



## **Application procedure:**

**Word marks, Design marks, 3D marks, GIs  
To file or not to file – Answers from the OHIM**

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**Member, Second Board of Appeal  
Office for Harmonization in the Internal Market**

**ECTA Conference Bucharest, June 2013**



# 1. WORD MARKS

- Descriptive prefixes:

R1595/2011-2



ECOBLOC

- Americanisms:

R2320/2011, 'RETURN PATH'

- Neologisms or incorrect grammar:

Case T-294/10 of 11 April 2013, 'Carbon Green'

R1363/2011-2 'EFFET MIRACLE'



# 1. WORD MARKS (cont'd)

- **Descriptiveness for trade circles**

R1095/2011-5 'SHARBATI' 'evidence has been shown ...that importers or retailers of Indian foods offer Sharbati rice to the European public, starting with the public of the United Kingdom where the highest demand is demonstrated' (para. 32)

- **Laudatory slogans**

R 609/2012-2 (25/01/2013), 'SOFT'N FRESH'

R2197/2011-2 (11/05/2012) 'WE RESTORE, YOU RECOVER'

('double meaning', a 'play on words', a 'linguistic trick' that is surprising and unexpected', and 'alliteration' are likely to endow th[e] mark

With distinctive character ( C-398/08 P, 'VORSPRUNG DURCH TECHNIK', para. 47).



# 1. WORD MARKS (cont'd)

- **Offensive marks**

R 254/2012-2 – ‘CURVE 100’ (1/06/2012) ‘it is not because the goods “fireplaces” are unrelated to the sex industry or to the notion of a “slut”, that the Romanian public will view the mark as a non-offensive English word, as the applicant has argued. If the mark had contained a clearly foreign, for instance English, element, which it does not contain, the public possibly might have been deemed to view the mark applied for as non-offensive’ (para. 26 of the decision).

- **Problem of geographical scope of objection**

Case T-412/11 and T-426/11, ‘TRANSENDENTAL MEDITATION’

Case R1709/2011-2 BATEAUX-MOUCHES (9/10/2012)



## 2. DESIGN MARKS

- Images of basic shapes



R 936/2012-5 (4/02/2013) — DEVICE OF A TENNIS RACKET

‘...the figurative representation of a racket, does not have an unusual shape. Although the racket has an ‘X’ marked in its strings, this cannot mean that the mark should be automatically registered... [T]he letter ‘X’ is particularly lacking in distinctiveness because it may be seen by the relevant public as simply marking the spot where the hitting power of the racket will be greatest (i.e. ‘X’ marks the spot). In any event, it is very difficult for the ‘X’ to indicate commercial origin without the relevant public being ‘educated’ as to its secondary meaning’ (para. 15).

R0698/2012-2 - DEVICE OF INVERTED U



‘...the contested decision asserts that the mark is a mere variation on a basic shape commonly used on the goods. However, this is not backed up with any evidence. Nor is it a well-known fact, derived from common knowledge or everyday experience, that such a mark is commonplace’ (para. 19).



## 2. DESIGN MARKS (cont'd)

- Use of the EU flag



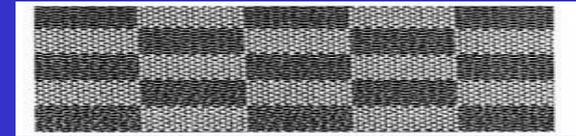
R 1296/2011-4 – EUROPEAN DIAMONDS (6/03/2013)

Patterns or colour combinations



R 2417/2011-5 – BLUE-GREEN; BLACK (19/07/2012)

R 1854/2011-1 – DEVICE OF A CHEQUER-BOARD PATTERN  
(FIG. MARK) 16/05/2012



R2244/2010-2 (blue and black colour mark)

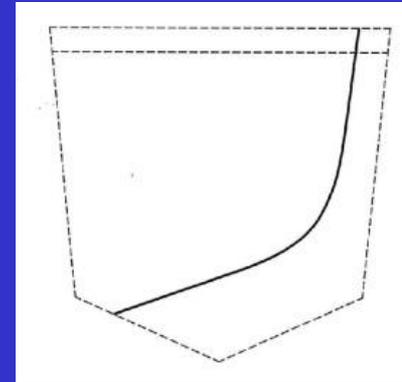




## 2. DESIGN MARKS (cont'd)

- **Jean pocket stitching**

R920/2012-4-DEVICE OF STITCHING ON A POCKET



‘a basic pocket design with a curved line is a usual and commonplace feature in the fashion sector that might be applied to any kind of pocket on trousers, shirts, blouses and dresses. Such lines will be perceived as a decorative element and not as an indication of the commercial origin of these goods (T-388/09, ‘Two curves on a pocket’, para. 19)’ (para. 13).



### 3. 3-D MARKS

- Packaging

R1572/2011-1 - SHAPE OF A TUB - 03/08/2012



Joined Cases C-344/10 P and C-345/10 P, *Freixenet SA v. OHIM*

The GC should have assessed whether the TM ‘varied significantly from the norm or customs of the sector’ ...An assessment [that no bottle had been sold without a label or an equivalent, which enabled it to function as a TM] means that marks consisting of the appearance of the packaging of the product itself that do not contain an inscription or a word element would be excluded automatically from the protection that may be conferred by Regulation No 40/94’ (par. 51).

R2464/2011-2



‘This Board has also been unable to find any evidence that the trade mark applied for was a normal type of packaging for sparkling wines on the decisive date of the application’



## 3. 3-D MARKS (cont'd)

- Geographical scope

Case C-98/11 P Chocoladefabriken Lindt & Sprüngli AG v OHIM (24/05/2012), the Court of Justice states that:

‘It would be excessive to require that proof of acquired distinctiveness be adduced for each Member State taken individually’ (paragraph 63)





## 3. 3-D MARKS (cont'd)

- Applying Article 7(1)(e) CTMR

(e) signs which consist exclusively of:

- i. the shape which results from the nature of the goods themselves;
- ii. the shape of goods which is necessary to obtain a technical result;

**Judgment of 19 September 2012 in Case T-164/11, Reddig GmbH v OHIM**





## 3. 3-D MARKS (cont'd)

### iii. The shape which gives substantial value to the goods.

R486/2010 (under appeal T161/2011)



‘The value and reputation of the chair stem from the fact that it is a solid, comfortable and ergonomic design which has become famous due to the combination of all th[e aforementioned] features (as well as considerable marketing efforts over the years) and not just its eye-appeal. In short, the marked goods are intended to be high quality and prestigious...The Board agrees that the shape is aesthetically pleasing and has some eye-appeal but does not consider that the cancellation applicant has proved that consumers are primarily or substantially driven by the desire to purchase a work of art. Much less does the shape ‘exclusively realize an aesthetic function’ (see OHIM examination Guidelines, No 7.6.2., p. 38). The CTM proprietor is therefore correct in distinguishing the present case from the ‘Loudspeaker’ decision, cited above. It is unlikely to be perceived primarily as a ‘timeless sculpture’. Instead it is rather to be seen inherently as ‘one of the customary shapes of the goods in the sector concerned’ or, at least, ‘a mere variant of those shapes’ (para. 21-22).



## 4. Geographical Indications

- **Article 7(1)(c) CTMR** ‘trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the...geographical origin of the goods...or services’

R 1118/2012-5 – CAMBRIA



- **Article 7(1)(g) – deceptive marks**

R 697/2008/1 - ‘MÖVENPICK OF SWITZERLAND’



## 4. Geographical Indications (cont'd)

- Geographical indications and wine

Art. 7(1)(j) CTMR prohibits: ‘trade marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin’

Case R0822/2010-2, ‘VAL DUNÁ’: ‘Th[e] accent [on the A] will significantly alter the pronunciation ...for Hungarian speakers who are the only members of the public in the European Community who are likely to understand this word ... [W]hile a trade mark that contains the whole of the protected geographical indication (plus other additional elements) may not be protected (such as ‘VAL DUNA Borrégió’), the partial reproduction in the trade mark of an element of the geographical indication does not necessarily give rise to an automatic justification of refusal of protection. It will depend on the particular circumstances of the case’.



## 4. Geographical Indications (cont'd)

- Designations of origin and G.I.s

Art. 7(1)(k) CTMR prohibits: ‘trade marks which contain or consist of a designation of origin or a geographical indication registered in accordance with Regulation (EEC) No 2081/92 when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication’

R 659/2012-5 (16/01/2013)





**THE END**

**THANK YOU FOR YOUR ATTENTION!**