



# Leading Case-law of the Boards of Appeal of OHIM

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Office for Harmonization in the Internal Market

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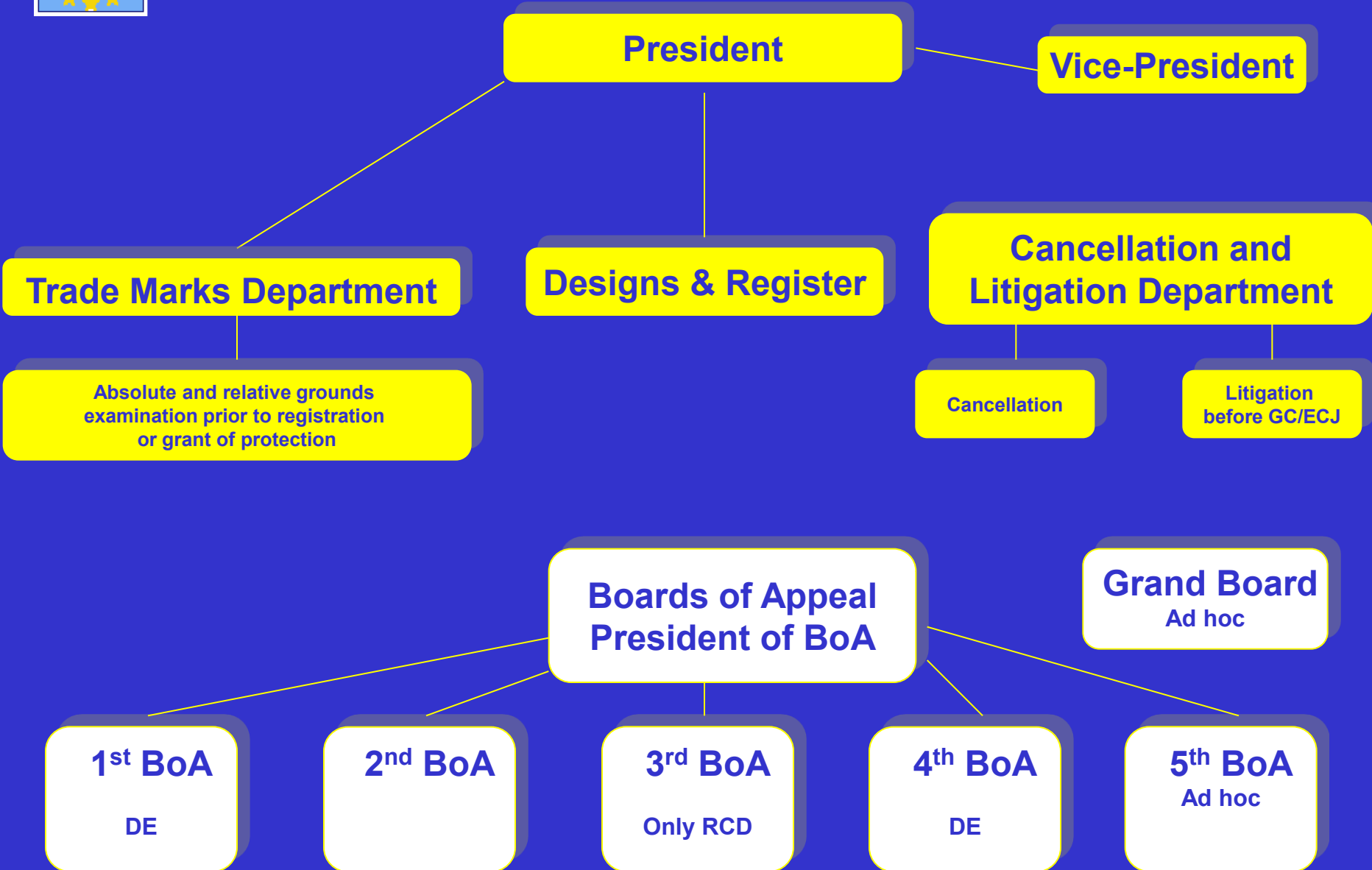
# Scheme

- Introduction & Statistics
- Procedural questions
- Relative grounds
- Absolute grounds



# INTRODUCTION

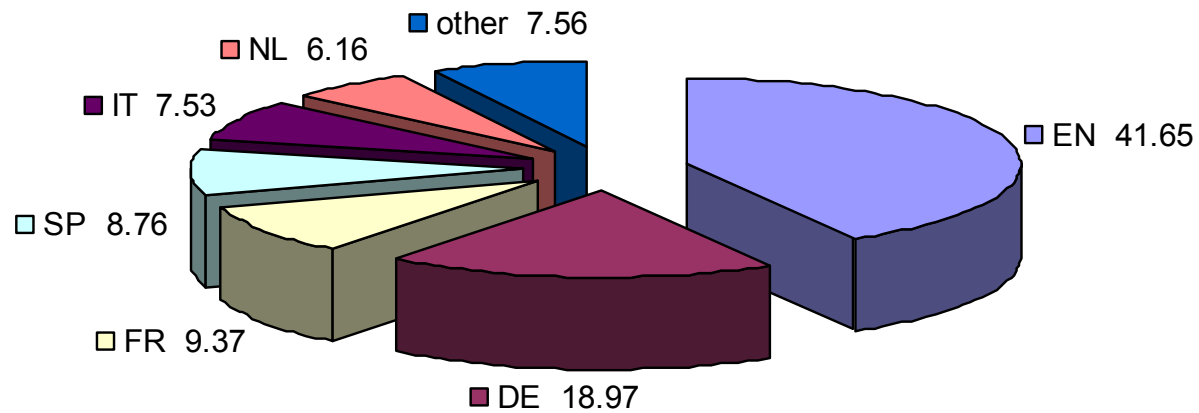
## Organization of OHIM's Operative Departments





# Statistics

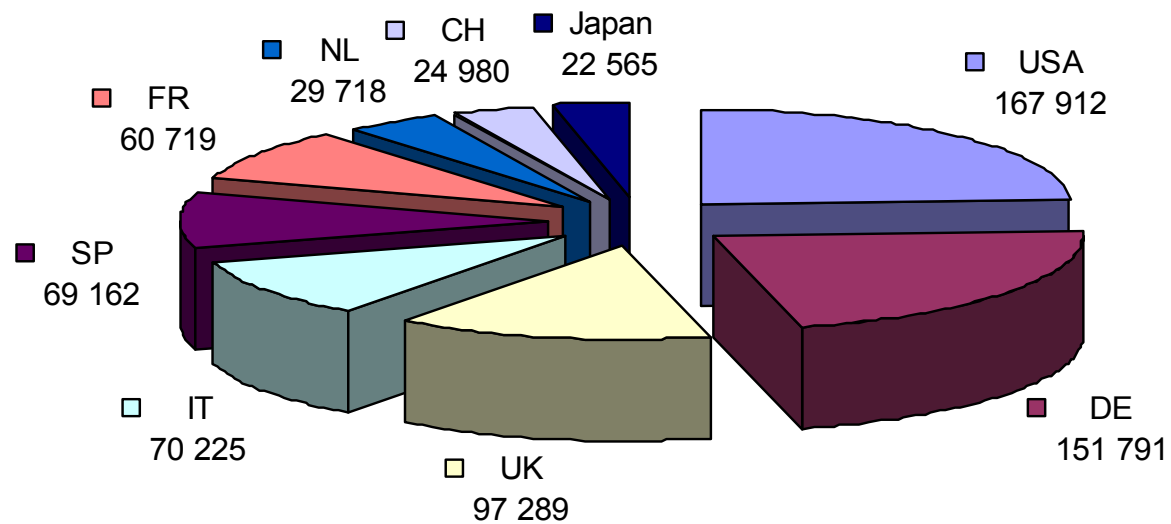
**% of Community Trade Mark Applications or designations of the European Union filed, by language as of 31/08/2010  
(Total - 889 355)**





# Statistics

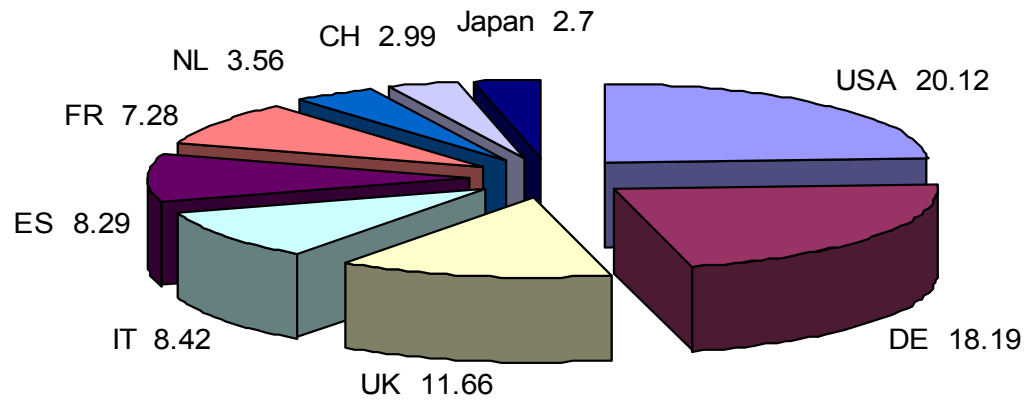
No. of Community Trade Mark Applications and Designations of the European Union, by country of origin (as of 31/08/10)





# Statistics

**% of Community Trade Marks or Designations of the European Union filed by country (as of 31/08/2010)**





# 1. Procedural questions

*"Watch the little things; a small leak can sink a great ship."* -  
Benjamin Franklin (1706 -1790)

## Discretion to admit late evidence

**R0055/2009-2 BRAVIA / BRAVIA –15 March 2010**

FACTS: Late evidence of reputation before Oppo. Div. ruled inadmissible.

ISSUE: Discretion to admit such evidence?

- HELD:
- (1) Late evidence must be 'additional' and 'new factors' must justify admitting it.
  - (2) Special circumstances = a 700-page CD, referred to by the opponent within the time-limit, and received one day late.
  - (3) New evidence relevant to the outcome of the opposition.

⇒ Contested decision annulled



# Procedural questions

## Appeal from 'adversely affected' party

R0963/2009-4 HAMMER –25 May 2010

**FACTS:** CTM registration declared invalid for all goods because of bad faith and an earlier conflicting national right. The invalidity meant that, from the outset, the CTM never had any effect.

**ISSUE:** Could the invalidity applicant (the successful party) appeal the decision?

**HELD:**

1. 'Complementing' existing reasoning is not a basis of appeal. The CD does not have to examine every ground of appeal.
2. An appeal of this kind places the Community Trade Mark proprietor in an impossible situation (defending what has already been cancelled).
3. Appellant not 'adversely affected'.

⇒ Appeal inadmissible.





# Procedural questions

## Peremptory deadlines

R1260/2009-4 (Shape of bottle – 3D mark) 14 May 2010



**FACTS:** Request to extend deadline for filing statement of grounds of appeal.

**ISSUE:** Can the deadline in question be extended?

**HELD:** 4-month deadline is peremptory. No extension possible (as per Decision of 18 April 2008 – R 1341/2007-G – KOSMO / COSMONE, at paragraph 14).



## 2. Relative grounds

*'One man's misery is another man's joy'*

### Independent role of distinctive elements

**R 1466/2008-2 and R 1565/2008-2 COMMERZBANK  
ARENA/ARENA et al. – 12 December 2009**

**FACTS:** Community Trade Mark application (word mark) for G&S in Classes 9, 14, 16, 18, 20, 21, 24, 25, 28, 35, 36



These marks showed use in Classes 9, 18, 25 and 28 (water sports goods and bags) in Germany, Spain, Portugal, Benelux and Italy. Use also shown for 'ARENA' (word mark) for Class 41 ('swimming activities' and 'organization of swimming events') in Germany. Applicant subsequently excluded everything directly related to swimming or diving.

**ISSUE:** Likelihood of confusion (LOC) under Article 8(1)(b) CTMR?

**HELD:** 1. Despite the limitation a number of goods & services, they remained identical or similar.



# Relative grounds

2. The 'ARENA' brand was shown to enjoy enhanced distinctiveness for 'swimwear' and 'swimming articles'.
3. The marks were found to be visually and phonetically similar because of the overlapping term. Conceptually, the word 'arena' is meaningful in almost every European language (especially English, Spanish, German and Italian) but 'COMMERZBANK' would be perceived either as a fanciful term or as the applicant's company name (especially in Germany).
4. Overall, there was LOC for identical or similar goods (Classes 9, 18, 24, 25 and 28) for which the word 'arena' played an independent role in the marks – as per Case C-120/04 *Medion* ('LIFE/THOMSON LIFE') [2005] ECR I-8551. However, no LOC for the contested services (Class 41) because the relevant public was exclusively German and the image that such public would keep in mind would be likely dominated by the word element 'COMMERBANK'.



# Relative grounds

## Opposition Proceedings - distinctive elements - dominant elements

### R-1000/2009-1 GigaFlex / FLEX (FIG. MARK) et al.

Earlier Spanish trade marks

Contested CTM application



**GigaFlex**

**FACTS:** 'Beds and mattresses' were expensive household items which are not bought every day in a hurry.

**ISSUE:** Likelihood of confusion.

**HELD:** (1) 'Beds and mattresses' are expensive household items which are not bought every day in a hurry.



# Relative grounds

- (2) Inclusion of the element FLEX does not automatically lead to a finding of similarity. This is because the opponent has no exclusive right to the element FLEX, per se. That finding stands even though the opponent claimed that the word 'flex' (i) is not a Spanish word; (ii) is 'distinctive' and 'dominant'; (iii) has been used on the Spanish market for decades and enjoys reputation, the fact is that the opponent never obtained a registration for that word per se in Spain. Importantly, the opponent had himself admitted in his own statements that the figurative element of the composite mark was significant. This was also apparent from the opponent's website, which showed that the swan was central to its brand strategy. In the Board's opinion, in terms of distinctiveness, the role of the Swan device within the earlier mark is highly significant. The swan has become the 'emblem' of the opponent over some five decades and is an inseparable element of the mark.
- (3) Therefore, in comparing the marks all the elements must be considered, not merely the word element. The overlap in the term FLEX is insufficient for a likelihood of confusion on the part of the Spanish consumers. The Board considers FLEX to be of a low distinctive character and thus the visual differences between the marks were sufficient to exclude confusion on the part of a well-informed public under Article 8(1)(b) CTMR.
- (4) The Board also rejects the opposition based on Article 8(5) CTMR



# Relative grounds

R0070/2009-1 and R0069/2009-1 **Red Dog** (Red Dog) / Red Bull – 11 January 2010

- FACTS: RED BULL (word mark), the earlier CTM, was found to be reputed in Austria and Germany.
- ISSUE: Unfair advantage / dilution of distinctive character
- HELD:
1. A mental link between RED DOG and RED BULL was possible because of (a) the marks' common relevant features, (b) identical nature of the goods, (c) RED BULL's reputation mark, (d) RED BULL's strong distinctive character acquired through use and (e) the possibility of confusion.
  2. Dilution was the most likely injury to RED BULL



# Relative grounds

**R0765/2009-1 Bob the Builder**  
**24 February 2010**



**et al.**

**ISSUE: Unfair advantage?**

- HELD:**
1. 'BOB' is dominant and makes the marks visually, orally and conceptually similar. This, together with the reputation of the earlier mark ('BOB' et al.) in Sweden for jams, jellies, fruit drinks, etc creates a link.
  2. The proximity of the sectors (fruit drinks versus basic foodstuffs), together with the degree of reputation of the earlier mark, justifies the claim of unfair advantage.



# Relative grounds

The greater the distinctiveness, the more probability there is of unfair advantage

→ **R1276/2009-2** **BEATLE** The Beatles,  **31 May 2010**

**FACTS:** OD considered despite the earlier marks' reputation for 'sound records, video records', these goods were too far removed from 'wheelchairs electric, wheelchairs non-electric' of the CTMA for Art. 8(5) CTMR to apply.

**ISSUE:** Are the goods too far apart to justify Art. 8(5) – unfair advantage?

**HELD:**

1. The marks are visually, phonetically and conceptually similar.
2. The relevant public overlaps.





# Relative grounds

3. The enormous reputation of the earlier marks has an overspill into merchandising (toys), which makes an association more likely.
4. The possibility of a 'do-gooder' image transfer through brand extension is a real one.

=> Unfair advantage



# Relative grounds

## Weak marks and disclaimers

R0109/2009-1  /  et al. – 26 January 2010

- PRINCIPLE:** When marks are accepted for registration exclusively on the basis of their device elements, they cannot successfully oppose marks with different device elements, even if the word element is the same. It is thus important to request disclaimers in order to avoid confusion regarding the scope of protection.
- HELD:** Disclaimer of an exclusive right to ‘SPORTS’ and ‘WORLD’ by the applicant, removes any LOC.



# Absolute grounds

**Colour per se**

**R0371/2009-2**



**11 February 2010**

**FACTS:** The Cancellation Division rejected an application to declare invalid a colour mark for 'rubber teats for milking installations' for lack of inherent distinctiveness. It concluded that the goods were very restricted and the relevant market very specific.

**ISSUE:** Inherent distinctiveness of a colour mark

**HELD:**

1. The goods are very specific and limited.
2. The CTM proprietor's yellow differs markedly from the standard black for rubber.
3. The sign is capable, in the perception of the relevant public, of serving as an indication of origin, and is thus not devoid of any distinctive character.

⇒ The appeal is dismissed.



# Absolute grounds

## Inability to act as a sign

**R1475/2009-2**



**29 April 2010**

**FACTS:** The Colour sign was refused registration for lacking contours and not complying with Art. 4 CTMR (the ability to constitute a trade mark). Examiner did not give a prior opportunity to comment on the application of Art. 4.

**ISSUE:** Procedural violations and compliance with Article 4 CTMR.

**HELD:**

1. The procedural violations that occurred would justify the annulment of the contested decision and the reimbursement of the appeal fee. However, because a considerable period of time had elapsed since the CTM application was filed, the Board decided to deal with the substance of the case.
2. The description of the mark in the CTM application did not comply with Article 4 CTMR. It was highly unlikely that anyone could deduce from that information that the application was to register the Rubik's cube. The applicant failed to provide a clear, concise, easily accessible and intelligible graphic representation.

⇒ Appeal fee reimbursed and registration refused.



# Absolute grounds

## Overly simplistic shapes

**R0553/2009-2**



**20 April 2010**

ISSUE: Distinctive character.

HELD: The sign is simply an inverted triangle with a bold (grey) margin and rounded corners. No colour is claimed and, if the sign is noticed at all, it is not likely to be perceived as denoting a connection with a specific provider of goods such as electrical household appliances, beard clipping devices, computers, photocopiers, brushes, massage apparatus, barbecues, clocks and so on. For some of those goods the sign is just as likely to be perceived as indicating the presence of a switch or as inviting the consumer to pay attention to printed information about how to use the goods correctly.

⇒ Appeal rejected.



# Absolute grounds

## Technical functions

R0808/2009-2



(shape of oven) 26 January 2010

HELD: CTM proprietor's 3D mark consisted exclusively of the shape of the goods necessary to achieve a technical result (heating), and, because of this was declared invalid. The Board noted that the mark had been the subject-matter of an expired American patent. The fact that the same result can be achieved by other shapes is immaterial and any 'aesthetic features' which the mark may have are simply the outcome of good design, but do not make the mark fanciful in any way.

⇒ CTM registration declared invalid.



# Absolute grounds

## Current usage of words

**R1350/2009-2    SEALINE    13 April 2010**

**FACTS:** The examiner found the word sign to be descriptive and/or non distinctive for fishing gear. That conclusion was reached in the light of a definition in the *Oxford English Dictionary* (complete works).

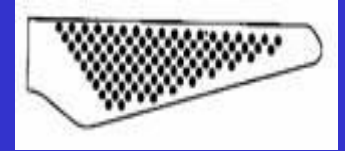
**HELD:** The absence of a descriptive definition in any other dictionary strongly suggests that the term is not in current usage in the way defined in the *Oxford English Dictionary* (complete works) and that the word has now acquired a meaning that is not relevant to the goods at issue.

⇒ Contested decision annulled



# Absolute grounds

## R1235/2008-1 a surface covered with circles (Fig. Mark)



**FACTS:** The registered CTM was attacked under cancellation proceedings on the ground that it was a sign consisting 'exclusively of the shape of goods which is necessary to obtain a technical result' (Article 7(1)(e)(ii) CTMR). The Cancellation Division cancelled the registration under that article.

**ISSUE:** Applicability of Article 7(1)(e)(ii) CTMR

**HELD:** (1) The sign is a figurative mark consisting of the two-dimensional representation of the handle of the products for which registration is sought (i.e. the handle of knives, etc).

(2) The handle has side faces formed with a 'non-skid structure comprised of an array of dents'. This has been the subject of a US patent. The patent description shows that the 'dents' make the handle surface uneven and provide a better grip. Consequently, the dents are necessary to obtain a technical result, i.e. the result of preventing the hand holding the handle from accidentally slipping. The fact that the same result can be obtained by other shapes does not exclude the applicability of the ground for refusal.

(3) Because Article 7(1)(e)(ii) CTMR applies, the registration must be declared invalid.





# Absolute grounds

## Public policy and morality

R1509/2008-2



28 May 2010

**(coat of arms of the Soviet Union, with red star, sickle and hammer)**

**FACTS:** CTMA refused registration for goods and services in Classes 3, 14, 18, 23, 26 and 43 on the basis of being contrary to public policy or accepted principles of morality.

**HELD:** Confirmed that the sign is contrary to public policy / morality in Hungary, Latvia and the Czech Republic.

The sign's power lies in it being able to communicate a political or ideological message. Public use of Soviet symbols is prohibited in Hungary and the sign would still be viewed by Hungarian consumers as being contrary to public policy and accepted principles of morality. In Latvia, the sign would be also contrary to both its national trade mark and criminal law. Moreover, a decision of the Czech Patent and Trade mark Office indicates that the sign would also be unacceptable there.

⇒ Appeal dismissed.



**THE END**

THANK YOU FOR YOUR ATTENTION!