32nd ANNUAL CONFERENCE

THE JURY IS STILL OUT

BUCHAREST, 19-22 June 2013
New OHIM practices
Update on latest changes in OHIM Manual

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- Geographical Indications (GI)
- Deceptiveness
- Acquired distinctiveness
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Relative grounds
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GI examination practice

• Parts of the Manual on Articles 7(1)(j) and 7(1)(k) CTMR updated by Knowledge Circle in Dec. 2012

• Alicante News of Nov. 2012 anticipated and illustrated changes

• Part of wider revision of the Manual undertaken by KC
GI examination practice

Art. 7(1)(j) and 7(1)(k) CTMR apply where:

• the CTM application and the PGI/PDO cover identical goods,

• the CTM application covers ‘comparable products’ to those of the PGI/PDO

( The Manual, Part B, Examination, Section 4, pages 42 and 46)

NEW!
GI examination practice

- Vinegar (cl.30) and most (cl.32) are ‘comparable’ to wines - although they appear in different classes
- CTM application that conflicts with a PGI/PDO for wines must also be refused for must or vinegar
GI examination practice

• Restrictive interpretation of ‘comparable’ goods
• E.g. mere fact that butter and olive oil may both be eaten with bread or used for frying not sufficient for them to be considered comparable products

*(Manual Part B, Section 4, p. 47)*
GI examination practice

• Art. 7(1)(j) and 7(1)(k) CTMR apply where the CTM application contains or consists of a term or a sign which is ‘evocative’ of the PGI/PDO

• No actual confusion or liability to mislead the public is necessary

(The Manual Part B, Section 4, p. 43 & 47)
GI examination practice

Decision of the 2\textsuperscript{nd} BoA of 26 Oct 2012 (R 1731/2012-2)

CTM no. 6 650 519 covering \textit{inter alia} ‘olive oils’ in cl. 29
GI examination practice

CTM no. 6 650 519 covering *inter alia* ‘olive oils’ in cl. 29
GI examination practice

• The BoA confirmed that CTMA evokes PDO ‘Sierra de Cazorla’ protected for olive oil (Regulation No 1971/2001)

• Fact that the applicant owned since 1987 the Spanish national mark Cazorliva (word) held irrelevant
Deceptiveness
Deceptiveness - Art. 7 (1)(g) CTMR

• New practice of the OHIM on Article 7(1)(g) updated by KC and taking effect as of 1 July 2012

• Past practice: if a non deceptive use could be foreseen for at least one of the good/service designated in the CTM specification \(\Rightarrow\) no objection
Deceptiveness - Art. 7 (1)(g) CTMR

• New practice: objection raised when the list of goods/services contains goods/services for which it is impossible to envisage a non-deceptive use of the CTM

• notwithstanding the fact that the list might also contain goods/services for which the CTM is not deceptive

NEW!
Deceptiveness - Art. 7 (1)(g) CTMR

• Example: if confronted with a CTM ‘KODAK VODKA’ for ‘vodka, rum, gin, whisky’, an examiner will raise an objection in respect of ‘rum, gin, whisky’, since a non-deceptive use of the mark is impossible for these goods (Manual Part B, Section 4, p. 56)

• Previous practice more tolerant: CTM accepted (as it contained ‘vodka’)
Deceptiveness - Art. 7 (1)(g) CTMR

• No objection is raised when the list of goods/services is worded in such a broad way that a non-deceptive use is possible

• E.g. ‘KODAK VODKA’ filed for ‘alcoholic beverages’ ⇒ no objection since this broad category includes vodka, in respect of which the trade mark is not deceptive
Acquired distinctiveness
Acquired distinctiveness

- C-98/11 P (shape of a chocolate rabbit with a red ribbon), para. 62: unreasonable to require proof of acquired distinctiveness for each individual Member State
- May pave the way for less strict approach
- Currently applicants of three-dimensional CTMs bear an exceptionally heavy burden
Acquired distinctiveness

BoA R 513/2011-2 of 11 Dec 2012 Nestlé v Cadbury (four-finger chocolate bar)
Appeal against it pending before GC
Acquired distinctiveness

- Acquired distinctiveness proven in France, Italy, Germany, Spain, the UK and the Netherlands
- More than 80% of the total population of the EU-15 (CTM filed back in 2002)
- Disproportionate to refuse protection to a trade mark whose recognition has been shown for the vast majority of the EU
Repute as well known fact
Repute as well known fact

- **Old practice**: opponent needs to prove reputation with submission of detailed evidence
- OD decision 2551/2002 of 28 Aug 2002 (McDonalds et alt. / McBAGEL)
- Reputation or well known character (Art. 6\(^{bis}\) PC) of earlier marks with the prefix “Mc” not proven
Repute as well known fact

• **New practice**: reputation of an earlier mark may be a well-known fact which can be found by the BoA *ex officio*
  
  
Procedural changes
Procedural changes - Opposition

OHIM's practice to accept printouts of the CTM-Online database for oppositions based IR-EU ended on 30 June 2012

Contravenes Rule 19(2)(a) CTMIR
Procedural changes - Opposition

Only database extracts accepted for substantiating IR-EU

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