



ABSTRACT

APPLICATION PROCEDURE: WORD MARKS; DESIGN MARKS, 3D MARKS, GIS TO FILE OR NOT TO FILE – ANSWERS FROM THE OHIM

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Imagination is named as the sixth of the 16 Laws of Success; without it enterprise will not prosper as it should (Napoleon Hill, *The Law of Success*, 1927). Yet being imaginative or creative with trade mark registration is not a legal requisite. Novelty, creativeness and inventiveness may be what are needed to either get or maintain a design, copyright or patent on the register but trade mark law makes no such demands. In the Orwellian world of trade marks, all forms of trade mark are equal in theory but some are more equal than others in practice because consumer perception may not be the same (Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34). For example, getting a slogan or shape mark on the register is often nothing short of a Herculean task. Demonstrating a 'certain originality or resonance' (judgment of 21 January 2010 in Case C-0398/08 P 'Vorsprung durch Technik',) can be a way forward for such marks, rather than embarking on the rocky road of showing acquired distinctiveness through use.

But weak trade marks are popular with applicants. The traditional view is that marks that are highly suggestive of the products or services they seek to cover incur less expense in marketing. The register authority is enjoined by the Court of Justice to be thorough and rigorous in its examination of absolute grounds. Applicants have to tread a fine line between marks that are so suggestive as to be descriptive and those where the descriptive nature of the sign in relation to the goods and services for which registration is sought is not directly and immediately perceivable. In addition the sign chosen must act as an identifier of commercial source and further obstacles posed by possible technical functions, geographical references and heraldry (to name but a few) may lie in the path to registration. The result is a 'cat and mouse' game between the register authority and applicants. Some blatantly unregistrable marks slip through the net and find their way onto the register while other, more meritorious ones have to fight every inch of the way and may fall prey to an arguably overzealous examination. Does this mean that the system is unfair?

The problem is the subjective element of trade mark law. It is not mathematics. Regulations, case law and guidelines are intended to help examiners to be as objective and predictable as possible but they can never totally exclude any human element in interpretation. In the vicarious world of perception through the eyes of another, protecting public interest and balancing competition with the granting of monopoly rights, it is hardly surprising that 100% predictability is not possible. But trends are present and these are what will be looked at by both applicants and examiners.

This paper looks at a small cross-section of recent cases that have come before the Boards of Appeal in order to identify some of the common pitfalls that applicants fall into as well as decisions that have been more fortuitous from the applicant's perspective. Although registration of many different types of trade mark are applied for at OHIM, this paper concentrates on the main ones: (1) word marks, (2) design marks, (3) 3-D marks and (4) marks containing geographical indications.



Consideration is given to the absolute grounds objections most commonly raised for the particular type of trade mark application in question. While all four types of sign may fall foul of Article 7(1)(b) and (c) CTMR, word marks may also raise issues of public policy or morality (Article 7(1)(f) CTMR), design marks may encroach on protected heraldry (Article 6ter of the Paris Convention), 3-D marks often trace a blurred line, skirting around the thorny issue of dual protection alongside design rights, patents and even copyright and thus are potentially objectionable under the three branches of Article 7(1)(e) CTMR, finally, geographical indications most commonly arise in a trade mark context in the world of wines and spirits and bring into play some of the lesser known provisions such as Article 7(1)(j) CTMR .

More than 2500 decisions are taken by the Boards of Appeal every year. Of the cases dealing with absolute grounds, word marks make up an important percentage. This type of mark often touches ordinary language, using descriptive prefixes, Americanisms, laudatory terms, and offensive words. With 23 official languages of the EU (and soon to be 24 with the membership of Croatia), it is increasingly hard to spot 'offenders'. Additional complication is given by the use of neologisms and incorrect grammar, which may well not save the sign from being immediately and directly understood by the relevant public as descriptive term for the goods and services in question.

Applicants in the EU unwisely favour the use of the stars of the European flag in their design marks. With so many fields of European business and everyday life being regulated by EU directives and regulations, it is becoming increasingly harder not to find a link (in the sense of an implied guarantee or endorsement) between the EU and certain goods and services where the European flag (or elements thereof) are used as part of the design mark. Additionally, distinctive character may be a problem where combinations of colours are concerned and showing acquired distinctiveness EU-wide is a hard task.

A highly conservative approach continues to be taken in relation to 3-D marks, although in exceptional circumstances the applicant might meet with success (see Freixenet cases). Article 7(1)(e)(iii) CTMR has been ruled on by the Boards (see Eames Chair case) but it remains to be seen what interpretation the General Court makes.

Finally, Article 7(1)(j) CTMR can require interpretation in the light of Article 24(5) of the TRIPS Agreement, where good faith use of a G.I. in a trade mark predates the protection of the G.I. itself. In all cases, the Boards must ensure that a good measure of common sense is applied to avoid possible iniquities.