German consumer, despite the similarities between some of the goods at hand. **NO LOC**

◆ [T-98/13](#) and [T-99/13](#); **CAMOMILLA / CAMOMILLA**, Judgment of 9 July 2015, *C.M.T. – Compagnia Manifatture Tessili S.r.l., v OHIM - Camomilla S.p.A. – IT*.

CTMAs	Earlier mark
	

Camomilla S.p.A., (the CTM owner) was granted CTM registration for the abovementioned figurative marks for goods in Classes 16, 18, and 24 and for goods in Classes 3, 9, 14, 16, 21, 24 and 28. *Compagnia Manifatture Tessili S.r.l.*, (applicant before the GC or applicant), submitted two applications for a declaration of invalidity against the marks at issue, based on the abovementioned figurative Italian mark registered for 'clothing items' in Class 25. The applications were filed under Articles 52(1)(b) and 53(1)(a) CTMR in conjunction with Article 8(1)(b) and Article 8(5) CTM. The CD dismissed the applications for invalidity. The BoA confirmed the CD's decision and dismissed the appeal. The BoA found that the applicant did not show that the contested mark was registered in bad faith under Article 52(1)(b) CTMR. In relation to Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR, the BoA found that there was no likelihood of confusion since there was no similarity between the goods at issue. Therefore, the ground based on Article 8(1)(b) CTMR was also dismissed. The applicant filed two actions before the GC, alleging the infringement of Article 52(1)(b) CTMR, the infringement of Article 53(1)(a) CTMR in conjunction with Article 8(1)(a)(b) CTMR and the infringement of Article 53(1)(a) in conjunction with Article 8(5) CTMR. The GC joined the two cases. In relation to Article 8(1)(a) and (b) CTMR in conjunction with Article 53(1)(a) CTMR: The GC found that the arguments put forward by the





applicant are not such to call into question the assessment made by the BoA on the similarity of the goods in question. The applicant only made some statements of principle, without giving any substantial reason to show that the finding of the BoA was erroneous. (paras 66-67). The only argument, which was that some of the goods such as glasses, suitcases or sport bags may be sold in the same places, is not significant since in supermarkets, for example, consumers may find any kind of goods. In relation to fashion items, the GC noted that: Although the search for aesthetic harmony is common to the entire sector of fashion and clothing, it is a too vague factor to justify the conclusion that all those goods are complementary each other and, therefore, similar (paras 68 and 73). In light of the above, the BoA was right in finding that the goods at hand were dissimilar and that there was no risk of confusion between the marks. Therefore, the plea alleging infringement of Article 8(1)(b) CTMR was also dismissed. **NO LOC**

[T-102/14](#); **TPG POST / POST**, Judgment of 13 May 2015; *Deutsche Post AG v OHIM – DE*. The applicant sought to register the word mark 'TPG POST' as a CTM for goods and services within Classes 6, 9, 16, 20, 35, 38 and 39. An opposition based on the earlier German word mark 'POST', registered on account of acquired distinctiveness in 2003, and the earlier Community word mark 'Deutsche Post' was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition and the BoA confirmed the decision. The GC dismissed the appeal confirming that there is no likelihood of confusion between the conflicting signs even though the CTMA partially contains the earlier national mark. The goods and services are partially (dis-)similar and for the rest identical (para. 33). **FOR THE SIMILARITY OF THE SIGNS**, as follows from the case law, account must be taken of the intrinsic qualities of each of those components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark. Account must be taken of the intrinsic qualities of each element (para. 37). The relevant public attaches more importance to the CTMA's beginning, 'TPG' (para. 42). The fact that 'POST' ought to have a certain independent distinctive role on account of its registration as a national mark (C-196/11 P, 24/05/2012, Formula One Licensing/HABM) does not require to attach such a high degree of distinctiveness thereto that it gives an unlimited right to oppose all trade mark applications containing it (para. 43). A word forming part of a composite sign may be perceived differently than on its own or in combination with other elements. In this case, when following the company initials 'TPG' (in accordance with the practice in this sector to use three capital letters as company signs) the word 'POST' will be perceived as a reference to the postal goods and services offered by this company. Thus, it is considerably less distinctive than 'TPG' (para. 45). This finding cannot be called into question by case law (C-120/04, 6/10/2005, Medion): a) the factual circumstances differ in that 'life' was considered to have a normal degree of distinctiveness in that case law, contrary to the word 'POST' (para. 50); b) 'POST' forms a logical unit together with 'TPG' (para. 51); c) the mere fact that an earlier mark is contained in a CTMA does not amount to an usurpation for which, rather, a likelihood of confusion is required (para. 52). The signs show visual and aural differences (para. 54-55). This also applies conceptually since the earlier mark will be perceived as a reference to the opponent as the traditional service provider in Germany whereas the CTM evokes postal products and services offered by the company TPG (para. 56). **IN THE GLOBAL ASSESSMENT**, with respect to these differences there is no likelihood of confusion taking also account of the fact that the relevant public is used to encounter various postal service providers that are using the word 'POST' as part of their company signs (para. 63-64). The claimed enhanced distinctiveness of the earlier mark was not shown and, in any event, would not give rise to a likelihood of confusion (para. 70). The CTMA will not be considered to form part of the opponent's family of marks (INFOPOST, E EPOST, POSTKIT, etc.) since there is no evidence for the relevant public to be familiar with it and they will not be related to one another due to their different structure (para. 72). The earlier



Community word mark 'Deutsche Post' is even more different than 'POST' and thus a likelihood of confusion is excluded. **NO LOC**

◆ [T-631/14](#); **DEVICE OF A RED SOLE / my SHOES**, Judgment of 16 July 2015; *Roland SE v OHIM – FR*.



CTMA	Earlier mark
 <p>'Other' type of mark: 'The trade mark consists of the colour red (Pantone No 18.1663TP) applied to the sole of a shoe as shown (the outline of the shoe is therefore not part of the trade mark but serves to show the positioning of the trade mark).'</p>	

The applicant sought to register the mark represented above as a CTM for 'high heel shoes' within Class 25. An opposition based on the earlier figurative IR designating the EU represented above, registered for goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC relying on two pleas in law: (i) infringement of the right to be heard and (ii) infringement of Article 8(1)(b) CTMR. Concerning the second plea, the opponent alleged that the red colour was predominant in both marks. The GC finds that the red colour is not predominant in the earlier mark (para. 46). The rectangular shape is banal and the rectangle is not dominant in the overall impression of the sign (para. 47). The red colour itself is a minor part of the earlier mark (para. 48). Moreover, the GC confirms that the red rectangle is decorative and of secondary importance (para. 49). Each element of the earlier mark has the same importance, none of them being more distinctive (para. 56). The opponent's argument that the earlier mark might be applied to the sole of high heel shoes is irrelevant. The earlier mark must be considered as registered. The graphic representation in the registration defines the scope of protection of the mark. The analysis of the likelihood of confusion should not depend on the trade mark owner's commercial intentions (para. 58). The GC confirms that the signs are visually dissimilar. The phonetic comparison was not challenged. The earlier mark will be referred to as 'my shoes'. As regards the contested mark, the regulations do not mention 'position marks' as a category of marks. According to the case law, such marks are similar to the categories of figurative marks and 3D marks (para. 63). There is no phonetic similarity. The contested mark, if pronounced, will be referred to as a description of the sign (para. 64). There is no conceptual link in the coincidence of the red colour (para. 69). The verbal element 'my shoes' is descriptive of shoes. Therefore it has a low degree of distinctiveness. Even if it is true that both marks refer to shoes, this idea is endowed with a low distinctiveness, even very low, taking into



account the goods in question (para. 74). The signs do not have a sufficient conceptual link. The GC thus confirms that the signs are globally dissimilar. **NO LOC**

◆♦[T-195/14](#); **PRIMA KLIMA / PRIMAGAZ**, Judgment of 24 September 2015, *Compagnie des gaz de Pétrole Primagaz SA v OHIM – DE*.


CTMA	Earlier mark
	

The CTM applicant sought to register the figurative trade mark 'PRIMA KLIMA', displayed above, for goods and services in Classes 11 and 42 (e.g. lighting, heating drying apparatus; R&D in the field of lighting, heating, drying). The opponent (applicant before the GC) filed an opposition based, inter alia, on the earlier figurative CTM 'PRIMAGAZ' as displayed above, registered, inter alia, for identical goods in Class 11. The opposition was based on Article 8(1)(b) CTMR and directed against all the goods and services in Classes 11 and 42. The OD found no likelihood of confusion (no LOC) and rejected the opposition in its entirety. The BoA dismissed the appeal. It found that the R&D services are directed at a professional public with an enhanced degree of attentiveness, whereas the goods are directed at the public at large, which will nevertheless — due to the relatively expensive goods with a long life span — be attentive to an above average degree as well. With regard to the contested services in Class 42, the opposition already fails, because these services are dissimilar to the goods in Class 11 of the earlier mark. With regard to the goods in Class 11, which are identical/highly similar, the opposition fails, because the marks are not sufficiently similar to conclude a LOC (visually dissimilar, aurally lowly similar, conceptually dissimilar for those consumers who perceive the meaning of 'KLIMA' and 'GAZ'). Taking into account that the marks only coincide in a non-dominant, descriptive and non-distinctive element ('PRIMA') and considering that all word elements are descriptive and non-distinctive, the consumers will rather focus on the marks' figurative elements. The opponent filed an application to the GC, based on a claimed violation of Article 8(1)(b) CTMR, requesting the annulment of the BoA's decision. With regard to the comparison of the goods in Class 11 with the services in Class 42, the GC confirmed the BoA's finding of dissimilarity. It pointed out that they are directed at a different public and not complementary either, as the goods are not indispensable or important for rendering the (R&D) services (paras 31-37). With regard to the distinctiveness and dominant character of the individual elements of the signs, the BoA erred in several aspects. First, when composite marks are compared, the word elements are usually considered more distinctive than the figurative elements, in particular if the figurative elements — as in the present case — are rather banal (paras 46-47). Second, even though it is true that 'KLIMA' and 'GAZ' are of a low degree of distinctiveness (as they refer to 'Climate' and 'Gas', para. 51), the same cannot be said about the word 'PRIMA', which has only a clearly laudatory meaning in German and Dutch, but not in other relevant languages (e.g. French or Italian (para. 48)). Third, even if 'PRIMA' were considered to be laudatory/weak, this would not automatically mean that this element can be disregarded in the comparison, particularly due to its size and positioning within the signs (para. 49). With regard to the possible meaning of 'PRIMA' the BoA has basically stated that it will be perceived as laudatory in all



languages, as it derives from the Latin word 'Primus' (the first) and has similar equivalents in most languages (French: 'Primaire'; English: 'primary'; Italian: 'prima'). The GC does not share this view. 'Primus' (female form: 'prima') is primarily an ordinal number, which does not convey an immediate image of high quality. Furthermore, in Italian, 'GAZ' and 'CLIMA' are masculine words, and the public will note the wrong declination and grammatical inconsistency in combination with the 'feminine' adjective 'PRIMA' (instead of 'Primo'). Similar considerations apply with regard to French consumers. In light of what has been said above, the marks do not merely raise the concept of an 'extraordinary gas/climate'. Therefore, the conceptual comparison as performed by the BoA was incomplete and erroneous, as the signs display a certain degree of conceptual similarity, at least for Italian and French consumers (paras 61-71). With regard to the visual comparison, the BoA has erroneously stripped the element 'prima' completely of its importance in the overall appearance of the signs, which is not to be neglected, at least for the Italian and French public. As the marks share at least a low degree of visual similarity, the BoA's finding of visual dissimilarity was wrong (paras 72-78). As regards the overall assessment, the BoA erroneously referred to the 'earlier trade mark's non-distinctive character'. A minimum degree of distinctiveness of the earlier mark is to be assumed in opposition proceedings and can only be challenged in cancellation proceedings. Even assuming that the BoA wanted to refer (merely) to a weak distinctive character of the earlier mark, it is to be noted that the distinctive character of the earlier mark is only one factor in the overall assessment (paras 95-97). Finally, due to the fact that the element 'PRIMA' is of normal distinctiveness for the Italian/French part of the public, which perceives the combination of 'PRIMA' with 'GAZ'/'PRIMA' as unusual, the earlier mark enjoys a normal degree of distinctiveness for this part of the public. In light of what has been said above, the identity of the goods and the high degree of consumer attention, the contested decision of no LOC is annulled for the goods found to be identical/highly similar in Class 11, however the finding of no LOC is confirmed for the remaining services in Class 42 (para. 100). **NO LOC**

◆◆[T-323/14](#); *Bankia / BANKY*, Judgment of 17 September 2015; *Bankia, SA v OHIM* – EN.



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

The applicant sought to register the figurative sign 'Bankia' represented above as a CTM for the goods and services in Classes 9, 16, 35, 36, 38, 41 and 45. An opposition was filed based on the basis of the earlier national word mark 'BANKY', which covers services in Class 3, against the registration of the sign for the services in Class 36. The OD partially upheld the opposition for most of the services in Class 36. Both the applicant and the opponent filed an appeal before the BoA. The BoA dismissed the applicant's appeal and upheld the opposition in respect of 'real estate services' in Class 36. The applicant filed an application for annulment before the GC on the basis of infringement of Article 8(1)(b) CTMR. The contested decision was annulled to the extent that it upheld the appeal of the opponent concerning the 'real estate services' covered by the CTM application in Class 36. The GC concluded that the relevant



public is made up of the general public and professionals with a high level of attention. According to the GC, the mark possesses a certain degree of visual and conceptual similarity and a high degree of phonetic similarity. Despite the fact that the two signs in question are not purely descriptive of the services at issue, the relevant public will associate them with the same concept. The GC upheld the applicant's plea in law to the extent that the BoA wrongly found that there was LOC for the part of services in Class 36, 'real estate services' and therefore wrongfully upheld the appeal of the opponent. The GC dismissed the remainder of the action. **NO LOC**

◆ [T-60/13](#); *AC / AC ANN CHRISTINE et al*, Judgment of 23 September 2015, *Reiner Appelrath-Cüpper Nachf. GmbH v OHIM* – EN.


CTMA	Earlier marks
	

The applicant sought to register the figurative trade mark above as a CTM for goods and services in Classes 9, 14, 18, 25 and 35. The OD rejected the opposition. The BoA partly upheld the appeal. The CTM applicant filed an application before the GC for the partial annulment of the decision of the BoA. The relevant public is made up of the German general public (for goods in Classes 9, 14, 18 and 25) and German professionals, such as businessmen and women, with regard to services in Class 35. The findings of the BoA as to the identity or similarity of the goods and services are not vitiated and uncontested by the parties. The BoA erred in finding at least an average degree of visual similarity between the signs. There is only a low degree of visual similarity between them. There is an interesting finding (paras 39-40) in that while in the fashion sector, consumers are accustomed to acronyms consisting of two or three letters being used to refer to trade marks that reproduce the initials of the words, the average consumer will tend not to pronounce the letters of the acronym, but the words beginning with those initials, except where the acronym is well-known. Therefore, when pronouncing the earlier German marks, the relevant public will have the tendency to restrict themselves to pronouncing the word elements 'ann christine', instead of AC or AC Ann Christine. As the mark applied for is composed of the sole word element 'ac', the BoA erred in finding that those marks were phonetically identical. The BoA was right to find that none of the signs at issue have a meaning in German, which excludes conceptual similarity. Given that the signs at issue are similar to a low degree only and that they have a normal degree of distinctiveness, and despite the fact that the goods and services for which the mark applied for seeks registration are partly identical and partly similar to those designated by the earlier



marks, there is no LOC. The contested decision must be annulled insofar as it upheld the opposition in part. **NO LOC**

[T-400/13](#); **AINHOA**, Judgment of 23 September 2015, *L'Oréal v OHIM* – ES.

CTM	Earlier mark
AINHOA	


The applicant registered the word mark 'AINHOA' as a CTM for goods and services within Classes 3, 35 and 39. An application for invalidity was filed based on the figurative CTM and the identical IR, represented above for goods within Class 3. The CD dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal. The invalidity applicant filed an action before the GC. The GC ruled in accordance with the conclusion of the BoA that the relevant public is made up of average consumers with an average level of attention in relation to the goods and services in Classes 3 and 35 and professionals in the cosmetics sector with a higher level of attention for the services in Class 39 (paras 18, 19, 20). The GC held that the goods covered by the earlier marks are included in part of the goods in respect of which protection was sought and therefore they are identical (para. 24). Moreover, the goods and services under Classes 3 and 35 according to the GC have the same distribution channels (para. 25). However the services in Class 39 covered by the CTM at issue are different from the goods in Class 3 covered by the earlier marks (para. 29). The GC ruled that there is low visual similarity, mainly due to the fact that the length, the numbers of letters, their structure, as well as the initial part of the signs are different. According to the GC, there is low aural similarity limited only to the last part of the signs and no conceptual similarity between the CTM and the earlier marks (para. 30 et seq.). The GC ruled that the proof of the claimed high level of distinctiveness of the earlier marks provided by the invalidity applicant is very limited and refers to a period that is more than seven years prior to the invalidity application. Therefore it is not capable of proving such distinctive character (paras 54-56). The GC found that there is no LOC (para. 58). The GC stated that as the proof was not sufficient to demonstrate the high distinctive character of the earlier marks, therefore it could not be sufficient also to establish reputation of the earlier marks in the meaning of Article 8(5) CTMR (para. 63). In conclusion, the invalidity applicant's argument that the mark applied for could take unfair advantage of the earlier marks was not to be examined (para. 64). **NO LOC**

[T-736/14](#); **MoMo Monsters / MONSTER**, Judgment of 28 October 2015, *Monster Energy Company v OHIM* – EN. The applicant sought to register the word mark 'MoMo Monsters' as a CTM for goods and services within Classes 14, 16, 25, 28, 30 and 41. An opposition based on, inter alia, the earlier word mark 'MONSTER', registered for goods in Classes 5, 29, 30, 32, and 33, was filed on the grounds of Article 8(1)(b) CTMR. The OD partially upheld the opposition insofar as there would be a likelihood of



confusion with respect to all the goods and services applied for except the goods in Class 30 (inter alia, confectionary, biscuits, cakes, pastries). It considered that the earlier goods, and in particular the goods in Class 29 (milk-based products) and Class 30 (coffee-based products) were dissimilar to the contested products. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC. The GC dismissed all of the opponent's arguments regarding the similarity of the goods in conflict. In particular, it considered that the goods have a different nature and that this is not called into question by the possibility that milk-based or coffee-based products also contain sugar (para. 24). Moreover, they do not serve the same purpose: confectionary, biscuits, cakes or pastries serve to satiate hunger or address a desire to eat sugary goods whilst the earlier goods serve to quench thirst or satisfy a need for calcium or caffeine (para. 25) The GC emphasised that confectionary and milk-based and coffee-based products are not in competition as they are not interchangeable insofar they have different purposes (para. 27). It further indicated that they are not complementary as one is not absolutely indispensable for the other. Whether they are consumed together is just optional (para. 29). Finally, the GC dismissed the argument that similarity results from the fact that the goods are sold at the same outlets such as coffee chains. The GC considered this fact not particularly significant since different kinds of goods can be found in these outlets without the consumers considering that they have the same commercial origin (para. 30). **NO LOC**

[T-597/13](#); *dadida / CALIDA*, Judgment of 23 October 2015, *Calida Holding AG v OHIM* – EN.

IR designating the EU	Earlier mark
	<p style="text-align: center;">CALIDA</p>

The CTM proprietor registered the figurative mark represented above as an IR designating the EU for goods within Class 25. An application for invalidity was filed based on the earlier CTM word mark 'CALIDA', registered for goods in Class 24 and 25, on the grounds of Articles 53(1)(a) and 8(1)(b) CTMR. The CD dismissed the application for invalidity in its entirety, on the ground that there was no likelihood of confusion between the marks. While the goods were either similar or identical, the comparison of the signs, namely the low degree of similarity of the signs offset by considerable visual differences, led to the conclusion that no likelihood of confusion existed. This finding would not be altered even if enhanced distinctiveness of the earlier mark was proven and therefore the evidence submitted in support of the enhanced distinctiveness claim was not examined. The BoA dismissed the invalidity applicant's appeal, concluding that the marks were visually dissimilar, aurally similar to an average degree and conceptually neutral. The BoA assessed the evidence and concluded that the earlier mark lacked enhanced distinctiveness and therefore had a normal degree of distinctiveness. The invalidity applicant filed an action before the GC contesting the BoA's assessment of visual similarity, the assessment of the distinctive character, and the outcome of likelihood of confusion. **SUBSTANCE:** The GC dismissed the action. As regards the visual similarity, the invalidity applicant claimed that the marks were similar to at least an average degree. However, the GC found that the word elements were visually different, the



figurative element of the bear playing the trumpet was codominant with the word element 'dadida', and the Chinese calligraphic characters completed the different overall impression between the marks (paras 25-29). Concerning the enhanced distinctive character, the invalidity applicant declared that the evidence proved that the earlier mark had enhanced distinctive character, and that this had been concluded in two previous decisions of the BoA between the same parties. The GC confirmed the BoA's decision to refute this argument as the applicant had failed to adduce all of the facts of these separate administrative proceedings and therefore the outcome of the previous cases could not be relied on in the case at hand (paras 43-49). The GC assessed the evidential value of the evidence submitted and concluded that the documents submitted did not prove any enhanced distinctive character (paras 60-66). The GC concluded (paras 74-76) that mere phonetic similarity is insufficient to lead to a finding of likelihood of confusion, and that even if acquired enhanced distinctive character were proven, it would not alter this finding. **NO LOC**

[T-61/14](#); *icexpresso + energy coffee / MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY et al* Judgment of 6 October 2015, *Monster Energy Company v OHIM* – EN.



CTMA	Earlier marks
	<ol style="list-style-type: none"> 1. X-PRESSO MONSTER 2. HAMMER M X-PRESSO MONSTER ESPRESSO + ENERGY 3. MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY

The applicant sought to register the figurative mark 'icexpresso + energy coffee' as a Community trade mark (CTM) for goods and services in Classes 9, 30, 32 and 35. An opposition based on the earlier CTMs 'X-PRESSO MONSTER', 'HAMMER M X-PRESSO MONSTER ESPRESSO + ENERGY' and 'MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY' registered for goods in Classes 5 and 32, was filed on the grounds of Article 8(1)(b) CTMR. With regard to the examination of the likelihood of confusion, the goods in question were presumed to be identical (not disputed). The OD rejected the opposition and the BoA dismissed the appeal. The GC confirmed no likelihood of confusion. The figurative element of the contested mark is constituted in a specific and original way and will attract the attention of the relevant public (para. 38). Considering that 'expresso' and 'energy coffee' are descriptive of the goods and services in question, the BoA rightly relied on the overall impression given by the marks (para. 39). The BoA did not err in its assessment of the dominant and distinctive elements of the mark applied for (para. 40). In view of the clear differences at the beginning of marks and the coincidence in elements which do not stand out, the overall similarity between the marks is low. The GC referred to the case law, pointing out that where some elements of a trade mark are descriptive of the goods and services in respect of which that mark is registered or the goods and services covered by the application for registration, those elements are recognised as having only a weak, or even very weak, distinctive character (para. 76). The BoA was entitled to find that the word elements common to the signs at issue



will not attract the attention of the relevant public and, therefore, to conclude that, even if the goods and services at issue are identical, there was no likelihood of confusion (para. 78). **NO LOC**



[T-60/14](#); *GO / GO*, Judgment of 17 June 2015; *B.M.V. Mineralöl Versorgungsgesellschaft mbH v OHIM – DE*.

CTMA	Earlier mark
	

The applicant sought to register the figurative sign shown above as a CTM for, inter alia, goods and services in Classes 9, 35 and 36. The opponent based its opposition on Article 8(1)(b) CTMR using the earlier CTM shown above, registered for goods in Classes 4, 19, 35, 39 and 42. The OD upheld the opposition in part for the services in Class 35. The BoA dismissed the opponent's appeal, finding that there was no likelihood of confusion, since the goods and services are dissimilar. The opponent appealed to the GC, arguing an infringement of Article 8(1)(b) CTMR. The applicant puts forward that the findings of the BoA as to the dissimilarity of the goods and services is wrong. It contends in particular that the 'fuel cards' in Class 9 are similar to the opposed services in Class 36 and the fuel (Class 4). The GC confirms the BoA's affirmation that the contested goods 'magnetic and machine-readable cards containing encoded information; cards with built-in facilities for storing and processing data (smart cards); apparatus for reading and writing encoded information on cards; encoded cards for use when buying petrol; payment cards; apparatus for data processing; recorded computer programs; encoded cards, in particular fuel cards' are dissimilar to the earlier services in Class 36 and 'fuel' in Class 4. Although the distribution channels and the consumers are the same, since the confronted goods may be acquired by car drivers in a petrol station, the goods are not complementary, since there is no need for a fuel card in order to buy fuel (paras 31-33). Further on, the goods are usually not produced by the same entities and the public will not consider the goods as coming from the same undertaking (para. 34). Consequently, the BoA was right to exclude likelihood of confusion between 'encoded cards for use when buying fuel; encoded cards, in particular fuel cards' (Class 9) and 'fuel' (Class 4), since these goods are dissimilar (para. 35). **NO LOC**



◆ [T-534/13](#); Krispy Kreme DOUGHNUTS / DONUT et al., Judgment of 7 October 2015, *Panrico, S.A. v OHIM* – ES.

CTM	Earlier marks
	<p data-bbox="1034 544 1182 618">DOGHNUTS DONUT</p> 

The applicant registered the figurative mark represented above as a CTM for goods and services within Classes 30 and 42. An application for invalidity was filed based on the ground of current Article 53(1)(a) EUTMR in conjunction with Article 8(1)(b) and Article 8(5) EUTMR. The CD dismissed the application for invalidity in its entirety. The BoA dismissed the invalidity applicant's appeal. The invalidity applicant filed an action before the GC. RES JUDICATA: In line with existing case law, this allegation on the basis of previous opposition proceedings is rejected (paras 23-25); LIKELIHOOD OF CONFUSION: The consumers' attentiveness in relation to goods in Class 30 is low (para. 32); the goods were found identical, whereas these goods in Class 30 are similar to services in Class 42 only to a low degree (paras 36-40). The signs are visually dissimilar because of the dominant elements 'KRISPY KREME' in the CTMA and the different complexity and structure of the verbal and figurative elements of the earlier marks (para. 44). The signs cannot be compared from a conceptual point of view, since the verbal elements do not have a particular meaning (para. 45); they are phonetically similar to a remote degree, because of the possible association of the word 'DOUGHNUTS' to the verbal element 'DONUT/S' of the earlier marks (paras 46-50). For the goods in Class 30, the visual impression is more relevant than the phonetic one, whereas for the services in Class 42, both of them are equally relevant (para. 56-58). The compared signs are not similar and consequently, the BoA could conclude that there is no likelihood of confusion between them, even without assessing the evidence submitted to prove the reputation of the earlier marks (paras 61-63). Despite the fact that having used the word 'donuts' in the Spanish version of the list of goods of the CTMA indicates that the Spanish public tends, to a certain degree, to consider this word as a descriptive term, the earlier marks cannot be considered to be descriptive (paras 64-65). There is no need to determine the admissibility of the allegation regarding the existing national judgment since its text does not establish that the signs involved there were comparable to those in the present case (para. 66). **NO LOC**

[C-270/14 P](#); *SÔ:UNIC / SO...?* et al., Judgment of 15 October 2015, *Debonair Trading Lda v OHIM* – EN. The CTM applicant sought to register the word mark 'SÔ:UNIC' as a CTM for goods in Class 3. An opposition was filed based on the earlier CTM word marks 'SO...?' and 'SO...? CHIC' and UK word mark 'SO...? ONE', inter alia. The OD rejected the opposition. The BoA dismissed the appeal. The GC partially annulled the BoA's decision (insofar as it rejected as inadmissible the opposition based on some of the earlier rights) and dismissed the action as to the remainder. The opponent filed an application before the CJ for the partial setting aside of the judgment under appeal (insofar as it dismissed its action). If the likelihood of confusion with regard to a family of marks results from the possibility that the relevant public





may believe that a mark in respect of which registration is sought is part of the same family as that formed by earlier trade marks, it is then necessary, in order for that likelihood of confusion to exist, that the mark concerned should have characteristics which might suggest that it belongs to the family of marks in question. The BoA's approach cannot be regarded as incorrect in itself insofar as it initially consisted of ascertaining whether there was an element enabling the mark applied for to be associated with the family of marks relied on in order subsequently to examine, in the context of a global assessment, whether consumers were likely to establish a connection between that mark and that family of marks, and whether there was a possibility that consumers might perceive the former as a new member of the latter (paras 34-35). In order to arrive at the conclusion that the mark applied for could not be associated with the family of marks relied on, the GC correctly relied, first, on the finding that the element 'so...?' shared by the earlier trade marks liable to form the family of marks relied on did not coincide with the element 'sô:' of the mark applied for and, second, on the lack of any other factor connecting the marks concerned (para. 36). However, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case. In order to complement its assessment, the GC correctly emphasised the fact that the BoA had drawn attention to differences between the mark applied for and the family of marks relied on relating to, inter alia, the perception of the marks at issue from a conceptual point of view, and explained that the conceptual point of view was an essential element in the context of a family of marks. The GC also examined the structure of the marks under comparison, taking into consideration the influence of both the shared element of those marks, which it identified as being the modifier 'so', and the element specific to the mark applied for — the term 'unic' — on the perception that the relevant public might have of those marks. In the context of that examination, it found that there were substantial structural differences between the marks in question (paras 37-39). **NO LOC**

[T-576/13](#); **MIRUS / MIRUS**, Judgment of 28 October 2015, *Verus Eood v OHIM* – EN. The applicant sought to register the word mark 'MIRUS' as a CTM for goods in Class 12, 'strollers'. The opponent's predecessor in law filed an opposition on the grounds of Article 8(1)(a) and (b) CTMR on the basis of the earlier German word mark 'MIRUS', registered for the goods in Class 12, 'vehicles as well as their parts and accessories, as far as in Class 12 included; wheels for vehicles'. The opponent's predecessor then transferred the earlier trade mark to the opponent and informed the Office. The OD upheld the opposition. The CTM applicant filed an appeal against the decision. After the decision of the OD, a third company was entered in the Register of Community trade marks as the new proprietor of the mark at issue. The BoA upheld the applicant's appeal. The opponent filed an action before the GC. The GC rejected the Office's argument that the opponent no longer had standing to act. The GC stated that the opponent was authorised by the CTM proprietor (para. 20 et seq.). On the infringement of Article 8(1)(b) CTMR, the GC ruled that the territory in respect of which the likelihood of confusion must be assessed is that of Germany. The GC held that the goods at issue are different because of their different nature, purpose and use. The aim of 'strollers' is to transport, small children on wheels, by non- motorised energy, meanwhile 'vehicles' are means of transport, which may or may not be motorised and are operated by and for persons and are meant to facilitate moving from one place to another. 'Parts and accessories of vehicles and wheels for vehicles', on the other hand, are meant for building vehicles and not to be used as building components, whereas the goods covered by the mark applied for are finished products (paras 36-39). Furthermore, there is no link of complementarity between the goods at issue (para. 41). The two kinds of goods, according to the GC, would generally be manufactured in different production centres (para. 42). The GC pointed out that the goods at issue cannot be regarded as being similar to



each other on the ground that they appear in the same class, as the classification is to serve exclusively administrative purpose (para. 43). The GC ruled that the signs at issue are identical (para. 45). However, the GC confirmed that there is no likelihood of confusion within the meaning of Article 8(1)(b) CTMR (para. 48). According to the GC, there is no infringement of Article 8(1)(a) CTMR, as the goods at issue are different and therefore one of the two cumulative conditions is not met (para. 50 et seq.). As a consequence, the action is dismissed in its entirety (para. 55). **NO LOC**


♦ [T-320/14](#); **WAVY BLACK LINES / WAVY BLACK LINE**, Judgment of 25 November 2015, *Sephora v OHIM* – ES.

CTMA	Earlier mark
	

The applicant sought to register the figurative mark represented above as a EUTM for goods and services within Classes 3, 35 and 44. An opposition based on the earlier figurative national mark and IR with effect in Bulgaria, the Benelux countries, Spain, Italy, Poland, Portugal and Romania, represented above, registered for goods in Class 3, was filed on the grounds of Article 8(1)(b) CTMR. In response to the opposition, the applicant requested the opponent to provide proof of use of the earlier marks for all goods on which the opposition was based pursuant to Article 42(2) and (3) CTMR. Evidence was submitted by the opponent. The OD rejected the opposition. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC. The GC confirmed that the relevant goods are directed at the general public in Bulgaria, the Benelux countries, Spain, Italy, Poland, Portugal and Romania, with an average level of attention. The GC stated that although the BoA did not define the relevant public, this point will be examined before the GC as the BoA implicitly accepted the OD's finding regarding the level of attention of the relevant public and it was also not questioned before it (paras 19-25). The GC ruled that the earlier marks and the contested mark are visually dissimilar (paras 26-41). Aurally, as the conflicting marks are figurative marks that cannot be pronounced, a comparison is not possible (paras 42-46) and the conceptual comparison between the signs at issue remains neutral, as neither of them conveys any concept (paras 47-54). Therefore, there is no likelihood of confusion. The opponent's arguments regarding the high level of distinctiveness of the CTM are irrelevant in the case at issue (paras 55-66). **NO LOC**



♦ [T-718/14](#); *W E / WE*, Judgment of 30 November 2015, *Hong Kong Group Oy v OHIM* – EN.

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



The applicant sought to register the figurative mark depicted above for, inter alia, goods in Classes 25 and 35. An opposition was filed based on the earlier Community word mark 'WE', registered for goods and services in Classes 25 and 35. The grounds for the opposition were based on Article 8(1)(b) CTMR. The OD upheld the opposition in its entirety. The applicant filed an appeal against the OD's decision, which was dismissed by the BoA. It found that the goods in Class 25 and the services in Class 35, limited to those to which the opposition relates, covered by the mark applied for and the goods in Class 25 and the services in Class 35 covered by the earlier mark were identical and similar respectively. Furthermore, it found that the signs at issue were visually and phonetically similar and that it is possible that, for a part of the Spanish-speaking public, they were also conceptually similar, concluding that there was a likelihood of confusion within the meaning of Article 8(1)(b) CTMR. The applicant filed an appeal before the GC. The applicant relied on one single plea in law, alleging the infringement of Article 8(1)(b) CTMR. The applicant submits that the BoA erred in concluding that the services in Class 35 covered by the mark applied for and the services in Class 35 covered by the earlier mark were similar. Secondly, the BoA erred in concluding that the signs at issue were similar. Thirdly, the applicant submits that, in the present case, there is no likelihood of confusion (para. 22). With regard to the dominant element of the mark applied for, the GC stated that the elements 'w' and 'e', together with the figurative element, form a unit having a different meaning when compared to the meaning of those elements taken separately (para. 43). Therefore, it found that although the verbal elements cannot be regarded as negligible in the overall impression created by the mark applied for, the dominant element of the mark is its figurative element (para. 45). When assessing the visual comparison of the signs, the GC pointed out that the structures of the signs at issue are very different, since the mark applied for is a figurative mark in which the figurative element is the dominant element, while the earlier mark is a verbal mark consisting only of the word 'we' (para. 48). In addition, the fact that the earlier mark and the mark applied for contain the letters 'w' and 'e' is not in itself sufficient to justify the conclusion that the conflicting signs are visually similar (para. 49). In this light, the GC found that the signs were visually dissimilar (para. 51). In the phonetic comparison of the signs, the letters 'w' and 'e' of the mark applied for will not be perceived by the relevant public as composing a word, but as two individual letters, separated by the axis of the weather vane (para. 54). Furthermore, it found that the relevant public could refer to the letters as 'west' and 'east', in reference to the cardinal points they represent (para. 56). Therefore, the GC found the signs to be phonetically dissimilar (para. 57). In the conceptual comparison of the signs at issue, the GC found that the mark applied for taken as a whole, would be understood by the Spanish-speaking public as referring to a weather vane, and would understand the elements 'w' and 'e' as the cardinal points for east and west. In addition, it found that the relevant public would not perceive the verbal elements of the mark applied for as constituting a word (para. 60). In this light, the GC found that the signs are conceptually dissimilar overall (para. 61) concluding that the signs at issue are dissimilar overall (para. 62). In light of the above, the GC found that there was no likelihood of confusion since there was no similarity of the



signs at issue and therefore there was no need to examine the similarity of the goods and services at issue (para. 64). **NO LOC**

[T-404/14](#); **UNITED VEHICLES / Junited**, Judgment of 26 November 2015, *Junited Autoglas Deutschland GmbH & Co. KG v OHIM* – DE. The applicant sought to register the word mark ‘UNITED VEHICLES’ for services within Classes 35 and 36. An opposition based on the earlier Community word mark ‘Junited’, registered for services in Classes 35 and 36 was raised. The OD dismissed the opposition. Its decision was confirmed by the BoA. The opponent filed an action before the GC, claiming infringement of Article 8(1)(b) CTMR. The GC dismissed the action and confirmed the finding of the BoA that a likelihood of confusion can be excluded. It confirmed that the services concerned are partly similar (para. 20), whereas there is only a remote degree of similarity in the visual (para. 35) and conceptual aspects (para. 42), and an average degree of phonetic similarity (para. 40). Within the global assessment of likelihood of confusion, the latter can be excluded (para. 45). **NO LOC**

[T-491/13](#); **TRIDENT PURE / PURE et al.**, Judgment of 16 December 2015, *Perfetti Van Melle Benelux BV v OHIM – Intercontinental Great Brands LLC* – EN.

CTMA	Earlier marks
<p style="text-align: center;">TRIDENT PURE</p>	<div style="text-align: center;">  <p>CTM No 9 291 634</p>  <p>CTM No 6 771 869</p> </div>

The applicant sought the registration of the Community word mark ‘TRIDENT PURE’ for the following goods in Class 30: ‘non-medicated confectionery, sugar confectionery including mints’. An opposition was lodged based on, inter alia, the earlier figurative Community marks shown above. The OD upheld the opposition on the ground that there was a likelihood of confusion, within the meaning of Article 8(1)(b) CTMR, between the mark applied for and the Community figurative mark No 9 291 634 in relation to all the goods covered by the application. The applicant filed a notice of appeal with the Office. The BoA upheld the appeal and annulled the OD’s decision. The applicant appealed to the GC, alleging the infringement of Article 8(1)(b) CTMR. The GC dismissed the appeal. The relevant public is the public at large in the EU and the goods at issue are identical. Those issues were not disputed by the parties. The GC confirmed the assessment made in the contested decision that the word element ‘pure’ featuring in all the marks at issue will be perceived by a part of the relevant public, in particular by consumers in English-, French-, Italian-, German-, Dutch-, Portuguese-, Spanish- and Romanian-speaking areas, as



being a reference to the freshness or purity of the goods sold and, therefore, as a mere description of those goods. For those consumers who do not understand the meaning of the word 'pure', the element has an average level of distinctiveness (paras 44-45). For the part of the relevant public that understand the meaning of the word 'pure', the more distinctive and dominant element of the mark applied for is the element 'trident'. For those consumers who do not understand the word 'pure', the element 'trident' is still the more dominant element, since it features at the beginning of the mark and is longer than the element (paras 51 and 54). Earlier CTM No 9 291 634 'PURE' — the GC found that, despite its weak distinctive character in relation to the public who understand its meaning, the element 'pure' cannot be regarded as being secondary in the overall visual impression produced by the earlier mark, since it also attracts attention by reason of its size and the fact that it is the sole word element and is placed at the top of that mark. The GC recalled the case law for which the fact that one of the two words that make up a word mark is descriptive is not, on its own, sufficient to conclude that that word is negligible in the overall impression produced by that mark. The BoA therefore erred in denying the existence of any visual similarity between the marks. However, for those consumers who understand the word 'pure', the main element of that mark consists of the image of the mint leaf. Similarly, the main element of the mark applied for, for that category of consumers, is the word element 'trident'. It follows that the element common to both marks, namely the element 'pure', will attract those consumers' attention to a limited extent and that the degree of visual similarity is thus very low (paras 68-71). For those consumers who do not understand the word 'pure', that element is endowed with a more evident distinctive character. However, it must be stated that that fact is mitigated by the position, size and graphic representation of the mint leaf. Moreover, the more important element of the mark applied for is, for that category of consumers also, the word element 'trident'. Therefore, the degree of visual similarity is, for those consumers, low, as the BoA correctly found (para. 72). Phonetically, for those consumers who understand the word 'pure', that fact, the absence of distinctiveness of the element 'pure' and the fact that the different element is placed at the beginning result in a low phonetic similarity between the marks at issue. By contrast, the degree of similarity for other consumers is greater. For those who pronounce the word 'pure' in one syllable, the phonetic similarity between the marks at issue remains below average, since the word 'trident' consists of two syllables containing three dental consonants the pronunciation of which is even more emphasised, as opposed to one syllable in the word 'pure', which, phonetically, plays a less important role in the mark applied for. However, even for those consumers who pronounce the word 'pure' in two syllables, the significance of the element 'trident', which is positioned in first place, lessens the resemblance between the marks at issue, with the result that, for those consumers, those marks are of merely average phonetic similarity (paras 84-89). Conceptually, the GC held, contrary to the BoA's findings, that for those consumers who understand the word 'pure' as being a reference to the purity of the goods at issue and to the purity of breath, there is a conceptual similarity between the marks at issue. The fact that the word 'pure' is descriptive of the characteristics of the goods in question does not alter the conceptual content of those marks. For consumers who do not understand the word 'pure', the conceptual comparison is neutral (paras 90-94). In the global assessment of the likelihood of confusion, the GC found that the goods covered by the signs at issue are intended for the general public and can be bought in, inter alia, supermarkets, specialised points of sale, such as kiosks, or service stations. As a general rule, those shops operate on a self-service basis. Even if the goods at issue may be purchased orally, visual perception of the marks at issue will take place before the actual purchase. Therefore, the visual similarity of the signs at issue carries more weight than their phonetic similarity in the assessment of overall similarity (para. 106). In relation to those consumers who do not understand the word 'pure', the GC found that the overall impressions created by the marks at issue are, despite the similarities identified, sufficiently different to justify the conclusion that there is no likelihood of confusion



for consumers who do not understand the word 'pure'. For those consumers who do understand that word, any likelihood of confusion must also a fortiori be ruled out, since, first, those consumers will attribute even less importance to the element 'pure', which to them is merely descriptive, and, second, the impact of the identified conceptual similarity on the overall impression created by the marks at issue is very low and is thus not decisive for the purposes of the global assessment of the likelihood of confusion (paras 107-108). Accordingly, the BoA was right to conclude that there was no likelihood of confusion between the marks at issue, even if it committed two errors, first, in concluding that there was no visual similarity between those marks and, second, in taking the view that the conceptual similarity of those marks resulting from the presence of the word element 'pure' was not relevant for the purposes of the conceptual comparison. However, those errors had no bearing on the result of the assessment which it carried out (para. 109). Earlier CTM No 6 771 869 'PURE WHITE' — for the part of the relevant public that does not understand either 'pure' or 'white', each of those elements is of average distinctiveness. From a visual perspective, they have the same weight in the earlier mark on account of their very similar size and similar graphic representation. While it is true that the element 'pure' appears at the beginning of the mark, the element 'white' is nevertheless emphasised by virtue of the small star featuring at the bottom left of the capital letter 'W', a factor which, to a certain extent, focuses attention on that element and mitigates the fact that the element 'white' is placed below the element 'pure'. Since, for those consumers, the element 'trident' in the mark applied for is of greater importance than the element 'pure', it must be held as the BoA correctly did, that there is a low degree of visual similarity between those marks. From a phonetic perspective, those consumers will attribute more value to the beginning of each of the marks at issue. In addition, the dissimilarity between the elements 'trident' and 'white' lessens the similarity associated with the common element 'pure'. Therefore, for those consumers the similarity of the marks is, at most, average. The conceptual comparison remains neutral (paras 113-115). For those consumers who understand the words 'pure' or 'white', those elements are descriptive. Therefore, although they have to be taken into account for the purposes of the comparison, those consumers will attribute more attention to the graphic representation and the degree of similarity for that category of consumers is lower than for those who do not understand those words. Therefore, the degree of phonetic similarity is merely very low. Conceptually, there is a certain degree of similarity between the marks, also for those consumers who understand the word 'pure', but not the word 'white' (paras 116-119). In the global assessment, the GC found that, taking into account the fact that, first, consumers pay more attention to the beginnings of marks than to their ends and that, second, visual appearance plays a more important role than phonetic appearance, the BoA was correct to exclude, also for CTM No 6 771 869, all likelihood of confusion for all groups of consumers (paras 120-121). The GC confirmed that a likelihood of confusion in relation to the remaining earlier marks is excluded, given that the similarities between those marks and the CTMA are even less evident than in the context of the other marks examined. **NO LOC**



[T-128/15](#); **RED RIDING HOOD / ROTKÄPPCHEN**; Judgment of 16 December 2015, *Rotkäppchen-Mumm Sektkellereien GmbH v OHIM* – EN. The applicant sought to register the word sign 'RED RIDING HOOD' as a CTM for goods in Class 33. An opposition based on the earlier word mark 'ROTKÄPPCHEN', registered for goods in Class 33, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA dismissed the appeal. The opponent filed an application before the GC for annulment of the decision of the BoA. Given the visual and phonetic dissimilarities, the fact that the mark applied for, 'RED RIDING HOOD', and the earlier German trade mark 'ROTKÄPPCHEN' are made up of the title of the fairy tale 'Little Red Riding Hood' does not justify any conceptual similarity. This is because: it has not been established that the meaning of the mark applied



for will immediately be understood by the German-speaking public. This is all the more true given that the words used in the signs at issue are very different and, as far as 'red', 'riding' and 'hood' are concerned, it has not been established that they are part of basic English vocabulary (paras 29-31). It cannot be considered that the average consumer necessarily knows the title of the fairy tale 'Little Red Riding Hood' in a language other than his or her own, nor that the average consumer will immediately grasp the meaning of the sign for which registration is sought as being the English translation of the earlier mark (para. 36). The signs being dissimilar, there can be no likelihood of confusion between them. The GC therefore dismissed the action without it being necessary to rule on the other claims of the opponent (para. 43). **NO LOC**

III. Other LOC related cases

◆ [T-599/13](#); GELENGGOLD / DEVICE OF A TIGER, Judgment of 7 May 2015, *Cosmowell GmbH v OHIM* – DE.

CTMA	Earlier mark
	

The applicant sought to register the figurative mark represented above as a CTM for goods within Class 5. An opposition was filed based, inter alia, on the earlier figurative mark represented above, registered for goods in Class 5. The OD upheld the opposition. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC annulled the BoA decision. It considered erroneous the BoA's finding that the signs in question cannot be compared phonetically since only one contains the verbal element. The GC found that the earlier mark can be compared phonetically and will be pronounced as 'tiger', whereas the CTM application will be pronounced as 'Gelenkgold', which makes them phonetically dissimilar (para. 65). The action for annulment is therefore successful, the request for alteration of the contested decision in the sense that the opposition be refused requires further assessment of the distinctive character of the earlier mark by the BoA and is inadmissible (paras 78 and 84).



◆◆[T-624/13](#); *Darjeeling / DARJEELING et al.*, Judgment of 2 October 2015; *The Tea Board v OHIM – EN*.

CTMA	Earlier marks
	<p>1. DARJEELING</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark ‘DARJEELING’ and the earlier collective figurative mark represented above, registered for goods in Class 30, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC. The GC has confirmed that the essential function of a Community collective trade mark (CCTM) is the same as that of a CTM (paras 40-46) and that the criteria for the comparison of the goods and services under Article 8(1)(b) CTMR do not change when a CCTM is involved (para. 49). It further points out that the possibility that the public might believe that the goods/services covered by the signs have the same geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8(1)(b) CTMR (paras 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8(1)(b) CTMR is not applicable where one of the cumulative conditions has not been met (paras 59-61).






◆◆[T-625/13](#); *Darjeeling collection de lingerie / DARJEELING et al.*, Judgment of 2 October 2015, *The Tea Board v OHIM* – EN.

CTMA	Earlier marks
	<p>1. DARJEELING</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark ‘DARJEELING’ and the earlier collective figurative mark represented above, registered for goods in Class 30, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC. The GC has confirmed that the essential function of a CCTM is the same as that of a CTM (paras 40-46) and that the criteria for the comparison of the goods and services under Article 8(1)(b) CTMR do not change when a CCTM is involved (para. 49). It further points out that the possibility that the public might believe that the goods/services covered by the signs have the same geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8(1)(b) CTMR (paras 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8(1)(b) CTMR is not applicable where one of the cumulative conditions has not been met (paras 59-61).




◆◆[T-626/13](#); *Darjeeling collection de lingerie / DARJEELING et al.*, Judgment of 2 October 2015; *The Tea Board v OHIM* – EN.

CTMA	Earlier marks
	<p>1. DARJEELING</p>   <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark ‘DARJEELING’ and the earlier collective figurative mark represented above, registered for goods in Class 30, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC. The GC has confirmed that the essential function of a CCTM is the same as that of a CTM (paras 40-46) and that the criteria for the comparison of the goods and services under Article 8(1)(b) CTMR do not change when a CCTM is involved (para. 49). It further points out that the possibility that the public might believe that the goods/services covered by the signs have the same geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8(1)(b) CTMR (paras 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8(1)(b) CTMR is not applicable where one of the cumulative conditions has not been met (paras 59-61).



◆♦[T-627/13](#); *Darjeeling / DARJEELING et al.*, Judgment of 2 October 2015; *The Tea Board v OHIM – EN*.


CTMA	Earlier marks
	<p>1. DARJEELING</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark, 'DARJEELING' and the earlier collective figurative mark represented above, registered for goods in Class 30, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC. The GC has confirmed that the essential function of a CCTM is the same as that of a CTM (paras 40-46) and that the criteria for the comparison of the goods and services under Article 8(1)(b) CTMR do not change when a CCTM is involved (para. 49). It further points out that the possibility that the public might believe that the goods/services covered by the signs have the same geographical origin does not constitute a criterion sufficient to establish their similarity/identity for the purposes of Article 8(1)(b) CTMR (paras 51-52) and that, even assuming that the (geographical) origin of the goods or services covered by the signs at issue may constitute one of the factors to be taken into account in the global assessment of the likelihood of confusion, Article 8(1)(b) CTMR is not applicable where one of the cumulative conditions has not been met (paras 59-61).

[T-105/14](#); *iDrive / IDRIVE*, Judgment of 3 December 2015, *TrekStor Ltd v OHIM – DE*. The applicant sought to register the word mark 'iDrive' for goods within Class 9. An opposition based on the earlier German word mark 'IDRIVE', registered for goods in Class 9 was filed on the grounds of Article 8(1)(b) CTMR and led to the refusal of the CTM application. The BoA confirmed the decision. The CTM applicant filed an action before the GC, requesting the suspension of the proceedings until the German authority decides about the revocation of the earlier mark and claimed the infringement of Article 42(2) CTMR and Article 8(1)(b) CTMR. The GC rejected the request for suspension, as well as both claims. The possible revocation of the earlier German trade mark due to the alleged lack of use would have an ex nunc effect. The revocation request was made after the contested decision was rendered and cannot challenge its legality (paras 14-17). The obligation to prove the genuine use of the earlier mark depends on the timely request made by the CTM applicant pursuant to Article 42(2) CTMR in conjunction with Rules 20(2) and 22(1) CTMIR. The CTM applicant failed to make such a request in due time. A request made in the application to the GC is too late (paras 22 and seq.). There is a likelihood of confusion pursuant to Article 8(1)(b) CTMR, as the goods are identical or similar (para. 49) and the signs are identical in visual (para. 63), phonetic (para. 69) and conceptual terms (paras 81-82).



[C-20/14](#); **BGW / BGW Bundesverband der deutschen Gesundheitswirtschaft**, Preliminary ruling of 22 October 2015, *BGW Beratungs-Gesellschaft Wirtschaft mbH v Bodo Scholz* – DE.


Later mark	Earlier mark
<p style="text-align: center;">BGW Bundesverband der deutschen Gesundheitswirtschaft</p>	

On 11 December 2006, the word mark ‘BGW Bundesverband der deutschen Gesundheitswirtschaft’ was registered at the German Patent and Trade Mark Office (DPMA), inter alia, for goods and services in Classes 16, 35, 41 and 43. BGW filed an opposition against that registration on the basis of the German word and figurative mark, registered for goods and services in Classes 16, 35 and 41, represented above. The DPMA upheld the opposition in part and partially cancelled the registration of the later mark. BGW brought an action for annulment of that decision before the Federal Patents Court, which decided to stay the proceedings and to refer the following question to the CJ for a preliminary ruling: ‘Must Article 4(1)(b) of Directive 2008/95 be interpreted as meaning that, in the case of identical and similar goods and services, there may be taken to be a likelihood of confusion for the public if a distinctive sequence of letters which dominates the earlier word/figurative trade mark of average distinctiveness is made use of in a third party’s later mark in such a way that the sequence of letters is supplemented by a descriptive combination of words relating to it which explains the sequence of letters as an abbreviation of the descriptive words?’ The Federal Patents Court has asked that question in the light of the doubts which it has as regards the application of the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147). The CJ agrees with the national court that the relevant public’s perception of a sign cannot be dependent on the ground for refusal of registration in question. However, the CJ states that the angle from which that perception is viewed varies according to whether what is being assessed is the descriptiveness of a sign or the existence of a likelihood of confusion (para. 27). The CJ also rules that in the light of the different legal context of the cases which gave rise to the judgment in *Strigl and Securvita* (C-90/11 and C-91/11, EU:C:2012:147) and the scope which must be attributed to that judgment, the findings in it are not capable of being applied to the main proceedings for the purposes of assessing whether there is a similarity between the two marks at issue (para. 34). The CJ insists that in the present case, it will be for the national court to ascertain the overall impression made on the relevant public by the later mark (para. 41), in particular the national court shall examine, if necessary, whether the elements of which the later mark consists, taken as a whole, form a separate logical unit which has a different meaning from that of those elements taken separately (para. 43). However, according to the CJ the mere fact that the later mark consists of a sign reproducing the letter sequence that constitutes the only word element of the earlier mark and of a combination of words the initial letters of which correspond to that sequence cannot, on its own, preclude a likelihood of confusion with that earlier mark (para. 42). Finally, the answer to the question referred is that Article 4(1)(b) of Directive 2008/95 must be interpreted as meaning that, in the case of identical or similar goods and services, there may be a likelihood of confusion on the part of the relevant public between an earlier mark consisting of a letter sequence which



is distinctive and is the dominant element in that mark of average distinctiveness, and a later mark which reproduces that letter sequence and to which is added a descriptive combination of words, the initial letters of which correspond to the letters of that sequence, with the result that that sequence is perceived by that public as the acronym of that combination of words (para. 44).

◆ [T-548/12](#); **REDROCK / ROCK** *et. al.*, Judgment of 8 July 2015, *Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM* – CS.

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


The applicant registered the figurative mark represented above as a CTM for goods and services within Classes 1, 2, 17, 19 and 37. An application for invalidity was filed on the grounds of Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR. It was based on the earlier word marks represented above, registered for goods and services in Classes 1, 6, 7, 8, 17, 19, 37 and 42. The CD dismissed the application for invalidity. The BoA dismissed the invalidity applicant's appeal. The invalidity applicant filed an action before the GC. FAMILY OF MARKS: The element 'ROCK' is broadly descriptive and laudatory and, therefore, cannot represent a common element on which a family of trade marks could be based (paras 93-98). In addition, the invalidity applicant failed to prove use of the family of marks (paras 99-103).

◆◆ [T-278/10 RENV](#); **WESTERN GOLD / WeserGold** *et al.*, Judgment of 24 November 2015, *riha WeserGold Getränke GmbH & Co. KG v OHIM* – DE. The applicant sought to register the word mark 'WESTERN GOLD' for goods in Class 33. The opponent based an opposition on Article 8(1)(b) CTMR relying, *inter alia*, on the earlier Community word mark 'WeserGold' registered for goods in Classes 29, 31 and 32. The OD upheld the opposition. The BoA set the OD decision aside finding that there is no likelihood of confusion (low similarity of goods in Classes 32 and 33; the signs are visually and aurally similar but conceptually dissimilar; the earlier mark's distinctiveness is below average due to the element 'Gold' with a low degree of distinctiveness). The opponent filed an action before the GC based on an infringement of Article 8(1)(b) CTMR and three further pleas with respect to Articles 64 and 75 CTMR. The GC annulled the BoA decision (T-278/10). After holding that the signs are dissimilar on account of their clear conceptual difference, the GC based its ruling on the fact that the BoA failed to assess the claimed enhanced distinctiveness of the earlier mark. Upon the Office's appeal, the CJ annulled the GC decision holding that the omitted assessment of the earlier mark's distinctiveness could have had no bearing on the outcome since the GC considered the conflicting signs to be dissimilar. The CJ remitted the case to the GC, noting that it cannot be adjudicated upon as the GC merely assessed the first out of four pleas. The CJ annulled the GC decision without specifying the exact extent thereof. However, in accordance with established case law, the operational part must be read in conjunction with the reasoning. The CJ merely reasoned that the annulment follows from the fact that the GC considered the



BoA to be obliged to assess the enhanced degree of distinctiveness despite holding the signs to be dissimilar beforehand. Hence, the CJ did not put into question the factual findings concerning the signs' similarity. Therefore, the assessment of the first plea before the GC was final. Otherwise, if the GC in the present case were to query the signs' similarity, it would act as an appeal court in relation to the prior GC finding. Furthermore, it would deprive the CJ decision of its binding effect, since an annulment in the present case cannot go beyond that of the CJ and render moot facts on which the CJ reasoning rests (paras 36-45).

◆ [C-182/14 P](#); **MAGNEXT / MAGNET 4**, Judgment of 19 March 2015, *MEGA Brands International v OHIM* – EN.



CTMAs	Earlier mark
<p data-bbox="427 819 560 853" style="text-align: center;">MAGNEXT</p> <p data-bbox="400 893 596 927" style="text-align: center;">(Case T-292/12)</p> <div data-bbox="363 969 624 1039" style="text-align: center;">  </div> <p data-bbox="397 1079 592 1113" style="text-align: center;">(Case T-604/11)</p>	<p data-bbox="1034 969 1171 1003" style="text-align: center;">MAGNET 4</p>

The appellant sought to register the word mark 'MAGNEXT' (T-292/12) and a figurative mark (T-604/11), represented above as two CTM's for Class 28 goods, namely 'toys and playthings, in particular multi-part construction toys, its parts, its accessories and its fittings'. An opposition based on, inter alia, an earlier Spanish word mark represented above, covering goods in Class 28 namely 'games, toys, gymnastic and sports articles not included in other classes; decorations for Christmas trees' was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition on the basis of Article 8(1)(b) CTMR in both cases, finding that there was a likelihood of confusion for both the figurative mark and the word mark. The BoA confirmed the OD decisions. On appeal by the CTM applicant, the GC joined the two cases to the effect as held in a judgment of 4 February 2014 (T-604/11) that the BoA had made an error of assessment by recognising a likelihood of confusion between the figurative mark applied for and the earlier mark, and in case T-292/12, the GC confirmed the BoA decision. An appeal was filed by the CTM applicant specifically directed towards case T-292/12 as regards the word mark. On the argument that the GC failed to take into account the element '4' of the earlier mark, the CJ considered that the GC confined itself to establishing that the word mark in respect of which registration was sought, differs from the element 'magnet' in the earlier mark 'MAGNET 4', only through the presence of the capital letter 'X' (para. 36). The CJ explained that the failure to take account of the figure '4', present in the earlier mark 'MAGNET 4', must be seen in the light of the categorisation, expressly made in paragraph 25 of the judgment under appeal, of the element 'magnet' as being the dominant element of that mark (para. 37). The CJ recalled that in some circumstances, the assessment of similarity may be made solely on the basis of the dominant element of a composite mark. However, that case law concerns only exceptional situations (Order in *Repsol v OHIM*, C-466/13 P, EU:C:2014:2331, para. 83), and it is only if all the other components of the mark are negligible in the overall impression it conveys that the assessment of similarity can be carried out solely on the basis of the dominant element (see, inter alia, *Aceites del Sur-*



Coosur v Koipe, C-498/07 P, EU:C:2009:503, para. 62, and *United States Polo Association v OHIM*, EU:C:2012:550, para. 57) (para. 38). In paragraph 25 of the judgment under appeal, the GC merely confirms the dominant character of the element ‘magnet’ in the earlier mark, without providing any analysis whatsoever of the characteristics of the other element present in that mark, namely the figure ‘4’; consequently, that latter element is negligible (para. 39). Paragraph 22 of the judgment under appeal mentions only the finding by the GC, of the fact that the figure ‘4’ is not present in the contested figurative mark and does not contain any assessment of the visual impression produced by that figure in the context of the earlier mark, from which it follows that that impression is negligible (para. 40). In relation to the phonetic similarity between the contested figurative mark and the earlier mark, also referred to in paragraph 25 of that judgment, it makes no mention of the presence of the figure ‘4’ in the earlier mark. In particular, it does not contain any reference to the pronunciation of that figure in the form of ‘cuatro’, which is that of the Spanish language used by the public considered to be relevant for that mark, and also contains no assessment from which it follows that the phonetic impression produced by that sound is negligible (para. 41). Accordingly, the CJ concludes that the GC erred in law in not carrying out the comparison of the marks at issue by considering each of them in its entirety (para. 42). As to the failure to provide reasons in the judgment under appeal, the CJ takes note that paragraph 35 of the judgment under appeal, in which the GC finds that there is a likelihood of confusion between the signs at issue, is a conclusive point which relies implicitly, but clearly, on the findings made in the previous paragraphs of that judgment; first, as to the visual, phonetic and conceptual similarity between the contested word mark and the earlier mark and, second, as to the distinctive character of that earlier mark (para. 55). Therefore, insofar as it is based on an assessment of the visual and phonetic similarity of the signs at issue which is marred by a lack of reasoning, the GC finding that there was a likelihood of confusion in paragraph 35 of the judgment under appeal, is itself insufficiently substantiated (para. 59). The CJ referred the case back to the GC to complete the assessment of the facts in order to carry out the global assessment of the likelihood of confusion in accordance with the requirements of Article 8(1)(b) CTMR.

[T-257/14](#); **BLACK JACK / BLACK TRACK**, Judgment of 6 March 2015, *Novomatic AG v OHIM*, – DE.

CTMA	Earlier mark
	<p data-bbox="1002 1429 1198 1458">BLACK TRACK</p> 

The applicant sought to register the figurative mark represented above as a CTM for goods within Class 28. An opposition based on the earlier word mark ‘BLACK TRACK’ and on the earlier figurative represented above, registered for goods in Classes 18, 25 and 28, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition. The BoA, taking into account the earlier word mark, upheld the opponent’s appeal, finding that there exists a likelihood of confusion between the two marks, since the goods covered by them were identical or highly similar and the signs at issue had a high degree of visual and phonetic similarity and an average degree of conceptual similarity for the English-speaking public. The applicant filed an action before the GC. With regards to the examination of the similarity of the goods, the GC confirms that the goods covered by the mark applied for in Class 28, being hazard games or gaming apparatus, must be considered as included in the broader category of ‘games’ (para. 21) and therefore the goods covered by the marks at issue are identical (para. 22). The BoA was




not obliged to take into account the market reality, since the assessment of the likelihood of confusion must be based on taking into account the goods and services applied for in the CTMA and the goods and services registered under the earlier mark (para. 25). As regards the similarity of signs, for the relevant public the mark applied for 'BLACK JACK TM' has a clear meaning of a card game and this meaning is even strengthened by the image of two cards (para. 38). The relevant public will not divide this mark into its individual elements and also, the relevant public, or its English-speaking part, will not perceive the word 'black' as independent from the expression 'black jack' (paras 39). The mark 'BLACK TRACK' has also a clear meaning for the English-speaking consumer and will be perceived as a dark path (para. 40). Since each of the marks in conflict form for an English-speaking consumer an expression with a clear and distinct meaning, the BoA made an error in finding a conceptual similarity in the present case (paras 41-43). Such an error is capable of being decisive for the validity of the assessment of likelihood of confusion, since the conceptual differences between two signs may neutralise the visual and phonetic similarity between them (para. 44). The GC returned the case back to the BoA for further examination on this point (para. 45).

C. Article 8(3) and Article 53(1)(b) CTMR — trade marks filed by agents

[no entry]

D. Article 8(4) and Article 53(1)(c) CTMR — non-registered marks/other signs used in the course of trade

♦ [T-85/14](#); *DINKOOL / DIN et al*, Judgment of 10 February 2015; *Infocit – Prestacao de Servico, Comercio e Industria, Ltd v OHIM – EN*.

CTMA	Earlier marks
DINKOOL	<ol style="list-style-type: none"> 1.  2. DIN

The CTM applicant sought to register the mark represented above for goods in Classes 7, 9 and 11. An opposition was filed on the grounds of Article 8(1)(b), Article 8(5) and Article 8(4) CTMR, based on the following earlier rights, represented below: a) IR, protected in several Member States including Germany for identical, similar and dissimilar goods in Classes 1 to 34; reputation was claimed for 'printed matter' in Class 16; b) earlier non-registered sign, used in the course of trade in Germany for the 'development of norms, standards and technical rules as a service to industry, the State and Society as a whole'. The OD found that there was no likelihood of confusion, no sufficient evidence for the claimed reputation and consequently rejected the opposition based on Article 8(1)(b) and Article 8(5) CTMR. The opposition was also rejected with regard to Article 8(4) CTMR, as the OD found that the conditions of § 15 German Trade Mark Law were not fulfilled. The BoA annulled the OD decision and refused the CTM application in its




entirety. It found a likelihood of confusion with regard to the identical and similar goods. With regard to the dissimilar goods, the BoA upheld the opposition based on Article 8(4) CTMR in conjunction with § 15(3) German Trade Mark Law. The applicant filed an action before the GC. Concerning the dissimilar goods and Article 8(4) CTMR in conjunction with § 15 German Trade Mark Law, the applicant has not challenged the following findings of the BoA: a) § 15 German Trade Mark Law confers a right to prohibit the unauthorised use of a business sign, where there is a likelihood of confusion, or — irrespective of a likelihood of confusion — where the earlier sign has acquired a reputation in Germany and use would be detrimental to, or take unfair advantage of, the distinctiveness or reputation of the business sign; b) the earlier, unregistered sign 'DIN' has been used in Germany in activities with more than mere local significance; c) the earlier sign enjoys reputation in Germany for the services claimed; d) the dissimilar goods at stake in Class 9 and 11 are technical goods, likely to be manufactured in accordance with agreed norms. The applicant submitted, in essence, that the signs at issue are dissimilar, because 'DIN' will not be understood as a reference to the opponent's name unless it is used in isolation and because the contested sign is composed of the combination of two English words, namely 'DIN' and 'COOL'. This argument must be rejected for the same reasons it was rejected under Article 8(1)(b) CTMR (para. 70). The applicant's argument that, where a product is certified by the opponent, clear reference is made to that certification through the identification of the opponent by its full name or acronym, is not capable of invalidating the BoA's finding that the relevant public might believe that goods marketed under the trade mark 'DINKOOL' were manufactured in compliance with the 'DIN' norms established by the opponent. The applicant has failed to explain whether — and, if so, why — it is clear that the contested sign 'DINKOOL' has nothing to do with the norms established by the opponent and why the relevant public could not possibly be led to believe that goods marketed under the contested sign were manufactured in compliance with the norms established by the opponent. In those circumstances, the application based on Article 8(4) CTMR must fail (paras 69-75). Based on the foregoing, the action was dismissed.

◆ [T-229/14](#); *Yorma Eberl / NORMA*, Judgment of 16 June 2015, *Norma Lebensmittelfilialbetrieb Stiftung & Co. KG v OHIM* – DE. The applicant sought to register the word mark 'Yorma Eberl' as a CTM for goods and services within Classes 3, 5, 21, 24, 25, 28 to 36, 40 and 43. An opposition based on several earlier word marks 'NORMA', registered for goods and services in Classes 3, 5, 8, 9, 11, 16, 18, 21 to 23, 24, 25, 28 to 36, 38, 39, 41 and 42 was filed on the grounds of Article 8(1)(b) CTMR. The OD rejected the opposition. The BoA rejected the appeal. In the overall impression, the BoA considered that given the average distinctive character of the earlier marks and the degree of visual and phonetic similarity, below average, between the signs, there was no risk of confusion, including for identical products and services. The opponent filed an action before the GC. The opponent alleged, in essence, infringement of Article 8(4) CTMR as a result of the existence of LOC under Article 8(1) CTMR. However, since the LOC under Article 8(1)(b) CTMR was not found, the opponent has not established any error in the contested decision regarding the absence of LOC on the basis of Article 8(4) CTMR (paras 64-66).



◆ [T-359/14](#); **COLOMBIANO COFFEE HOUSE**, Judgment of 18 September 2015, *Federación Nacional de Cafeteros de Colombia v OHIM* – EN.


CTMA	Earlier mark
	<p data-bbox="995 656 1219 689">Café de Colombia</p>

The applicant obtained the registration of the figurative sign represented above as a CTM for goods and services within Classes 30 and 43. An application for a declaration of invalidity based on the earlier protected geographical indication (PGI) 'Café de Colombia', registered in the European Union for 'coffee', was filed on the grounds of Article 7(1)(g) and (k) and Article 8(4) CTMR. The CD rejected the application for declaration of invalidity. The BoA upheld the appeal of the invalidity applicant in part on the basis of Article 7(1)(g) in conjunction with Article 52(1)(a) CTMR, for part of the goods covered by the contested mark, namely in respect of 'tea; cocoa; sugar' in Class 30 and rejected the application for a declaration of invalidity so far as it was based on Article 8(4) conjunction with Article 53(1)(c) CTMR, and Article 7(1)(k) in conjunction with Article 52(1)(a) CTMR. The invalidity applicant filed an action before the GC. The GC rejected the plea in law alleging infringement by the BoA of the obligation to state reasons. According to the GC, the BoA presented sufficiently clearly the reasons for the decision (para. 20). The GC ruled that in order for the earlier sign to be a valid basis for an opposition under Article 8(4) CTMR, it must confer on its proprietor the right to prohibit the use of a subsequent trade mark, but there is no requirement that the sign in question must confer on its proprietor the right to prohibit the registration of the trade mark (para. 37). The GC ruled that it is Article 13 of Council Regulation (EC) No 510/2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (Regulation No 510/2006) which shall be regarded as relating to opposition proceedings based on Article 8(4) CTMR and rejected the argument that Article 14 of Regulation No 510/2006 constitutes *lex specialis* for the conflicts between PGIs and trade mark applications in *inter partes* proceedings. According to the GC, Article 14 of Regulation No 510/2006 must be regarded as concerning the proceedings relating to the absolute grounds for refusal based on Article 7(1)(k) CTMR (para. 47). Consequently, in the view of the GC, the BoA erred in applying the provisions of Article 14 of Regulation No 510/2006 in the context of the opposition on the basis of Article 8(4) CTMR (para. 39). In its judgment, the GC took into consideration the Guidelines relating to proceedings before Office, as a consolidated set of rules setting out the line of conduct which the Office itself proposes to adopt (para. 41). The GC ruled that the error committed by the BoA insofar as it applied Article 14 of Regulation No 510/2006 and not Article 13 of Regulation No 510/2006 is liable to have a decisive effect and therefore the decision of the BoA must be annulled. According to the GC the concept of 'same class of product' in Article 14 of Regulation No 510/2006 in the decision of the BoA and 'comparable product' in Article 13(1)(a) of Regulation No 510/2006 could be identical in part of the situations invoked by the opponent in support of its opposition. However, the



outcome of the decision according to the GC could differ if the other situations invoked by the opponent under Article 13(1)(a) were examined by the BoA.


♦ [T-387/13](#); **COLOMBIANO HOUSE / Café de Colombia**, Judgment of 18 September 2015, *Federación Nacional de Cafeteros de Colombia v OHIM* – EN.

CTMA	Earlier mark
	Café de Colombia

The applicant obtained the registration of the figurative sign represented above as a CTM for goods and services within Class 43, ‘services for providing food and drink; restaurants, bars and cocktail bar services; catering services; stores administering of food and drink indoor or take away; food and beverage services; sandwich bars, snack bars’. An opposition based on the earlier PGI, ‘Café de Colombia’, registered in the European Union for ‘coffee’, was filed on the grounds of Article 8(4) CTMR. The OD dismissed the opposition. The BoA dismissed opponent’s appeal on the basis of Article 8(4) CTMR and Article 14 of Regulation No 510/2006. The opponent filed an action before the GC. The GC rejected the plea in law, alleging infringement by the BoA of the obligation to state reasons. According to the GC, the BoA presented sufficiently clearly the reasons for the decision (para. 20). The GC ruled that in order for the earlier sign to be valid basis for an opposition under Article 8(4) CTMR, it must confer on its proprietor the right to prohibit the use of a subsequent trade mark, but there is no requirement that the sign in question must confer on its proprietor the right to prohibit the registration of the trade mark (para. 42). The GC ruled that it is Article 13 of Regulation No 510/2006 which shall be regarded as relating to opposition proceedings based on Article 8(4) CTMR and rejected the argument that Article 14 of Regulation No 510/2006 constitutes *lex specialis* for the conflicts between PGIs and trade mark applications in *inter partes* proceedings. According to the GC, Article 14 of Regulation No 510/2006 must be regarded as concerning the proceedings relating to the absolute grounds for refusal based on Article 7(1)(k) CTMR (para. 52). Consequently in the view of the GC, the BoZ erred in applying the provisions of Article 14 of Regulation No 510/2006 in the context of the opposition on the basis of Article 8(4) CTMR (para. 44). In its judgment, the GC took into consideration the Guidelines relating to proceedings before the Office, as a consolidated set of rules setting out the line of conduct which the Office itself proposes to adopt (para. 46). The GC ruled that the error committed by the BoA insofar as it applied Article 14 of Regulation No 510/2006 and not Article 13 of Regulation No 510/2006 is liable to have a decisive effect and therefore the decision of the BoA must be annulled. According to the GC the concept of ‘same class of product’ in Article 14 of Regulation No 510/2006 in the decision of the BoA and ‘comparable product’ in Article 13(1)(a) of Regulation No 510/2006 could be identical in part of the situations invoked by the opponent in support of its opposition. However, the outcome of the decision according to the GC could differ if the other situations invoked by the opponent under Article 13(1)(a) were examined by the BoA.



◆ [T-136/14](#); **BASMALI LONG GRAIN RICE RIZ LONG DE LUXE / BASMATI**, Judgment of 30 September 2015, *Tilda Riceland Private Ltd v OHIM* – EN.

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

The CTM applicant sought to register the above figurative mark as a CTM for goods in Class 30. The opponent invoked Article 8(4) CTMR in conjunction with the UK Trade Marks Act 1994, section 5(4). The OD rejected the opposition. The BoA dismissed the appeal. The GC annulled the BoA's decision. The BoA dismissed the appeal once again, for different reasons. The opponent filed an application before the GC for annulment of the BoA's second decision. It is true that, under Article 8(4) CTMR, the sign at issue must be used as a distinctive element in that it must serve to identify an economic activity engaged in by its proprietor. However, that cannot mean that the function of the use of a sign, under Article 8(4) CTMR, should be exclusively that of identifying the commercial origin of the goods or services at issue. Article 8(4) CTMR covers non-registered trade marks and any '[other] sign' used in the course of trade. The function of the use of the sign at issue may lie not only in the identification by the relevant public of the commercial origin of the goods concerned, but also, inter alia, in the identification of their geographical origin and the special qualities inherent in them or of the characteristics on which their reputation is based. The sign at issue, in the light of its nature, may thus be classified as a distinctive element if it serves to identify the goods or services of one undertaking in relation to those of another undertaking, but also, inter alia, if it serves to identify certain goods or services in relation to other similar goods or services. The extended form of passing off, which is recognised by the UK courts, enables a number of traders to have rights over a sign which has acquired a reputation on the market (paras 27-30). It is irrelevant that the applicant's goods which were exported to the United Kingdom were marketed in that territory by another company and not by the applicant itself, since the function of the use of the sign at issue is not necessarily that of identifying the commercial origin of the goods concerned (para. 31). The applicant's single plea in law was upheld, and the contested decision was annulled.





◆♦[T-96/13](#); **MACKA / MACKA**, Judgment of 28 October 2015, *Rot Front OAO v OHIM* – EN.

CTMA	Earlier mark
<p data-bbox="316 562 592 645">Ма́чка</p>	

The applicant sought to register the figurative mark represented above as a CTM for goods within Class 30. An opposition based on the earlier sign used in Germany for ‘sweets’ was filed on the grounds of Article 8(4) CTMR. The OD dismissed the opposition and found that the earlier sign was not used as required to obtain protection under German law. The BoA confirmed the decision. The opponent filed an action before the GC claiming an infringement of Article 8(4) CTMR in conjunction with § 4 (2) German Trade Mark Law. The GC allowed the action. On substance, the GC decided that the BoA erred in law when it rejected, by referring to the case law of the GC, the applicant’s argument that the relevant public to be taken into account in the present case had to be limited only to Russian or Russian-speaking consumers in Germany on the ground that the goods covered by the earlier mark were sold only in shops which were specifically intended for them. The question of the extent to which an unregistered earlier mark protected in a Member State confers on its proprietor the right to prohibit the use of a subsequent trade mark must be examined in the light of the criteria laid down by the national law of the Member State where the sign relied on was used — namely, in the present case, German law — including national case law and academic writing, and not in the light of the case law of the GC concerning the application of the CTMR (para. 29). The GC recalled that as regards the examination of national law, it is indeed apparent from the case law that the opponent must establish that the earlier sign relied on in support of the opposition falls within the scope of the law of the Member State relied on and that it allows use of a subsequent mark to be prohibited. That rule places on the opponent the burden of providing the Office not only with particulars showing that he or she satisfies the necessary conditions, in accordance with the national law which the opponent is seeking to have applied, in order to be able to have the use of a CTM prohibited by virtue of an earlier right, but also with particulars establishing the content of that law (para. 30 with reference to further case law). However, it is also apparent from the case law that, in the circumstances in which the Office may be called upon to take account of the national law of the Member State in which an earlier right on which the opposition is based is protected, it must, of its own motion and by whatever means considered appropriate, obtain information about that national law, where such information is necessary to assess the applicability of the ground for refusal of registration in question; accordingly, the Office must take 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. The Office is under an obligation to obtain, of its own motion, information about national law where it already has before it information relating to national law, either in the form of claims as to its content, or in the form of evidence submitted and whose probative value has been claimed (para. 31).



[T-508/13](#); Halal Malaysia / HALAL MALAYSIA, Judgment of 18 November 2015, *Government of Malaysia v OHIM* – EN.

CTMA	Earlier mark
	

The CTM applicant sought to register the figurative mark above as a CTM for goods in Classes 5, 18, 25, 29, 30, 31, 32, 43. An opposition was filed on Article 8 (4) CTMR in conjunction with the UK Trade Marks Act 1994, section 5(4), that is to say, the UK tort or delict of passing off. The OD rejected the opposition. The BoA dismissed the appeal. The opponent filed an application before the GC for annulment of the BoA's decision. The GC first deemed the Office's argument that the earlier sign had not been used in the course of trade of more than mere local significance to be inadmissible under Article 135(4) RPGC. The reason was that the contested decision only found that the sign had not acquired the goodwill required under UK law and did not examine the other conditions laid down by Article 8(4) CTMR (paras 15-18). The GC then held that, in theory, public bodies such as the opponent may be protected by passing off actions, since if those bodies make use of a particular sign that belongs to them exclusively, they may rely on the goodwill attached to the marketing of goods and services bearing that sign. Similarly, if those bodies share the use of any sign with other operators, the goodwill may be relied on by the same public bodies and by the operators in question. The GC took the view that, in the present case, having regard to the opponent's certification system relating to the compliance of goods with Sharia law, to its function of inspecting the manufacturing processes developed by third parties wishing to become authorised users of its certification mark and to its function of monitoring use of the certification mark by those authorised users so as to ensure that the quality standards of its system are complied with, it was the opponent that had to be regarded as the owner of the goodwill. Nonetheless, the GC found that, regardless of whether the passing off was the 'classic' form (as claimed by the opponent) or the 'extended' form (that is to say when a sign has been used by several operators, as found by the BoA), the opponent had not demonstrated the existence of goodwill — that is to say, the attractive force over the customers who will make their choices according to the good reputation the opponent might have acquired — in its certification mark (paras 25-51). As for the assessment of the evidence submitted to prove the reputation and goodwill of the earlier mark in the UK, the GC held that, even if such evidence showed advertisement and disclosure of the mark, the opponent did not provide proof regarding the perception of it by Muslim and non-Muslim consumers. Muslim consumers, in particular, will pay attention first to the product itself and to the distinctive mark that identifies it, and it is only afterwards that they will make sure that the product complies with the halal diet by looking for the sign that shows this. As a result, those consumers will notice the opponent's certification mark, but only after perceiving the other signs incorporated into the product or service. Therefore, the evidence did not demonstrate that Muslim consumers knew the certification mark or that it was able to influence their purchasing decisions (paras 76-84). Likewise, with respect to the scope of the evidence, the GC ruled, in particular, that: with regard to the turnover concerning the 'Global halal food market', the opponent provided actual figures for the relevant period.



However, those figures did not indicate what percentage of turnover was achieved by products bearing the earlier sign. The document only indicated that ‘most of the products’ had the earlier mark, that the number of companies certified as halal in Malaysia ‘continue[d] to increase every year ...’ and that the potential of those companies that export to the world, especially in Europe, was ‘huge’. Because of their lack of precision, they could not be taken into account, since, in the context of Article 8(4) CTMR, the use of an earlier sign cannot be proved by means of probabilities or suppositions (paras 86-87); The opponent had provided proof of sale in the UK only for a total of 1 685 products with packaging bearing its certification mark, during the years 2008 and 2010. Such a quantity is negligible and therefore could not suffice to demonstrate knowledge of that mark by the relevant public (paras 88-90); Even though an article produced by the opponent made reference to a promotion of 22 000 food products by 16 companies, starting on 11 September 2010, it did not indicate whether they had been sold before or after the relevant period (paras 91-94). The GC therefore dismissed the opponent’s action in its entirety (para. 97).

◆ [T-659/14](#); **PORT CHARLOTTE / Porto**, Judgment of 18 November 2015, *Instituto dos Vinhos do Douro e do Porto, IP v OHIM* – EN. The applicant registered the word sign ‘PORT CHARLOTTE as a CTM for the goods in Class 33, ‘alcoholic beverages’. An application for invalidity was filed on the grounds of Article 53(1)(c) CTMR in conjunction with Article 8(4), Article 53(2)(d) CTMR in conjunction with an appellation of origin ‘Porto’ or ‘Port’, and Article 52(1)(a) in conjunction with Article 7(1)(c) and (g) CTMR. In response to the application for a declaration of invalidity, the intervener limited the list of goods in respect of which the contested mark was registered, to goods corresponding to the following description: ‘whisky’. The CD rejected the application for a declaration of invalidity. The BoA dismissed the invalidity applicant’s appeal. The invalidity applicant filed an action before the GC. First of all, the GC specified that the BoA’s reference to the term ‘oport’ as the name of the Portuguese city and to its entry in the list of quality wines were incorrect. However, such error did not suffice, on its own, to warrant the annulment of the contested decision (paras 31-32). The GC then went on to examine two questions that fall under the applicant’s second and third plea: (1) the precise scope of protection conferred on PDOs and PGIs under Regulation No 491/2009, and (2) whether that protection is exhaustive or whether, beyond the scope of that regulation, the BoA should have applied the Portuguese law which also protects the designation of origin ‘porto’ (para. 36). With respect to the first question above, it was found that, as regards the specific scope of Regulation No 491/2009, Article 118m(1) and (2) governs, in a uniform and exclusive manner, both the authorisation of and limits to, and even the prohibition of, commercial use of PDOs and of PGIs under EU law. As a result of this, and in that specific context, there was no need for the BoA to apply the conditions for protection specifically established in the relevant rules of Portuguese law in question (para. 41). Such conclusion, however, and as indicated in the second question above, did not exclude the need to assess whether or not the protection under Regulation No 491/2009 may be supplemented by another system of protection (para. 43). In that regard, the GC stated that neither Regulation No 491/2009, nor the CTMR exclude the possibility that such protection be supplemented, beyond its particular scope, by another system of protection. More in particular, the GC recalled that the grounds for invalidity may be based on earlier rights under EU legislation or national law. It follows that the protection conferred on PDOs and PGIs under Regulation No 491/2009, provided that they are ‘earlier rights’, may be supplemented by the relevant national law granting additional protection (para. 44). As a result, the BoA failed to apply the Portuguese legislation in question (paras 48-51 and 61). With respect to the other claims submitted by the applicant, the GC considered that there was no infringement of Article 118m(2) of Regulation No 491/2009, since the products in question were different (para. 65) and the contested mark





neither used nor invoked the PDO in question (para. 72). Similarly, it was found that the contested mark did not constitute a misleading sign under Article 7(1)(g) CTMR (para. 87), nor a descriptive trade mark under Article 7(1)(c) CTMR (para. 106). In view of the failure by the BoA to apply the relevant rules of Portuguese law, the GC annulled the contested decision.

◆ [T-257/11](#); **COLOURBLIND**, Judgment of 26 February 2015, *Pangyrus Ltd. v OHIM* – EN. The CTM holder registered the word mark ‘COLOURBLIND’ as a CTM in respect of a range of goods and services in Classes 9, 16, 28, 35 and 41. The invalidity applicant sought the cancellation of the contested CTM on the grounds of Article 52(1)(b) and Article 53(1)(c), in conjunction with Article 8(4) CTMR. The CD upheld the application for a declaration of invalidity, finding that bad faith had been established on the basis of Article 52(1)(b) CTMR, and declared the contested trade mark to be invalid. On appeal, the BoA annulled the CD’s decision and dismissed the application for a declaration of invalidity in its entirety. The GC dismissed the appeal and confirmed the BoA’s findings. Concerning the ‘passing off’ claim based on Article 53(1)(c) in conjunction with Article 8(4) CTMR, the GC noted that the invalidity applicant had only filed two invoices, each of which concerned the sale of seven units of a learning product distinguished by the contested CTM, and that this could not prove a sufficiently significant use of the sign ‘COLOURBLIND’ in the course of trade by the invalidity applicant, so that the claim was dismissed.

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

[T-570/10 RENV](#); **WOLF’S HEAD / WOLF JARDIN et al**, Judgment of 5 February 2015, *Environmental Manufacturing LLP v OHIM & Société Elmar* – EN.



CTMA	Earlier marks
	

The OD had dismissed the opposition based on Article 8(1)(b) and Article 8(5) CTMR as no likelihood of confusion and the opponent had not adduced evidence of a risk of dilution or free-riding. The BoA annulled the OD’s decision, upholding the opposition based on Article 8(5) CTMR. The BoA took the view that the use of the mark applied for would cause both a risk of dilution to the earlier marks and risk of free-riding, considering the high reputation of the earlier marks, the similarity of the marks and the similarity/identity of goods. In its first judgment, the GC dismissed the action, concluding that the BoA’s reasoning was correct. The GC rejected the applicant’s argument that ‘the proprietor of the earlier mark [must] show an additional effect, caused by the introduction of the later mark, on the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered’ (see judgment of 27/11/2008, C-252/07, *Intel*, EU:C:2008:655). Furthermore, the GC did not consider it necessary to give a ruling on the risk of free-riding since it took the view that the BoA had correctly applied Article 8(5) CTMR as far as the risk of dilution was concerned (judgment of 22/05/2012, T-570/10, *Représentation d’une tête de loup*, EU:T:2015:250, paras 25-68). On appeal, the CJ interpreted the aforementioned ‘*Intel*’ judgment and further elaborated on the concept of ‘change in the economic



behaviour of the average consumer'. It found that the GC erred in law by failing to criticise the BoA's failure to conduct an analysis of the effects of the use of the mark applied for on the economic behaviour of the average consumer of the goods covered by the earlier marks (judgment of 14/11/2013, C-383/12 P, *Répresentation d'une tête de loup*, EU:C:2013:741, paras 34-47). The CJ thus annulled the GC judgment and the case was remitted to the GC. The GC, firstly, upheld the CTM applicant's complaint alleging infringement of Article 8(5) CTMR insofar as the BoA incorrectly found that there was a risk of dilution (para. 41). The GC noted that the opponent did not establish the existence of evidence of a 'change in the economic behaviour of the average consumer' of the goods/services for which the earlier mark was registered, or a serious likelihood that such a change will occur in the future (paras 38-40). Secondly, since the CTM applicant's complaint challenging the risk of dilution was upheld, the GC verified whether the BoA was justified in finding that there was a risk of free-riding (paras 42-66). It upheld also this CTM applicant's complaint insofar as the BoA incorrectly found that there was a risk of free-riding (para. 65). The BoA correctly found that the relevant public might establish a link between the opposing signs (para. 54). However, the BoA erred in relying only on the long-standing reputation and highly distinctive character of the earlier mark (para. 56). In the absence of 'an exceptionally high reputation from which it might be presumed (...) that the probability of a risk of free-riding was so obvious that it was no longer necessary to verify whether the image of the earlier marks or the characteristics projected by those marks could be transferred to the goods covered by the mark applied for', the BoA was bound to examine whether the image conveyed by the earlier marks could be transferred to the goods covered by the mark applied for and, therefore, their power of attraction could be useful for the CTM applicant for the marketing of those goods (paras 57-58). Since the opponent did not submit any proof and argument both in respect of the 'image' with which the earlier marks are associated and of the transfer of this image, the BoA could not conclude that use of the mark applied for would cause a risk of free-riding (para. 59). The Office's arguments submitted before the GC in order to complement the BoA's reasoning were considered new and therefore inadmissible (para. 64).

◆ [T-76/13](#); **QUARTODIMIGLIO et al / LONGINES et al**, Judgment of 12 February 2015, *Compagnie des montres Longines, Francillon SA, Staccata Srl, v OHIM – EN*.

CTMA	Earlier marks
	

The applicant sought to register the figurative sign represented above as a CTM for Classes 9 and 14. An opposition based on several international figurative registrations for goods in Classes 9 and 14 was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The opposition was directed against all goods of the CTM. The OD rejected the opposition on both bases on the ground that there was no likelihood of confusion. The BoA confirmed the OD decision. It concluded that there was no likelihood of confusion between the signs, even for identical goods. On Article 8(5) CTMR, the BoA was correct when it stated



that the applicant did not provide specific evidence which makes it possible to establish that consumers were accustomed to focusing, in particular, on the 'winged hourglass' element in the earlier composite marks as used. The GC pointed out that that evidence does not contain any opinion polls of the relevant public relating, inter alia, to its perception of the composite marks used or the question of which elements were memorised or, at the very least, recognised by that public, when faced with various marks in the course of its shopping, as referring to the applicant's goods. In particular, the applicant has not, in addition, submitted opinion polls in which target persons who were shown only the figurative sign representing a 'winged hourglass' had to state whether they knew that sign and, if so, what they associated it with. The evidence which the applicant put forward before the Office regarding the use of the earlier marks consisting of a 'winged hourglass' is not sufficient for it to be held that they have been proved to have a reputation or enhanced distinctiveness. Consistent items of evidence show the long-term use of a composite mark corresponding, in essence, to earlier IR No 610 902, not only in Switzerland, but also in certain EU Member States that are relevant in the present case (para. 100). The BoA did not err in finding that it had not been proved that the earlier marks that consisted solely of a 'winged hourglass', taken as registered, have a reputation. In spite of the continuous quantitatively and qualitatively significant use over a period of time of a composite mark consisting of the graphic element of a 'winged hourglass' and the word 'longines', corresponding, in essence, to IR No 610 902, it is the latter word which will attract the attention of consumers and will probably be retained by them, and it has not been shown that a substantial part of the relevant public, in one or more of the EU Member States in respect of which a reputation has been claimed, is also aware of the earlier marks consisting solely of the graphic element of a 'winged hourglass' and associates them, without effort, with the applicant's horology and chronometric goods, which are the only goods to which the claim in respect of reputation relates (para. 108). Although it has already been stated that the reputation of the earlier composite marks including the word 'longines' was regarded as proved, in principle, on the basis of evidence relating to the use of a graphic device corresponding to IR No 610 902, the BoA was also right in finding that Article 8(5) CTMR was not applicable, on account of the significant differences between those marks and the mark applied for (para. 122). The earlier composite mark at issue differs visually and conceptually from the mark applied for in such a significant manner that no link may be made between them, notwithstanding the reputation of that earlier mark and the identity of the goods at issue. The GC draws attention, in that regard, in particular, to the notable differences resulting both from the actual design of the wings at issue, short and thick in one case and thin and longer in the others, and from the presence of the word elements 'longines' and 'quartodimiglio'. The same conclusion applies in respect of IR No 298 063 inasmuch as it has also been accepted indirectly that it has a reputation (para. 126).

◆ [T-393/12](#); **KENZO / KENZO**, Judgment of 22 January 2015, *Kenzo Tsujimoto v OHIM* – EN. The CTM applicant filed an application for the word mark 'KENZO' for 'wine; alcoholic beverages of fruit; western liquors (in general)' in Class 33. The opponent relied on the earlier CTM 'KENZO' claiming reputation for goods in Classes 3, 18 and 25. The OD dismissed the opposition stating that reputation was not proven. The BoA upheld the opponent's appeal. The CTM applicant brought an action before the GC based on two pleas in law. On the infringement of Article 8(5) CTMR, the GC endorsed the BoA's finding that the evidence filed during the substantiation period, together with the evidence filed to prove use clearly showed reputation of the earlier mark in a significant part of the relevant territory (paras 42-49). The BoA also correctly established a risk of an unfair advantage by taking into account the iconic image conveyed by the earlier trade mark (which can be transferred to other sectors, such as the wine sector) and by finding that it was highly likely that the mark applied for would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to



exploit, without paying any financial compensation, the marketing effort expended by the owner (paras 53-58).

◆ [T-322/13](#); **KENZO / KENZO**, Judgment of 22 January 2015, *Kenzo Tsujimoto v OHIM* – EN. The CTM applicant filed an application for the word mark ‘KENZO’ for services in Classes 35, 41 and 43 (all wine-related). The opponent relied on the earlier CTM ‘KENZO’ claiming reputation for goods in Classes 3, 18 and 25. The OD dismissed the opposition stating that reputation was not proven. The BoA upheld the appeal of the opponent. The CTM applicant brought an action before the GC based on two pleas in law. On the infringement of Article 8(5) CTMR, the GC endorsed the BoA’s finding that the evidence filed during the substantiation period, together with the evidence filed to prove use, clearly showed reputation of the earlier mark in a significant part of the relevant territory (paras 24-31). The BoA also correctly established a risk of an unfair advantage by taking into account the iconic image conveyed by the earlier trade mark (which can be transferred to other sectors, such as the wine sector) and by finding that it was highly likely that the mark applied for would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the owner (para. 43). As to the due cause for the use of the applicant’s mark, the GC recalls that the CTMR does not provide any unconditional right to register a surname as a CTM, let alone to register a forename as a trade mark. Consequently, the fact that the applicant’s forename is *Kenzo* is not sufficient to constitute due cause for the use of the mark applied for, for the purposes of Article 8(5) CTMR (para. 47).


◆ [T-414/13](#); **KENZO ESTATE / KENZO**, Judgment of 2 December 2015, *Kenzo Tsujimoto v OHIM* – EN. The IR holder filed an application for an IR designating the EU for the word mark ‘KENZO ESTATE’ for services in Classes 35, 41 and 43 (all wine-related). The opponent relied on the earlier CTM ‘KENZO’ claiming reputation for goods in Classes 3, 18 and 25. The OD dismissed the opposition stating that reputation was not proven. The BoA upheld the appeal of the opponent. The IR holder brought an action before the GC based on two pleas in law. The fact that the contested mark consisted exclusively of the earlier mark, to which another non-distinctive word (‘estate’) was added, made the two marks similar (paras 31-33). The evidence filed during the substantiation period together with the evidence filed to prove use clearly showed reputation of the earlier mark in a significant part of the relevant territory (para. 41). The BoA also correctly established a risk of an unfair advantage by taking into account the iconic image conveyed by the earlier trade mark, which can be transferred to the wine sector and by finding that it was highly likely that the mark applied for would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the owner (para. 54). As to the due cause, the CTMR does not provide any unconditional right to register a surname as a CTM, let alone to register a forename as a trade mark. Consequently, the fact that the IR holder’s forename is ‘Kenzo’ is not sufficient to constitute due cause for the use of the mark applied for, for the purposes of Article 8(5) CTMR (para. 58).

◆ [T-522/13](#); **KENZO ESTATE / Kenzo**, Judgment of 2 December 2015, *Kenzo v OHIM* – EN. The IR holder sought to register the word mark ‘KENZO ESTATE’ as an IR designating the EU for goods in Classes 29, 30, 31, 35, 41 and 43. The OD rejected the opposition. The BoA upheld the appeal,



upholding the opposition for some of the goods. The CTM applicant filed an application before the GC for partial annulment of the BoA's decision, that is to say, as far as it upheld the opposition in respect of the services in Classes 35, 41 and 43. It is not apparent that the BoA made any error of assessment in finding that the word 'estate', in association with the goods and services covered by the registration applied for, lacks distinctive character for a significant part of the relevant consumers. For English speakers, that word may denote the place of cultivation and production of wine, grapes and related goods as 'estate' means 'a large piece of landed property' (para. 33). The BoA correctly found that the earlier mark 'KENZO' had a reputation in the EU for clothing, cosmetics and perfume (para. 41). Services related to the retail of quality wines and services ancillary to the production and sale of such wines in the form of training, education, sommelier certification and so on, where wine will be the central focus, may, like clothing, perfumes and cosmetics, be part of the luxury sector. In addition, it is possible that proprietors of trade marks for cosmetics may also be active in the alcoholic drinks sector (para. 53). As regards the existence of a risk of an unfair advantage, it was by taking into account the existence of a link between the goods covered by the earlier mark and the services covered by the mark in respect of which registration is sought, the substantial reputation of the earlier trade mark, the high degree of similarity between the marks at issue and the sophisticated and iconic image conveyed by the earlier trade mark, which can be transferred to other sectors, such as the wine sector, that the BoA correctly found that it was highly likely that the IR designating the EU would ride on the coat-tails of the earlier trade mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the intervener in order to create and maintain the mark's image (para. 54). The BoA responded to the IR holder's argument concerning due cause by stating that 'no due cause [had] been demonstrated'. Admittedly, that is a laconic response, but it is adequate. The CTMR does not provide any unconditional right to register a name as a CTM, let alone to register a forename as a trade mark. Consequently, the fact that the IR holder's forename is 'Kenzo' is not sufficient to constitute due cause for the use of the IR designating the EU, for the purposes of Article 8(5) CTMR (para. 59).

◆ [T-131/12](#); *SPARITUAL / SPA et al.*, Judgment of 5 May 2015, *SPA Monopole v OHIM* – EN.

CTMA	Earlier marks
SPARITUAL	SPA 

The applicant sought to register the word mark represented above for goods in Class 3. An opposition pursuant to Article 8(1)(b) and Article 8(5) CTMR was filed, based on the earlier Benelux and German marks represented above in Classes 3 and 32. The OD upheld the opposition according to Article 8(5) CTMR, as the CTMA would take unfair advantage of the word mark 'SPA' covering goods in Class 32. The BoA annulled the OD's decision. No proof of reputation of the word mark 'SPA' for goods in Class 32, no proof of harm to the distinctive character or reputation of the earlier mark, no unfair advantage. The single plea was infringement of Article 8(5) CTMR. According to the BoA, reputation was proved only for the figurative mark with the *Pierrot* device, which could not be 'extended' to encompass the word mark. The GC stated that in order to prove enhanced distinctiveness or reputation, the owner of a registered




mark may rely on evidence of its use in a different form, as part of another registered mark and reputation, provided that the relevant public continues to perceive the goods and services at issue as originating from the same undertaking (para. 33). The word mark 'SPA', covering goods in Class 32, has a reputation because the word component 'SPA' is recognised by the public as distinctive for the goods marketed. Regardless of the presence or the absence of the *Pierrot* image, the relevant public continues to perceive the goods at issue as originating from a particular undertaking (p. 40). The BoA also erred in holding that the risk that use without due cause of the CTMA would take unfair advantage of the earlier mark had not been substantiated (para. 57). In the light of the considerable reputation of the word mark 'SPA' for goods in Class 32, a risk of free-riding cannot prima facie be ruled out (para. 59). The BoA should examine this question and rule on it. The contested decision is annulled.

◆◆[T-611/11](#); **MANEA SPA / SPA**, Judgment of 17 March 2015, *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM* – FR. The CTMA 'MANEA SPA' (word mark), in Classes 3, 24, 25, 43 and 44, was opposed on the basis of, inter alia, two earlier Benelux registrations of the word 'SPA' in Classes 3 and 32. Enhanced distinctiveness and reputation were claimed in respect of mineral water. The grounds of the opposition were Article 8(1)(b) and Article 8(5) CTMR. The OD upheld the opposition in respect of the goods and services in Classes 3 and 44 (beauty and wellness services, hammam, spa services, etc.) Both parties lodged an appeal. The BoA upheld the CTM applicant's appeal and dismissed the opposition both under Article 8(1)(b) and Article 8(5) CTMR. It found in substance that the signs were dissimilar given that the word 'SPA' is descriptive of hydrotherapy services. The BoA also dismissed the claim that the earlier word mark in Class 32 had acquired reputation, given that the vast majority of the evidence related to a figurative mark which is the object of a separate registration and in which the logo of a clown was found to surpass in importance the word element. The BoA relied for that purpose on the guidance of the CJ in 'Bainbridge' (13/09/07, C-234/06 P, EU:C:2007:514). The GC held that the BoA erred in denying that the evidence could not serve to establish the reputation of the earlier word mark 'SPA' in Class 32. Reputation can be acquired as part of another complex mark, notwithstanding the fact that the complex mark is also registered (25/10/2012, C-553/11, Proti et al., EU:C:2012:3861, paras 29-30). The 'Bainbridge' judgment only applies to situations in which an earlier right holder relying on a family of trade marks is requested to demonstrate genuine use of one or of some of them, having in mind that use of a sufficient number of trade marks is a requirement for substantiating the existence of a series. This was not the case here (paras 77-79). The reputation of the word mark 'SPA' can therefore be established on the basis of a complex figurative sign associating the word 'SPA' with the device of a clown. This is so because the word element holds a predominant position in the complex sign (para. 83). The statement of a director of the opponent, according to whom the clown is the 'brand ambassador', does not contradict this finding (para. 82). Use of the word 'SPA' in the press also corroborates the finding that this word alone is reputed (para. 84-85).



◆ [T-55/13](#); *F1H2O / F1 et. al.*; Judgment of 21 May 2015; *Formula One Licensing BV v OHIM & Idea Marketing SA* – EN.

CTMA	Earlier marks
F1H2O	<p style="text-align: center;">F1</p> 

The applicant sought to register the word mark 'F1H2O' as a CTM for goods and services within Classes 9, 25, 38 and 41. An opposition based on the earlier registrations (at national, international and Community level) concerning the word mark 'F1', 'the earlier word mark', and the figurative marks represented above, 'the earlier figurative marks', registered for goods in the same classes, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD rejected the opposition. The BoA dismissed the CTM applicant's appeal. The applicant filed an action before the GC, alleging two main pleas in law: the infringement of Article 8(1)(b) CTMR and the infringement of Article 8 (5) CTMR. The GC confirmed the decision of the BoA. The GC even rejected the second plea in law. First of all, it highlighted that the applicant has not proved the reputation of the earlier word mark relied on. Moreover, it stated that the relevant public would not establish a link between the earlier figurative marks and the mark applied for because of the several abovementioned differences.

◆ [C-125/14](#); *Be impulse / Impulse*, Preliminary ruling of 3 September 2015, *Iron & Smith kft v Unilever NV* – HU. This request for a preliminary ruling was made in proceedings between Iron & Smith kft ('Iron & Smith', the applicant), on the one hand, and Unilever NV ('Unilever', the opponent), on the other hand, concerning the variation of the decision of the Hungarian IP Office refusing registration of the mark 'Be impulsive' applied for by Iron & Smith. The earlier CTM 'Impulse' was found to have reputation across the EU, but not in Hungary. The referring CJ observed that Article 4(3) TMD and Article 9(1) CTMR do not offer any indication as to what is the relevant geographical territory within the EU in order to establish that a CTM has a reputation. Furthermore, it is unclear, even if the trade mark has such a reputation, whether it is possible that, where such a mark is unknown in the Member State concerned, the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier CTM (para. 13). First of all, the CJ observed that both Article 4(3) TMD and Article 9(1)(c) CTMR contain the expression 'has a reputation in the Community' which has the same meaning (para. 16). Therefore, the CJ, recalling the judgment in the 'PAGO International' case, stated: 'if the reputation of an earlier CTM is established in a substantial part of the territory of the EU which may coincide with the territory of a single Member State, that mark has a reputation in the EU and the CTM owner is not required to produce evidence of that reputation in the Member State in which the application for registration of the later national mark, which is the subject of an opposition, has been filed' (paras 17-20). Secondly, the provisions concerning the requirement of genuine use of the CTM (Article 15(1) and Article 51 CTMR) and the criteria laid down by the case law in order to prove genuine use are not relevant as such for the purpose of establishing a 'reputation' within the meaning of Article 4(3) TMD (paras 23-24) since those provisions pursue a different objective (para. 21). Finally, the CJ, recalling the



judgment in the ‘Intel’ case, ruled that if the earlier CTM has already acquired a reputation in a substantial part of the territory of the EU, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the CTM may still benefit from the enlarged protection introduced by Article 4(3) TMD where it is shown that a commercially significant part of that public is familiar with that mark and makes a connection between it and the later national mark and there is either actual and present injury to its mark or a serious risk that such injury may occur in the future (paras 27-34).

◆◆[T-624/13](#); *Darjeeling / DARJEELING et al.*, Judgment of 2 October 2015; *The Tea Board v OHIM – EN*.

CTMA	Earlier marks
	<p>1. DARJEELING</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark, ‘DARJEELING’, and the earlier collective figurative mark represented above, registered for goods in Class 30, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC. The definition of the relevant public is a necessary prerequisite for the purposes of applying Article 8(5) CTMR; this public varying according to the alleged type of injury (paras 70-71). REPUTATION AND LINK: The assessment of whether a CTM falling under Article 66(2) CTMR has a reputation must be carried out using the same criteria as those applicable to individual marks (paras 74-76). The GC concludes that the BoA continued its analysis for the purposes of applying Article 8(5) CTMR while relying on two hypothetical premises: the first being that the earlier trade marks enjoyed a reputation, the strength of which was that which the applicant had ascribed to them, namely, exceptional, and the second that it was possible that the relevant public might establish a link between the signs at issue (paras 78-93). DETRIMENT TO DISTINCTIVENESS: After considering that the word element ‘darjeeling’ can be used for marks other than those earlier marks, as is clear from the second sentence of Article 66(2) CTMR, and that the existing unique connection between the geographical name ‘Darjeeling’ and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (paras 99-113). DETRIMENT TO REPUTATION: The GC takes into account that the applicant did not mention the



characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that no evidence establishes that the image generally conveyed by the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (paras 114-122). UNFAIR ADVANTAGE: Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the case law that states that where an earlier trade mark with an exceptional reputation is involved, even if the goods and services covered by the signs at issue are quite different, it is not altogether inconceivable that the relevant public could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element 'darjeeling' shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction of that mark. The same cannot be said of the rest of contested services (paras 136-145). CONCLUSION: The contested decision is partially annulled. It is left to the BoA to re-examine the opponent's arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public's mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some of the goods and services and the examination on the existence of due cause should be carried out.

◆◆[T-625/13](#); *Darjeeling collection de lingerie / DARJEELING et al.*, Judgment of 2 October 2015; *The Tea Board v OHIM* – EN.

CTMA	Earlier marks
	<p>1. DARJEELING</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark 'DARJEELING', and the earlier collective figurative mark represented above, registered for goods in Class 30, was filed



on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC. The definition of the relevant public is a necessary prerequisite for the purposes of applying Article 8(5) CTMR; this public varying according to the alleged type of injury (paras 70-71). **REPUTATION AND LINK:** The assessment of whether a CTM falling under Article 66(2) CTMR has a reputation must be carried out using the same criteria as those applicable to individual marks (paras 74-76). The GC concludes that the BoA continued its analysis for the purposes of applying Article 8(5) CTMR while relying on two hypothetical premises: the first being that the earlier trade marks enjoyed a reputation, the strength of which was that which the applicant had ascribed to them, namely, exceptional, and the second that it was possible that the relevant public might establish a link between the signs at issue (paras 78-93). **DETRIMENT TO DISTINCTIVENESS:** After considering that the word element 'darjeeling' can be used for marks other than those earlier marks, as is clear from the second sentence of Article 66(2) CTMR, and that the existing unique connection between the geographical name 'Darjeeling' and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (paras 99-113). **DETRIMENT TO REPUTATION:** The GC takes into account that the applicant did not mention the characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that no evidence establishes that the image generally conveyed by the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (paras 114-122). **UNFAIR ADVANTAGE:** Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the jurisprudence that states that where an earlier trade mark with an exceptional reputation is involved, even if the goods and services covered by the signs at issue are quite different, it is not altogether inconceivable that the relevant public could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element 'darjeeling' shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction of that mark. The same cannot be said of the rest of the contested services (paras 136-145). **CONCLUSION:** The contested decision is partially annulled. It is left to the BoA to re-examine the opponent's arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public's mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some of the goods and services and the examination on the existence of due cause should be carried out.



◆♦[T-626/13](#); *Darjeeling collection de lingerie / DARJEELING et al.*, Judgment of 2 October 2015; *The Tea Board v OHIM* – EN.

CTMA	Earlier marks
	<p>1. DARJEELING</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark 'DARJEELING' and the earlier collective figurative mark represented below, registered for goods in Class 30, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent's appeal. The opponent filed an action before the GC. The definition of the relevant public is a necessary prerequisite for the purposes of applying Article 8(5) CTMR; this public varying according to the alleged type of injury (paras 70-71). REPUTATION AND LINK: The assessment of whether a CTM falling under Article 66(2) CTMR has a reputation must be carried out using the same criteria as those applicable to individual marks (paras 74-76). The GC concludes that the BoA continued its analysis for the purposes of applying Article 8(5) CTMR while relying on two hypothetical premises: the first being that the earlier trade marks enjoyed a reputation the strength of which was that which the applicant had ascribed to them, namely, exceptional, and the second that it was possible that the relevant public might establish a link between the signs at issue (paras 78-93). DETRIMENT TO DISTINCTIVENESS: After considering that the word element 'darjeeling' can be used for marks other than those earlier marks, as is clear from the second sentence of Article 66(2) CTMR, and that the existing unique connection between the geographical name 'Darjeeling' and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (paras 99-113). DETRIMENT TO REPUTATION: The GC takes into account that the applicant did not mention the characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that no evidence establishes that the image generally conveyed by the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (paras 114-122). UNFAIR ADVANTAGE: Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the jurisprudence that states that where an



earlier trade mark with an exceptional reputation is involved, even if the goods and services covered by the signs at issue are quite different, it is not altogether inconceivable that the relevant public could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element ‘darjeeling’ shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction of that mark. The same cannot be said of the rest of the contested services (paras 136-145). **CONCLUSION:** The contested decision is partially annulled. It is left to the BoA to re-examine the opponent’s arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public’s mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some of the goods and services and the examination on the existence of due cause should be carried out.

◆♦[T-627/13](#); *Darjeeling / DARJEELING et al.*, Judgment of 2 October 2015; *The Tea Board v OHIM – EN*.

CTMA	Earlier marks
	<p>1. DARJEELING</p>  <p>2.</p>

The applicant sought to register the figurative mark represented above as a CTM for goods and services within Classes 25, 35 and 38. An opposition based on the earlier collective word mark ‘DARJEELING’ and the earlier collective figurative mark represented above, registered for goods in Class 30, was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition. The BoA dismissed the opponent’s appeal. The opponent filed an action before the GC. The definition of the relevant public is a necessary prerequisite for the purposes of applying Article 8(5) CTMR; this public varying according to the alleged type of injury (paras 70-71). **REPUTATION AND LINK:** The assessment of whether a CTM falling under Article 66(2) CTMR has a reputation must be carried out using the same criteria as those applicable to individual marks (paras 74-76). The GC concludes that the BoA continued its analysis for the purposes of applying Article 8(5) CTMR while relying on two hypothetical premises: the first being that the earlier trade marks enjoyed a reputation the strength of which was that which the applicant had ascribed to them, namely, exceptional, and the second that it was possible that the relevant



public might establish a link between the signs at issue (paras 78-93). **DETRIMENT TO DISTINCTIVENESS:** After considering that the word element 'darjeeling' can be used for marks other than those earlier marks, as is clear from the second sentence of Article 66(2) CTMR, and that the existing unique connection between the geographical name 'Darjeeling' and Darjeeling tea does not exist between that name and the goods and services covered by the contested mark, the GC confirms, in the absence of evidence to establish a serious likelihood of a change in the economic behaviour of the average consumer, that there is no risk of detriment to the distinctiveness of the earlier mark (paras 99-113). **DETRIMENT TO REPUTATION:** The GC takes into account that the applicant did not mention the characteristics of the goods or services covered by the contested mark which would be liable to have a negative impact on the image of the earlier trade marks; that no evidence establishes that the image generally conveyed by the contested goods and services is negative or that there is antagonism between the nature or the method of use of tea and the contested goods or services; and that there is no unique connection between this region and the contested goods and services. Thus, the GC confirms that there is no risk of detriment to the reputation of the earlier mark (paras 114-122). **UNFAIR ADVANTAGE:** Even though the GC recognises that the characteristics normally associated with a mark with a reputation for tea cannot be considered to be such as to bring any advantage to a mark under which goods and services such as the contested ones are marketed, it refers to the jurisprudence that states that where an earlier trade mark with an exceptional reputation is involved, even if the goods and services covered by the signs at issue are quite different, it is not altogether inconceivable that the relevant public could be led to transfer the values of that earlier mark to the goods or services covered by the mark applied for. The GC concludes, in the light of the fact that the hypothetical premise on which the contested decision is based refers to a reputation of exceptional strength, the positive qualities evoked by the word element 'darjeeling' shared by the signs at issue (the image of sophistication or exotic sensuality) are capable of being transferred to some of the goods and services covered by the mark applied for (namely the goods in Class 25 and the retail services in Class 35 related to those goods) and, as a result, of strengthening the power of attraction of that mark. The same cannot be said of the rest of the contested services (paras 136-145). **CONCLUSION:** The contested decision is partially annulled. It is left to the BoA to re-examine the opponent's arguments in order to reach a definitive conclusion on whether any of the earlier mark is reputed (and how strong this reputation would be) and only if so, to reach a definitive conclusion on whether there is a link between the marks in the public's mind. If the BoA concludes that the reputation is exceptionally strong and that there is a link between the marks, a risk of unfair advantage should be found in relation to some of the goods and services and the examination on the existence of due cause should be carried out.



◆ [T-364/13](#); **KAJMAN / DEVICE OF A CROCODILE** et al., Judgment of 30 September 2015; *Eugenia Mocek, Jadwiga Wentka KAJMAN Firma Handlowo-Uslugowo-Produkcyjna v OHIM* – EN.

CTMA	Earlier mark
	

The applicant sought to register the figurative sign represented above as a CTM for goods and services in Classes 18, 20, 22, 25 and 36. An opposition was filed against the registration on the basis, inter alia, of the earlier figurative CTM represented above, which covers, inter alia, goods and services in Classes 18, 20, 24 and 25. The OD rejected the opposition. The BoA annulled the decision of the OD in part. The BoA considered there was a likelihood of confusion between the marks at issue in respect of goods in Classes 18 and 25. The applicant filed an application for annulment and the opponent filed an application for annulment in part and alteration before the GC. The GC rejected the argument of the applicant that the BoA's decision grants the opponent an unjustified monopoly of the representation of a reptile of the order of *Crocodylia*, regardless of its degree of artistic stylisation. The GC stated that the advantage of the legal regime of the CTM lies precisely in the fact that it enables holders of an earlier trade mark to oppose the registration of later marks which take unfair advantage of the distinctive character or the repute of the earlier trade mark (para. 72).


◆ [C-603/14 P](#); **The English Cut / EL CORTE INGLES** et al., Judgment of 10 December 2015, *El Corte Inglés SA v OHIM* – ES. The applicant sought to register the word mark 'The English Cut' as a CTM for goods and services within Class 25. An opposition based, inter alia on the earlier word mark 'El Corte Inglés' and other Community figurative marks was filed. The OD dismissed the opposition and the BoA dismissed the appeal. The GC in T-515/12 found a 'low' degree of conceptual similarity between the signs, but took the view that the signs were dissimilar overall. As a consequence, Article 8(1)(b) CTMR cannot be applied because there is no likelihood of confusion and Article 8(5) CTMR is not applicable either. The opponent filed an appeal before the CJ. The CJ found no distortion of facts and declared inadmissible the alleged infringement of Article 8(1)(b) CTMR. The CJ upheld the third ground of appeal alleging infringement of Article 8(5) CTMR. The GC erred in law in ignoring that the degree of similarity of the signs necessary to apply Article 8(1)(b) and Article 8(5) CTMR is different (para. 41), as the latter does not request a finding of LOC, but just a link between the signs (para. 42). Since a certain degree of (conceptual) similarity was found between the signs, the GC should have examined whether that degree of similarity, albeit low, was not sufficient, on account of the presence of other relevant factors such as the renown or reputation of the earlier mark, for the relevant public to establish a link between those signs, for the purpose of Article 8(5) CTMR (paras 43-48) (see judgment of 20/11/2014, C-581/13 P & C-582/13 P, Golden balls, EU:C:2014:2387, para. 73).

[T-517/13](#); **QUO VADIS / QUO VADIS**, Judgment of 29 October 2015, *Editions Quo Vadis v OHIM* – EN. The OD partially upheld the opposition ex Article 8(5) CTMR with regard to some products in Class 33



and some services in Class 35. The BoA annulled the OD's decision and rejected the opposition also regarding Article 8(5) CMR, since there was no link between the contested mark, which was used in relation to 'alcoholic beverages and the retailing of wine', and the earlier mark, which was used in relation to 'time planners'. The GC confirms the absence of any proximity or link between, on the one hand, 'alcoholic beverages and the retailing of wine' and, on the other, 'time planners'. They have a completely different nature, purpose and method or use. Their producers and suppliers are active in completely different fields of business without the slightest overlap or link (para. 30). Furthermore, the public at which the goods and services covered by the marks at issue are aimed do not overlap. The earlier goods and services target youngsters or teenagers, whereas the contested goods and services are not, by definition, mentioned in relation to youngsters or teenagers (para. 32). The distinctive character of the earlier mark is at most average, as the expression 'QUO VADIS' is a Latin phrase meaning 'Where are you going?', which is used by third parties in various sectors in connection with other goods and services (para. 35). Since no link between the marks at issue may be established, the use of the mark applied for is not likely to take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier word mark. The action is dismissed.

[C-548/14 P](#); **GRAZIA / GRAZIA**, Order of 17 September 2015, *Arnoldo Mondadori Editore SpA v OHIM* – EN.

CTMA	Earlier mark
GRAZIA	

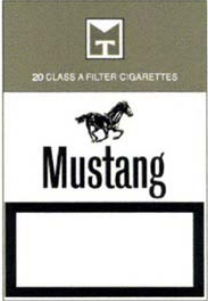

As to the application of Article 8 (5) CTMR the GC confirmed conclusions of the BoA that the 'link' between the marks in order to establish the encroachment required by the aforementioned provision is not present in this case. In particular, the goods and services are too different and completely unrelated. According to Article 169(1) RPCJ, an appeal is to seek to have set aside, in whole or in part, the decision of the GC as set out in the operative part of that decision. The CJ, however, finds that from the terms in which the appeal is couched that it seeks to have that judgment partially set aside on account of infringements of the CTMR. Consequently, lack of a reference, in the form of order sought, to the operative part of the judgment under appeal does not preclude the CJ from deciding on the action to be taken concerning the dispute and cannot render the head of claim inadmissible (paras 21–24). The appellant claimed that the comparison of goods and services has not been correctly examined. The CJ recalled that the assessment of the similarities between the goods and services at issue is of a factual nature and, save where the evidence and facts are distorted, is not subject to review by the CJ in the course of an appeal. The GC duly assessed the similarities between the goods and services. As regards the distortion, given the exceptional nature of a complaint of distortion, Article 256 TFEU, Article 58, first paragraph, of the Statute of the CJ and Article 168(1) (d) RPCJ, an appellant must indicate precisely the evidence alleged to have been distorted by the GC and show the errors of appraisal which, in its view, led to that distortion. Such distortion must be obvious from the documents on the GC's file, without there being any need to carry out a new assessment of the facts and evidence. Since the claimed distortion



has not been substantiated it has been found as manifestly inadmissible (paras 37-43). The appellant further stated that the GC incorrectly found that the earlier mark's reputation is not strong but 'only' normal. The CJ finds that the assessment on the degree or strength of a reputation of a mark is a question of facts, which renders the appellant's claim as manifestly inadmissible (paras 57-58). The appellant further argued that the GC erred in finding that there was no link between the marks for the purpose of applying Article 8(5) CTMR. The GC would have erred in the assessment of the applicable factors and of the relevant case law (para. 59). The CJ underlines that as regards calling into question of the GC's assessment of each of the cumulative conditions for establishing the link between the marks, it must be pointed out that, in so doing, the appellant calls into question the GC's factual assessments relating to the nature of the goods and services concerned by the marks at issue, the relevant sections of the public at which those goods and services are aimed, the strength of the earlier mark's reputation and the distinctive character of that mark, but does not, however, put forward any error of law which would mar the judgment under appeal (para. 67). The CJ finally makes clear that in accordance with the case law, the GC correctly concluded that in the absence of any link that may be established between the marks at issue, the use of the mark in respect of which registration is sought is not likely to take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier figurative mark (paras 77-78).

♦ [T-534/13](#); *Krispy Kreme DOUGHNUTS / DONUT et al.*, Judgment of 7 October 2015, *Panrico, S.A. v OHIM* – ES. The applicant registered the figurative mark as a CTM for goods and services within Classes 30 and 42. An application for invalidity was filed based on the ground of current Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) and Article 8(5) CTMR. The CD dismissed the application for invalidity in its entirety. The BoA dismissed the invalidity applicant's appeal. The invalidity applicant filed an action before the GC. ARTICLE 8(5) CTMR: The GC confirms that, since the signs are neither visually nor conceptually similar, being phonetically similar only to a remote degree, the dissimilarity between the signs is so significant that a link between them cannot be established. Consequently, the BoA correctly found that there was no injury of the earlier marks' distinctiveness or reputation (para. 73). Moreover, the GC also confirms that arguing that the lack of the risk of injury 'is hardly justifiable' does not constitute the required evidence to conclude prima facie the existence of such risk (paras 75-78).

[T-606/13](#); *Mustang / MUSTANG et al.*, Judgment of 18 November 2015, *Mustang – Bekleidungswerke GmbH & Co. KG v OHIM* – DE.

CTMA	Earlier marks
	<p>1. MUSTANG</p>  <p>2. MUSTANG</p>



The CTM applicant sought to register the figurative sign above as a CTM for goods in Class 34. The OD rejected the opposition, which had been based on Article 8(5) CTMR and the two earlier German word marks displayed above, registered for goods in Class 25. The BoA dismissed the appeal. The opponent filed an application before the GC for annulment of the BoA's decision. ON THE DEGREE OF REPUTATION OF THE EARLIER MARKS: even though a degree of recognition of more than 80 % for 17 years among the German public was corroborated by the fact that 27 % of this public owned (clothing) products bearing the earlier word mark, the GC found this reputation to be important, albeit not 'exceptionally high' in the absence of an explanation on the method used for the collection and evaluation of said data and in the absence of proof regarding the share held by the products in question in a market with many undertakings such as the German market for clothing articles. It follows that the opponent cannot rely on the case law according to which, when the reputation of an earlier mark is exceptionally high, the opponent does not need to adduce further factual elements to establish unfair advantage or detriment to its mark pursuant to Article 8(5) CTMR (paras 27-36). As far as the earlier figurative mark is concerned, the 'galloping horse' was found to be a non-negligible element of the mark. It follows that, by only submitting evidence of other complex marks containing the word element 'mustang', the opponent did not prove the reputation of its mark (paras 37-39). ON THE SIMILARITY OF THE SIGNS: The GC confirmed the BoA's finding that the similarity between the CTMA and the earlier word mark was more than average, because of an average visual similarity and of phonetic and conceptual identity. More in detail, the signs are not highly similar, as the opponent claimed: the fact that the black frame is meant to contain the notices imposed by law on the negative effects of tobacco for health does not make it a descriptive element. Moreover, the upper square containing the letter 'T' is sufficiently large so as not to consider it a negligible element (paras 45-47). ON THE LINK BETWEEN THE MARKS: The CTMA's tobacco products and the earlier mark's clothing articles are dissimilar because of a difference in their nature. The applicant did not show that there is a general practice in the market for clothing articles to be sold under tobacco products' marks nor for tobacco products to bear clothing articles' marks. Even if the fact that cigarette TM-holders 'Marlboro' and 'Camel' sold clothes bearing their marks was to be considered as well-known, this would still not suffice to establish a general practice (paras 53-54). The GC thus concluded that, when it comes to the global assessment of all the relevant factors, despite the similarity between the marks and the important reputation of the earlier mark, the distance between the goods will prevent the relevant public from establishing a link between the marks (para. 55). ON THE RISK OF DETRIMENT: The GC further ruled that, even if a link were to be established, the opponent had not proven that use of the CTMA would be detrimental to the repute of the earlier mark. The study submitted by the opponent, showing that tobacco companies have a worse appraisal than pharmacists, is not relevant for this assessment. Tobacco products are undisputedly hazardous to health and associated with something bad for one's health by the German public, but this on its own is insufficient to imply a loss of attractive force by the earlier mark due to its association with tobacco. This is also shown by the opponent's argument, insofar as it submitted that the 'Davidoff' mark was originally used for tobacco products but might now be associated with perfumes (paras 57-66). The opponent's action is therefore dismissed in its entirety (para. 67).

F. Other issues

◆ [T-187/14](#); **FLEX**, Judgment of 7 October 2015, *Sonova Holding AG v OHIM* – EN. The applicant sought the registration of the word mark 'FLEX' for 'hearing aids and hearing aids components; hearing aids accessories; parts and fittings for the aforesaid' in Class 10. The OD's decision, rejecting the application




for registration in its entirety based on Article 7(1)(c) and Article 7(2) CTMR, was confirmed by the BoA. The applicant filed an action before the GC alleging an infringement of Article 7(1)(c) and Article 7(2) CTMR. The GC confirmed the BoA's decision and dismissed the appeal. The GC then refused the applicant's complaint that the decision was in breach of the principles laid down in the Guidelines relating to procedures before the Office (Part B, Section 4, paragraph 2.3.2.4), according to which, in order to refuse abbreviations, 'it is not only necessary for the examiner to show that the abbreviation actually is a composition of terms which on their own are purely descriptive, but in addition it must be shown that this abbreviation is commonly used or at least understood by the relevant specialists in the field, as an abbreviation identifying the goods as to their characteristics'. The GC held that according to the guidelines it is not necessary to show common use of an abbreviation, but suffices that an abbreviation be understood by a not insignificant number of persons amongst the relevant public. Moreover, the Office Guidelines cannot prevail over the provisions of the Regulation and, finally, the question whether the Office guidelines refer or do not refer to relevant GC judgments is irrelevant for the outcome of the present proceedings (paras 31-34).



IV. Proof of Use

[T-46/13](#); *KIT, EL SABOR DE NAVARRA / SABORES DE NAVARRA*, Judgment of 21 January 2015, *Sabores de Navarra, A.I.E. v OHIM – ES*.

CTM	Earlier mark
KIT, EL SABOR DE NAVARRA	 <i>La Sabiduría del Sabor</i>

Signs appearing as the Proof of use		Sign as compared by by BoA
SABORES DE NAVARRA		

The applicant filed an invalidity action against the CTM ‘KIT, EL SABOR DE NAVARRA’ (in English: The flavour of Navarra) registered for goods in Classes 29, 30 and 33. It was based on the earlier CTM registration as represented above for goods and services in Classes 29, 30, 33, 39 and 42. The CTM proprietor requested that the invalidity applicant file proof of use of the earlier CTM. The CD partially upheld the application for some of the contested goods. Both parties filed an appeal against this decision. The BoA dismissed the appeal filed by the invalidity applicant and upheld the one filed by the CTM proprietor on the grounds that the evidence of use submitted shows use of signs that differ in essential aspects of the signs as registered and alters its distinctive character. Therefore, the evidence submitted does not demonstrate genuine use of the earlier CTM. The applicant for invalidity filed an action before the GC. With regard to the place of use, the GC found that submitting labels drafted in certain languages is in itself insufficient to show genuine use. Other kinds of evidence in support of real use, such as invoices that confirm sales are necessary (paragraph 28). The figurative sign as appearing in the evidence and the one compared in the contested decision only differ in ancillary and ornamental elements as well as in the colours and are insufficient to alter the distinctiveness of a trade mark. (para. 34). In order to evaluate whether the distinctive character of a mark has been altered, it is necessary to examine the distinctive and dominant character of the elements which have been omitted in view of their inherent characteristics and relative position among the different elements of the marks as registered (para. 36). When a sign is composed of one or various non-distinctive elements, its modification or omission has not sufficient impact as to alter the distinctive character of the mark as a whole (para. 36). The GC focused on the perception of the Spanish consumer because the proof of use essentially refers to this territory. The expression ‘Sabores de Navarra’ (Flavours of Navarra) will be seen by the Spanish public as an expression essentially descriptive because it informs about the geographical origin and characteristics of the goods in question. ‘Sabores’ is descriptive from the moment at which it



designates a characteristic of these goods (para. 39 and 44). 'La sabiduría del sabor' (the wisdom of flavour) is not a descriptive expression, it uses a human quality, wisdom ('la sabiduría') to a feeling ('sabor' – flavour). Consequently, the distinctive character of the earlier is essentially located in this expression (paras 40-41) and its omission in the signs as used have a sufficient entity as to alter the distinctive character of the mark as registered (para. 42). The applicant's arguments concerning the perception of the public not located in Spain are insufficient to declare the illegality of the contested decision because the proof of use does not reflect effective use outside Spain (para. 45). Alteration of the mark as registered is present even under the assumption that 'Sabores de Navarra' is the dominant element of the sign from the visual and phonetic perspective (para. 46). Principles of equal treatment and sound administration must be reconciled by the principle of legality (para. 47). The appeal was dismissed.

◆ [T-287/13](#); **HUSKY**, Judgment of 13 February 2015, *Husky CZ s.r.o. v OHIM* – EN. The CTM proprietor registered the word mark 'HUSKY' as a CTM for goods within Classes 3, 9, 14, 16, 18 and 25. An application for revocation was filed based on the ground that the mark at issue had not been put to genuine use in connection with the goods in respect of which it had been registered according to Article 51(1)(a) CTMR. The CD has extended, on request by the CTM proprietor, the time limit for the submission of the evidence proving genuine use several times. The CD granted the application for revocation in part. It decided that the mark could remain registered for 'bags' in Class 18 and 'shirts, trousers, jackets, coats, waistcoats, jumpers, pullovers, sweaters, boots, shoes, tops, jeans, belts and footwear' in Class 25. The BoA dismissed the applicant's appeal. The revocation applicant filed an action before the GC relying on three pleas in law: the taking into consideration of (i) evidence submitted out of time; (ii) untranslated documents; (iii) undated documents as evidence of proof of use. As to the third plea in law (undated documents), Rule 22 CTMIR (applicable to revocation proceedings in accordance with Rule 40(5) CTMIR) refers to indications concerning the place, time, extent and nature of use, and gives examples of acceptable evidence; that rule does not state that each item of evidence must necessarily give information about all four elements to which proof of genuine use must relate (para. 65). An accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (para. 66). The fact that invoices do not specify whether they relate to goods covered by the mark does not mean that they relate *ipso facto* to other trade marks. At the very most, in analysing the accumulated evidence, the probative value of those invoices may be qualified, but not dismissed (para. 69). In order to establish use, the proprietor of a mark may legitimately rely on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form may itself be registered as a trade mark (para. 72). The GC dismissed the action in its entirety, rejecting all three pleas.

◆ [T-41/12](#); **L'Wren Scott / LOREN SCOTT**, Judgment of 27 February 2015, *LS Fashion, LLC v OHIM*, – EN. The applicant sought to register the word mark 'L'Wren Scott' as a CTM, inter alia, for goods within Class 25. An opposition based on the earlier Spanish word mark 'LOREN SCOTT', registered for goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the applicant's appeal, finding the genuine use of the earlier mark sufficiently proven, the goods identical or similar and the signs visually and aurally similar to an average degree. According to the BoA there was a likelihood of confusion between the signs. The applicant filed an action before the GC.



In its first plea in law, the applicant claims that the evidence submitted by the opponent in order to show genuine use of the earlier mark does not satisfy the conditions laid down by the case law. The GC first of all summarises the relevant case law related to proof of use (paras 18-26). Subsequently, the GC provides the summary of the evidence submitted by the opponent (paras 29-35). According to the GC, the fact that the earlier mark does not appear in full on certain invoices in the list setting out the articles sold does not mean that they cannot be taken into consideration. The earlier mark appears at the top of the header and, through the identification of the goods mentioned on the invoice, it is clear that those goods can refer solely to the earlier mark. Furthermore, it is not unusual for the trade mark not to even be mentioned in the list of goods sold (para. 37). It is clear that the small amount from sales is due to the very low price of the goods marketed, with the result that, when applied to the volume of sales, it cannot be regarded as derisory, particularly since the invoices were submitted merely by way of illustration, as is apparent from the fact that their numbering and dates are spaced out and those data are coherent and chronological, and thus do not represent the amount of actual sales (paras 41-42). The invoices were made out to different persons, which demonstrates that the earlier mark was used publicly and externally (para. 45). The sales effected, even though they are not considerable, constitute use which objectively is such as to create or preserve an outlet for the goods concerned, the commercial volume of which, in relation to the period and frequency of use, is not so low that it may be concluded that the use is merely token (para. 46). The plea was rejected.


◆ [T-254/13](#); **STAYER**, Judgment of 4 June 2015, *Stayer Ibérica, SA v OHIM* – EN. The GC recalls the judgment in *New Yorker SHK Jeans v OHIM*, C-621/11 P, and states that where evidence that is considered to be relevant for the purposes of establishing use of the mark at issue has been produced within the time limit set by the Office under Rule 40(6) CTMIR, the submission of additional proof of such use remains possible after the expiry of that time limit. In such a case, the Office is in no way prohibited from taking account of evidence submitted out of time through use of the discretion conferred on it by Article 76(2) CTMR (para. 32). In the context of invalidity proceedings, taking facts or evidence of genuine use submitted out of time into account is particularly likely to be justified where the Office considers, first, that the evidence submitted late is, on the face of it, likely to be relevant to the outcome of the invalidity proceedings brought before it and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not preclude such evidence being taken into account (para. 33). The fact that the invoices submitted out of time concerned a larger number of goods than those produced before the CD is not capable of calling into question the fact that they constitute additional evidence (para. 37). Furthermore, it is not necessary that the party concerned be unable to submit evidence within the time limit (para. 41).

◆◆ [T-660/11](#); **POLYTETRAFLON / TEFLON**, Judgment of 16 June 2015, *Polytetra GmbH v OHIM* – EN. The applicant sought to register the word mark 'POLYTETRAFLON' as a CTM for a range of goods in Classes 1, 11, 17 and 40. An opposition was lodged, based on the earlier word mark 'TEFLON'. The opposition was filed on the grounds of Article 8(1)(b) and Article 8(5) CTMR. The OD dismissed the opposition in its entirety. The BoA annulled the OD's decision and rejected the contested mark. The CTM applicant filed an action before the GC raising two pleas in law: (i) breach of Article 8(1)(b) CTMR and (ii) breach of Article 42(2) and (3) CTMR. Additionally, the GC examined, on its own motion, whether the duty to state reasons for the contested decision had been observed under Article 75 CTMR. The GC found that the fact that the earlier mark 'TEFLON' was used in respect of third parties' final products



incorporating the opponent's coating does not permit the conclusion that it has been used for the final products for which that mark was registered. Even in the event that third parties' final products incorporate the opponent's non-stick materials or if their coating is manufactured from those materials, they, both by their nature and by their intended purpose, are essentially different from non-stick materials and do not belong to the same group (paras 68-69). Thus, the 'TEFLON' mark used by third parties in respect of their final products does not perform the essential function of guaranteeing the origin of those final goods (para. 81). The presence of the earlier mark, identifying a component of the product, in advertisements, brochures or even on the product itself is a commercial strategy of the manufacturer of the final product indicating certain functional characteristics of that product due to the presence of a component identified by the 'TEFLON' mark. Use of the 'TEFLON' mark in respect of third parties' final products may thus result in that mark performing an advertising or communication function aimed at informing or persuading the consumer. Nevertheless, it does not thereby perform the essential function of guaranteeing the origin of the final product, the only relevant factor for the assessment of genuine use of a mark within the meaning of Article 42(2) and (3) CTMR (paras 85-86). The GC therefore concluded that the BoA's decision was vitiated by an error of law in that the BoA wrongly found that the opponent had proved use of the earlier mark for final products on account of the fact that the coating produced by the opponent was integral to the makeup and structure of third parties' final products and that the earlier mark had been displayed in brochures and advertisements for those goods (para. 91).

◆ [T-24/13](#); **CACTUS OF PEACE, CACTUS DE LA PAZ / Cactus**, Judgment of 15 July 2015, *Cactus SA v OHIM* – EN.


CTMAs	Earlier marks
<p style="text-align: center;">CACTUS OF PEACE</p> <p style="text-align: center;">CACTUS DE LA PAZ</p>	 <p style="text-align: center;">CACTUS</p>

The applicant sought to register the figurative sign 'CACTUS OF PEACE, CACTUS DE LA PAZ' as a CTM for goods and services within Classes 31, 35 and 39. An opposition based on the earlier word mark 'CACTUS' as well as on an earlier figurative mark 'Cactus' was filed on the grounds of Article 8(1)(b) CTMR. The OD partially upheld the opposition for 'seeds, natural plants and flowers' in Class 31 and 'gardening, plant nurseries, horticulture' in Class 44, which are covered by the earlier word mark and it accepted the registration of the contested CTMA for the services in Class 39. The BoA upheld the appeal filed by the opponent and dismissed the opposition in its entirety. It held that the OD had erred in considering that the applicant had adduced proof of genuine use of the earlier marks in respect of 'retailing of natural plants and flower grains; fresh fruits and vegetables' services in Class 35. No proof of genuine use had been provided either for the goods and services covered by the earlier marks. Lastly, the BoA rejected the evidence produced by the applicant to prove genuine use of the earlier marks in respect of the services in Class 39, on the ground that the evidence had been submitted for the first time before the BoA. The opponent filed an action before the GC relying on three pleas in law. In the first plea in law, the opponent alleged that the BoA infringed Article 42(2) CTMR, by finding that it had failed to



show that, in relation to ‘natural flowers and plants, grains’ in Class 31, the earlier marks had been put to genuine use (para. 41). The GC pointed out that several documents provided by the opponent, showed only the figurative element of the earlier figurative mark, namely the stylised cactus, without the word element ‘Cactus’ (para. 59). In this regard, the opponent argued that the use of the stylised cactus constituted use of the earlier figurative mark that did not alter its distinctive character (para. 59). It further submitted that the use of a stylised cactus was used as an abbreviation of the earlier figurative mark and therefore could be used for the purposes of establishing genuine use of the earlier figurative mark and therefore, there was no alteration of its distinctive character (para. 60). The GC found that the earlier figurative mark was made of a figurative element, namely a stylised cactus, followed by the word element ‘Cactus’ and these two elements of the earlier figurative mark convey, in their respective forms, the same semantic content. Furthermore, the GC pointed out that the representation of the mark was the same with the result that the consumer would equate the abbreviated form of the mark with its registered form, being regarded as essentially equivalent (para. 61). Lastly, the GC found that it was not necessary for the marks concerned to be affixed to the goods in order to find genuine use of the mark in relation to them (para. 65); it further mentioned that in the specific plants and flowers sector, it is not an usual practice to affix a mark directly to those goods (para. 66). In this light, the GC found that the BoA erred in deciding that the applicant had not proved genuine use of the earlier marks in relation to ‘natural flowers and plants, grains’ in Class 31 (para. 71) and upheld the first plea. The first and second pleas in law were upheld, while the third plea was rejected with the outcome that BOA’s decision was partly annulled.

♦ [T-398/13](#); **TVR ITALIA / TVR et al.**, Judgment of 15 July 2015, *TVR Automotive Ltd v OHIM & TVR Italia S.r.l.* – EN.


CTMA	Earlier marks
	<p>TVR</p>

The CTM applicant sought to register the figurative sign ‘TVR Italia’ reproduced above for goods and services in Classes 12, 25 and 37. An opposition was filed based on the earlier word CTM ‘TVR’ registered in Class 12 and the earlier UK word mark No 2 343 460 registered in Classes 9, 11, 25 and 41. The grounds relied on in support of the opposition were those referred to in Article 8(1)(b) and Article 8(4) and (5) CTMR. The OD partially upheld the opposition. The CTM applicant filed an appeal before the BoA against the OD’s decision, to the extent that it had refused the application for registration. At the same time, the CTM applicant filed an application for revocation of the earlier CTM with regard to all the goods in Class 12 covered by that mark and requested that the proceedings before the BoA be stayed pending a decision on the application for revocation. The CD rejected the application for revocation on the ground that the opponent had furnished proof of genuine use of the earlier CTM. The BoA dismissed the appeal brought against the CD’s decision as inadmissible because the appeal was out of time. Once the proceedings resumed, the BoA upheld the appeal in its entirety, annulled the OD’s decision and rejected the opposition in its entirety. The BoA found that (i) the opponent had not furnished proof of genuine use of either the earlier CTM or the earlier UK mark and (ii) the opposition was to be rejected insofar as it was based on Article 8(4) CTMR. The CTM applicant filed an application for annulment before the GC and



relied on two pleas in law, alleging, first, infringement of Article 42(2) and (3) CTMR and, secondly, infringement of Article 42(2) CTMR in conjunction with Article 15(1) CTMR. INFRINGEMENT OF ARTICLE 42(2) AND (3) CTMR. The GC upheld the first plea in law, finding that the BoA erred in rejecting the opposition on the basis of allegedly insufficient use of the earlier UK trade mark. As a matter of fact, the CTM applicant did not request proof of genuine use of the earlier UK trade mark during the proceedings before the Office, nor was it entitled to do so since the five-year period had not yet expired on the date of publication of the CTM application (paras 33-35). INFRINGEMENT OF ARTICLE 42(2) CTMR, IN CONJUNCTION WITH ARTICLE 15(1) CTMR, AND FAILURE TO TAKE ACCOUNT THE PRINCIPLES OF *RES JUDICATA / NON BIS IN IDEM* AND THE ADAGE *VENIRE CONTRA FACTUM PROPRIUM*. The GC rejected the first part of the plea in law and found that the BoA was not obliged to follow faithfully the considerations set out in the CD's decision that ruled in the opponent's favour on whether there had been genuine use of the earlier CTM. Furthermore, the GC held that the subject matter of the opposition proceedings and the revocation proceedings was not entirely identical since the five-year periods in respect of which genuine use of a CTM is required were different: therefore, the BoA had the authority to reassess the evidence (paras 38-40). With regard to the second part of the plea in law, the GC concluded that the BoA erred in rejecting the opposition based on the failure to prove genuine use of the earlier CTM, since the BoA misunderstood Article 42(2) CTMR and incorrectly assessed the evidential value of the relevant evidence as a whole (paras 51 and 59). Having regard to all the evidence produced by the opponent, the use of the earlier CTM was established during a substantial part of the five-year period (paras 54-56). Furthermore, the evidence was sufficient from a territorial point of view and demonstrated the nature and a certain scale of use of the earlier CTM during the relevant period (para. 57). The fact that the production and sale of the products fell and that their manufacture ceased because of the insolvency of the factory in the UK in the relevant period is not sufficient for the contrary conclusion to be reached, having regard to the proven attempts by the opponent of that trade mark to revive the production of such products and its commercial activities during the relevant period (para. 59).

◆ [T-172/13](#); **AFRICAN SIMBA / Simba**, Judgment of 22 January 2015, *Novomatic AG, v OHIM* – DE.

CTMA	Earlier mark
AFRICAN SIMBA	

The CTM applicant sought to register the word mark 'AFRICAN SIMBA' for goods and services in Classes 9, 28 and 41. The opponent based its opposition inter alia on Article 8(1)(b) CTMR using, inter alia, the earlier German figurative mark as depicted above, registered for goods in Class 28. The opposition was directed against all the goods and services covered by the CTMA. The OD upheld the opposition partially for the contested goods in Classes 9 and 28. The BoA dismissed the applicant's appeal, finding that there was a likelihood of confusion (for the goods in Classes 9 and 28), taking into account the identity of the goods and the similarity of the signs. The CTM applicant appealed to the GC, arguing an infringement of Article 42(2) and (3), Article 75 and Article 8(1)(b) CTMR. INFRINGEMENT OF ARTICLE 42(2) AND (3) CTMR. The GC confirmed the BoA assessment on proof of use. An affidavit confirming that the earlier mark has been used during the relevant period, is not prima facie without any probative value, even if it comes from the sphere of the interested party. If it is corroborated by objective




evidence, it may have a certain probative value. (paras 30-31). In the case at hand, the affidavit is confirmed by a catalogue and several invoices attesting use of the earlier mark in Germany (para. 33). The catalogues and the invoices show use for several playthings and they show also the earlier mark. They also cover a period of three years encompassed within the relevant period and they show constant and continuous use during these three years (para. 35). The GC also stresses the fact that the invoices which are numbered are only a selection of the invoices within the said period. Consequently, they do not reflect the full turnovers and therefore they corroborate the content of the affidavit in terms of volume (para. 40).

◆◆[T-382/14](#); **PROTICURD / PROTI et al.**, Judgment of 24 September 2015, *Bernhard Rintisch v OHIM – EN*. The holder of the IR designating the EU sought to register the word mark ‘PROTICURD’ for, inter alia, goods in Classes 5 and 29. The opponent based its opposition on Article 8(1)(b) CTMR using, inter alia, the earlier German word mark ‘PROTI’, registered for goods in Classes 29 and 32. The applicant requested that the opponent demonstrate genuine use of its earlier marks. The OD upheld the opposition in part for the goods in Classes 5 and 29. The BoA partially annulled the First Instance by rejecting the opposition for all of the goods in Class 5 and some of Class 29. The opponent appealed to the GC alleging, inter alia, infringement of Article 75 CTMR (obligation to state reasons). This first plea alleging the infringement of the obligation to state reasons laid down in Article 75 CTMR was upheld and the contested decision was annulled. The case has been reallocated to the BOA for a decision on the substance (R 247/2016).

◆[T-583/14](#); **FLAMINAIRE / FLAMINAIRE**, Judgment of 8 December 2015, *Giand Srl v OHIM – IT*. The CTM applicant sought to register the word mark ‘FLAMINAIRE’ as a CTM for goods in Classes 16 and 34. An opposition based on earlier Spanish word marks ‘FLAMINAIRE’, registered for goods in Classes 16 and 34, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA dismissed the appeal. The CTM applicant filed an application before the GC for annulment of the decision of the BoA. The GC confirmed the BoA’s finding that the earlier marks had been put to genuine use, even if the mark was used with a slight stylisation. In this respect, the GC reminded that use limited to the Spanish territory could be sufficient for an earlier Spanish trade mark (paras 30-41).





◆ [T-361/13](#); **VIGOR / VIGAR**, Judgment of 18 November 2015, *Menelaus BV v OHIM* – EN.

CTM	Earlier mark
VIGOR	

The applicant registered the word mark 'VIGOR' represented above as a CTM for goods and services within Class 21. An application for invalidity was filed based on the earlier CTM reproduced above and identical IR registered for goods in Class 21. The applicant requested the invalidity applicant to prove genuine use of the earlier marks. The CD dismissed the application for invalidity. The BoA partly upheld the invalidity applicant's appeal and annulled the decision of the CD to the extent that that decision had rejected the application for a declaration of invalidity as regards all of the goods in Class 21, with the exception of 'brush-making materials' and 'glassware, porcelain and earthenware'. The applicant filed an action before the GC. The GC ruled that the BoA did make appropriate use of its discretion in taking into account the evidence submitted for the first time before it, as the stage of the proceedings and the circumstances surrounding it did not preclude a submission of that additional evidence (paras 41- 61). The GC rejected the applicant's plea in law alleging that the use of a variant altering the distinctive character of the earlier CTM was incorrectly taken into account by the BoA. In this regard, the GC found that the word 'vigar' in the earlier CTM as registered is an invented word and is therefore inherently distinctive and is the dominant and most distinctive element of the earlier mark. The GC further stated that the earlier sign as registered differs from the sign as used only in the ascending orientation of its oval background, the use of standard lower case instead of standard upper case letters and the replacement of the crown element by a sequence of three dots (paras 62-76). The GC found that the reasoning of the BoA allows the applicant to know the justification for the measure taken so as to enable it to protect its rights (para. 82). Furthermore, the applicant's plea in law alleging an absence of proof of use for all the goods for which the earlier CTM has been registered was rejected (para. 77-113). The GC rejected as ineffective the applicant's plea in law alleging that the BoA should not have taken the earlier IR into account, given that the invalidity applicant was not the proprietor of the earlier IR at the time when the contested decision was adopted. The GC found that the examination of whether there was a likelihood of confusion between the signs at issue was carried out by reference to the earlier CTM, therefore, any error which may have been made by the BoA as regards the proof of use of the earlier IR has no effect on the legality of the contested decision as regards the existence of a LOC in respect of the goods covered by the contested mark and the earlier CTM that were found to be identical or similar (paras 114-129).




[T-83/14](#); ARTHUR & ASTON / ARTHUR et al., Judgment of 15 December 2015, *LTJ Diffusion v OHIM* – FR.

CTMA	Earlier mark as registered
ARTHUR & ASTON	
	<p data-bbox="975 683 1236 716">Earlier mark as used</p> 

The applicant sought to register the word mark 'ARTHUR & ASTON' as a CTM for goods within Class 25. An opposition based on the earlier figurative mark represented above, registered for goods in Class 25, was filed on the grounds of Article 8(1)(b) CTMR. The OD dismissed the opposition with the finding that the opponent failed to prove the use of the earlier mark in the form as registered. The BoA confirmed this decision. The opponent filed an action before the GC claiming the breach of Article 15(1) CTMR. The GC found that the earlier mark as genuinely used differed from the earlier mark as registered in a way that altered its distinctive character. That is because even if the sign as used coincides in the word element 'ARTHUR', it adopts white capital letters, with a slight stylisation, on a black background, with a horizontal disposition and on a black rectangular frame with a white frame line. The graphic element of the mark as used is thus a classic one, symmetrical and static, whereas the mark as registered attracts the attention because it conveys an impression of asymmetry and dynamism (paras 22-23). The GC stressed that the coinciding word element might as well be the dominant one, but the alteration of the distinctiveness cannot be ruled out for this sole reason. The specific handwriting font which accompanies the word 'ARTHUR' may be an element of secondary importance but it is not negligible. The modification of this graphic presentation is therefore liable to alter the distinctive character of the mark as registered (paras 33-34). The use of the mark as registered not being proven, the GC dismissed the action (para. 40).



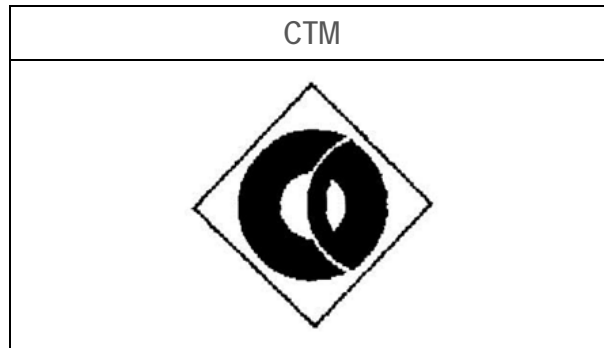
◆ [T-624/14](#); *bice / Bice*, Judgment of 17 December 2015; *Bice international Ltd v OHIM* – DE.

CTM	Earlier mark
<p>bice</p>	

The owner of the earlier figurative Spanish trade mark 'Bice' (as displayed above) in Class 42 filed a request for invalidity (Article 53(1)(a) / Article 8(1)(b) CTMR) against the CTM 'bice' (word mark, registered for goods in Classes 29, 30 and 43). Upon request of the owner of the contested CTM, the owner of the earlier Spanish mark provided evidence of genuine use. The CD rejected the invalidity request in its entirety as it deemed genuine use of the earlier mark was not proven. This decision was confirmed by the BoA, which emphasised the limited geographic extent of use (in one single restaurant in Madrid only) and the lack of solid evidence with regard to the extent of use. The CTM owner filed an application before the GC, requesting annulment of the BoA's decision. The application was based on one plea of law, namely a claimed infringement of Article 57(2) and (3) CTMR /Article 42(2) CTMR. In the oral hearing, the applicant raised a second plea of law, namely a violation of Article 75 CTMR (duty to state reasons). With regard to the claimed violation of Article 42 CTMR, the GC confirmed that a statutory declaration from the General Manager of the applicant, which furthermore only contained very vague and unspecified explanations regarding the extent of use, is not sufficient evidence on its own to prove genuine use, but must rather be corroborated by further documentation (paras 54-59). The GC considered that the only reliable evidence to prove the extent of use of the earlier mark consisted of 19 invoices for restaurant services in one establishment over a period of six years, displaying a total turnover of EUR 14 278. In light of the nature of restaurant services (being everyday services) the proven extent of use was deemed insignificant (paras 69-74). Furthermore, the applicant could not demonstrate a geographical dimension of use of its mark beyond one single restaurant in Madrid. As a finding of genuine use cannot be based on presumptions and suppositions, the BoA was right to reject the proof of use as insufficient (paras 82-85). Based on the foregoing the action was dismissed.



◆ [T-137/14](#); **DEVICE OF A CIRCLE**, Judgment of 23 October 2015, *Castellani Srl v OHIM* – EN.




The applicant sought to cancel the CTM as represented above for goods in Class 19. The CD revoked the CTM for all the contested goods because the nature of the use was not proven. The appeal before the BoA was dismissed, however, not because the mark was not used in its registered form but because the extent of the use was not sufficiently proven. The GC dismissed both pleas on which the action was based, the alleged infringement of Article 75 CTMR and of Articles 15(1)(a) and 51(1)(a) CTMR. **ARTICLE 15(1)(a) AND ARTICLE 51(1)(a) CTMR:** The applicant's argument concerning the nature of use is ineffective since the BoA itself found that there is no precept in the CTM system that obliges the proprietor of the CTM to prove the use of its mark on its own, independently of any other mark (paras 40-42). Contrary to the BoA's assessment, the extracts from the website as a whole establish a connection between the website references, the invoices and the photographs of the packaging despite the fact that the contested mark did not feature on the website (para. 47). However, having regard to the market price of the goods concerned in Class 19, the value of the marketed goods was very low (para. 50). The additional documents, including the catalogues, do not compensate for the low sales of the goods concerned and are, therefore, not sufficient to demonstrate the genuine use of the contested mark (paras 53-54).

◆ [T-186/14](#); **NOxtreme / X-TREME**, Judgment of 7 October 2015, *Atlantic Multipower Germany GmbH & Co. OHG v OHIM* – DE. The invalidity applicant requested the invalidity of the CTM 'NOxtreme' (word), registered for goods in Classes 5, 29 and 32. The invalidity application was based on Article 53(1) CTMR in conjunction with Article 8(1)(b) CTMR using, inter alia, the earlier figurative CTM 'X-TREME', registered for goods in Classes 5, 29 and 32. Both instances at the Office upheld the application for invalidity. The CTM proprietor appealed before the GC, arguing an infringement of Article 57(2) and (3) CTMR in conjunction with Article 42(2) and (3) CTMR as well as Article 53(1) CTMR in conjunction with Article 8(1)(b) CTMR. The GC confirms that the use of a mark according to Article 15(2) CTMR may also be made by a third party with the consent of the proprietor of said mark and it is not necessary that this third party be a licensee. Moreover, the fact that the documents showing such uses of the mark are in possession of the proprietor of the earlier mark indicates that the use has been made with the proprietor's consent (paras 28 and 30). Consequently, the affidavit of the third party, which is corroborated by objective evidence, has been correctly taken into account by the BoA (para. 32).



◆ [T-642/13](#); *she / SHE*, Judgment of 15 October 2015, *Wolverine International, LP v OHIM* – EN.

Contested IR designating the EU	Earlier marks
	SHE


The owner of several earlier German trade marks, ‘SHE’, filed a request for invalidity (Article 53(1)(a) / Article 8(1)(b) CTMR) against the figurative IR designating the EU (as displayed above). All trade marks are registered for identical goods, namely clothing, footwear, headgear. The IR holder requested the invalidity applicant to provide proof of use of its earlier marks. The CD— without examining the submitted evidence for proof of use for reasons of procedural economy — found a low degree of visual and phonetic and no conceptual similarity and denied a likelihood of confusion. Consequently, the invalidity request was rejected. The BoA annulled the CD’s decision. With regard to proof of use, the BoA found genuine use of the earlier marks for clothing and footwear. As regard the comparison of signs, the BoA found the marks phonetically identical and visually and conceptually similar. In view of all those factors and the identity and similarity of the goods, the BoA found LoC despite a low degree of distinctive character of the earlier marks. The IR holder filed an application before the GC, requesting annulment of the BoA’s decision. The application was based on two pleas of law, namely a claimed infringement of Article 57(2) and (3) CTMR and Article 8(1)(b) CTMR. With regard to Article 57(2) and (3) CTMR (PoU), the applicant had questioned the probative value of the numerous catalogues, due to the fact that they also contained non-relevant goods in Class 18 (bags). The GC pointed out that the probative value of the catalogues could not be undermined by this fact, as the goods displayed were primarily relevant clothing goods (para. 27). With regard to 38 invoices from suppliers concerning the sale of large quantities to the owner of the earlier marks, the GC held that the BoA was entitled to take them into account, despite the fact that they were not addressed to end consumers. In this respect the GC stressed that an accumulation of evidence may allow the necessary facts to be established, even though each of those pieces of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts. Furthermore, taking account of the particular method of distribution that retail constitutes, it is possible to provide evidence other than invoices addressed to end consumers (para. 34). As the owner of the earlier marks had submitted a large number of invoices, catalogues, figures on advertisement expenditures, product samples and a sworn statement, the GC in an overall assessment deemed the evidence sufficient to demonstrate genuine use and particularly its extent (paras 35-38). The action was dismissed.

◆ [T-21/14](#); **SANDTER 1953 / SANDER**, Judgment of 29 October 2015, *NetMed Sàrl v OHIM* – DE. The CTM applicant sought to register the word mark ‘SANDTER 1953’ for goods in Classes 3, 5 and 10. An opposition was filed on the grounds of Article 8(1)(b) CTMR, based on the earlier German word mark ‘SANDER’, registered for goods in Classes 5, 10 and 25. Upon request by the CTM applicant, the owner of the earlier mark provided evidence to prove genuine use of its mark. The OD found genuine use proven for ‘Fingerlinge’ [‘rubber protection for fingers’] for medical purposes’, belonging to the category of ‘bandages’ in Class 10. The signs were held to be confusingly similar and, consequently, the CTMA was partly rejected for the goods deemed to be similar/identical to ‘bandages’. The BoA confirmed the OD’s



decision. The CTMA applicant filed an application before the GC, claiming infringement of Article 42 CTMR and Article 8(1)(b) CTMR. With regard to the extent of use, the opponent has, inter alia, provided 20 invoices documenting the sale of up to 10 000 ‘Fingerlinge’ to four different companies during the relevant period. The fact that the prices were blackened in the invoices (thus not conveying any information about the actual turnover) is not decisive, as the further material (product packaging, price lists, a witness statement) allows the safe conclusion that the use was not merely symbolic and the owner of the earlier mark seriously aimed to acquire a commercial position in the market (paras 29-34). It is also irrelevant that ‘Fingerlinge’ are cheap, mass consumption products with low revenues, as proof of use is not about evaluating the commercial success or the business strategy of a company. A *de minimis* rule with regard to the extent of use cannot be established (paras 35-38). Even though ‘Fingerlinge’ are mainly used for risk prevention and not as sanitary/first-aid products, the ‘medical purpose’ (Class 10) has to be interpreted broadly (paras 39-46). The applicant’s claim that ‘Fingerlinge’, if used in the medical field, are required by law to display a ‘CE-certification’ (which in the present case was undisputedly not the case) might be true but mixes up two sets of different rules. Rules about the safety of medical equipment have different aims and purposes than the Nice Classification (paras 47-50). Finally, ‘Fingerlinge’ form part of the general term ‘bandages’ and are not completely different products, as claimed by the applicant. Both can serve to cover and protect injured body parts, they address the same public, have the same functioning methods and are classified in the same class (paras 54-59). It follows that the first plea of law must be dismissed.

◆ [T-354/14](#); **ZuMEX / JUMEX**, Judgment of 9 December 2015, *Comercializadora Eloro, S.A. v OHIM – ES*.

CTMA	Earlier mark
	JUMEX

The applicant sought to register the figurative mark represented above as a CTM for goods in Class 32. An opposition based on the earlier word mark ‘JUMEX’, registered for goods in Class 32, was filed on the grounds of Article 8(1)(b) CTMR. The OD upheld the opposition. The BoA upheld the applicant’s appeal. The opponent filed an action before the GC. **GENUINE USE:** The nature of use of the earlier mark is proven by the evidence submitted: the name of the product shown in the invoices, which is one of the most important elements of an invoice, corresponds to the name of the product that is shown in the internet printouts and thus, a link between them can be easily established; the internet printouts are a visual support of the invoices dated within the relevant period and the fact that they were printed out of the relevant period does not affect the probative value of the submitted evidence (paras 54-59). Genuine use within the EU has not been proven: the buyer’s establishment in the EU is insufficient on its own to prove genuine use in the EU (para. 60); there is no evidence of the import formalities that would lead to the custom status of Community goods (para. 61); the buyer’s condition of also being the recipient of the goods is not sufficient to prove genuine use in the EU: the mere importation of goods to the EU with the aim of re-exporting outside the EU cannot create or maintain a market share (para. 62); no evidence of free circulation or commercialisation in the EU has been submitted (para. 63).



V. Other Cancellations

A. Article 51(1)(a) CTMR – revocation due to non-use

◆ [T-250/13](#); **SMART WATER**, Judgment of 18 March 2015, *Naazneen Investments Ltd v OHIM* – EN. The CD upheld the application for revocation of the registered CTM ‘SMART WATER’ on the grounds of Article 51(1)(a) CTMR for all the goods in respect of which it had been registered. The CTM proprietor filed an appeal. The BoA dismissed the appeal and upheld the contested decision. The BoA stated that the evidence provided by the CTM proprietor did not make it possible to establish that the mark at issue had been put to genuine use and, concurrently, there were no proper reasons for non-use. The applicant filed an action before the GC. As to the issue on infringement of Article 51(1)(a) CTMR, the GC confirmed that affidavits from a person who has close links with the party concerned are of lower evidential value than those from third parties and they cannot therefore, on their own, constitute sufficient proof of use of the mark (para. 30). Furthermore, as regards the assessment of the evidence on actual sales, the GC confirmed that a quantity of 15 552 bottles sold cannot be sufficient to establish the genuine use of trade mark in the context of the significant size of the relevant market for beverages in Class 32 which are mass consumption goods aimed at the general public (para. 35). Regarding the imminent marketing claim, the GC recalled that use of a mark must relate to goods or services already marketed or whose marketing is imminent and for which preparations by the undertaking to secure customers are under way. In the present case, the advertising and promotional activities concerning the production of beverages and labels relate solely to the years 2006 and 2007. The applicant has not adduced any proof that the goods in question were marketed between 2007 and the end of the relevant period. An advertising campaign presupposes the use of various media, certain intensity and the possibility of reaching a large audience, and therefore advertisements in two specialist German magazines cannot suffice (paras 38-42). Also, the GC confirmed that non-disclosure agreements submitted by the CTM proprietor were not followed by contracts for the manufacture and delivery of the goods in question. Moreover, the extracts from the website did not show any actual commercial activity (paras 43-44). The CTM proprietor’s claim that the BoA did not determine a minimum threshold of use, which could be considered as genuine, was also unfounded. The goods in question were for everyday use and not very expensive. The total amount of transactions over the relevant period (EUR 800), seemed to be so token as to suggest, in the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the mark at issue could not be regarded as sufficient, in the economic sector concerned (paras 48-51). In relation to the assessment of the genuineness of the use, the GC pointed out that there was a gap of almost three years between the attempt to launch the mark at issue invoked by the CTM proprietor and the end of the relevant period (paras 53-55). When the genuine use of a mark is assessed, the evidence of the existence of such use and not evidence explaining non-use must be taken into account (para. 56). Furthermore, no proper reason for non-use of trade mark at issue in connection with the goods in question was found. The problems associated with the manufacture of the products of an undertaking form part of the commercial difficulties encountered by that undertaking. It was for the CTM proprietor to supervise and control the manufacture of the goods in question, even though they were being manufactured by a third party. Furthermore, further products could have been manufactured and placed on the market within a reasonable period (paras 66-69). The fact that revocation proceedings have been brought against a trade mark does not prevent the proprietor of that mark from using it (para. 71). It is for the proprietor of a trade mark to conduct an adequate assessment of its chances of prevailing in the



revocation proceedings and to draw the appropriate conclusions from that assessment as to whether to continue to use its mark (para. 73).

◆ [T-215/13](#); **LAMBDA**, Judgment of 15 July 2015, *Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM* – EN.



The Office registered the above figurative trade mark in respect of ‘insulating materials’ in Class 17 and ‘building materials (non-metallic)’ in Class 19. Following an application for revocation of the contested mark based on Article 51(1)(a) CTMR, and the submission of evidence of use, the CD partially revoked the rights of the CTM owner as regards ‘building materials (non-metallic)’, with the exception of ‘building materials having insulating properties’ in Class 19. By contrast, it rejected the application for revocation in respect of the goods in Class 17. On appeal, the BoA upheld the appeal in part by revoking the contested mark in respect of all of the goods in Class 19. By contrast, it confirmed the CD’s assessment as regards the goods in Class 17. ON THE ALLEGED INFRINGEMENT OF ARTICLE 51(1)(a) CTMR: The GC confirmed the findings of the BoA. As to the extent of use requirement, the GC found that the contested sign appears on the CTM owner’s website and in pictures of the goods at issue, as well as in advertising materials, where it is used in association with, inter alia, the word marks EUROFLOOR, EUROTHANE, EUROWALL, POWERDECK, and POWERROOF or as replacing their first letter ‘o’, that is to say, EUR FLOOR, EUR WALL, P WERDECK, P WERROOF and EUR THANE, which are also registered in the name of the CTM owner. The BoA rightly found that the goods at issue had been marketed under the contested mark, on the basis of a declaration of an external auditing undertaking. That declaration was the outcome of a check which the external auditing undertaking carried out on a sample of randomly selected invoices relating to the relevant period. Furthermore, the result was compared with the turnover in the CTM owner’s accounting software (paras 40-54). Turning to the nature of use requirement, the GC noted that the use of the word marks in question in which the contested figurative mark is incorporated (as shown above) reflects the commercial need of being able to refer to that mark orally without its losing its distinctive and recognisable character (para. 56). The contested mark does not lose its distinctive character since it is rather a juxtaposed element, which is substituted for a letter, retains its independence and does not constitute a unit in connection with those other marks. The Greek letter ‘lambda’ in white written in a red circle also confers enhanced distinctiveness on the word marks of which it is part (para. 57).

[T-584/14](#); **ZARA**, Judgment of 9 September 2015, *Industria de Diseño Textil, S.A. (Inditex) v OHIM* – ES. The applicant sought to register the word sign ‘ZARA’ as a CTM for the goods and services in Classes 3, 9, 14, 16, 24, 25, 28, 37, 39, 40 and 42 and the mark was registered on 3 January 2001. On 24 October 2011, an application for revocation of the CTM for the goods and services in Classes 39 and 42 was filed. The CD issued a decision upholding the application for revocation, which was confirmed by the BoA regarding only the goods and services in Class 39. The proprietor filed an application for annulment





before the GC. The contested decision was upheld by the GC. The GC confirmed the BoA's finding that there was no public and outward use of the mark for the goods and services in Class 39. The judgment refers to the case law establishing that it is not sufficient for genuine use to appear probable or credible; actual proof of that use must be given (para. 38). According to the GC, for the franchisee companies to be considered independent entities in general they must not be fully integrated in the entity of the franchisor, but instead they must be associated with it. In the current case the GC found that, although the franchisees are independent entities, they in fact form part of the internal organisation of the trade mark owner. The main characteristic of Zara's franchise model is the full integration of the franchisees with Zara's shops, as well as integrated logistics and a high degree of vertical integration (para. 33). The GC found that the evidence provided does not prove external and public use of the CTM (para. 34). In particular, it is not possible to identify the transportation costs in the invoices. Furthermore, the total cost of transport is included in the resale price. On the basis of those considerations, the GC concluded that there was no sufficient evidence submitted in order to prove genuine use of the mark for the goods and services in Class 39.

[T-278/13](#); **NOW**; Judgment of 30 January 2015, *Now Wireless Ltd v OHIM* – EN. The application for the revocation of the figurative CTM 'NOW' originally registered for services in Classes 35, 41 and 42 and limited later to services in Class 42, due to non-use was rejected by the CD and confirmed by the BoA. The cancellation applicant filed an action before the GC claiming an infringement of Article 51(1)(a) and/or Article 51(2) CTMR. The GC dismissed the action. It observed that the single plea in law, alleging infringement of Article 51(1)(a) and/or Article 51(2) CTMR, concerning the genuine use of the mark, consists in essence of four parts, alleging: (i) use of the contested mark has not been demonstrated for the services concerned; or (ii) the BoA incorrectly assessed the use of such services in that it did not subdivide them precisely and narrowly; or (iii) the BoA wrongly inferred that consent had been granted for use of the contested mark beyond that explicitly granted by the licence in the present case; or (iv) the BoA incorrectly assessed the extent of the genuine use, which must extend beyond a limited geographical area to be sufficient use to constitute use in a Member State or in the EU (para. 10). The first and second parts of the single plea which relate to the use of the contested mark claimed for the services concerned were examined together and rejected. The assessment of genuine use must be based on the services as specified in the application for registration and not on a possible marketing concept. The BoA was therefore wrong to find, that 'all these services would form part of the service package known as 'wireless broadband'. It appears that the contested mark was registered for the services concerned and does not cover 'wireless broadband' as such. Nevertheless, the items of evidence analysed by the BoA establish use of the contested mark for all the services concerned (para. 21). It is not necessary, in the present case, to define a sub-category of services as claimed by the applicant (para. 26 with references to further case law). With regard to the third part of the single plea in law, the intervener relied upon acts of use of the contested mark by its licensee as evidence of its genuine use. Those factors formed a sufficiently firm basis to allow the conclusion that the contested trade mark had been used with its proprietor's consent (para. 40). With regard to the fourth part of the single plea in law, although the concept of genuine use excludes all minimal and insufficient use as the basis for a finding that a mark is being put to real and effective use in a given market, nevertheless the requirement of genuine use does not seek to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks (para. 40). In addition, it is apparent from the case law that the territorial borders of the Member States should be disregarded in the assessment of 'genuine use in the [EU]' (para. 46). Having regard, in particular, to the evidence submitted, the use of the mark in



the geographical area comprising London and the Thames Valley was sufficient to constitute genuine use in the EU (para. 49).

◆ [T-690/14](#); *Vieta*, Judgment of 10 December 2015, *Sony Computer v OHIM* – EN.

CTMA	Mark as used
	<p>vieta</p> 

A revocation request for lack of use pursuant to Article 51(1)(a) CTMR. The BoA found that the contested mark had been put to genuine use in relation to ‘loudspeakers, loudspeaker systems, sound amplifiers’ and ‘computers, video screens, apparatus for the reproduction of sound and images, television sets and record players’ in Class 9. With regard to the alleged infringement of Article 15(1) CTMR, point (a) of the second subparagraph, the GC confirms that the distinctive character of the contested mark is essentially derived from its word element ‘VIETA’, not from its figurative elements (para. 47). The word ‘VIETA’ has a high level of distinctive character and occupies an important position in the overall impression created by the contested mark, as registered, whilst the figurative elements occupy merely an ancillary position and have a relatively marginal visual impact (para. 48). As a consequence, the contested mark has been used in a form that does not alter its distinctive character. However, the confirmation by the BoA that the earlier mark had been used for ‘apparatus for reproduction of sound and images’ should be annulled because such category is not defined sufficiently ‘precisely and narrowly’. On the one hand, it includes equipment for which the CD found that proof of genuine use had not been provided, such as ‘video cameras or photographic apparatus’. However, such expression can, at the very least, be subdivided into two subcategories: ‘apparatus for the reproduction of sound’ and ‘apparatus for the reproduction of images’. The contested decision is partially annulled insofar as it found that genuine use of the contested mark had been proven for ‘apparatus for the reproduction of sound and images’.



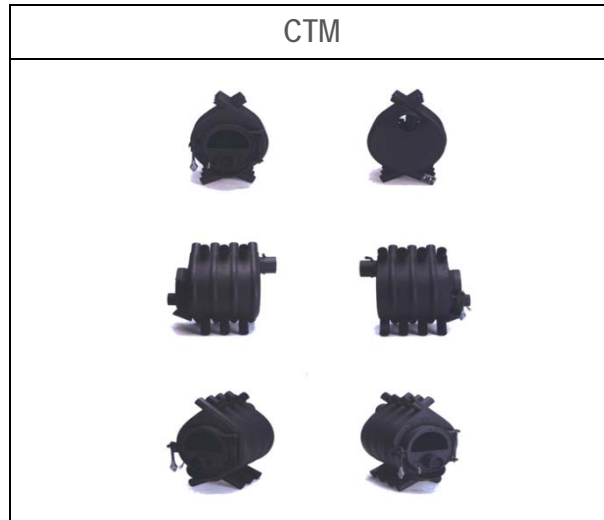
T-317/14; **SHAPE OF A COOKING STOVE (3D MARK)**, Judgment of 24 September 2015, *Bernhard Rintisch v OHIM* – DE.



The applicant for cancellation requested the revocation for non-use of the 3D mark shown above. The CTM is registered for ‘ovens’ (Class 11). The proprietor of the CTM filed evidence of use of the CTM which contained the shape of the CTM with the additional word element ‘Voxka’ on it. Both instances found that the use requirements have been satisfied and rejected the request for declaration of revocation for non-use. The applicant for cancellation appealed to the GC alleging infringement of Article 15(1)(a) CTMR. The GC departs from the statement that in proceedings of declaration of revocation based on non-use, it might not be assumed that the registered mark is devoid of distinctive character or necessary to obtain a technical result (para. 19 and 20). The applicant puts forward that if a distinctive word element is added to a shape of the goods, the shape can no longer fulfil the original function of a mark. Secondly, the applicant contends that the addition of the word element would alter the distinctiveness of the mark as registered (para. 25). The GC refers to the case law that a mark can be used as such also in the context of a complex mark, in the sense that two marks may be used at the same time in one complex mark containing both of those marks (para. 29). However, according to the case law, in the above case, the use of a mark in a more complex mark will not influence the mark as registered and for the purpose of this assessment, the intrinsic distinctive character of the mark as registered must be examined and then compared to the distinctive character of the additional elements included in the mark as used (paras 32-33). For the case in question, the GC concluded that the shape is unusual and recalls an engine of an aeroplane rather than an oven. The distinctive character is therefore high (para. 38). The distinctive character of the word element ‘Voxka’ is average (para. 40). Under the given circumstances the distinctive character of the mark as used does not alter the distinctive character of the mark as registered and is to be considered as an acceptable variant thereof according to Article 15(1)(a) CTMR.



[T-211/14](#); **SHAPE OF AN OVEN (3D MARK)**, Judgment of 24 September 2015, *Bernhard Rintisch v OHIM* – DE.



The applicant for cancellation requested the revocation for non-use of the 3D mark shown above. The CTM is registered for ‘ovens’ (Class 11). The proprietor of the CTM filed evidence of use of the CTM which contained the shape of the CTM with the additional word element ‘Bullerjan’ on it. Both instances found that the use requirements have been satisfied and rejected the request for a declaration of revocation for non-use. The applicant for cancellation appealed to the GC alleging infringement of Article 15(1)(a) CTMR. The GC departs from the statement that in proceedings of a declaration of revocation based on non-use, it might not be assumed that the registered mark is devoid of distinctive character or necessary to obtain a technical result (paras 19-20). The applicant puts forward that if a distinctive word element is added to a shape of the goods, the shape can no longer fulfil the original function of a mark. Secondly, the applicant contends that the addition of the word element would alter the distinctiveness of the mark as registered (para. 25). The GC refers to the case law that a mark can be used as such also in the context of a complex mark, in the sense that two marks may be used at the same time in one complex mark containing both of those marks (para. 29). However, according to the case law, in the above case, the use of a mark in a more complex mark will not influence the mark as registered and for the purpose of this assessment, the intrinsic distinctive character of the mark as registered must be examined and then compared to the distinctive character of the additional elements included in the mark as used (paras 32-33). For the case at hand, the GC concluded that the shape is unusual and recalls an engine of an aeroplane rather than an oven. The distinctive character is therefore high (para. 38). The distinctive character of the word element ‘Bullerjan’ is average (para. 40). Under the given circumstances, the distinctive character of the mark as used does not alter the distinctive character of the mark as registered and is to be considered as an acceptable variant thereof according to Article 15(1)(a) CTMR.

[T-258/13](#); **ARKTIS**, Judgment of 16 April 2015, *Matratzen Concord GmbH v OHIM* – DE. The applicant before the GC requested the revocation for non-use according to Article 51(1)(a) CTMR of the CTM, ‘ARKTIS’, registered for goods in Classes 20 and 24. The CD revoked the mark partially for the goods in Class 20. It found that for the goods in Class 24 the CTM has been used. The BoA confirmed the first instance decision. The applicant put forward that the evidence showing use of the mark does not clearly



establish a sufficient volume of use, nor does it show that the invoices related to the contested goods in Class 24. The GC states that the references in the invoices and delivery bills relate to the contested goods. There might be slight discrepancies but in general there is no incoherence, so that it may be established that the invoices and delivery documents refer to those goods. The discrepancies in the criteria for the purpose of referring to the goods denotes a certain lack of systematic method, but is not an incoherence and therefore does not diminish the probative value of the documents (paras 20-24). The GC also stresses that that evidence which does not directly establish a link with the contested goods as, for example, the purchase of tags bearing the contested mark, is an indication which has to be taken into account in an overall assessment. Moreover, the catalogues show that in the relevant market sector, marketing with a tag on the product bearing the mark is usual (paras 29- 31). The GC examines further if the use is to be considered as genuine and states that the volume of 3 490 'pillows and sleeping bags' (Class 20) confirms the position of the BoA that this shows a sufficient volume of use and cannot be considered as token use. A further argument of the applicant, namely that the addition of the term 'line' would alter the distinctive character of the sign as used, is rejected by the GC. This expression will also be understood in Germany, where the mark has been used, in the sense as product line. The GC also quotes the case law (12/01/2000, T-19/99, *Companyline*, EU:T:2000:4; or 22/05/2012, T-273/10, *O•live*, EU:T:2012:246). The addition is subordinate and the term 'ARKTIS' is dominant. (para. 26 – 27). Finally, the applicant contends that according to the evidence it has not only been the proprietor of the contested mark that used it, but also another company, and such use must not be taken into account. The GC confirms the case law that from the fact that the proprietor has the information referring to the use of another company it may be inferred that such use has taken place with its consent (para. 43). Additionally, according to the GC the applicant contested this issue for the first time before the GC and such new plea would alter the subject matter of the contested decision and is inadmissible (paras 46-48).

◆ [T-426/13](#); *AINHOA*, Judgment of 23 September 2015, *L'Oréal v OHIM* – ES. The applicant registered the word mark 'AINHOA' as a CTM for goods and services within Class 3, 35 and 39. An application for revocation was filed, based on the grounds that the CTM has not been put to genuine use in the EU and in connection with the goods or services in respect of which it is registered within a continuous period of five years. The CD upheld the application for the services in Classes 35 and 39 and dismissed the application for the goods in Class 3. The BoA dismissed the applicant's appeal. The applicant filed an action before the GC. The GC stated that in the case at issue, the use of the mark in a form differing in elements does not alter its distinctive character. The CTM is a word mark and the specific representation of a word mark is not generally of such a nature as to alter the distinctive character of that mark as registered, the graphic element is not distinctive and the word elements used in relation to the mark are describing the properties of the goods (para. 22 et seq.). The GC dismissed the argument of the applicant that the evidence provided by the CTM proprietor is not relevant and cannot demonstrate the genuine use of the CTM. The GC stated that although the probative value of the different pieces of evidence is not the same, the BoA carried out an overall assessment and the fact that the mark has been put to genuine use in the relevant period had been proven (para. 33 et seq.). The GC also held that a piece of evidence with a low probative value, could be taken into account as additional evidence which supports the other items of evidence (para. 53). The GC refers to the case law establishing that the fact that the mark is not referred to on the invoices provided cannot prove that the latter are irrelevant for the purposes of proving genuine use. 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 (paras 48-49).



B. Article 52(1)(b) CTMR — bad faith

◆ [T-257/11](#); **COLOURBLIND**, Judgment of 26 February 2015, *Pangyrus Ltd. v OHIM* – EN. The CTM holder registered the word mark ‘COLOURBLIND’ as a CTM in respect of a range of goods and services in Classes 9, 16, 28, 35 and 41. The invalidity applicant sought cancellation of the contested CTM on the grounds of Article 52(1)(b) and (c) in conjunction with Article 8(4) CTMR. The CD upheld the application for a declaration of invalidity, finding that bad faith had been established on the basis of Article 52(1)(b) CTMR, and declared the contested trade mark to be invalid. On appeal, the BoA annulled the CD’s decision and dismissed the application for a declaration of invalidity in its entirety. The GC dismissed the appeal and confirmed the BoA’s findings. Concerning the bad faith claim based on Article 52(1)(b) CTMR, the GC noted that it was not disputed by the parties that the ‘COLOURBLIND’ product consisting of an ‘experimental learning’ toolbox’ was invented in 1991 by a physical person, a Mr C. (main shareholder and director of the CTM holder at the time of the invalidity request), who in 1993 had set up the invalidity applicant’s company, with Mr C. holding 99 % of the latter’s shares. Although Mr. C. was closely and continuously involved, from 1991 until 2003, in activities leading to the use of ‘COLOURBLIND’ by the invalidity applicant first and later by another connected company, and was therefore necessarily aware of that use, such awareness on his part — as noted by the GC — was not sufficient, in itself, to establish that the CTM holder (whom Mr. C. controlled) acted in bad faith. The GC dismissed the invalidity applicant’s argument that Mr C.’s aim in filing the application for registration of the contested trade mark was to ‘lay his hands’ on the trade mark of a third party with which he had had contractual or pre-contractual relations. In that respect, the GC held that, owing to the connections between Mr C. and the invalidity applicant (the former holding 99 % of the latter’s shares in the early 1990s), the invalidity applicant could not be described as a third party in relation to Mr C. The GC also found that the main item of evidence relied upon by the invalidity applicant (a share purchase agreement), in order to argue that the rights in the contested CTM had been assigned to it by Mr. C., only contained a generic reference to ‘warranties’ and ‘intellectual property’ and that there was no mention of ‘COLOURBLIND’ in that agreement. The GC went on to note that, even assuming it to be established that the sign ‘COLOURBLIND’ was indeed covered by that agreement, all that was mentioned with regard to the invalidity applicant was its being the beneficial owner of rights in that sign, not that it had legal title to those rights. The GC went on to say that, if there were an agreement between Mr C. and the invalidity applicant concerning the use of ‘COLOURBLIND’, it is possible that, owing to its implied or informal nature, it was not mentioned in the mentioned share purchase agreement. The GC held that, in the light of the evidence produced, it could not be excluded that Mr C. considered himself to have rights in the sign ‘COLOURBLIND’ up until the moment of its transfer to the CTM holder and that both the invalidity applicant and a third, connected company that had later made use of the sign were acting under an implied or informal agreement on the part of Mr C.

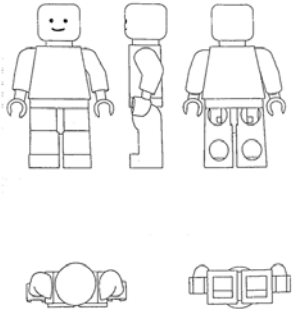
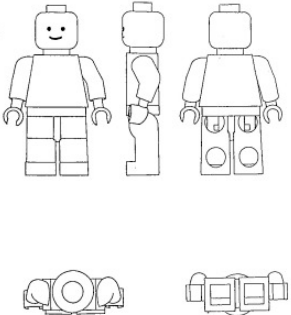
[T-306/13](#); **LLRG5**, Judgment of 16 June 2015; *Silicium España Laboratorios, SL v OHIM* – EN. An application for a CTM was sought for the word sign ‘LLRG5’ for Classes 5, 32 and 44. A request was submitted to the Office to register the assignment of the application for the CTM to one of the shareholders of the invalidity applicant, Mr. R. The request for the application as well as for the assignment was made by an intermediary of Mr. R. on his behalf. The change of the proprietor was registered and published. Mr. R. and the invalidity applicant concluded an agreement that would confer to the later an exclusive licence which stated, inter alia, that Mr. R. would not authorise others to use the names ‘LLRG5’ or ‘G5’. After Mr. R.’s death, the invalidity applicant filed an application for registration of the transfer of the CTM ‘LLRG5’ at the Office, based on the agreement between the parties referred to.



The application was refused on the ground that the agreement did not state that Mr. R had actually transferred the contested mark to the invalidity applicant. Subsequently, the invalidity applicant filed an application for a declaration of invalidity of the CTM on the basis of an absolute ground for invalidity under Article 52(1)(b) CTMR, namely that the proprietor of the CTM in question had acted in bad faith when filing the application for registration of the said mark. A document issued by the executor of Mr. R's will was submitted to the Office certifying that the trade mark had been transferred to the CTM owner and the change of ownership was registered. The CD rejected the request for a declaration of invalidity on the ground that there was no evidence of bad faith of Mr. R. when instructing an intermediary to file for an application for registration of the CTM. The invalidity applicant filed an appeal to the BoA against the CD's decision which was upheld, annulled the decision and declared the contested mark to be invalid. The BoA found, *inter alia*, that Mr. R. as a beneficial applicant had acted in bad faith when instructing an intermediary to file an application for registration of the said mark. The CTM owner filed an appeal to the GC relying on a single plea in law. The CTM owner relied on one plea in law alleging the infringement of Article 52(1)(b) CTMR, namely that the BoA committed an error of law in finding that Mr. R. acted in bad faith in filing, through another person, an application before the Office seeking the registration of the sign LLRG5 as a CTM (para. 27). The GC noted that one of the relevant factors to determine whether there is bad faith is when a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for, and the sign enjoys some degree of legal protection (para. 32). The CTM owner considered that Mr. R. had a legitimate interest in applying for the registration of a CTM and disputes the probative value of matters that were taken into consideration by the BoA when determining bad faith (para. 40). The GC rejected this argument since the invalidity applicant produced a formal statement by its representative, Mr. V., made before a solicitor as well as a set of documents which contained his opinion that the application for registration of the CTM, was made in bad faith due to the fact that the filing was made without the knowledge of the invalidity applicant (paras 42-43). With regard to the probative value of the statement, the GC pointed out that it did not fall solely into the category of self-supporting evidence but instead was substantiated by the documents that were submitted to the Office. It stated that the BoA did not err in law when it found that the application for a declaration of invalidity, based on bad faith on the part of Mr. R., had been substantiated by clear and convincing evidence, in particular, to the formal statement submitted (para. 46). With regard to the argument that the BoA did not draw the conclusions, it should have drawn from the evidence that was produced, the GC found that it was apparent from the case file that Mr. R. could not have been unaware that the invalidity applicant used the sign 'LLRG5' as its company name (para. 47). Furthermore, although it was not possible to establish with certainty what the common intention between the parties was with regard to the sign, no evidence was submitted that could lead to the conclusion that Mr. R. had reserved rights to himself over that name (para. 52). Therefore, the GC found that there was no error of assessment when the BoA found that the CTM owner did not prove the existence of the exclusive rights it alleged (para. 58). The GC stated that Mr. R. did not give the invalidity applicant the possibility of considering whether it was appropriate to oppose the application for registration of the sign at issue, which led to the finding that the application could be held to be a 'concealed act', carried out through an intermediary, with the intention of preventing the invalidity applicant from being able to use the sign (para. 71). In this light, it was found that the BoA did not err in finding that the invalidity applicant had proved that the application for registration of the contested mark was made in bad faith on the part of Mr. R. (para. 73). The GC dismissed the single plea in law and the application in its entirety as unfounded (para. 74).





◆ [T-395/14](#) and [T-396/14](#), **SHAPE OF A TOY FIGURE I and II (3D MARKS)**, Judgments of 17 June 2015, *Best-Lock (Europe) Ltd v OHIM – Lego Juris A/S – EN*.

Contested CTM in Case T-395/14	Contested CTM in Case T-396/14
	

The invalidity applicant applied for a declaration of invalidity of the 3D CTMs represented above as regards the goods ‘games and playthings; decorations for Christmas trees’ (Class 28) based upon Article 52(1)(a) in conjunction with Article 7(1)(e)(i) and (ii), and Article 52(1)(b) CTMR. The CD rejected the request as it found that none of the grounds of invalidity invoked by the invalidity applicant were met. The BoA dismissed the appeal. With respect to Article 52(1)(b) CTMR, the GC found that the applicant had neither put forward any evidence in the application to substantiate its assertions that the CTM owner had filed the contested CTMs in bad faith, nor referred, with the minimum level of detail required to the evidence submitted during the proceedings before the Office, nor submitted arguments to contest the specific findings made by the Office with regard to the CTM owner’s bad faith.

◆ [T-98/13](#) and [T-99/13](#): **CAMOMILLA / CAMOMILLA**, Judgment of 9 July 2015, *C.M.T. – Compagnia Manifatture Tessili S.r.l., v OHIM - Camomilla S.p.A. – IT*.

CTMAs	Earlier mark
	


Camomilla S.p.A., (the CTM owner) was granted CTM registration for the abovementioned figurative marks for goods in Classes 16, 18, and 24 and for goods in Classes 3, 9, 14, 16, 21, 24 e 28. *Compagnia Manifatture Tessili S.r.l.*, (applicant before the GC or applicant), submitted two applications for a declaration of invalidity against the marks at issue, based on the abovementioned figurative Italian mark registered for ‘clothing items’ in Class 25. The applications were filed under Article 52(1)(b) CTMR and



Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) and Article 8(5) CTMR. The CD dismissed the applications for invalidity. The BoA confirmed the CD's decision and dismissed the appeal. The BoA found that the applicant did not show that the contested mark was registered in bad faith under Article 52(1)(b) CTMR. In relation to Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR, the BoA found that there was no likelihood of confusion since there was no similarity between the goods at issue. Therefore, the ground based on Article 8(1)(b) CTMR was also dismissed. The applicant filed two actions before the GC, alleging infringement of Article 52(1)(b) CTMR, infringement of Article 53(1)(a) in conjunction with Article 8(1)(a)(b) CTMR and the infringement of Article 53(1)(a) in conjunction with Article 8(5) CTMR. The GC joined the two cases. In relation to the infringement of Article 52(1)(b) CTMR — bad faith: The GC recalled that there is not a definition of 'bad faith' in the legislation, but that the case law has given some important guidance about how to interpret this concept. The GC confirmed the case law that the three factors set out in the 'Chocoladefabriken Lindt & Sprüng' judgment (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361 (identity/confusing similarity of the signs; knowledge of the use of an identical or confusingly similar sign and dishonest intention on the part of the CTM owner)) are only examples drawn from a number of factors which can be taken into account in order to decide whether the applicant was acting in bad faith at the time of filing the application. For example, account may also be taken of the commercial logic underlying the filing of the application for registration of the sign as a CTM and the chronology of events relating to the filing (paras 37-42). The GC recalled in particular the case law according to which the mere knowledge of the earlier marks is not sufficient, in itself, to conclude that the CTM owner was acting in bad faith. Consequently, in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration. The CTM owner's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case. To that respect, the GC noted that the applicant only argued that the same disputes between the parties were able to demonstrate the conscious and deliberate intention of the CTM owner to appropriate the 'Camomilla' mark, previously used and register by the applicant. Those disputes would show that the filing of the CTMs was made for the only purpose of reinforcing the parallel national marks, by so extending their protection to goods not compatible with those of the applicant. Therefore, according to the applicant, the sole objective of the CTM owner was that of preventing the applicant from entering the EU market. The GC found that the existence of a previous dispute between the parties does not show per se that the party that registered its national mark also as a CTM acted in bad faith. The GC further found that there was no evidence showing that the applicant had the intention to exploit its national mark in the market sectors at issue, neither that the CTM owner knew about that intention at the relevant time (paras 46 to 50). The GC also recalled the case law for which good faith is presumed until proof to the contrary is adduced. Therefore, the invalidity applicant needs to prove that there was bad faith on the part of the CTM owner at the time of filing the CTM. Consequently, the applicant's observations, devoid of any evidence to support them, are not sufficient to prove bad faith from the CTM owner (para. 51). The first applicant's plea was therefore dismissed.



◆♦ [T-100/13](#); **CAMOMILLA / CAMOMILLA**, Judgment of 9 July 2015, *C.M.T. – Compagnia Manifatture Tessili S.r.l., v OHIM – Camomilla S.p.A* – IT.

CTMA	Earlier mark
CAMOMILLA	

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

Compagnia Manifatture Tessili S.r.l., (applicant before the GC or applicant), submitted an application for a declaration of invalidity of the mark at issue, based on the above indicated figurative Italian mark registered for ‘clothing items’ in Class 25. The application was filed under Article 52(1)(b) CTMR and Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) and Article 8(5) CTM. The CD dismissed the application for invalidity. The BoA confirmed the CD’s decision and dismissed the appeal. The BoA found that the applicant did not demonstrate that the contested mark was registered in bad faith under Article 52(1)(b) CTMR. In relation to Article 53(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR, the BoA found that the genuine use of the earlier mark was not proven, in particular as far as the nature of the use was concerned. The BoA also found that the additional documents filed before the BoA in order to demonstrate the use of the earlier mark could not be taken into account since they had been filed out of time. The BoA stated that belated evidence could be admitted only when ‘new elements’ occurred to the extent that it became necessary to assess that evidence, which was not the case. Therefore, the ground based on Article 8(1)(b) CTMR was dismissed. The applicant filed an action before the GC, alleging three pleas in law: the infringement of Article 52(1)(b) CTMR, the infringement of Article 53(1)(a) in conjunction with Article 8(1)(b) CTMR and the infringement of Article 53(1)(a) in conjunction with Article 8(5) CTMR. In relation to the infringement of Article 52(1)(b) CTMR — bad faith: The GC recalled that there is not a definition of ‘bad faith’ in the legislation, but that the case law has given some important guidance about how to interpret this concept. The GC confirmed the case law that the three factors set out in the ‘Chocoladefabriken Lindt & Sprüng’ judgment (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361 (identity/confusing similarity of the signs; knowledge of the use of an identical or confusingly similar sign and dishonest intention on the part of the CTM owner)) are only examples drawn from a number of factors which can be taken into account in order to decide whether the applicant was acting in bad faith at the time of filing the application. For example, account may also be taken of the commercial logic underlying the filing of the application for registration of the sign as a CTM and the chronology of events relating to the filing (paras 33-36). The GC recalled in particular the case law according to which the mere knowledge of the earlier marks is not sufficient, in itself, to conclude that the CTM owner was acting in bad faith (paras 38-36). Consequently, in order to determine whether there was bad faith, consideration must also be given to the applicant’s intention at the time when the application for registration is filed. The CTM owner’s intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case. In that respect, the GC noted that the applicant only argued that the same disputes between the parties were able to demonstrate the conscious and deliberate intention of the CTM owner to appropriate the ‘Camomilla’ mark, previously used and registered by the applicant. Those disputes would show that the filing of the Community marks was made for the only purpose of reinforcing the parallel national marks, by so extending their protection to goods not compatible with those of the applicant. Therefore, according to the





applicant, the sole objective of the CTM owner was that of preventing the applicant from entering the EU market (paras 38-39). The GC found that the existence of a previous dispute between the parties does not show per se that the party that registered its national mark also as a Community mark acted in bad faith (para. 41). The GC further found that there was no evidence showing that the applicant had the intention of exploiting its national mark in the market sectors at issue, nor that the CTM owner knew about that intention at the relevant time. The GC also recalled the case law for which good faith is presumed until proof to the contrary is adduced. Therefore, the invalidity applicant needs to prove that there was bad faith on the part of the CTM owner at the time of filing the CTM. Consequently, the applicant's observations, devoid of any evidence to support them, are not sufficient to prove bad faith from the CTM owner (paras 41-44). The first applicant's plea was therefore dismissed.

C. Article 53(1), (2) and (3) CTMR — other relative grounds for invalidity

◆ [T-544/12](#) and [T-546/12](#): *pensa / PENTASA* and *PENSA PHARMA / PENTASA*, Judgment of 3 June 2015, *Pensa Pharma, SA v OHIM* – EN. The CTM owner registered the word mark 'PENSA PHARMA' and the figurative mark 'pensa' as CTMs for goods and services within Classes 3, 5 and 44. The invalidity applicants filed first oppositions which were afterwards withdrawn. After registration of the contested marks, applications for invalidity based on the earlier word mark 'PENTASA' registered for goods in Class 5, namely 'pharmaceutical preparations', in several Member States, were filed on the grounds of Article 8(1)(b) CTMR. The list of contested goods was restricted to Classes 5 and 44. The CD upheld the applications for invalidity. The BoA dismissed the CTM owner's appeals finding that the goods and services at issue were identical or similar and that the marks were also similar. The visual differences between the marks were not sufficient to rule out a likelihood of confusion, in view, inter alia, of the highly distinctive character acquired through use of the earlier rights. Neither the CTM owner's arguments relating to the invalidity applicants' consent to the registration of the contested marks may be taken into consideration for the purposes of assessing whether there is a LOC. The CTM owner filed an action before the GC. The GC first decided on inadmissibility of documents submitted for the first time before the GC (para. 25) and of arguments put forward for the first time at the hearing (para. 31) referring to settled case law. **FIRST PLEA IN LAW — ARTICLE 53(3) CTMR**: The consent of the proprietor of the right must be express for the registration of a sign which may result in a LOC to be permitted (para. 37). The peaceful coexistence of the marks at issue cannot take the place of the 'express consent' of the right holder (for the purposes of Article 53(3) CTMR) to the registration (para. 40). Furthermore, despite the argument of the peaceful coexistence in Italy and Spain, a LOC established in one or more Member States is sufficient to refuse registration of a trade mark applied for without it being necessary to rule on the LOC in other states relevant to the dispute (para. 42). Regarding the withdrawal of the oppositions, the GC stresses out that the principle of procedural economy cannot preclude a party's right to protect its earlier rights by withdrawing its opposition with a view to filing an application for a declaration of invalidity. In the absence of any provision to the contrary in the legislation, a party is free to choose the legal remedy which it intends to use to assert its rights (para. 45). The coexistence agreement cannot be interpreted in such a way as to the extent beyond its scope without the express consent of the parties; there is no consent on the part of the invalidity applicants (paras 50-51). A clerical error made by the BoA in the contested decision is not capable of invalidating its findings as to the inapplicability of the coexistence agreement to the marks at issue, since it draws no formal inferences as to the lawfulness of the decision (para. 52-54). The first plea was thus rejected as unfounded.



◆♦ [T-404/10 RENV](#); **DEVICE OF A HAND**, Judgment of 30 June 2015, *Gambling Commission (formerly National Lottery Commission) v OHIM* — EN.

CTMA	Earlier Copyright
	

The CTM proprietor obtained the registration of the CTM figurative mark represented above. Two applicants filed a joint invalidity request on the basis of Article 52(2)(c) CTMR, invoking a prior copyright, under the Italian law, in the figurative sign reproduced above. The invalidity applicants relied on an agreement dated 16 September 1986 (the date resulting from a post office stamp affixed to it) under which a third party purporting to be the author of the allegedly earlier copyright claimed that he had assigned to one of them his rights to reproduce and use the work in question. The CTM proprietor argued that the mentioned agreement presented certain anomalies that she doubts as to the reliability of the date resulting from the post office stamp affixed to the document and, therefore, on whether an earlier copyright existed at all. THE DECISION OF THE CD: the CD granted that application for a declaration of invalidity on the ground, in essence, that the applicants for a declaration of invalidity had demonstrated the existence of an earlier copyright protected by Italian legislation and which was virtually identical to the contested trade mark. THE DECISION OF THE BoA: the BoA dismissed the CTM proprietor's appeal, holding that the anomalies invoked by the CTM proprietor did not give grounds for doubting the veracity of the content of the 1986 agreement. In that context, the BoA considered, in essence, that it was not competent to assess the validity of the 1986 agreement and that this could only be challenged by bringing separate judicial proceedings for declaration of forgery. The CTM proprietor filed an action before the GC. THE JUDGMENT OF THE GC: the GC granted the appeal, holding on the one hand that the BoA had infringed Article 53(2)(c) CTMR insofar as it had found that the existence of an earlier copyright had been proved by the invalidity applicants and, on the other, finding that the BoA had incorrectly assessed its powers to determine whether that agreement was authentic. In particular, the GC referred to an article of the Italian Civil Code and a judgment of the ISCC interpreting that article — neither of which had been invoked and relied upon by the parties before the Office — and held that, in accordance with that judgment, it was open for the CTM proprietor, without it being necessary to bring separate proceedings for a declaration of forgery, to adduce proof that, in fact, the 1986 agreement had been drawn up on a date other than that shown on the post office stamp. The GC therefore inferred from this that the BoA had misinterpreted the national law applicable pursuant to Article 53(2) CTMR and therefore had failed to assess accurately the precise scope of its own powers. Had the BoA considered itself competent to assess the validity of the 1986 agreement, it might have come to a different conclusion. THE APPEAL LODGED BY THE OFFICE: the Office filed an appeal to the 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. The Office argued that it read the judgment of the CJ in the *Edwin v OHIM* case (05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452) 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 CTM prohibited by virtue of an earlier right, but also particulars establishing the content of that law. THE JUDGMENT OF THE CJ: 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 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 Office's decision is called to take in an invalidity scenario, which 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 abovementioned judgment of the ISCC, 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. NEW JUDGMENT OF THE GC: the GC issued a new judgment, again rejecting the Office's arguments and noting that the abovementioned judgment of the ISCC necessarily implies greater freedom on the BoA's part in the assessment of the evidence. Thus, the GC annulled the decision of the BoA, holding that it could not be excluded that the BoA would have reached a different conclusion had it considered itself fully competent to assess the validity of the 1986 agreement, which had been filed to prove the existence of the alleged earlier copyright.

D. Article 54 CTMR — acquiescence

[no entry]



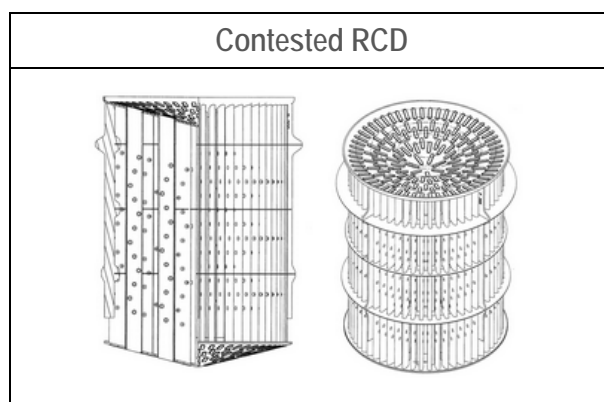
VI. Design Matters

A. Article 3(a) and Article 9 CDR — registration proceedings

[no entry]

B. Article 25(1)(b) CDR — invalidity proceedings

[T-617/13](#) and [T-616/13](#); **DESIGN OF HEAT EXCHANGER INSERTS**, Judgment of 20 January 2015, *Aic S.A. v OHIM* – EN.



The goods to which the contested registered Community design (RCD) is intended to be applied are in Class 23.03 of the Locarno Agreement and correspond to the following description: ‘heat exchangers inserts’. The invalidity applicant filed an application with the Office for a declaration of invalidity of the contested RCD based on Article 25(1)(b) CDR on the ground that it did not meet the requirements of Article 4(1) and (2) CDR in conjunction with Articles 5 and 6 and Articles 8(1) and (2) CDR. The Invalidity Division (ID) declared the RCD invalid pursuant to Article 25(1) and Article 4(2) CDR. The applicant filed an appeal against the ID decision which the BoA dismissed. The BoA found that the heat exchanger insert to which the contested RCD was applied was presented as a part of a complex product, namely a heat exchanger, which was itself incorporated into an even more complex product, in the present case, a household boiler. It also noted that no part of the heat exchanger insert remained visible after its installation in a boiler. In this regard, since the heat exchanger insert would be incorporated into a complex product it lacked both novelty and individual character since it was not visible during normal use of the complex product at issue for the purposes of Article 4(2) CDR. The applicant relied on a single plea in law alleging infringement of Article 25(1)(b) in conjunction with Article 4(2) CDR (para. 9). The main arguments put forward by the applicant were that the BoA did not take into account that the bottom of the heat exchanger has a characteristic conical shape which, as a result, requires the pipe bundles in the heat exchanger insert to have a special, specific shape (para. 17). It was also claimed that the BoA incorrectly assessed the evidence adduced by the parties and relied on presumptions that led to the finding that the contested RCD was applied to a part which necessarily formed part of the heat exchanger incorporated into a boiler intended **for domestic use** (para. 18). The GC dismissed these arguments and confirmed the BoA’s findings. In this light, firstly it is pointed out that the argument that the special, specific shape of the pipe bundles required in the heat exchanger insert as a result of the characteristic conical shape of the heat exchanger, should be rejected as unfounded. Since the heat exchanger was



considered invalid on the basis of Article 4(2) CDR, the assessment should be if it constitutes a visible part of a complex product and therefore the shape of the heat exchanger cannot be of use when assessing the visibility of the insert once incorporated into a boiler, an issue that would fall within the scope of Article 8 CDR (designs dictated by their technical function) (para. 21). Secondly, the GC refers to Article 63(1) CDR concerning the evidence taken into account by the BoA and indicates that it is for the parties to adduce evidence to support their claims and in this regard, the evidence adduced by the applicant did not relate to the heat exchanger inserts covered by the contested RCD. Therefore, the evidence provided by the applicant cannot be used to challenge the conclusions reached by the BoA (para. 23). The GC concluded that the evidence produced before the BoA by the invalidity applicant made it possible to conclude that the contested RCD concerned a part intended to be incorporated into a complex product (para. 24). Furthermore, the GC notes that the applicant did not dispute that a heat exchanger insert is an internal part of a complex product, namely a heat exchanger (para. 25) as well as did not provide any specific evidence to contradict any of the findings of the BoA (para. 28). Nevertheless, the GC states that the Office is under a duty to exercise its powers in accordance with the general principles of EU law, namely of equal treatment and sound administration. Therefore, the examination of any design must be stringent and comprehensive in order to prevent designs from being improperly registered (para. 32). However, in the present case none of the evidence provided by the applicant could reverse the BoA's decision, namely that it erred in finding that the heat exchanger was necessarily part of a complex product, namely a **household boiler** in which a heat exchanger is incorporated (para. 33). Taking the aforementioned into account, the GC rejected the plea in law and dismissed the action in its entirety (para. 36).

[T-615/13](#); DESIGN OF A HEAT EXCHANGER, *Aic S.A. v OHIM*, Judgment of 20 January 2015 – EN.



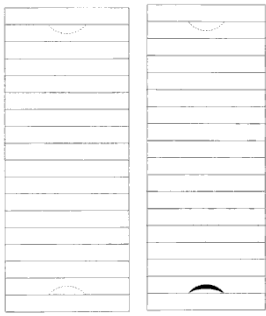
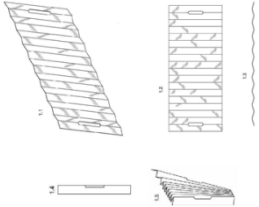
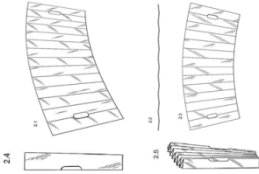
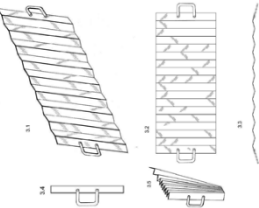
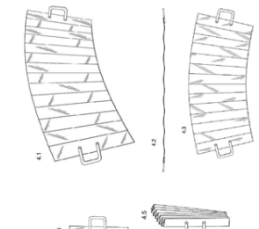
The goods to which the registered Community design (RCD) is intended to be applied are in Class 23.03 of the Locarno Agreement and correspond to the following description: 'heat exchangers'. The invalidity applicant filed an application with the Office for a declaration of invalidity of the contested RCD based on Article 25(1)(b) CDR on the ground that it did not meet the requirements of Article 4(1) and (2) CDR in conjunction with Articles 5 and 6 and Article 8(1) and (2) CDR. The ID declared the RCD invalid pursuant to Articles 4(2) and 25(1) CDR. The applicant filed an appeal against the ID's decision, which the BoA dismissed. The BoA found that the heat exchanger was presented as part of a complex product and that no part of it remained visible after its installation in a boiler. In this regard, since the heat exchanger would be incorporated into a complex product it lacked both novelty and individual character since within the meaning of Article 4 CDR it was not visible during normal use of the complex product at issue for the purposes of Article 4(2) CDR. The applicant relied on a single plea in law alleging infringement of



Article 25(1)(b) in conjunction with Article 4(2) CDR (para. 9). The main arguments put forward by the applicant were that the BoA did not consider that the appearance of a heat exchanger could be separated from its performance and that it relied solely on the evidence provided by the other party to the proceedings, which showed that a heat exchanger was necessarily incorporated into a boiler (para. 17). In this regard, it was claimed that the BoA did not provide an appropriate assessment of the prerequisite of visibility of the contested RCD during normal use. The GC dismissed these arguments and confirmed the BoA's findings. In this light, firstly it is pointed out that the question raised in the appealed decision is not whether the appearance of a heat exchanger may be separated from its performance, an issue dealing within the scope of Article 8 CDR, which deals with designs dictated by their technical function and designs of interconnections, but whether the heat exchanger at issue constitutes a visible part of a complex product according to Article 4(2) CDR (para. 21). Secondly, the GC refers to Article 63(1) CDR concerning the evidence taken into account by the BoA and indicates that it is for the parties to adduce evidence to support their claims and in this regard, the applicant's criticism that the BoA relied on the evidence brought by the other party cannot be accepted (para. 23). The GC concluded that the evidence produced before the BoA by the invalidity applicant made it possible to conclude that the contested RCD concerned a part intended to be incorporated into a complex product (para. 24). Also, the GC notes that the applicant did not provide any evidence to contradict any of the findings of the BoA (para. 25). Nevertheless, the GC states that the Office is under a duty to exercise its powers in accordance with the general principles of EU law, namely of equal treatment and sound administration. Therefore, the examination of any design must be stringent and comprehensive in order to prevent designs from being improperly registered (para. 28). However, in the present case none of the evidence provided by the applicant could substantiate the assertion that the BoA erred in finding that the heat exchanger was necessarily part of a complex product, namely a boiler for domestic use rather than for industrial use (para. 29). Furthermore, the BoA did make an assessment with regard to the possibility of the heat exchanger being used in installations other than a boiler for domestic use. However, the applicant did not provide any further evidence concerning the use of the heat exchanger to which the contested RCD is applied (para. 30). Taking the aforementioned into account, the GC rejected the plea in law and dismissed the action in its entirety (para. 32).



T-41/14; DESIGN OF ADVERTISING ARTICLES, Judgment of 28 January 2015, *Argo Development and Manufacturing Ltd v OHIM* – EN.


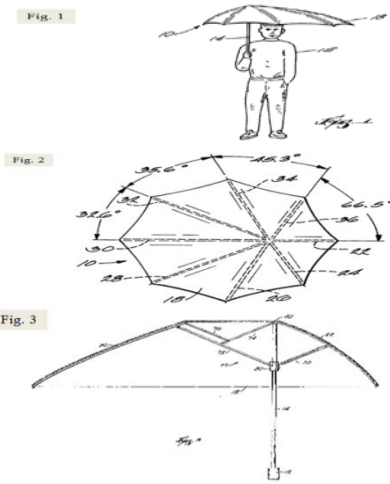
Contested RCD	Earlier Designs
	<p>(1)</p>  <p>(2)</p>  <p>(3)</p>  <p>(4)</p> 

The design holder registered the design represented above (RCD) with the product indication ‘advertising articles’. An invalidity application for lack of novelty and individual character was filed based on the designs represented above. The ID upheld the application for invalidity. The BoA in turn upheld the design holder’s appeal. The invalidity applicant filed an action before the GC. The contested RCD does not constitute a complex product and thus the invalidity applicant cannot effectively claim that part of the handles do not remain visible during normal use under Article 4 CDR (paras 13-18). As to the novelty, the differences in the conflicting signs’ handles is not immaterial within the meaning of Article 5(2) CDR (paras 19-25). The contested RCD applies to a rectangular cardboard signboard divided into pleats, which can be folded like an accordion, and that the signboard can be used in an unfolded position in



order to convey a message or, in a folded state, to produce a sound effect (paras 30-33). The informed users are both the persons who use the signboards at group events and the bodies which buy and distribute them (para. 35). The rectangular shape of the cardboard signboard and its division into accordion-like foldable pleats constitute two features in relation to which the designer has a very limited degree of freedom. The handles are the only part of the signboards in relation to which the designer had some creative freedom (paras 37-48). For the comparison of the overall impression, therefore, the aspect of the handles plays an essential role. The handles are visible folded and unfolded. The handles in the earlier designs (3) and (4) are attached whereas they are represented as a line of perforations to be pressed out in the RCD. Given the very limited degree of freedom of the designer these differences produce a different overall impression. The handles in the earlier designs (1) and (2) are cut out and have an oblong shape, whereas they have a semi-circular shape in the RCD. In addition, they are positioned differently on the signboard. Hence, they also give rise to a different overall impression (paras 49-63). The invalidity applicant cannot claim that the holder was registered in bad faith since Article 25(1) CDR is exclusive in character and does not provide for such an invalidity ground (paras 65-66). The GC dismissed the action in its entirety.

◆ [T-22/13](#) and [T-23/13](#); DESIGN OF UMBRELLAS, Judgment of 21 May 2015, *Senz Technologies BV v OHIM* – EN.

Contested RCD	Earlier US Design Patent
	

The applicant filed two applications for registration of Community designs (RCD's) which were registered with the indication mentioning 'umbrellas' (hereinafter the contested RCDs). The intervener lodged an application for a declaration of invalidity based on Article 25(1)(b) CDR, alleging that the contested RCDs did not comply with the requirements laid down in Articles 4 to 9 CDR. The intervener invoked that the umbrellas covered in the contested RCDs did not have individual character as they created the same overall impression on the informed user, as a certain number of umbrellas that had an identical/similar shape and which have been the subject of patents or designs registered and made available to the public prior to the registration of the contested RCDs. The earlier rights relied on included an American patent. The ID upheld the intervener's applications for a declaration of invalidity. It found that the earlier patent had been made available to the public within the meaning of Article 7(1) CDR as well as being devoid of



individual character within the meaning of Article 6(1) CDR. The applicant brought an appeal against each of the decisions adopted by the ID. The BoA dismissed the appeals on the ground that the contested RCDs did not have distinctive character. In this light, the BoA considered that the earlier patent could reasonably be known to the circles specialised in the sector concerned within the EU, since the site of the USPTO is accessible free of charge. It was also held that the informed user knows the different designs and the normal characteristics of umbrellas and has a relatively high level of attention. With regard to the freedom of the designer, the BoA held that there is some degree of freedom considering the wide range of possibilities of decorating the canopy of an umbrella with patterns and colours. The applicant filed an action before the GC in both cases T-22/13 and T-23/13 pleading for annulment of the contested decisions. The applicant relied on two pleas in law: (i) infringement of Article 7(1) CDR and (ii) infringement of Article 6(1) CDR. With regard to the first plea in law, the applicant begins by criticising the BoA for having held that an American patent could be known to circles specialised in the sector concerned operating in the EU (para. 19). Secondly, the applicant criticises the BoA for having held that the average EU designer of umbrellas would have known that, in the United States, the term 'patent' also refers to 'design', when even many European intellectual property lawyers are not aware of this fact (para. 20). Thirdly, the applicant challenges the BoA's statement that 'it would be imprudent for designers seeking to register designs in the EU not to check for the existence of prior art in one of the world's major IP registers (namely the USPTO) given the almost legendary reputation of the United States as a centre of innovation and designs ...' in the sense that a small or medium sized enterprise would only search the existing market in the EU (para. 21). The applicant's fourth point of argument was, that contrary to the BoA's finding, specialised circles in the umbrella sector may not be aware of developments in the United States, because: (i) contrary to what the BoA held, the United States is not the European Union's principal trading partner in umbrellas; and (ii) it is not possible to be aware of the existence of an umbrella patented in the United States if it has never been manufactured and marketed (para. 22). The GC found that it seems reasonable that the designer of a wind-resistant umbrella will undertake searches in patent registers before placing them on the market, as it may be deemed to know that such a product must meet not only aesthetic but also technical requirements (para. 32). In this light, the applicant failed to substantiate the argument that specialised circles in the umbrella sector do not engage in such searches (para. 32). With regard to the second argument concerning the fact that EU lawyers are unaware of design patents, the GC found that the applicant failed to adduce any factual evidence or arguments to support such allegation (para. 33). As to the third argument presented above, the GC found that the applicant did not provide any specific information about the companies operating in the EU umbrella sector and therefore, failed to substantiate its allegations (para. 35). Lastly, with regard to the fourth argument presented above, the GC found that Article 7(1) CDR does not impose any requirement that the earlier design relied on by the opposing party, must have been used for the manufacture or marketing of a product (para. 36). The argument put forward regarding the fact that the earlier patent could not have been known by the circles specialised in the sector because it had never been produced was not accepted by the GC, since the sector concerned could have gained knowledge otherwise, namely through an online search in the US Patent Register (para. 37). In addition, the GC found that even if the USA is not the EU's principal trading partner, this fact does not preclude the fact that the earlier patent could have been known to the specialised circles (para. 38). In this light, the first plea in law was rejected in its entirety. With regard to the second plea in law, the GC upheld the definition of the informed user provided by the BoA, as someone wishing to use an umbrella, who needs to purchase one and who has become informed on the subject (para. 41-46). With regard to the level of attention of the informed user, it was held that neither an unusual shape of the umbrellas at issue nor the fact that they may be solely a fashion accessory affects the level of attention of the informed user (para. 53). When assessing the



freedom of the designer, the GC pointed out that the umbrellas covered by the contested RCDs are umbrellas intended to have a wind-resistant function, which places limitations subsequently on the possibilities for varying, inter alia, the shape and depth of the canopy, ribs and eye savers (para. 58). Accordingly, the GC concluded that the degree of freedom of the designer is limited resulting in the fact that even minor differences between the earlier patent and the contested RCDs suffice to produce different overall impressions on the informed user (para. 59). Regarding the overall impressions produced by the earlier patent and the contested RCDs, the GC concluded that the canopy shapes that characterise the overall impressions produced by the earlier patent and by the contested RCDs are the ones that give each of the umbrellas examined a very specific and, therefore, individual character within the meaning of Article 6(1) CDR, rejecting the arguments put forward by the Office and the intervener (para. 93-95). The GC points out that if the Office's line of argument were to be followed, it would lead to a situation where the proprietor of the first design registered for a new product could prevent protection of any subsequent design concerning the same category of products on the sole ground that the new and unusual character of the design of the first model no longer allows for identification and perception of differences in subsequent models or, that the first design protected precludes, for the duration of its protection, any future design concerning the same type of product (para. 95). In this light, The GC concluded that the BoA erred in attaching only limited importance to the features which also resulted from the wind-resistance function of the umbrellas covered by the contested RCDs for the purpose of assessing the individual character of those designs (para. 101). The GC therefore concluded that the applicant's second plea was admissible. The action was upheld and the contested decision annulled (para. 102).

[T-525/13](#); **DESIGN OF HANDBAGS**; Judgment of 10 September 2015; *H&M Hennes & Mauritz BV & Co. KG v OHIM* – EN.


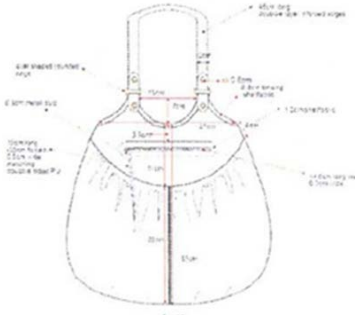
Contested RCD	Earlier design
	

The RCD proprietor registered a design for handbags in Class 03-01. The invalidity applicant claimed that the contested RCD lacked individual character within the meaning of Article 6 CDR, invoking his earlier design reproduced above. The ID rejected the application. The invalidity applicant appealed the decision and its appeal was dismissed by the BoA. Before the GC, the invalidity applicant alleges that: 1) the BoA did not sufficiently state why the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression 2) the BoA erroneously concluded that the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression and that the differences between the designs at issue were significant enough to create a different overall impression, failing to identify and correctly



asses the similarities between the designs. The BoA did not fail to state the reasons for its decision since its reasoning is sufficiently clear and unequivocal. The invalidity applicant's claim is therefore rejected as unfounded (para. 18). The assessment of the designer's degree of freedom does not necessarily constitute a preliminary and abstract step in the comparison of the overall impression by each design at issue (para. 33). The BoA correctly found that was the designer's degree of freedom was a factor which made it possible to moderate the assessment of the individual character of the contested RCD (para. 35). The BoA correctly stated that the overall impressions produced by designs differed as to three features which decisively influenced their overall visual appearance, namely the overall shape, structure and surface finish of the bag (para. 36). The assessment of the overall impression produced by a design includes the manner in which the product represented by that design is used. The contested RCD represents a bag to be carried solely by hand, whereas the earlier design represents a bag to be carried on the shoulder. Accordingly, the features that are common to the two designs at issue, namely their upper contour and the presence of a handle in the form of a strap or straps attached to the body by a system of rings reinforced by rivets, do not suffice to confer the same overall impression (para. 39). Even assuming that the invalidity applicant's claim is admissible, it is wholly unfounded. The action must therefore be dismissed in its entirety (paras 44-45).

[T-526/13](#); **DESIGN OF HANDBAGS**; Judgment of 10 September 2015; *H&M Hennes & Mauritz BV & Co. KG v OHIM* – EN.


Contested RCD	Earlier design
	

The RCD proprietor registered a design for handbags in Class 03-01. The invalidity applicant claimed that the contested RCD lacked individual character within the meaning of Article 6 CDR, invoking his earlier design reproduced above. The ID rejected the application. The invalidity applicant appealed the decision and its appeal was dismissed by the BoA. Before the GC, the invalidity applicant alleges that: 1) the BoA did not sufficiently state why the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression 2) the BoA erroneously concluded that the high degree of freedom of the designer did not have any impact on the finding that the designs at issue produced a different overall impression and that the differences between the designs at issue were significant enough to create a different overall impression, failing to identify and correctly assess the similarities between the designs. The BoA did not fail to state the reasons for its decision since its reasoning is sufficiently clear and unequivocal. The invalidity applicant's claim is therefore rejected as unfounded (para. 18). The assessment of the designer's degree of freedom does not necessarily constitute a preliminary and abstract step in the comparison of the overall impression by each design at



issue (para. 33). The BoA correctly found that was the designer’s degree of freedom was a factor which made it possible to moderate the assessment of the individual character of the contested RCD (para. 35). The BoA correctly stated that the overall impressions produced by designs differed as to three features, which decisively influenced their overall visual appearance, namely the overall shape, structure and surface finish of the bag (para. 36). The assessment of the overall impression produced by a design includes the manner in which the product represented by that design is used. The contested RCD represents a bag to be carried solely by hand, whereas the earlier design represents a bag to be carried on the shoulder. Accordingly, the features that are common to the two designs at issue, namely their upper contour and the presence of a handle in the form of a strap or straps attached to the body by a system of rings reinforced by rivets, do not suffice to confer the same overall impression (para. 39). Even assuming that the invalidity applicant’s claim is admissible, it is wholly unfounded. The action must therefore be dismissed in its entirety (paras 44-45).

[T-278/14](#); DESIGN OF BELTS, Judgment of 9 of September 2015, *Mansour Dairek Attoumi v OHIM* – ES.


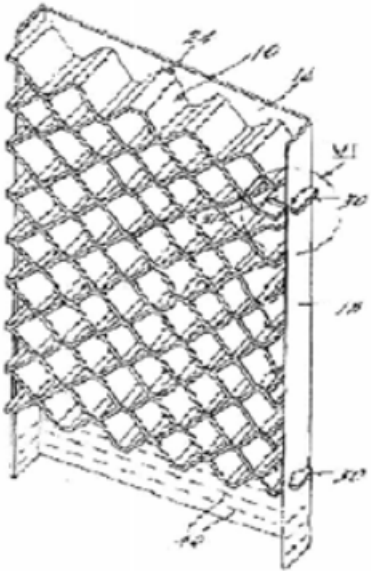
Contested RCD	Earlier mark
	<p style="text-align: center;">DIESEL</p>

The invalidity applicant is the proprietor of the earlier international word mark represented above, with effect in Spain and other EU countries, registered for the goods and services within Classes 3, 9, 14, 16, 18, 24 and 25. On 12 August 2010, on the basis of the earlier international word mark, the invalidity applicant filed an application for declaration of invalidity of the RCD represented above, registered for the products ‘belts’ in Class 02.07 of the Locarno Classification. The RCD proprietor requested proof of genuine use of the earlier trade mark to be furnished. The ID declared the invalidity of the RCD. The BoA decided not to stay the proceedings on the basis of the invalidity application filed by the RCD proprietor against the earlier trade mark before the national court. The BoA confirmed the decision of the ID. The RCD proprietor filed an action before the GC. The GC dismissed the action of the RCD proprietor in its entirety. The GC considered that the BoA adequately examined the interests of the parties and correctly dismissed the application of suspension of the proceedings (para. 29). The GC referred to the case law stating that the judicial review of the discretion of the BoA to suspend proceedings is restricted to ensuring that there is no manifest error of assessment or misuse of powers (para. 26). There is no infringement of the right of defence of the party although the RCD proprietor was not provided with part of the evidence. According to the GC, there was no indication that the outcome of the proceedings could have been different in the case as the BoA did not base any conclusions on this particular evidence (para. 35). According to the GC sufficient evidence has been provided and the genuine use of the earlier mark has been proven for part of the goods and services (para. 58). The GC ruled that the RCD



proprietor could rely on the coexistence in the Spanish market of a trade mark identical to the earlier trade mark in order to show lower likelihood of confusion between the RCD and the earlier trade mark. However, the RCD proprietor was unable to prove that the LoC is lower. The GC stated that the mere lack of action by the invalidity applicant against the coexisting mark is not sufficient to support this allegation. According to the GC, the relevant public is the average Spanish consumer and there is similarity between the goods and services. The GC ruled that the earlier trade mark and the word element represented on the RCD are visually and phonetically identical and possess at least an average degree of conceptual similarity; therefore there is a LOC (paras 78-103).

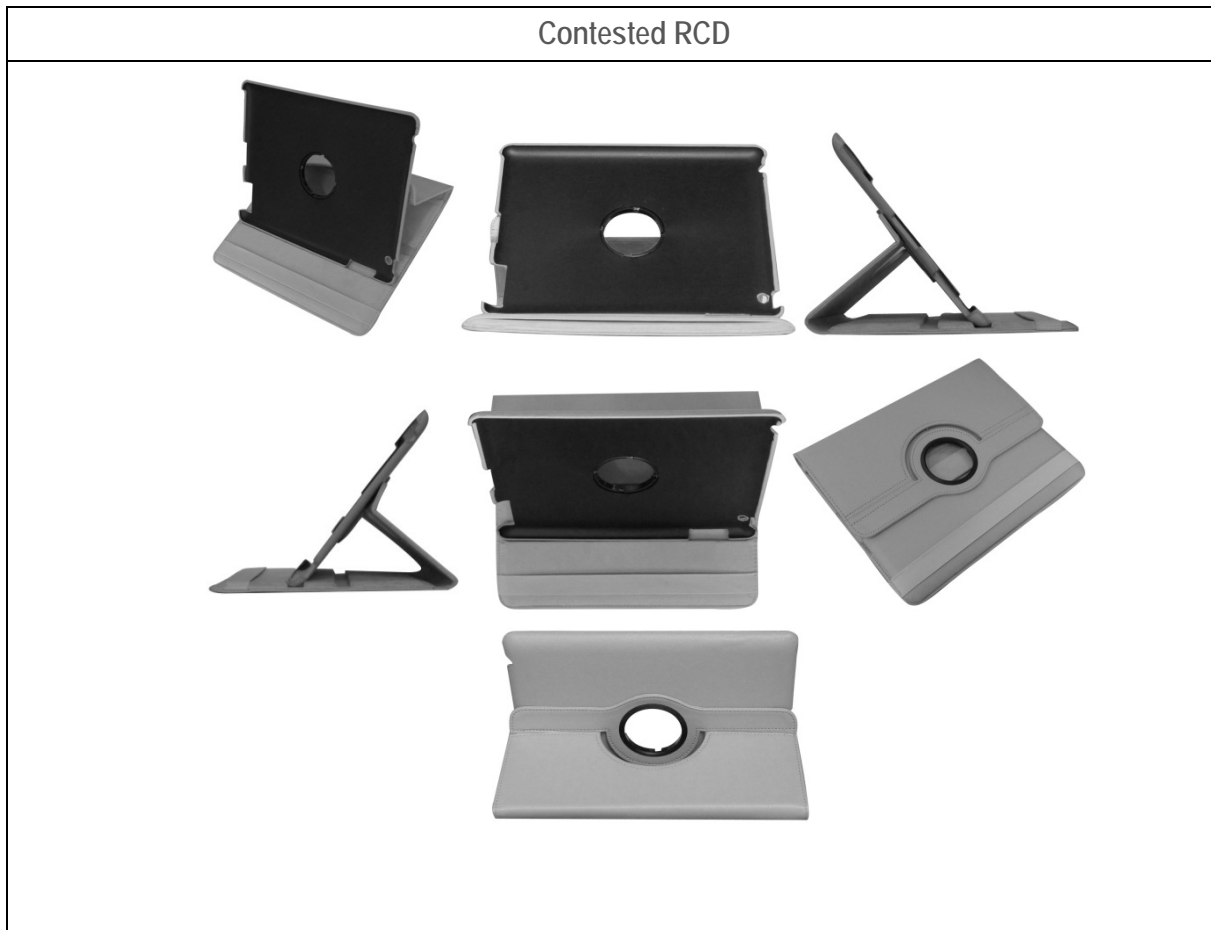
[T-251/14](#); **DESIGN OF PARTS OF DOORS**, Judgment of 15 October 2015, *Promarc Technics s.c. Tomasz Pokrywa, Rafał Natorski v OHIM* – PL.

Contested RCD	Earlier patent
	

The applicant registered the RCD represented above for ‘parts of doors’ in Class 25.02 of the Locarno Classification. An invalidity action was filed and during the invalidity proceedings it was found that the RCD lacks individual character pursuant to Article 6 CDR. The decision was confirmed by the BoA. The applicant filed an action before the GC claiming an infringement of Article 6 and Article 7(1) CDR. A publication as a patent by the USPTO is sufficient for the purposes of Article 7(1) CDR (paras 23 and 31). ‘Parts of doors’ target producers and distributors on the one hand, and the end user on the other. It is sufficient that one of these groups considers the RCD lacks an individual character (para. 48). The BoA was correct in the assessment that the challenged RCD produces the same overall impression as the invention patented by the USPTO, which was earlier than the application for the RCD and therefore lacks individual character pursuant to Article 6 CDR.



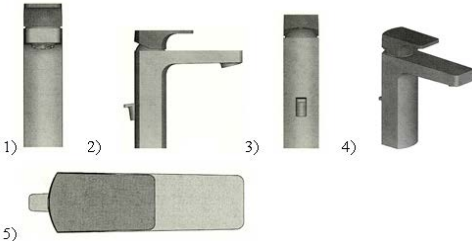

[T-813/14](#); DESIGN OF CASES FOR PORTABLE COMPUTERS, Judgment of 18 November 2015, *Min Liu v OHIM* – EN.



The applicant registered the RCD represented above. The RCD was intended to be applied to ‘cases for portable computers’. An application for a declaration of invalidity of the contested RCD, pursuant to Article 25(1)(b) CDR was filed on the grounds that the contested RCD was not new within the meaning of Article 5 CDR. The ID declared the contested RCD invalid for lack of novelty. The BoA dismissed the appeal of the applicant. The GC ruled that the contested decision is sufficiently reasoned and does not breach Article 62 CDR as even though the BoA did not provide an account that follows exhaustively, one by one, the stages of the reasoning set out by the applicant, it did implicitly, as is allowed by the case law, respond to all of the arguments of the applicant (para. 16). The GC further stated that the applicant had not proved that he is the creator of the contested RCD, therefore, he is not justified in relying on the provisions of Article 7(2) CDR (para. 30). The GC found that the argument by which the applicant seeks to establish the lack of probative value of a document, which mentions the date of first disclosure, is of no consequence since that date was used by the BoA solely as a contextual element (para. 35). According to the GC, the applicant does not develop any argument capable of proving that the BoA treated evidence submitted by the parties unequally (para. 39). The GC ruled that there is no infringement of the applicant’s right to be heard, as although it covers all the factual and legal evidence which forms the basis for making the decision, it does not apply to the final position which the administration intends to adopt (para. 40).



[T-334/14](#); DESIGN OF TAPS, Judgment of 29 October 2015; *Roca Sanitario S.A. v OHIM* – ES.

Contested RCD	Earlier RCD
	

The CD annulled the RCD for lack of novelty. The BoA annulled the CD's decision, as the designs are not identical but there are significant differences which are not insignificant details. However, it found that the RCD lacked individual character and annulled it on the basis of Article 6 in conjunction with Article 25(1)(b) CDR. It found that the degree of freedom of the designer is not limited and that, for the informed user (who is the general consumer who chooses taps for the house), the general impression produced by both designs is very similar. The differences are not sufficient to produce a different general impression on the informed user. Single plea: infringement of Article 6 in conjunction with Article 25(1)(b) CDR. The GC confirms that the degree of freedom of the designer is not limited (para. 46), that the general impression produced by both designs is very similar (para. 81), and that there is no crowded art (para. 90). The action is dismissed.



VII. Enforcement

[no entry]



VIII. Others

A. Seniority (Article 34 CTMR)

[no entry]

B. *Restitutio in integrum* (Article 81 CTMR)

[T-585/13](#) and [T-586/13](#); **Gauff JBG Ingenieure and Gauff The ENGINEERS WITH THE BROADER VIEW**, Judgment of 16 June 2015, *H.P. Gauff Ingenieure GmbH & Co.KG – JGB v OHIM – DE*. An appeal was filed against the decision of the OD, it was however filed late, after the expiry of the two month period for filing an appeal. The applicant before the GC filed a request for *restitutio in integrum* according to Article 81 CTMR. It explained that the delivery service provider confirmed the timely delivery of the appeal. The BoA rejected the *restitutio in integrum* request because the only evidence was a sworn statement by the representative. The GC states that for the assessment of the due care criteria for *restitutio in integrum* in cases of representation, the behaviour of the representative chosen by the party is relevant (para. 23). The GC further reiterates that the observance of deadlines is a matter of public policy and *restitutio in integrum* may attempt against legal certainty. Consequently, the conditions laid down in Article 81 CTMR must be applied strictly (para. 25). The GC states that the declaration from the representative comes from the interested party and has therefore a lower probative value. The consequence is that such declarations must be supported by further evidence in order to show the facts which are intended to be proven. (para. 27–30). In the absence of any further evidence the BoA was right in dismissing the request for *restitutio in integrum* (para. 31).

[T-850/14](#); **SAM BA / SAM**, Order of 21 December 2015; *CompuGroup Medical AG v OHIM – DE*. The applicant sought to register the word mark 'SAM BA' for goods and services within Classes 9, 38, 41 and 42. An opposition based on the earlier word mark 'SAM', registered for goods and services in Classes 9, 35, 37, 41 and 42, was filed on the grounds of Article 8(1)(b) CTMR. The OD partially upheld the opposition. The BoA partly upheld the applicant's appeal. The decision of the BoA was notified to the applicant via an eComm on 29 July 2014. On 29 December 2014, the applicant filed an action before the GC requesting *restitutio in integrum* and annulment of the decision of the BoA as far as it rejects the CTMA. The GC found that the BoA decision was put into the eComm account of the applicant on 24 July 2014. According to the GC this was proven by an extract from the Office's database indicating the type of the document (R420a), the number of pages and the message 'eComm OK'. Furthermore, the Office provided an extract from its electronic log files, which tracks all operations relating to a particular eComm account, confirming that the document R420a was put into the relevant eComm account on 24 July 2014. According to Rule 65(2) CTMIR in conjunction with Article 4(4) of Decision No EX-13-2 of the President of the Office of 26 November 2013 concerning electronic communications with and by the Office, notification will be deemed to have taken place on the fifth calendar day following the day on which the Office placed the document in the user's inbox. The GC therefore concluded that the decision of the BoA was notified on 29 July 2014. Furthermore, the GC concluded that following Article 65(5) CTMR and Article 102(2) RPGC, the deadline for filing an application expired on 9 October 2014. The application was only filed on 29 December 2014 and was therefore belated. Finally, the applicant did not prove or even claim *force majeure* or unforeseeable circumstances. The GC found the application to be manifestly inadmissible.



C. Classification of Goods and Services

[no entry]

D. Exhaustion of rights

[no entry]

E. *Renewal*

[T-572/12](#); *CVTC*, Judgment of 4 March 2015, *Nissan Jidosha KK v OHIM*, – EN. The applicant filed an application to register the figurative mark as a CTM for a range of goods in Classes 7, 9 and 12. The mark was registered in respect of all those goods. When the expiry date of the registration approached, the Office informed the applicant that the mark was due for renewal. The applicant requested renewal only in respect of the goods in Classes 7 and 12. The Office therefore informed the applicant that the renewal of the mark in respect of the goods in Classes 7 and 12 had been recorded in the CTM Register and that the registration in respect of the Class 9 goods had been removed from the Register. Following the CTM proprietor's subsequent request that the Class 9 goods be included in the renewal of the mark, the Office refused the request and the Administration of the Trade Marks Division subsequently confirmed that decision. On appeal, the BoA dismissed the appeal. In essence, the BoA found that the request for renewal of the mark in respect of the goods in Classes 7 and 12 constituted an express and unequivocal partial surrender, for the purposes of Article 50 CTMR, in relation to the goods in Class 9, which took effect vis-à-vis the proprietor of the mark at issue as soon as it was received. Not only was that partial surrender received, but it was also registered and the CTM proprietor notified accordingly. According to the BoA, the proprietor of the mark is bound by the declaration of surrender, which cannot be affected by the six-month grace period allowed under the third sentence of Article 47(3) CTMR. For reasons of legal certainty, the CTM proprietor could not be allowed to reverse its decision not to renew the mark at issue in respect of certain goods. The GC dismissed the appeal and confirmed the BoA's findings. The GC found that the BoA had erred in treating the request for partial renewal as equivalent to a partial surrender, and that there was no evidence to support the conclusion that, as required under Article 50 CTMR, the proprietor of the CTM had declared to the Office in writing that it was surrendering the mark in respect of the Class 9 goods (paras 27-28 and 32-33). The decision of the Administration of Trade Marks Division had clearly explained that the CTM proprietor was not entitled to the grace period, given that, during the initial period, its representative had requested renewal, and paid the related fees, in respect of two classes only and that, consequently, the Office had renewed the registration only for those two classes. It is clear from the wording of Article 47(3) CTMR that the possibility of submitting a request for renewal after the expiry of the initial period is conditional on no request for renewal having been submitted during that period (para. 38). If a request for partial renewal has been submitted before the date on which the existing registration expires and the related fees have been paid, the renewal takes effect from the day following that date. As of that date, the renewal has effect *erga omnes* (i.e. towards everyone) and, consequently, the principle of legal certainty precludes supplementation of the request for renewal after that renewal has taken effect (para. 41).




E. Surrender

[T-572/12](#); *CVTC*, Judgment of 4 March 2015, *Nissan Jidosha KK v OHIM*, – EN. The GC found that the BoA had erred in treating the request for partial renewal as equivalent to a partial surrender, and that there was no evidence to support the conclusion that, as required under Article 50 CTMR, the proprietor of the CTM had declared to the Office in writing that it was surrendering the mark in respect of the Class 9 goods (paras 27-28). The GC noted that under the above provision, a surrender must be declared to the Office in writing by the proprietor of the trade mark, whereas in the present case the form requesting the partial renewal had been submitted by a representative of the proprietor of the mark, and not by the proprietor itself (para. 29). However, the GC held that that error by the BoA could not, in the circumstances of the case, result in the annulment of the BoA’s decision. In that respect, the GC noted that the BoA’s reasoning, although succinct, should be read in the light of the statement of reasons set out in the decision of the Administration of Trade Marks Division, which must also be taken into account. That decision, having been confirmed by the BoA, and its statement of reasons, form part of the context in which the BoA’s decision was adopted.

F. Written Communications

◆ [T-361/13](#); *VIGOR / VIGAR*, Judgment of 18 November 2015, *Menelaus BV v OHIM* – EN.

CTM	Earlier mark
VIGOR	

The applicant registered the word mark ‘VIGOR’ represented above as a CTM for goods and services within Class 21. An application for invalidity was filed based on the earlier CTM reproduced above and an identical IR registered for goods in Class 21. The applicant requested the invalidity applicant to prove genuine use of the earlier marks. The CD dismissed the application for invalidity. The BoA partly upheld the invalidity applicant’s appeal and annulled the decision of the CD to the extent that that decision had rejected the application for a declaration of invalidity as regards all of the goods in Class 21, with the exception of ‘brush-making materials’ and ‘glassware, porcelain and earthenware’. The applicant filed an action before the GC. The GC rejected the applicant’s plea in law alleging, that the use of two CD-ROMs for the submission of evidence before the CD and before the BoA does not comply with Rule 22(4) CTMIR (para. 22). The GC stated that Rule 79(a) CTMIR which applies to such a situation is not limiting the types of media which make it possible to store evidence submitted as an annex to a signed document sent by post (para. 32). Furthermore, according to the GC, the applicant did not put forward any infringement of its rights of defence which could have been caused by the method of submission of the evidence in question. The GC also found that the probative value of the content of the CD-ROMs is not



called into question as the scanned documents stored in the electronic files which they contain are identifiable and legible (para. 36).



Annex 1:

Alphabetical List of GC and CJ Judgments and Important Orders in 2015 by nickname of trade mark / Registered Community Design

Actions On Appeal From The Office

◆ 101 / 501, Judgment of 3 June 2015, [T-604/13](#), *Levi Strauss & Co. v OHIM*

2D SHAPE WITH COLOURS, Judgment of 12 February 2015 in Case [C-35/14 P](#), *Enercon GmbH v OHIM & Gamesa Eólica SL*

2GOOD, Judgment of 25 September 2015 in Case [T-366/14](#), *August Storck KG v OHIM*

3D, Judgment of 17 December 2015 in Case [T-79/15](#), *Olympus Medical Systems Corp. v OHIM*

9flats.com / 50flats, Judgment of 26 February 2015 in Case [T-713/13](#), *9Flats GmbH v OHIM*

◆ A ASTER / A-STARs; Judgment of 7 July 2015 in Case [T-521/13](#), *Alpinestars Research Srl v OHIM; Kean Tung Cho, and Ling-Yuan Wang Yu*

◆ AC / AC ANN CHRISTINE et al., Judgment of 23 September 2015 in Case [T-60/13](#), *Reiner Appelrath-Cüpper Nachf GmbH v OHIM*

AERONAUTICA / NAUTICA et al., Judgment of 23 September 2015 in Case [T-193/14](#), *Cristiano di Thiene SpA v OHIM*

◆ AFRICAN SIMBA / Simba, Judgment of 22 January 2015 in Case [T-172/13](#), *Novomatic AG, v OHIM*

AGRI.CAPITAL / AgriCapital et al., Judgment of 10 June 2015 in Case [T-514/13](#), *AgriCapital Corp. v OHIM*

AINHOA, Judgment of 23 of September 2015 in Case [T-400/13](#), *L'Oréal v OHIM*

◆ AINHOA, Judgment of 23 of September 2015 in Case [T-426/13](#), *L'Oréal v OHIM*

AKTIVAMED / VAMED, Judgment of 26 March 2015 in Case [T-551/13](#), *Michael Radecki v OHIM*

◆ ALETE / ALETA, Judgment of 12 November 2015 in Case [T-544/14](#), *Société des produits Nestlé SA v OHIM*

◆ ALEX / ALEX, Judgment of 2 July 2015 in Case [T-657/13](#), *BH Stores BV v OHIM*

◆ ANGIPAX / ANTISTAX, Judgment of 10 February 2015 in Case [T-368/13](#), *Boehringer Ingelheim International GmbH v OHIM*

APRO / B-PRO et al., Judgment of 4 February 2015 in Case [T-372/12](#), *El Corte Inglés, SA v OHIM*

◆ AQUAPERFECT / WATERPERFECT, Judgment of 28 January 2015 in Case [T-123/14](#), *BSH Bosch und Siemens Hausgerate GmbH v OHIM*

ARKTIS, Judgment of 16 April 2015 in Case [T-258/13](#), *Matratzen Concord GmbH v OHIM*



ARTHUR & ASTON / ARTHUR et al., Judgment of 15 December 2015 in Case [T-83/14](#), *LTJ Diffusion v OHIM*

ATHEIST / athé, Judgment of 15 October 2015 in Case [T-714/14](#), *David Bonney v OHIM*

bambinoLÜK / BAMBINO, Judgment of 15 July 2015 in Case [T-333/13](#), *Westermann Lernspielverlag GmbH v OHIM & Diset, SA*

◆◆ **Bankia / BANKY**, Judgment of 17 September 2015 in Case [T-323/14](#), *Bankia, SA v OHIM*

Basic / BASIC, Order 16 July 2015 in case [C-400/14P](#), *Basic AG Lebensmittelhandel v OHIM & Repsol YPF SA*

◆ **BASMALI LONG GRAIN RICE RIZ LONG DE LUXE / BASMATI**, Judgment of 30 September 2015 in Case [T-136/14](#), *Tilda Riceland Private Ltd v OHIM*

◆ **BATEAUX MOUCHES**, Judgment of 26 March 2015 in Case [T-72/14](#), *Compagnie des bateaux mouches SA v OHIM*

BE HAPPY, Judgment of 30 April 2015 in Cases Joint Cases [T-707/13 and 709/13](#), *Steinbeck GmbH v OHIM*

◆ **bice / Bice**, Judgment of 17 December 2015 in Case [T-624/14](#), *Bice international Ltd v OHIM*

BIO – COMPLEXE DE PLANTES ENRICHI EN PROTEINES — PROPRE FABRICATION, Judgment of 10 September 2015 in Case [T-569/14](#), *Laverana GmbH & Co. KG v OHIM*

BIO – CON ESTRATTI VEGETALI, Judgment of 10 September 2015 in Case [T-572/14](#), *Laverana GmbH & Co. KG v OHIM*

BIO - FLUIDE DE PLANTE – PROPRE FABRICATION, Judgment of 10 September 2015 in Case [T-568/14](#), *Laverana GmbH & Co. KG v OHIM*

BIO - INGRÉDIENTS VÉGÉTAUX - PROPRE FABRICATION, Judgment of 10 September 2015 in Case [T-30/14](#); *Laverana GmbH & Co. KG v OHIM*

BIO - MIT PFLANZENFLUID - AUS EIGENER HERSTELLUNG, Judgment of 10 September 2015 in Case [T-570/14](#), *Laverana GmbH & Co. KG v OHIM*

BIONECS / BIONECT, Judgment of 26 November 2015 in Case [T-262/14](#), *Bionecs GmbH v OHIM / Fidia farmaceutici SpA*

BIO ORGANIC, Judgment of 10 September 2015 in Case [T-610/14](#), *Laverana GmbH & Co. KG v OHIM*

BIO - PROTEINREICHER PFLANZENKOMPLEX – AUS EIGENER HERSTELLUNG, Judgment of 10 September 2015 in Case [T-571/14](#), *Laverana GmbH & Co. KG v OHIM*

BLACK JACK / BLACK TRACK, Judgment of 6 March 2015 in Case [T-257/14](#), *Novomatic AG v OHIM*

◆ **BLUECO / BLUECAR**, Judgment of 25 September 2015 in Case [T-684/13](#), *Copernicus Trademark Ltd v OHIM*

BLUECO / BLUECOAT, Judgment of 21 January 2015 in Case [T-685/13](#), *Copernicus-Trademarks Ltd v OHIM*



- ◆ **bonus&more / bonus net**, Judgment of 5 February 2015 in Case [T-33/13](#), *Türkiye Garanti Bankasi AS v OHIM*
- ◆ **BULLDOG / BULL**, Judgment of 5 February 2015 in Case [T-78/13](#), *Red Bull GmbH v OHIM*
- ◆ **CACTUS OF PEACE, CACTUS DE LA PAZ / Cactus**, Judgment of 15 of July 2015 in Case [T-24/13](#), *Cactus SA v OHIM*
- CAMEA / BALEA**, Judgment of 14 January 2015 in Case [T-195/13](#), *dm drogerie markt GmbH & Co. KG v OHIM*
- ◆◆ **CAMOMILLA / CAMOMILLA**, Judgment of 9 July 2015 in Case [T-100/13](#), *C.M.T. - Compagnia Manifatture Tessili S.r.l., v OHIM - Camomilla S.p.A*
- ◆ **CAMOMILLA / CAMOMILLA**, Judgment of 9 July 2015 in Joined Cases [T-98/13 and T-99/13](#), *C.M.T. - Compagnia Manifatture Tessili S.r.l., v OHIM - Camomilla S.p.A.*
- ◆ **CASTEL / Castell**, Order of 30 April 2015 in Case [C-622/13 P](#), *Castel Frères SAS v Fürstlich Castell'sches Domänenamt Albrecht Fürst zu Castell-Castell & OHIM.*
- ◆◆ **Castello / Castelló, Castelló y Juan S.A.**, Judgment of 5 May 2015 in Case [T-715/13](#), *Lidl Stiftung & Co. KG v OHIM & Horno del Espinar, S L*
- ◆ **cat & clean / CLEAN CAT**, Judgment of 21 January 2015 in Case [T-587/13](#), *Miriam Schwerdt v OHIM*
- ◆ **CHEQUERBOARD PATTERN I**, Judgment of 21 April 2015 in Case [T-359/12](#), *Louis Vuitton Malletier v OHIM*
- ◆ **CHEQUERBOARD PATTERN II**, Judgment of 21 April 2015 in Case [T-360/12](#), *Louis Vuitton Malletier v OHIM*
- CHOICE**, Judgment of 22 October 2015 in Case [T-431/14](#), *Volkswagen AG v OHIM*
- CLEANIC natural beauty / CLINIQUE**, Judgment of 13 May 2015 in Case [T-363/12](#), *Harper Hygienics S.A. v OHIM*
- CLEANIC intimate / CLINIQUE**, Judgment of 13 May 2015 in Case [T-363/13](#), *Harper Hygienics S.A. v OHIM*
- CLEANIC Kindii / CLINIQUE**, Judgment of 13 May 2015 in Case [T-364/12](#), *Harper Hygienics S.A. v OHIM*
- COLA / COCA-COLA et al.**, Judgment of 18 March 2015 in Case [T-384/13](#), *Intermark Srl. v OHIM*
- ◆ **COLOMBIANO COFFEE HOUSE**, Judgment of 18 September 2015 in Case [T-359/14](#), *Federación Nacional de Cafeteros de Colombia v OHIM*
- ◆ **COLOMBIANO HOUSE / Café de Colombia**, Judgment of 18 September 2015 in Case [T-387/13](#), *Federación Nacional de Cafeteros de Colombia v OHIM*
- ◆ **COLOURBLIND**, Judgment of 26 February 2015 in Case [T-257/11](#), *Pangyrus Ltd v OHIM*
- COMPETITION**, Judgment of 17 September 2015 in Case [T-550/14](#), *Volkswagen AG v OHIM*



Cottonfeel, Judgment of 23 October 2015 in Case [T-822/14](#), *Geilenkothen Fabrik für Schutzkleidung GmbH v OHIM*

CREMERIA TOSCANA / la Cremeria et al., Judgment of 29 October 2015 in Case [T-256/14](#), *Andrea Giuntoli v OHIM*

CVTC, Judgment of 4 March 2015 in Case [T-572/12](#), *Nissan Jidosha KK v OHIM*

dadida / CALIDA, Judgment of 23 October 2015 in Case [T-597/13](#), *Calida Holding AG v OHIM*

◆◆ **DAISY / MARGARITAS**, Judgment of 16 December 2015 in Joined Cases [T-381/13](#) and [T-382/13](#), *Perfetti Van Melle SpA v OHIM*

◆◆ **Darjeeling collection de lingerie / DARJEELING et al.**, Judgment of 2 October 2015 in Case [T-625/13](#), *The Tea Board v OHIM*

◆◆ **Darjeeling collection de lingerie / DARJEELING et al.**, Judgment of 2 October 2015 in Case [T-626/13](#), *The Tea Board v OHIM*

◆◆ **Darjeeling / DARJEELING et al.**, Judgment of 2 October 2015 in Case [T-624/13](#), *The Tea Board v OHIM*

◆◆ **Darjeeling / DARJEELING et al.**, Judgment of 2 October 2015 in Case [T-627/13](#), *The Tea Board v OHIM*

◆ **deluxe**, Judgment of 4 June 2015 in Case [T-222/14](#), *Deluxe Laboratories, Inc. v OHIM*

DESIGN OF ADVERTISING ARTICLES, Judgment of 28 January 2015 in Case [T-41/14](#), *Argo Development and Manufacturing Ltd v OHIM*

DESIGN OF A HEAT EXCHANGER, Judgment of 20 January 2015 in Case [T-615/13](#), *Aic S.A. v OHIM*

DESIGN OF BELTS, Judgment of 09 of September 2015 in Case [T-278/14](#), *Mansour Daïrek Attoumi v OHIM*

DESIGN OF CASES FOR PORTABLE COMPUTERS, Judgment of 18 November 2015 in Case [T-813/14](#), *Min Liu v OHIM*

DESIGN OF HANDBAGS; Judgment of 10 September 2015 in Case [T-525/13](#), *H&M Hennes & Mauritz BV & Co. KG v OHIM*

DESIGN OF HANDBAGS; Judgment of 10 September 2015 in Case [T-526/13](#); *H&M Hennes & Mauritz BV & Co. KG v OHIM*

DESIGN OF HEAT EXCHANGER INSERTS, Judgment of 20 January 2015 in Cases [T-617/13](#) and [T/616-13](#), *Aic S.A. v OHIM*

DESIGN OF PARTS OF DOORS, Judgment of 15 October 2015 in Case [T-251/14](#), *Promarc Technics s.c. Tomasz Pokrywa, Rafał Natorski v OHIM*

DESIGN OF TAPS, Judgment of 29 October 2015 in Case [T-334/14](#), *Roca Sanitario S.A. v OHIM*

◆ **DESIGN OF UMBRELLAS**, Judgment of 21 May 2015 in Cases [T-22/13](#) and [T-23/13](#), *Senz Technologies BV v OHIM*



Detergent Optimiser, Judgment of 25 September 2015 in Case [T-707/14](#), *Grundig Multimedia AG v OHIM*

DEVICE OF A BLACK RIBBON, Judgment of 9 September 2015 in Case [T-530/14](#), *Verein Sterbehilfe Deutschland v OHIM*

DEVICE OF A BLUE PATTERN, Judgment of 10 September 2015 in Case [T-94/14](#), *EE Ltd. v OHIM*

DEVICE OF A BLUE SPHERE, Order of 24 June 2015 in Case [T-626/14](#), *Wm. Wrigley Jr. Company v OHIM*

◆ DEVICE OF A CIRCLE, Judgment of 23 October 2015 in Case [T-137/14](#), *I Castellani Srl v OHIM*

◆ DEVICE OF A GREEN OCTAGON, Judgment of 25 September 2015 in Case [T-209/14](#), *Carsten Bopp v OHIM*

DEVICE OF A GREY PATTERN, Judgment of 10 September 2015 in Case [T-77/14](#), *EE Ltd v OHIM*

◆◆ DEVICE OF A HAND, Judgment of 30 June 2015 in Case [T-404/10 RENV](#), *Gambling Commission (formerly National Lottery Commission) v OHIM*

DEVICE OF A PEACE SYMBOL, Order of 9 September 2015 in Case [T-633/14](#), *Monster Energy Company v OHIM*

DEVICE OF A RED AND WHITE CHECKED PATTERN, Judgment of 3 December 2015 in Case [T-327/14](#), *Compagnie des fromages & Richesmonts v OHIM*

◆ DEVICE OF A RED SOLE / my SHOES, Judgment of 16 July 2015 in Case [T-631/14](#), *Roland SE v OHIM*

◆ DEVICE OF A SHIELD, Judgment of 10 December 2015 in Case [T-615/14](#), *Fútbol Club Barcelona v OHIM*

DEVICE OF A SPHERE, Order of 24 June 2015 in Case [T-625/14](#), *Wm. Wrigley Jr. Company v OHIM*

DEVICE OF A WHITE CIRCLE AND RECTANGLE INSIDE A BLACK SQUARE, Judgment of 3 December 2015 in Case [T-695/14](#), *Omega International GmbH v OHIM*

DEVICE OF AN IVORY PATTERN, Judgment of 10 September 2015 in Case [T-144/14](#), *EE Ltd. v OHIM*

◆ DEVICE OF FIVE STRIPES, Judgment of 4 December 2015 in Case [T-3/15](#), *K-Swiss v OHIM*

◆◆ DEVICES OF BOARD GAMES, Judgment of 3 March 2015 in Cases [T-492/13](#) and [T-493/13](#), *Schmidt Spiele GmbH v OHIM*

◆ DINKOOL / DIN et al., Judgment of 10 February 2015 in Case [T-85/14](#), *Infocit – Prestacao de Servico, Comercio e Indústria, Ltd v OHIM*

◆ DINKOOL / DIN et al., Judgment of 24 June 2015 in Case [T-621/14](#), *Prestação De Serviços, Comércio Geral e Indústria, Lda. v OHIM*

DUALSAW, Judgment of 3 December 2015 in Case [T-647/14](#), *Infusion Brands, Inc. v OHIM*

DUALTOOLS, Judgment of 3 December 2015 in Case [T-648/14](#), *Infusion Brands, Inc. v OHIM*



◆ **easyAir-tours / airtours Ticket Factory**, Judgment of 13 May 2015 in Case [T-608/13](#), *easyGroup IP Licensing Ltd, & Tui AG v OHIM*

ECOSE / ECOSEC FACHADAS, Judgment of 15 July 2015 in Case [T-323/12](#), *Knauf Insulation Technology v OHIM*.

◆ **ECOSE TECHNOLOGY / ECOSEC FACHADAS**, Judgment of 15 July 2015 in Case [T-324/12](#), *Knauf Insulation Technology v OHIM*

ELITEDISPLAY, Judgment of 22 October 2015 in Case [T-563/14](#), *Hewlett Packard Development Company LP v OHIM*

ELITEPAD, Judgment of 22 October 2015 in Case [T-470/14](#), *Hewlett Packard Development Company LP v OHIM*

ELMA / ELMEX, Judgment of 22 October 2015 in Case [T-309/13](#), *Enosi Mastichoparagagon Chiou v OHIM*

Engineering for a better world, Order of 22 January 2015 in Case [T-488/13](#), *GEA Group AG v OHIM*

Engineering for a better world, Order of 6 October 2015 in Case [T-545/14](#), *GEA Group AG v OHIM*

◆◆ **ENGLISH PINK / PINK LADY**, Judgment of 25 March 2015 in Case [T-378/13](#), *Apple and Pear Australia, Star Fruits Diffusion v OHIM*

EQUIPMENT FOR LIFE, Judgment of 7 October 2015 in Case [T-642/14](#), *JP Divver Holding Company Ltd v OHIM*

ESSENCE, Judgment of 3 June 2015 in Case [T-448/13](#), *Bora Creations, SL, v OHIM*

EXTRA, Judgment of 28 April 2015 in Case [T-216/14](#), *Volkswagen AG v OHIM*

◆ **F1H2O / F1 et al.**, Judgment of 21 May 2015 in Case [T-55/13](#), *Formula One Licensing BV v OHIM & Idea Marketing SA*

◆ **FLAMINAIRE / FLAMINAIRE**, Judgment of 8 December 2015 in Case [T-583/14](#), *Giand Srl v OHIM*

◆ **FLEX**, Judgment of 7 October 2015 in Case [T-187/14](#), *Sonova Holding AG v OHIM*

◆ **FlexValve**, Judgment of 23 September 2015 in Case [T-588/14](#), *Mechadyne International Ltd v OHIM*

◆ **FoodSafe**, Order of 23 November 2015 in Case [T-766/14](#), *Actega Terra GmbH v OHIM*

FORTIFY, Judgment of 3 December 2015 in Case [T-628/14](#), *Hewlett Packard Development Company LP v OHIM*

◆ **FSA K-FORCE / FORCE-X**, Judgment of 4 March 2015 in Case [T-558/13](#), *FSA Srl v OHIM*

Gauff JBG Ingenieure and Gauff The ENGINEERS WITH THE BROADER VIEW, Judgment of 16 June 2015 in Joined Cases [T-585/13](#) and [T-586/13](#), *H.P. Gauff Ingenieure GmbH & Co.KG – JGB v OHIM*

◆ **GELENKGOLD / DEVICE OF A TIGER**, Judgment of 7 May 2015 in Case [T-599/13](#), *Cosmowell GmbH v OHIM*

GEL NAILS AT HOME, Judgment of 4 June 2015 in Case [T-140/14](#), *Bora Creations SL v OHIM*



- ◆ **GENTLECARE**, Judgment of 21 January 2015 in Case [T-188/14](#), *Grundig Multimedia AG v OHIM*
- ◆ **Genuß für Leib & Seele KLOSTER Andechs SEIT 1455 / ANDECHSER NATUR SEIT 1908 et al.**, Judgment of 8 October 2015 in Case [T-78/14](#), *Benediktinerabtei St. Bonifaz Körperschaft des öffentlichen Rechts v OHIM*
- ◆ **GLISTEN**, Judgment of 10 February 2015 in Case [T-648/13](#), *IOIP Holdings LLC v OHIM*
- GO / GO**, Judgment of 17 June 2015 in Case [T-60/14](#), *B.M.V. Mineralöl Versorgungsgesellschaft mbH v OHIM*
- GRAZIA / GRAZIA**, Order of 17 September 2015 in Case [C-548/14P](#), *Arnoldo Mondadori Editore SpA v OHIM*
- GREASECUTTER**, Judgment of 30 September 2015 in Case [T-610/13](#), *Ecolab USA, Inc., v OHIM*
- ◆ **GREEN**, Judgment of 28 January 2015 in Case [T-655/13](#), *Enercon GmbH v OHIM*
- GREEN BEANS**, Order of 9 September 2015 in Case [T-666/14](#), *Monster Energy Company v OHIM*
- GREEN'S / AMBAR GREEN**, Judgment of 21 May 2015 in Case [T-197/14](#), *La Zaragozana, S.A. v OHIM*
- ◆ **GREENWORLD**, Judgment of 27 February 2015 in Case [T-106/14](#), *Universal Utility GmbH & Co KG v OHIM*
- GROWTH DELIVERED**, Judgment of 2 December 2015 in Case [T-528/14](#), *Information Resources, Inc. v OHIM*
- ◆ **H / H**, Judgment of 22 January 2015 in Case [T-193/12](#), *MIP Metro v OHIM*
- Halal Malaysia / HALAL MALAYSIA**, Judgment of 18 November 2015 in Case [T-508/13](#), *Government of Malaysia v OHIM*
- HAPPY TIME / HAPPY HOURS**, Judgment of 15 July 2015 in Case [T-352/14](#), *The Smiley Company SPRL v OHIM / The Swatch Group Management Services AG*
- HIKARI / HIKARI**, Judgment of 11 December 2015 in Case [T-751/14](#), *Hikari Miso Co. Ltd v OHIM*
- ◆ **HostelTouristWorld.com / HOSTELWORLD.COM**, Judgment of 29 April 2015 in Case [T-566/13](#), *Hostel Tourist World, S.L. v OHIM*
- ◆◆ **HOT**, Judgment of 15 July 2015 in Case [T-611/13](#), *Australian Gold LLC v OHIM*
- ◆ **HUSKY**, Judgment of 13 February 2015 in Case [T-287/13](#), *Husky CZ s.r.o. v OHIM*
- HydroComfort**, Order of 30 November 2015 in Case [T-845/14](#), *August Brötje GmbH v OHIM*
- icexpresso + energy coffee / MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY et al** Judgment of 6 October 2015 in Case [T-61/14](#), *Monster Energy Company v OHIM*
- IDIRECT24**, Judgment of 3 September 2015 in Case [T-225/14](#), *iNET24 Holding AG v OHIM*
- iDrive / IDRIVE**, Judgment of 3 December 2015 in Case [T-105/14](#), *TrekStor Ltd v OHIM*
- IGLOTEX / IGLO**, Judgment of 23 April 2015 in Case [T-282/13](#), *Iglotex SA v OHIM*



- ◆ **INFOSECURITY**, Judgment of 23 September 2015 in Case [T-633/13](#), *Reed Exhibitions Ltd v OHIM*
- INTERFACE / Interfog**, Judgment of 27 February 2015 in Case [T-227/13](#); *Bayer Intellectual Property GmbH v OHIM*
- ◆ **IRAP**, Judgment of 12 November 2015 in Case [T-253/13](#), *Orthogen AG v OHIM*
- ◆ **KAJMAN / DEVICE OF A CROCODILE et al.**, Judgment of 30 September 2015 in Case [T-364/13](#), *Eugenia Mocek, Jadwiga Wenta KAJMAN Firma Handlowo-Uslugowo-Produkcyjna v OHIM*
- KARIS / CARYX et al.**, Judgment of 30 September 2015 in Case [T-720/13](#), *GAT Microencapsulation GmbH v OHIM*
- KIT, EL SABOR DE NAVARRA / SABORES DE NAVARRA**, Judgment of 21 January, 2015 in Case [T-46/13](#), *Sabores de Navarra, A.I.E. v OHIM*
- ◆ **KENZO / KENZO**, Judgment of 22 January 2015 in Case [T-322/13](#), *Kenzo Tsujimoto v OHIM*
- ◆ **KENZO / KENZO**, Judgment of 22 January 2015 in Case [T-393/12](#), *Kenzo Tsujimoto v OHIM*
- ◆ **KENZO ESTATE / KENZO**, Judgment of 2 December 2015 in Case [T-414/13](#), *Kenzo Tsujimoto v OHIM*
- ◆ **KENZO ESTATE / Kenzo**, Judgment of 2 December 2015 in Case [T-522/13](#), *Kenzo v OHIM*
- Kerashot / K KERASOL**, Judgment of 16 December 2015 in Case [T-356/14](#), *CareAbout GmbH v OHIM*
- KJ KANGOO JUMPS XR**, Judgment of 26 November 2015 in Case [T-390/14](#), *Etablissement Amra v OHIM*
- Klaes / Klaes**, Judgment of 12 February 2015 in Case [T-453/13](#), *Horst Klaes GmbH & Co. KG v OHIM*
- Koragel / Choragon**, Judgment of 13 May 2015 in Case [T-169/14](#), *Ferring BV v OHIM*
- ◆ **Krispy Kreme DOUGHNUTS / DONUT et al.**, Judgment of 7 October 2015 in Case [T-534/13](#), *Panrico, S.A. v OHIM*
- ◆ **LAMBDA**, Judgment of 15 July 2015 in Case [T-215/13](#), *Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM*
- LEMBERGERLAND**, Judgment of 14 July 2015 in Case [T-55/14](#), *Genossenschaftskellerei Rosswag-Mühlhausen eG v OHIM*
- LEXDELL / DELL et al.**, Judgment of 24 September 2015 in Case [T-641/14](#), *Alexandra Dellmeier v OHIM*
- LIFEDATA**, Judgment of 12 February 2015 in Case [T-318/13](#), *Vita Phone GmbH v OHIM*
- LITHOFIX / LITHOFIN**, Judgment of 3 July 2015 in Case [T-273/14](#), *Lithomex ApS v OHIM*
- LLRG5**, Judgment of 16 June 2015 in Case [T-306/13](#); *Silicium España Laboratorios, SL v OHIM*
- ◆ **LUCEA LED / LUCEO**, Judgment of 25 June 2015 in Case [T-186/12](#), *Copernicus-Trademarks Ltd v OHIM & Maquet SAS*
- ◆ **L'Wren Scott / LOREN SCOTT**, Judgment of 27 February 201 in Case [T-41/12](#), *LS Fashion, LLC v*



OHIM

INVESTING FOR A NEW WORLD, Judgment of 29 January 2015 in Case [T-59/14](#), *Blackrock, Inc.*, v OHIM

M / dm, Judgment of 25 June 2015 in Case [T-662/13](#), *dm-drogerie markt GmbH & Co. KG* v OHIM

◆◆ **MACKA / MACKA**, Judgment of 28 October 2015 in Case [T-96/13](#), *Rot Front OAO* v OHIM

◆ **MAGNEXT / MAGNET 4**, Judgment of 19 March 2015 in Case [C-182/14 P](#), *MEGA Brands International* v OHIM

◆◆ **MANEA SPA / SPA**, Judgment of 17 March 2015 in Case [T-611/11](#), *Spa Monopole, compagnie fermière de Spa SA/NV* v OHIM

MARINE BLEU / BLUMARINE, Order of 7 May 2015 in Case [C-343/14 P](#), *Adler Modemärkte AG* v OHIM

masafi juice / masafi, Judgment of 25 November 2015 in Case [T-248/14](#), *Masafi Co. LLC* v OHIM

Masafi / masafi, Judgment of 25 November 2015 in Case [T-249/14](#), *Masafi Co. LLC* v OHIM

Matratzen Concord / MATRATZEN et al., Judgment of 19 November 2015 in Case [T-526/14](#), *Matratzen Concord GmbH* v OHIM

◆ **meet me**, Judgment of 24 November 2015 in Case [T-190/15](#), *Intervog* v OHIM

MEGARAIL, Judgment of 28 April 2015 in Case [T-137/13](#), *Saferoad RRS* v OHIM

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

MIGHTY BRIGHT, Judgment of 8 September 2015 in Case [T-714/13](#), *Gold Crest LLC* v OHIM

MIRUS / MIRUS, Judgment of 28 October 2015 in Case [T-576/13](#), *Verus Eood* v OHIM

◆ **mobile.de proMotor / mobile**, Judgment of 22 April 2015 in Case [T-337/14](#), *Rezon OOD* v OHIM

MoMo Monsters / MONSTER, Judgment of 28 October 2015 in Case [T-736/14](#), *Monster Energy Company* v OHIM

◆ **MONACO**, Judgment of 15 January 2015 in Case [T-197/13](#), *Marques de l'État de Monaco (MEM)* v OHIM

◆ **Moon**, Judgment of 4 February 2015 in Case [T-374/13](#), *KSR Kunststoff Rotation GmbH* v OHIM

MovieStation, Judgment of 23 October 2015 in Case [T-636/13](#), *TrekStor Ltd* v OHIM

Multi Win, Judgment of 2 December 2015 in Case [T-529/14](#), *adp Gauselmann GmbH* v OHIM

Mustang / MUSTANG et al., Judgment of 18 November 2015 in Case [T-606/13](#), *Mustang – Bekleidungswerke GmbH & Co. KG* v OHIM

NAEL / McNEAL, Judgment of 26 March 2015 in Case [T-596/13](#), *Emsibeth SpA* v OHIM

◆ **NANO**, Judgment of 10 February 2015 in Case [T-379/13](#), *Innovation First, Inc.* v OHIM



NANU / NAMMU, Judgment of 9 July 2015 in Case [T-89/11](#), *Nanu-Nana Joachim Hoepp GmbH & Co. KG v OHIM & Vincci Hoteles SA*

NEW MAX / MAX, Judgment of 3 September 2015 in Case [T-254/14](#), *Warenhandelszentrum Ltd v OHIM*

NEXTCARD, Order of 5 March 2015 in Case [T-233/14](#), *Intesa Sanpaolo SpA v OHIM*

Nordschleife / Management by Nordschleife, Judgment of 26 November 2015 in Case [T-181/14](#), *Nürburgring GmbH v OHIM*

◆ **NOURISHING PERSONAL HEALTH**, Judgment of 8 October 2015 in Case [T-336/14](#), *Société des produits Nestlé SA v OHIM*

NOW; Judgment of 30 January 2015 in Case [T-278/13](#), *Now Wireless Ltd v OHIM*

◆ **NOxtreme / X-TREME**, Judgment of 7 October 2015 in Case [T-186/14](#), *Atlantic Multipower Germany GmbH & Co. OHG v OHIM*

nuru / DURU, Judgment of 21 May 2015 in Case [T-56/14](#), *Evyap Tag Gliserin Sanayi ve Ticaret A.S. v OHIM*

ORGANIC WITH PLANT FLUID, Judgment of 10 September 2015 in Case [T-608/14](#); *Laverana GmbH & Co. KG v OHIM*

ORGANIC PROTEIN RICH PLANT COMPLEX, Judgment of 10 September 2015 in Case [T-609/14](#); *Laverana GmbH & Co. KG v OHIM*

◆ **OLEOSPA / SPA**, Judgment of 27 February 2015 in Case [T-377/12](#), *Spa Monopole, compagnie fermière de Spa SA/NV & Olivar Del Desierto, SL v OHIM*

PARALLEL STRIPES ON A SHIRT, Judgment of 15 December 2015 in Case [T-63/15](#), *Shoe Branding Europe BVBA v OHIM*

PARALLEL STRIPES ON PANTS, Judgment of 15 December 2015 in Case [T-64/15](#), *Shoe Branding Europe BVBA v OHIM*

◆ **Pensa / PENTASA and PENZA PHARMA / PENTASA**, Judgment of 3 June 2015 in Joined Cases [T-544/12 and T-546/12](#), *Pensa Pharma, SA v OHIM*

◆◆ **PerfectRoast**, Judgment of 25 September 2015 in Case [T-591/14](#), *BSH Bosch und Siemens Hausgeräte GmbH v OHIM*

PETCO / PETCO, Judgment of 21 October 2015 in Case [T-664/13](#), *Petco Animal Supplies Stores, Inc. v OHIM*

PIANISSIMO, Judgment of 21 January 2015 in Case [T-11/14](#), *Grundig Multimedia AG v OHIM*

◆◆ **POLO CLUB / BEVERLY HILLS POLO CLUB**, Judgment of 26 March 2015 in Case [T-581/13](#), *The Royal County of Berkshire Polo Club Ltd. v OHIM*

◆◆ **POLYTETRAFLON / TEFLON**, Judgment of 16 June 2015 in Case [T-660/11](#), *Polytetra GmbH v OHIM*

◆ **PORT CHARLOTTE / Porto**, Judgment of 18 November 2015 in Case [T-659/14](#), *Instituto dos Vinhos do Douro e do Porto, IP v OHIM*



- ◆ **PRANAYUR / AYUR** et al., Judgment of 5 March 2015 in Case [T-543/13](#), *Three-N-Products & Munindra Holding v OHIM*
- ◆◆ **PRIMA KLIMA / PRIMAGAZ**, Judgment of 24 September 2015 in Case [T-195/14](#), *Compagnie des gaz de Pétrole Primagaz SA v OHIM*
- ◆◆ **PROTICURD / PROTI** et al., Judgment of 24 September 2015 in Case [T-382/14](#), *Bernhard Rintisch v OHIM – EN*.
- OTA S. JOSÉ DE PERAMANCA / PÊRA-MANCA** et al., Judgment of 9 July 2015 in Case [C-249/14P](#), *Pêra-Grave — Sociedade Agrícola, Unipessoal Lda v OHIM & Fundação Eugénio de Almeida*
- ◆ **QUARTODIMIGLIO** et al. / **LONGINES** et al., Judgment of 12 February 2015 in Case [T-76/13](#), *Compagnie des montres Longines, Francillon SA, Staccata Srl, v OHIM*
- QUO VADIS / QUO VADIS**, Judgment of 29 October 2015 in Case [T-517/13](#), *Editions Quo Vadis v OHIM*
- RACE GTP**, Judgment of 25 November 2015 in Case [T-520/14](#), *bd breyton-design GmbH v OHIM*
- ◆ **RAUSCHBRILLE**, Judgment of 16 April 2015 in Case [T-319/14](#), *Drogenhilfe Köln Projekt GmbH v OHIM*
- ◆ **real,- / Real**, Order of 21 April 2015 in Case [T-580/13](#), *Real Express SRL. v OHIM*
- RED RIDING HOOD / ROTKÄPPCHEN**; Judgment of 16 December 2015 in Case [T-128/15](#), *Rotkäppchen-Mumm Sektkellereien GmbH v OHIM*
- ◆ **REDROCK / ROCK** et al., Judgment of 8 July 2015 in Case [T-548/12](#), *Deutsche Rockwool Mineralwoll GmbH & Co. OHG v OHIM*
- Rock & Rock / Rock** et al., Judgment of 8 July 2015 in Case [T-436/12](#), *Deutsche Rockwool Mineralwoll GmbH & Co. OHG, v OHIM - Ceramicas del Foix, SA*.
- ◆ **SafeSet**, Judgment of 6 March 2015 in Case [T-513/13](#), *Braun Melsungen AG v OHIM*
- SAM BA / SAM**, Order of 21 December 2015 in Case [T-850/14](#), *CompuGroup Medical AG v OHIM*
- SAMSARA / SAMSARA**, Judgment of 26 February 2015 in Case [T-388/13](#), *Costa Crociere SpA v OHIM*
- ◆ **SANDTER 1953 / SANDER**, Judgment of 29 October 2015 in Case [T-21/14](#), *NetMed Sàrl v OHIM*
- SEQUOIA CAPITAL / SEQUOIA**, Judgment of 30 September 2015 in Case [T-369/14](#), *Sequoia Capital Operations LLC v OHIM*
- SEVEN FOR ALL MANKIND / ZEVEN** et al., Order of 23 February 2015 in Case [T-505/14](#), *Seven For All Mankind LLC v OHIM*
- SHADOW COMPLEX / BusinessShadow**, Judgment of 29 April 2015 in Case [T-717/13](#), *Chair Entertainment Group LLC v OHIM*
- ◆◆ **SHAPE OF A CAR (3D MARK)**, Judgment of 25 November 2015 in Case [T-629/14](#), *Jaguar Land Rover Ltd v OHIM*



SHAPE OF A COOKING STOVE (3D MARK), Judgment of 24 September 2015 in Case [T-317/14](#), *Bernhard Rintisch v OHIM*

SHAPE OF A CYLINDRICAL BOTTLE (3D MARK), Judgment of 7 May 2015 in Case [C-445/13 P](#), *Voss of Norway ASA, INTA v OHIM, Nordic Spirits*

SHAPE OF A CYLINDRICAL CONTAINER (3D MARK), Judgment of 16 June 2015 in Case [T-654/13](#), *Gako Konietzko GmbH v OHIM*

◆◆ **SHAPE OF A FACE (3D MARK)**, Judgment of 7 October 2015 in Case [T-242/14](#), *The Smiley Company SPRL v OHIM*

◆◆ **SHAPE OF A FACE (3D MARK)**, Judgment of 7 October 2015 in Case [T-243/14](#), *The Smiley Company SPRL v OHIM*

◆◆ **SHAPE OF A FACE IN THE FORM OF A STAR (3D MARK)**, Judgment of 7 October 2015 in Case [T-244/14](#), *The Smiley Company SPRL v OHIM*

SHAPE OF A GAMES BOX (3D MARK), Judgment of 8 October 2015 in Case [T-547/13](#), *Rosian Express SRL v. OHIM*

SHAPE OF A MEXICAN TORTILLA (3D MARK), Judgment of 29 June 2015 in Case [T-618/14](#), *Grupo Bimbo, S.A.B. de C.V. v OHIM*

SHAPE OF AN OVEN (3D MARK), Judgment of 24 September 2015 in Case [T-211/14](#), *Bernhard Rintisch v OHIM*

SHAPE OF A SMILEY WITH HEART-SHAPED EYES (3D MARK), Judgment of 7 October 2015 in Case [T-656/13](#), *The Smiley Company SPRL v OHIM*

◆ **SHAPE OF A TOY FIGURE I and II (3D MARKS)**, Judgments of 17 June 2015 in Cases [T-395/14](#) and [T-396/14](#), *Best-Lock (Europe) Ltd v OHIM – Lego Juris A/S*

SHAPE OF A WATER BOTTLE (3D MARK), Judgment of 14 January 2015 in Case [T-70/14](#), *Research and Production Company « Melt Water » UAB v OHIM*

SHAPE OF SURFACE WITH DENTS, Judgment of 21 May 2015 in Joined Cases [T-331/10 RENV](#) and [T-416/10 RENV](#), *Yoshida Metal Industry Co. Ltd v OHIM*

◆ **she / SHE**, Judgment of 15 October 2015 in Case [T-642/13](#), *Wolverine International, LP v OHIM*

Skype / SKY, Judgment of 5 May 2015 in Case [T-423/12](#), *Skype Ultd. v OHIM*

SKYPE / SKY, Judgment of 5 May 2015 in Case [T-184/13](#), *Skype Ultd. v OHIM*

SMARTER SCHEDULING, Judgment of 5 February 2015 in Case [T-499/13](#), *Metric LLC v OHIM*

SmartTV Station, Judgment of 23 October 2015 in Case [T-649/13](#), *TrekStor Ltd v OHIM*

◆ **SMART WATER**, Judgment of 18 March 2015 in Case [T-250/13](#), *Naazneen Investments Ltd v OHIM*

SOLID FLOOR The professional's choice / SOLID FLOOR et al., Judgment of 11 February 2015 in Case [T-395/12](#), *Fetim BV v OHIM*

SOPRAPUR / Sopro, Judgment of 25 November 2015 in Case [T-763/14](#), *Holding Soprema v OHIM*



SÔ:UNIC / SO...? et al., Judgment of 15 October 2015 in Case [C-270/14 P](#), *Debonair Trading Lda v OHIM*

SO WHAT DO I DO WITH MY MONEY, Judgment of 29 January 2015 in Case [T-609/13](#), *Blackrock, Inc. v OHIM*

◆ **SPARITUAL / SPA** et al., Judgment of 5 May 2015 in Case [T-131/12](#), *SPA Monopole v OHIM*

SPIN BINGO / ZITRO SPIN BINGO, Judgment of 29 January 2015 in Case [T-665/13](#), *Zitro IP Sàrl v OHIM*

◆ **STAYER**, Judgment of 4 June 2015 in Case [T-254/13](#), *Stayer Ibérica, SA v OHIM*

STREET, Judgment of 10 September 2015 in Case [T-321/14](#), *Volkswagen AG v OHIM*

SUN FRESH / SUNNY FRESH, Order of 3 June 2015 in Case [C-142/14 P](#), *The Sunrider Corporation v OHIM*

◆ **TAFEL**, Judgment of 18 September 2015 in Case [T-710/13](#), *Bundesverband Deutsche Tafel e.V. v OHIM*

◆ **TECALAN / TECADUR**, Judgment of 30 April 2015 in Case [T-100/14](#); *Tecalan GmbH v OHIM*

◆ **The English Cut / EL CORTE INGLES** et al., Judgment of 10 December 2015 in Case [C-603/14 P](#), *El Corte Inglés SA v OHIM*

TPG POST / POST, Judgment of 13 May 2015 in Case [T-102/14](#), *Deutsche Post AG v OHIM*

Trecolore / FRECCE TRICOLORI et al., Judgment of 7 October 2015 in Case [T-227/14](#), *CBM Creative Brands Marken GmbH v OHIM*

TRECOLORE / FRECCE TRICOLORI et al., Judgment of 7 October 2015 in Case [T-228/14](#), *CBM Creative Brands Marken GmbH v OHIM*

TRECOLORE / FRECCE TRICOLORI et al., Judgment of 7 October 2015 in Case [T-365/14](#), *CBM Creative Brands Marken GmbH v OHIM*

TRIDENT PURE / PURE et al., Judgment of 16 December 2015 in Case [T-491/13](#), *Perfetti Van Melle Benelux BV v OHIM - Intercontinental Great Brands LLC*

TRILOBULAR; Judgment of 18 November 2015 in Case [T-558/14](#), *Research Engineering & Manufacturing, Inc. v OHIM*

Turbo Drill, Judgment of 26 November 2015 in Case [T-50/14](#), *Demp BV v OHIM*

◆ **TVR ITALIA / TVR** et al., Judgment of 15 July 2015 in Case [T-398/13](#), *TVR Automotive Ltd v OHIM & TVR Italia S.r.l.*

ULTIMATE, Judgment of 30 September 2015 in Case [T-385/14](#), *Volkswagen AG v OHIM*

◆◆ **Ultra.air ultrafilter**, Judgment of 9 March 2015 in Case [T-377/13](#), *ultra air GmbH v OHIM*

UNITED VEHICLES / Junited, Judgment of 26 November 2015 in Case [T-404/14](#), *Junited Autoglas Deutschland GmbH & Co. KG v OHIM*



- VAKOMA / Vacom, Order of 13 January 2015 in Case [T-535/13](#), *Vakoma GmbH Appellant v OHIM*
- ◆ VENT ROLL, Judgment of 25 November 2015 in Case [T-223/14](#), *Ewald Dörken AG v OHIM*
 - ◆ Vieta, Judgment of 10 December 2015 in Case [T-690/14](#), *Sony Computer v OHIM*
 - ◆ VIGOR / VIGAR, Judgment of 18 November 2015 in Case [T-361/13](#), *Menelaus BV v OHIM*
- VIMEO / meo et al., Judgment of 23 October 2015 IN Case [T-96/14](#), *Vimeo LLC v OHIM*
- ◆ VIÑA ALBERDI / VILLA ALBERTI, Judgment of 30 of June 2015 in Case [T-489/13](#), *La Rioja Alta, S.A. v OHIM*
 - ◆ WAVY BLACK LINES / WAVY BLACK LINE, Judgment of 25 of November 2015 in Case [T-320/14](#), *Sephora v OHIM*
 - ◆ W E / WE, Judgment of 30 November 2015 in Case [T-718/14](#), *Hong Kong Group Oy v OHIM*
 - ◆◆ WESTERN GOLD / WeserGold et al., Judgment of 24 November 2015 in Case [T-278/10 RENV](#), *riha WeserGold Getränke GmbH & Co. KG v OHIM*
 - ◆ WET DUST CAN'T FLY, Judgment of 22 January 2015 in Case [T-133/13](#), *Pro-Aqua International GmbH v OHIM*
 - ◆ WIN365, Judgment of 23 October 2015 in Case [T-264/14](#), *Robert Hansen v OHIM*
 - ◆ WINDER CONTROLS, Judgment of 30 January 2015 in Case [T-593/13](#), *Siemag Tecberg Group GmbH v OHIM*
- Wine in Black / NOVAL BLACK, Judgment of 21 May 2015 in Case [T-420/14](#), *Wine in Black GmbH v OHIM*
- ◆ WISENT / ZUBROWKA BISON BRAND VODKA, Judgment of 12 November 2015 in Case [T-449/13](#), *CEDC International sp. z o.o. v OHIM*
 - ◆ WISENT VODKA / ZUBROWKA et al., Judgment of 12 November 2015 in Case [T-450/13](#), *CEDC International sp. z o.o. v OHIM*
- WOLF'S HEAD / WOLF JARDIN et al., Judgment of 5 February 2015 in Case [T-570/10 RENV](#), *Environmental Manufacturing LLP v OHIM & Société Elmar*
- WORLD OF BINGO, Order of 20 November 2015 in Case [T-202/15](#), *Zitro IP Sàrl v OHIM*
- WORLD OF BINGO, Order of 20 November 2015 in Case [T-203/15](#), *Zitro IP Sàrl v OHIM*
- XΑΛΛΟΥΜΙ / HALLOUMI, Judgment of 7 October 2015 in Joined Cases [T-292/14](#) and [T-293/14](#), *Republic of Cyprus v OHIM*
- ◆ XKING (FIG. MARK) / X (FIG. MARK) et al., Judgment of 8 December 2015 in Case [T-525/14](#), *Compagnie générale des établissements Michelin v OHIM*
 - ◆ YELLOW DEVICE, Judgment of 10 September 2015 in Case [T-143/14](#), *EE Ltd. v OHIM*
- YOO / YO, Judgment of 4 June 2015 in Case [T-562/14](#), *Yo holdings Ltd v OHIM*



◆ **Yorma Eberl / NORMA**, Judgment of 16 June 2015 in Case [T-229/14](#), *Norma Lebensmittelfilialbetrieb Stiftung & Co. KG v OHIM*

ZARA, Judgment of 9 September 2015 in Case [T-584/14](#), *Industria de Diseño Textil, S.A. (Inditex) v OHIM*

◆ **ZEBEXIR / ZEBINIX**, Judgment of 3 March 2015 in Case [T-366/11 RENV](#), *Bial-Portela & Ca SA v OHIM, Isdin, SA (intervener)*

◆ **ZuMEX / JUMEX**, Judgment of 9 December 2015 in Case [T-354/14](#), *Comercializadora Eloro, S.A. v OHIM*

Preliminary Rulings

Bacardi, Preliminary ruling of 16 July 2015 in Case [C-379/14](#), *TOP Logistics BV, Van Caem International BV v Bacardi & Company Ltd, Bacardi International Ltd and Bacardi & Company Ltd, Bacardi International Ltd v TOP Logistics BV, Van Caem International BV*

◆ **Be impulse / Impulse**, Preliminary ruling of 3 September 2015 in Case [C-125/14](#), *Iron & Smith kft v Unilever NV*

BGW / BGW Bundesverband der deutschen Gesundheitswirtschaft, Preliminary ruling of 22 October 2015 in Case [C-20/14](#), *BGW Beratungs-Gesellschaft Wirtschaft mbH v Bodo Scholz*

EL BAINA / EL BENNA et al., Preliminary ruling in Judgment of 25 June 2015 in Case [C-147/14](#), *Louffi Management Propriété intellectuelle SARL v AMJ Meatproducts NV and Halalsupply NV*

FORD MOTOR, Preliminary ruling of 6 October 2015 in Case [C-500/14](#), *Ford Motor Company v Wheeltrims srl*

◆ **SHAPE OF A FOUR FINGER CHOCOLATE-COATED WAFER (3D MARK)**, Preliminary ruling of 16 September 2015 in Case [C-215/14](#), *Société des Produits Nestlé SA v Cadbury UK Ltd*