



FULL TEXT

RECENT DECISIONS OF THE COURT OF JUSTICE AND THE GENERAL COURT OF THE EUROPEAN UNION RELATIVE GROUNDS OF REFUSAL AND RELATED ISSUES EFFECT ON PRACTICE

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Overview and introduction

The way to the General Court (GC) and the Court of Justice (ECJ)
Some numbers
The relative grounds of refusal and the infringement criteria
Scope of review of ECJ
Scope of review of GC
Likelihood of confusion
Reputation marks
Defenses
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Infringement

The way to the General Court and the European Court of Justice

References pursuant to Article 264 TFEU

Appeals pursuant to Article 65 CTMR to GC and on points of law to the ECJ

Some numbers

Statistics September 2012 – 2013

ECJ

2012: 35

2013: 14 (including Orders)

Pending: ca. 35

GC

2012: 156

2013 (1 January to 5 June): 72 decisions [19 absolute ground decisions, one partial reversal; 45 relative grounds decisions, 2 total reversals, 4 partial reversals; 8 other cases]



The relative grounds of refusal and the infringement criteria

Earlier CTMs and national marks (Article 8 (1) and (2), Article 8 (5))

- Double identity
- Likelihood of confusion
- Reputation

Earlier agents' marks (Article 8 (3))

Earlier unregistered rights (Article 8 (4))

Earlier national IP rights (Article 53 (2))

New "relative" grounds of refusal in the Commission proposal for an amendment of the CTMR

Scope of review by ECJ and GC

GC: Control of legality of Board decision on the basis of facts and law at the time of Board decision: no new facts and no new evidence (some exceptions); GC considers some issues as issues of law (inherent degree of distinctiveness, similarity of goods?); degree of analysis and "depth" of review of Board decisions varies greatly

ECJ: Review on appeal from GC is limited to issues of law; ECJ considers most issues of likelihood of confusion to be factual if GC applies the right legal criteria (similarity of marks, similarity of goods/services, degree of distinctiveness, ...). ECJ very rarely reverses GC

ECJ: On reference from national courts ECJ makes statements of law (interpretation of EU law) only.

Agents' marks – Article 8 (3)

Criteria

- Earlier mark
- In a MS or third country
- Owned by principal
- Application for CTM by agent
- Without authorisation

GC 29.11.2012, T-538/10, Fabryka Wezy Gumowych I Tworzyw Sztucznych fagumit sp. z o.o.

Earlier unregistered rights – Article 8 (4)

Criteria

- Earlier unregistered trade mark or other similar right
- Used in a MS (or in the EU: GIs)
- Of more than mere local significance
- Granting the right to prohibit the use of a later trade mark



Main issue

Scope of protection vs. territorial scope of use

Commission proposal: include expressly EU GIs

Cases

GC 22.1.2013, T-225/06 RENV et al, Budejovicky Budvar n.p. – Anheuser-Busch LLC
BUD/BUD

GC 18.4.2013, T-506 & 507/11, Peek & Cloppenburg KG – Peek & Cloppenburg
(Peek & Cloppenburg)

Earlier marks – Article 8 (2) – well-known trade marks

GC 20.3.2013, T-277/12, Bimbo SA – Café do Brasil SpA (BIMBO)

21 Since Article 8(2)(c) of Regulation No 207/2009 refers to trade marks which are ‘well-known in a Member State, in the sense in which the words “well-known” are used in Article 6 bis of the Paris Convention’, it is necessary, in order to ascertain how the existence and extent of a well-known mark can be proved, to refer to the guidelines for the interpretation of Article 6 bis (see, by analogy, Case T-420/03 El Corte Inglés v OHIM – Abril Sánchez and Ricote Saugar (BoomerangTV) [2008] ECR II-837, paragraph 79).

22 Under Article 2 of the joint recommendation concerning the provisions on the protection of well-known trademarks, adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organisation (WIPO) at the 34th series of meetings of the assemblies of the Member States of the WIPO (of 20 to 29 September 1999), in determining whether a mark is a well-known mark within the meaning of the Paris Convention, the competent authority can take into account any circumstances from which it may be inferred that the mark is well known, including: the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of any use of the mark; the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies; the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent to which they reflect use or recognition of the mark; the record of successful enforcement of rights in the mark, in particular, the extent to which the mark has been recognised as well known by competent authorities; the value associated with the mark (see, to that effect and by analogy, BoomerangTV, paragraph 21 above, paragraph 80).

23 Likewise, pursuant to Article 4 of that recommendation, a mark is to be deemed to be in conflict with a well-known mark where that mark, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration, liable to create confusion, of the well known mark, and is used, is the subject of an application for registration, or is registered, in respect of goods and/or services which are identical or similar to the goods and/or services to which the well-known mark applies.



Earlier marks – Article 8 (2) – Priority

ECJ 22.3.2012, C-190/10, Genesis Seguros Generales SA v. Boys Toys AG (Rizo v. Rizo's)

No differentiation within the same day (national or CTM)

Consequence for trade marks applied for on the same date (or priority date): Coexistence

Conflicts between marks – Criteria

Double identity: goods/services and marks identical

Likelihood of confusion

Identity or similarity of marks

Identity or similarity of goods or services

Likelihood of confusion: all circumstances

Reputation

Double identity

Marks are „identical“ if they are visually the same or have such minor differences which will go unnoticed by a reasonably attentive public

Identity in sound or concept without visual identity does not make marks identical

In office proceedings identity of goods/services is determined by comparing the specifications – identity exists if the descriptions are the same or, if not, there is overlap („overcoats“ in later mark are identical with „clothing“ in earlier mark)

In infringement proceedings court must make a comparison between earlier registered mark and the goods/services for which later mark/sign is used

Double identity is of practical relevance in infringement actions

Similarity of marks

Marks are similar if – disregarding the goods or services – they have one or more elements in common when comparing them visually, phonetically and conceptually, taking into account in particular their distinctive and dominant elements

Similarity is a necessary element in the LOC analysis; absence of similarity ends analysis

The „ultimate“ question should be:

Is the public likely to believe that when the marks would be used in the same market for identical goods/services that these goods/services have the same commercial origin or come from economically related companies

Only such elements may be disregarded in the comparison which are negligible in the overall impression

Courts are not always clear on whether distinctiveness (inherent or acquired) is part of the similarity analysis (it should not be) or only of the LOC „all circumstances“ rule.



Similarity of goods/services

Goods and services are similar if they have elements in common, such as their nature, characteristics, uses (purpose), complementarity or substitutability, or their manner of distribution or points of sale

Similarity is a necessary element in the LOC analysis; absence of similarity ends analysis

The „ultimate“ question should be:

Is the public is likely to believe that when identical marks (of normal distinctiveness) would be used in the same market for the respective goods/services that these goods/services have the same commercial origin or come from economically related companies

Likelihood of confusion

Likelihood of confusion requires, where similarity of the marks and of the goods/services has been found, an analysis of all relevant circumstances of the case, in particular

- the degree of similarity of the marks
- the degree of similarity of goods or services
- the degree of distinctiveness of the earlier mark
- the degree of attention of the relevant public
- etc.

in order to arrive at the ultimate finding that the public is likely to believe that the goods or services have a common commercial origin (same or economically related companies)

Degree of similarity

The degree of similarity of the marks is judged from „identity“ to „no similarity“
In between the „grading“ is done in three or four categories:

Slightly similar, average degree similarity, high degree of similarity

The degree of similarity of the goods/services is judged from „identity“ to „no similarity“
In between the „grading“ is done in three or four categories:

Slightly similar, average degree of similarity, high degree of similarity

Degree of distinctiveness

In determining the degree of distinctiveness, a distinction is made between „inherent“ distinctiveness and distinctiveness subsequent to the use made of the mark.

Inherent distinctiveness must be determined in relation to the goods/services for which the earlier mark claims protection. Inherent distinctiveness varies from very low (weak) to very high (strong).

The General Court takes the view that inherent distinctiveness may (or must) be determined by the office on the record and will be reviewed by the GC.



An enhanced degree of distinctiveness acquired through use must be proved by the claimant

Degree of attention of the public

The normal or standard degree of attention of the public is determined under the formula of „Gut Springenheide“, as imported into trade mark law in *Lloyds Schuhhandel v. Klijsen*:

The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect

The degree of attention must be determined in view of the goods/services involved

Courts will in most cases assume an average degree of attention

When professional users are involved, or in the case of pharmaceutical products, a high degree of attention is assumed

The higher the degree of attention, the more the likelihood of confusion will be reduced

Cases

Some examples from recent case law of the General Court and the Court of Justice

Similarity of marks
Similarity of goods and services
Overall evaluation

Similarity of marks

GC 22.5.2012, T-273/10, *Olive Line – Umbria Olii* (cl. 3)

GC 5.7.2012, T-466/09, *Comercial Losan – Mc Donald’s* (cl. 16,25, 28 v. 25, 35, 39)

GC 10.10.2012, T-333/11, *Wessang – Greinwald GmbH*, T-466/09
OD LOC; Board reversed marks not similar; GC reversed 11.5.2010, T-492/08 marks similar,
Board 15.4.2011 no LOC, R 1837/2010-4

GC 25.10.2012, T-552/10, *riha Richard Hartinger Getränke GmbH – Lidl Stiftung & Co. KG* (cl. 32 v. 32)

GC 29.1.2013, T-283/11, *Fon Wireless Ltd – nfon AG* (cl. 9, 38 v. cl. 9, 38)

GC 31.1.2013, T-54/12, *K2 Sports Europe – Karhu Sports Iberica* (cl. 18, 25, 28 v. cl. 18, 25, 28)

GC 7.1.2013, T-50/12, *AMC – MIP Metro Group* (cl. 24, 25, 39 v. cl. 24, 25, 39)

GC 20.2.2013, T-224, 225, 631/11, *Caventa AG – Anson’s Herrenhaus KG* (cl. 3, 18, 25, 35 v. cl. 25, 28)

GC 21.2.2013, T-444/10, *Esge AG – De’Longhi Benelux SA* (cl. 7, 40 v. cl. 7, 11)



GC 7.3.2013, T-247/11, FairWild Foundation – Rudolf Wild GmbH & Co. KG (cl. 3, 5, 29, 30 v. cl. 3, 5, 29, 30)

GC 8.3.2013, T-498/10, David Mayer Namen – Daniel Mayer Srl (cl. 25 v. cl. 18, 25)
DANIEL & MAYER MADE IN ITALY

GC 15.3.2013, T-533/10, Biodes, SL – Manasul Internacional, SL (cl. 5, 30, 31 v. cl. 5, 30, 31)
GC 23.4.2013, T-109/11, Apollo Tyres AG – Endurance Technologies Pvt Ltd (cl. 12 v. cl. 12, 35, 37)

GC 16.5.2013, T-508/10, Seba Diş Tıçaret ve Nakliyat AŞ – Joh. Wilh. Von Eicken GmbH (cl. 34 v. cl. 34)

GC 17.5.2013, T-502/11, Sanofi Pasteur MSD SNC – Munidipharma AG (cl. 5 v. cl. 5)

Similarity of goods and services

Description of goods and services in conflict
Similarity between goods
Similarity between goods and services

Similarity of goods – the scope of the specification – cl. 35

GC 31.1.2013, T-66/11, Present Services Ullrich GmbH & Co. KG – Punt-Nou SL

BABIDU cl. 35 (CTM) v. babilu (cl. 35)

Earlier mark: cl. 35 class headings (all)
'Advertising; business management; business administration; office functions'.

Later mark:
'Advertising; advertising mail; dissemination of advertising; on line advertising on a computer network; advertising mail; advertising on the Internet, for others; presentation of companies on the Internet and other media; provision of auctioneering services on the Internet'

44 Firstly, it should be noted that, as OHIM rightly points out, given that the opposition was brought against only the services in Class 35, the applicant's arguments relating to the other goods and services covered by the marks at issue are irrelevant in the context of the present action.

45 Secondly, the applicant's claim that it operates in a completely different commercial sector from the intervener is also irrelevant. In order to assess the similarity of the goods or services at issue for the purposes of Article 8(1)(b) of Regulation No 207/2009, the group of goods or services protected by the marks at issue must be taken into account, and not the goods or services actually marketed under those marks (see, to that effect, judgment of 16 June 2010 in Case T 487/08 Kureha v OHIM – Sanofi Aventis (KREMEZIN), not published in the ECR, paragraph 71, and judgment of 17 January 2012 in Case T 249/10 Kitzinger v OHIM – MDR and ZDF (KICO), not published in the ECR, paragraph 23).

46 Thirdly, the applicant's claim that the English words 'advertising' and 'publicity' are not the same cannot be accepted. The earlier Community trade mark application had been filed in Spanish, with the result that, under Article 120(3) of Regulation No 207/2009, Spanish is the authentic language in the present case.



The second language indicated by the intervener in that application, namely English, is, pursuant to Article 119(3) of that regulation, a language which it has accepted may be used as a language of proceedings for opposition, revocation or invalidity proceedings. In the Spanish language version of the list of the goods and services covered by the earlier trade mark, the services claimed are worded as follows: 'Publicidad; gestión de negocios comerciales; administración comercial; trabajos de oficina'. That wording corresponds exactly to that of the official Spanish version of the class heading of Class 35. The official English version of that class heading reads as follows: 'Advertising; business management; business administration; office functions'. Accordingly, as the Board of Appeal rightly concluded in paragraph 35 of the contested decision, the word 'publicité' should have been translated, in the English version of the list of the goods and services covered by the earlier trade mark, as 'advertising' and not as 'publicity'.

47 Fourthly, it should be noted that, as is clear from paragraph 46 above, the marks at issue both cover services described as 'publicidad'. Those services must therefore be considered to be identical, as the Board of Appeal rightly found in paragraph 38 of the contested decision.

48 Fifthly, regarding the services described as 'advertising mail', 'dissemination of advertising', 'on line advertising on a computer network', 'advertising mail', 'advertising on the Internet, for others' and 'presentation of companies on the Internet and other media' covered by the mark applied for, it must be found that, as the Board of Appeal rightly observed in paragraph 37 of the contested decision, those services are included in the broader category of 'advertising' services covered by the earlier trade mark and, accordingly, are identical to those services (see, to that effect, Case T 104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II 4359, paragraphs 32 and 33).

49 Sixthly, regarding the 'provision of auctioneering services on the Internet' covered by the mark applied for, it should be noted that, as has already been stated in paragraph 46 above, the earlier trade mark contains all the general indications of the class heading of Class 35. In accordance with the practice of OHIM described in Communication No 4/03 (see paragraphs 29 to 32 above), which is not challenged by the applicant, such use of all the general indications of the class heading of Class 35 constitutes, on the part of the intervener, a claim to all the services falling within that class and, in particular, to 'auctioneering' services, which are among the services included in the alphabetical list of that class. Since 'auctioneering' services clearly include the 'provision of auctioneering services on the Internet' covered by the mark applied for, those two service categories are identical, as the Board of Appeal rightly found in paragraph 36 of the contested decision.

GC 20.3.2013, T-571/11, El Corte Inglés SA – Groupe Chez Gerard Restaurants Ltd
CLUB DEL GOURMET fig cl. 35 v. CLUB GOURMET cl. 16, 21, 29, 30, 32, 33)

Earlier mark (ES)

'[class 35] An advertising sentence. It will be applied to the products covered by the trade marks Nos 1013156 (Class 29), 1013157 (Class 30) and 1815538 (Class 31), 1815539 (Class 32), 1013158 (Class 33), 1815547 (Class 42) "El Corte Inglés"

Later mark

cl. 16, 21, 29, 30, 32, 33

23 In the first place, it should be recalled that the list of goods and/or services designated by the earlier mark is worded as follows: '[class 35] An advertising sentence.



It will be applied to the products covered by the trade marks Nos 1013156 (Class 29), 1013157 (Class 30) and 1815538 (Class 31), 1815539 (Class 32), 1013158 (Class 33), 1815547 (Class 42) “El Corte Inglés” (figurative)’.

24 The Court notes, in that connection, that the list identifies a single service, in Class 35, namely ‘an advertising sentence’, whose envisaged use is then indicated. On the other hand, it is not apparent from the wording cited in the previous paragraph that the earlier mark is supposed also to designate the goods covered by the marks stated as constituting the scope of application of the service in question. However, since the classes of the Nice Agreement often cover a large number of very different goods, such information is not sufficient in order to identify the goods specifically covered (see, to that effect and by analogy, Case C-307/10 The Chartered Institute of Patent Attorneys [2012] ECR I-0000, paragraphs 49, 56, 61 and 62).

54 As stated above, the circumstances of the present case are characterised by the fact that, first, it was not apparent from either the wording of the description of the services designated by the earlier mark or from the submissions and contentions of the applicant during the procedure before OHIM that the scope of the protection of the mark in question went beyond that strict wording. Secondly, the specific features of Spanish national law, enabling, in the applicant’s view, the meaning of that description of the services to be usefully clarified, may not, for procedural reasons, be taken into account by the General Court. Accordingly, the Court must hold, as did the Board of Appeal, that the description of the services designated by the earlier mark, as set out in paragraph 8 above, does not allow them to be compared with the goods designated by the mark applied for.

Similarity of goods: examples – different beverages (cl. 32, 33)

GC 21.6.2012, T-276/09, Kavaklidere Europe – Yakult Honsha KK (cl. 32 v. cl. 33) (Yakult/Yakut) – similarity between cl. 32 and cl. 33

29 It must be stated that case law establishes that the term ‘alcoholic beverages’ includes cider, as well as ‘alcopops’, and that those beverages are very similar to beer. It also follows that, apart from wines and spirits, alcoholic drinks, including beer, are consumed for the same reason and have the same distribution outlets (order of 15 November 2006 in Case T 366/05 Anheuser-Busch v OHIM – Budějovický Budvar (BUDWEISER), not published in the ECR, paragraph 45).

30 There is, therefore, a large degree of similarity between the ‘beers’ covered by the earlier mark and the ‘alcoholic beverages (except beers)’ covered by the mark applied for. This is because the latter category undoubtedly applies to cider (as the Board of Appeal noted in the contested decision – without being challenged on that point). It also applies to ‘alcopops’, which are based on a mixture of soda and alcoholic beverages.

31 That high degree of similarity is not called into question or lessened by the fact that there is only a low degree of similarity, or indeed none at all, between certain goods in the broad category of goods covered by the mark applied for, and also certain goods in one of the categories of goods covered by the earlier mark.

GC 3.10.2012, T-584/10, Yilmaz – Tequila Cuervo, SA (Matador, cl. 32, MATADOR fig. 33) – no similarity between cl. 32 and cl. 33 – beer and tequila.

Goods vs. services – the textiles case

GC 16.5.2013, T-80/11, Dwarka Nath Kalsi – American Clothing Associates (cl. 24 v. cl. 40)



30 Folglich kann zwischen den von der älteren Marke erfassten Dienstleistungen „Verarbeitung und Veredelung von Häuten, Leder, Pelzen und Textilien“, die sich an ein begrenztes Fachpublikum der Leder- und Textilindustrie richten, und den für die angemeldete Marke beanspruchten Waren „Webstoffe und Textilwaren, soweit sie nicht in anderen Klassen enthalten sind; Bett- und Tischdecken“, die sich an die breite Öffentlichkeit richten, kein Ergänzungsverhältnis bestehen. Diese beiden Kategorien von Dienstleistungen und Waren werden nicht zusammen genutzt, da die Dienstleistungen der ersten Kategorie von den fraglichen Fachleuten selbst genutzt werden, während die Waren der zweiten Kategorie von Durchschnittsverbrauchern genutzt werden (vgl. in diesem Sinne Urteil *easyHotel*, oben in Randnr. 19 angeführt, Randnr. 58, und Urteil *DOLPHIN*, oben in Randnr. 29 angeführt, Randnr. 48). Sammlung veröffentlicht, Randnr. 43).

31 In diesem Zusammenhang kann dem Vorbringen des HABM, dass es im vorliegenden Fall eine Überschneidung zwischen der breiten Öffentlichkeit und den Fachkreisen gebe, da einige der Verbraucher der Waren der Klasse 24 auch in der Verarbeitung und Veredelung von Textilien tätig sein könnten, nicht gefolgt werden. Eine solche Argumentation würde nämlich dazu führen, dass im Rahmen des Vergleichs der einander gegenüberstehenden Marken die Unterscheidung zwischen der breiten Öffentlichkeit und dem aus Fachleuten bestehenden Publikum aufgehoben wird, da es immer möglich ist, dass einige Durchschnittsverbraucher auch Fachleute des Tätigkeitsbereichs sind, in den die von ihnen als Privatverbraucher gekaufte Ware fällt. Zwar mögen einige Durchschnittsverbraucher auch die Eigenschaft von Fachleuten des Tätigkeitsbereichs haben, in den die Waren der Klasse 24 fallen, doch werden sie beim Kauf dieser Waren eine höhere Aufmerksamkeit aufbringen, die es ihnen ermöglicht, die Herkunft der fraglichen Waren von der Herkunft der im Rahmen ihrer beruflichen Tätigkeit genutzten Dienstleistungen der Klasse 40 zu unterscheiden (vgl. in diesem Sinne Urteil des Gerichts vom 18. Oktober 2011, *SLV Elektronik/HABM – Jiménez Muñoz [LINE]*, T 449/08, nicht in der amtlichen Sammlung veröffentlicht, Randnr. 43).

Goods vs. services – the chicken case

GC 14.5.2013, T-249/11, *Sanco, SA – Marsalman, SL* (cl. 29, 31 v. cl. 29, 35, 39)

57 Purely to illustrate the error in the approach advocated by OHIM, it must be noted that, in the present case, it leads to the finding that when an undertaking which seeks both to purchase chickens and to transport them is faced with, first, a chicken producer present on the market under a particular mark and, second, a provider of chicken transport services present on that market with a mark identical to that of the aforementioned producer, that undertaking is not likely to consider that those goods and services come from the same undertaking because when a chicken producer provides a transport service that service is only a service which is ancillary or 'internal' to the production of chickens and it is therefore not in the market for the transport of chickens. According to the approach defended by OHIM, there is no similarity between the production of chickens and the transport, storage and distribution of chickens, so that the identical marks for those goods and services could coexist without a likelihood of confusion on the part of consumers of those goods and services. and services were in no way similar.

58 However, on the grounds set out at paragraph 53 above, the wholesale purchaser of chickens, which also needs a chicken transport service, is likely to take the view that there is a strong link between the production of chickens and the transport, storage and distribution of chickens, so that the consumer of those goods and services will consider that they come from the same undertaking.

59 Given that the presence on the market as defined by OHIM in the present case (see paragraph 54 above) cannot be taken into account, the analogy with the rules on the subject of actual use of an earlier mark in the context of an opposition must be rejected.



60 Furthermore, in so far as OHIM relies on the case giving rise to the judgment in COMP USA, it must be stated that it differs from the present case in so far as it related to the distance selling of information technology goods and services. In addition, in contrast to that case, where it was found that physically sending computer software and computers bought or rented from an undertaking offering its goods by means of the internet was merely the execution of a distance selling contract or of a service contract which is not connected to transport services (COMP USA, paragraph 47), it cannot be held, without proof from OHIM to that effect, that the transport, storage and distribution of chickens is merely the execution of the sale of chickens or of a service contract which is not connected to the transport, storage and distribution of chickens. in no way similar.

61 However, the Board of Appeal could not automatically exclude the existence of a complementarity between the goods of the earlier mark and the services of transport, storage and distribution of chickens. Such complementarity must be found between at least chickens and the transport, storage and distribution of chickens.

62 In assessing the similarity of the goods and services at issue, the Board of Appeal had to take into account all the relevant factors relating to the relationship between the goods and services at issue. Thus, notwithstanding the difference between, on the one hand, chicken meat and live chickens and, on the other, the transport, storage and distribution of chickens as regards their nature, their intended purpose, their method of use and whether they are in competition with each other, the Board of Appeal should have deemed them to have some degree of complementarity. It is apparent from the taking into account of all relevant factors in assessing the similarity of those goods and services that the Board of Appeal erred in considering that those goods and services were in no way similar.

Likelihood of confusion

Degree of similarity – marks, goods/services
Degree of distinctiveness, inherent, acquired
Attention of the public
Coexistence

The degree of distinctiveness

The degree of distinctiveness of the earlier mark may vary from 0 to 100 – however in an opposition or invalidation action it is not permissible to assign the value „0“ to an earlier mark

ECJ 24,5,2012, C-196/11 P, Formula One Licensing BV – Global Sports Media Ltd

F1 and  v.



44 Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation 40/94, read in conjunction with Article 8(2)(a)(ii).

45 Such a finding would be detrimental to national trade marks identical to a sign considered as being devoid of distinctive character, as the registration of such a Community trade mark would bring about a situation likely to eliminate the national protection of those marks.



Hence, such a finding would not respect the system established by Regulation No 40/94, which is based on the coexistence of Community trade marks and national trade marks as stated by the fifth recital in the preamble to that regulation, given that the validity of an international or national trade mark may be called into question for lack of distinctive character only in cancellation proceedings brought in the Member State concerned by virtue of Article 3(1)(b) of Directives 89/104 and 2008/95.

46 It should be noted that Article 8(2)(a)(ii) of Regulation No 40/94 expressly provides, in opposition proceedings, for trade marks registered in a Member State to be taken into consideration as earlier trade marks.

47 It follows that, in order to avoid infringing Article 8(1)(b) of Regulation No 40/94, it is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based.

48 However, the General Court has not done so in this case.

49 First, the General Court stated, in paragraph 44 of the judgment under appeal, that the 'F1' sign can be used in a descriptive context and that, as an abbreviation, it is just as generic as the term 'formula 1'. It considered, in paragraphs 49 and 51 of the judgment, that the 'f1' element in the mark applied for is not perceived as a distinctive element, but as an element with a descriptive function.

50 The General Court then held, in paragraphs 57 and 61 of the judgment under appeal, that consumers regard the 'F1' element in an ordinary typography as being the abbreviation of 'formula 1', that is to say, a description, and that the public attributes a generic meaning to the sign 'F1'. Finally, it added, in paragraph 67 of the judgment, that the presence of the letter 'f' and the numeral '1' in the mark applied for has no distinctive character.

51 Although the findings set out in paragraphs 44, 49, 51, 57, 61 and 67 of the judgment under appeal are made with regard to the sign in the earlier trade mark or with regard to the 'F1' element in the trade mark applied for, given that the General Court considered, in paragraph 54 of the judgment, that that sign and that element are the same, by doing so the General Court thus held that the sign is generic, descriptive and devoid of any distinctive character.

52 Hence, the General Court called into question the validity of those earlier trade marks in proceedings for registration of a Community trade mark and therefore infringed Article 8(1)(b) of Regulation No 40/94.

53 In those circumstances, Formula One Licensing is justified in claiming that the judgment under appeal is vitiated by an error in law.

Conclusions

In theory, the scope of protection is the greater the greater the elements of the conflict coincide: The more the marks are similar and the more the goods are similar and the higher the degree of distinctiveness the greater the likelihood of confusion; the converse should apply as well, but it is doubtful whether the courts will accept a very reduced scope of protection



The most significant areas of conflict today:

- Similarity between goods and services (e.g. cl. 25 and cl. 35)
- Scope of protection granted to „weak“ marks or marks composed of elements with a „weak“ or not as such registrable element where the later mark has the same element; the difficulty is compounded by the „language element“ in the comparison, where elements not as such registrable as a CTM are nevertheless given a „normal“ scope of protection because of the absence of knowledge of a particular language in parts of the EU („ARMAFOAM“ vs. „NOMAFOAM“, ECJ 2006)

Defenses – absence of genuine use

The procedure

- Opposition
- Invalidation
- Infringement
- CTM, national systems

The relevant points in time, determining the grace period, beginning and end

Commission proposals

Genuine use

Who – the proprietor

What – the mark as registered or an acceptable variant

Where – in the territory where the mark is protected

When – after the grace period has expired

How – use must be „genuine“ as regards time, place, extent

Excuses

Genuine use – the territory (German mark)

Genuine use – the territory (CTM)

ECJ 19.12.2012, C-149/11, Leno Merken BV v. Hagelkruis Beheer BV (OMEL/ONEL)

Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it.

FULL TEXT

Dr. Alexander von Mühlendahl



It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.

Genuine use – the mark as registered

ECJ 25.10.2012, C-553/11, Rintisch v. Eder (PROTI)

1. Article 10(2)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the proprietor of a registered trade mark is not precluded from relying, in order to establish use of the trade mark for the purposes of that provision, 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 is itself registered as a trade mark.

2. Article 10(2)(a) of Directive 89/104 must be interpreted as precluding an interpretation of the national provision intended to transpose it into domestic law whereby Article 10(2)(a) does not apply to a 'defensive' trade mark which is registered only in order to secure or expand the protection of another registered trade mark that is registered in the form in which it is used.

Genuine use – the extent of use

Extent of use is generally judged under the ANSUL criteria – the „all circumstances“ rule of genuine use

When „real“ use is shown, usually even small quantities suffice

Proof of use usually fails on faulty evidence

Attention must be paid when making use of affidavits or declarations – they must be supported by additional evidence

Case law is of little value

Genuine use – the extent of use

GC 17.1.2013, T-355/09, Reber Holding GmbH & Co. KG – Wedl & Hofmann GmbH (Walzertraum) (Appeal pending)

36 Die Klägerin trägt dazu vor, dass sie tatsächlich Umsätze erziele und kontinuierlich 40 bis 60 kg handgefertigte Schokolade pro Jahr verkaufe. Die Ernsthaftigkeit der älteren Marke hänge nicht ausschließlich von den erzielten Umsätzen ab, sondern vom konkreten Wirtschaftszweig und insbesondere davon, dass ihre handgefertigte Schokolade nicht als Ware des täglichen Bedarfs angesehen werden könne.



37 Im vorliegenden Fall ist festzustellen, dass die von der Klägerin als Nachweis für die Benutzung der älteren Marke vorgelegten Monatslisten über die Menge der unter dieser Marke verkauften Waren für den Zeitraum März 2001 bis Dezember 2002 einen Verkauf der Schokolade Walzertraum von durchschnittlich 40 bis 60 kg pro Jahr ausweisen. Auch wenn die Verkaufsmenge der fraglichen Schokolade, wie das HABM ausführt, mit Blick auf das Schutzgebiet der Marke, also Deutschland mit einer Bevölkerung von etwa 80 Millionen Einwohnern, relativ gering ist, sind die Verkaufszahlen dieser Schokolade mit etwa 3,6 kg pro Monat zwischen März 2001 und Dezember 2002 doch relativ konstant.

49 Nach alledem ist die Beschwerdekammer zu Recht zu dem Ergebnis gelangt, dass die Klägerin zwar eine gewisse Kontinuität der Benutzung der älteren Marke nachgewiesen habe, sich diese Benutzung aber in örtlichen und mengenmäßigen Grenzen gehalten habe, die als eng und lokal zu qualifizieren seien, so dass sie mit Blick auf ihre Art und ihren Umfang nicht als ernsthafte Benutzung angesehen werden könne. Die Beschwerdekammer hat nämlich in Übereinstimmung mit der oben in Randnr. 29 angeführten Rechtsprechung eine umfassende Beurteilung vorgenommen, indem sie das Verkaufsvolumen der durch die ältere Marke geschützten Ware, die Art und Merkmale der Ware, die geografische Verbreitung der Benutzung der Marke, die Werbung auf der Internetseite der Klägerin sowie die Kontinuität der Benutzung der älteren Marke berücksichtigt und dabei die berücksichtigten Faktoren in gewissem Maße zueinander in Beziehung gesetzt hat.

Defenses – bad faith

In LOC cases – opposition or cancellation – defenses other than absence of LOC or absence of genuine use are not available; the validity of the earlier mark cannot be challenged.

Bad faith presents a special case

Defenses – bad faith – absence of intent of use

GC 5.10.2012, T-204/10, Lancôme parfums et beauté & Cie – Focus Magazin Verlag GmbH (FOCUS/COLOR FOCUS)

59 It should be noted that, according to settled case-law, Community law may not be relied on for abusive or fraudulent ends (see, to that effect, Case C 255/02 Halifax and Others [2006] ECR I 1609, paragraph 68 and the case-law cited).

60 Evidence of an abusive practice requires, first, a combination of objective circumstances in which, despite formal observance of the conditions laid down by the Community rules, the purpose of those rules has not been achieved, and, second, a subjective element consisting in the intention to obtain an advantage from the Community rules by creating artificially the conditions laid down for obtaining it (see, by analogy, Case C 515/03 Eichsfelder Schlachtbetrieb [2005] ECR I 7355, paragraph 39 and the case-law cited).

61 In the present case, it should be noted that the applicant merely claims that the intervener's application for a declaration of invalidity constitutes an abuse of right, without producing evidence likely to establish that the latter registered the mark FOCUS with the fraudulent intention of not using it, in order to prevent other economic operators from registering certain marks.

62 Accordingly the applicant has not proved the subjective element, within the meaning of the case-law referred to at paragraph 60 above, of the abuse of right which it alleges against the intervener.



63 Therefore, the view must be taken that the applicant has not shown that the application for a declaration of invalidity made by the intervener was abusive.

64 Moreover, it should be noted that Article 57(2) of Regulation No 207/2009 states that, '[i]f the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years.'

65 It follows from that provision that the proprietor of an earlier Community trade mark, party to invalidity proceedings, is required to prove use of that mark only in so far as, at the date of the application for a declaration of nullity, the earlier Community trade mark had been registered for not less than five years.

Defenses – bad faith – bad faith in requesting invalidity

GC 30.5.2013, T-396/11, ultra air GmbH – Donaldson Filtration Deutschland GmbH (ultrafilter)

Claim of bad faith in requesting declaration of invalidity dismissed

25 The same conclusion must be reached in relation to the intervener's arguments alleging that the applicant has engaged in unfair competition against it. In that regard, the Court points out that Article 56(1)(a) of Regulation No 207/2009 does not make the admissibility or validity of an application for a declaration of invalidity subject to good faith on the part of the applicant for such a declaration (see, by analogy, the judgment of 3 December 2009 in Case T 245/08 Iranian Tobacco v OHIM – AD Bulgartabac (TIR 20 FILTER CIGARETTES), not published in the ECR, paragraph 26.) Indeed, even supposing that an application for a declaration of invalidity does form part of an overall confrontational commercial strategy, involving acts of unfair competition, the removal from the register of a mark which is either descriptive or devoid of distinctive character is a consequence of trade mark law, laid down in Article 57(5) and (6) of Regulation No 207/2009, and the trade mark's proprietor does not gain the right to retain its registration on the basis that the applicant for a declaration of invalidity has also engaged in unfair competition.

Reputation marks

Substantive law
Procedure

ECJ 10.5.2012, C-100/11 P, Helena Rubinstein SNC – Allergan Inc. (BOTOX/BOTOLIST, BOTOCYL)

UK market
Evidence
Language of evidence



Issues of procedure

Amending or restricting list of goods or services, competence to review in opposition procedure

Procedure before OHIM and Boards of Appeal

Changed circumstance

Amending list of goods or services

GC 16.5.2013, T-104/12, Verus Food – Performance Industries Mfg. Inc. (VORTEX/VORTEX))

Impermissible broadening of specification, not covered by priority claim, disregarded by Board in ongoing opposition proceedings; similarity of services to goods will be judged under specification as it was before amendment

Procedure before OHIM and Boards

Board of Appeal proceedings, ECJ 19.1.2012, C-53/11 P, OHIM – Nike International Ltd – Aurelio Munoz Molina

Admissibility deficiencies in appeal cases must be corrected within four months

OHIM decision to find opposition admissible may not be overturned in final decision, ECJ 18.10.2012, C-402/11 P, Jager & Polacek GmbH (Redtube)

Change of circumstances

Withdrawal of application

Withdrawal of opposition/invalidation or of application

„Loss“ of earlier right

Change of circumstances

Withdrawal of opposition

Where an opposition is withdrawn subsequent to Board of Appeal decision, the **court will declare the action devoid of purpose**

ECJ Order 18.9.2012, Joint Cases C-587/11 P, Omnicare Inc. – Astellas Pharma GmbH (OMNICARE)

11 The withdrawal by Astellas of the opposition which it had filed against the application submitted by Omnicare, following a transaction between those parties, has the effect of putting an end to the dispute concerning the rejection of that application, with the result that that appeal has become devoid of purpose (see, to that effect, order of 19 May 2009 in Case C 565/07 P AMS v OHIM, paragraphs 14 and 15).



12 Accordingly, it must be held that there is no need to adjudicate on that dispute.

13 Under those circumstances, it is not for the Court to give a ruling on a point of law as requested by OHIM.

Where the earlier mark is revoked or declared invalid subsequent to Board of Appeal decision, the **court will declare the action devoid of purpose**

GC Orders 26.11.2012, T-548/11 and T-549/11, MIP Metro Group Intellectual Property GmbH & Co. KG – Real Seguros, SA (REAL/real,-)

22 In those circumstances, the Court finds that the present action has become devoid of purpose following the revocation of the Portuguese word mark REAL, the mark which effectively constituted the sole basis of the opposition decision and of the contested decision (see, to that effect, order of 27 February 2012 in Case T 183/11 MIP Metro v OHIM – Jacinto (My Little Bear), not published in the ECR, paragraph 5; see, to that effect and by analogy, orders of 11 September 2007 in Case T 185/04 Lancôme v OHIM – Baudon (AROMACOSMETIQUE), not published in the ECR, paragraph 21, and of 26 June 2008 in Joined Cases T 354/07 to T 356/07 Pfizer v OHIM – Isdin (FOTOPROTECTOR ISDIN), not published in the ECR, paragraphs 5 and 6). There is therefore no need to adjudicate on the present action.

23 The Court finds in that regard that the decision of the Opposition Division has not taken effect. It must be noted that, in accordance with the second sentence of Article 58(1) of Regulation No 207/2009, appeals filed at OHIM have suspensive effect. Accordingly, a decision from which such an appeal lies, such as a decision of an Opposition Division, takes effect only where no appeal has been lodged at OHIM in the form and within the time-limits prescribed in Article 60 of Regulation No 207/2009 or such an appeal has been definitively dismissed by the Board of Appeal. However, the present case does not concern either of those situations, as the contested decision has not taken effect either. It is clear from Article 64(3) of Regulation No 207/2009 that the decisions of the Boards of Appeal take effect only as from the date of expiration of the period referred to in Article 65(5) of Regulation No 207/2009 or, if an action has been brought before the Courts of the European Union within that period, as from the date of dismissal of such action. The present case is not concerned with either of those two situations, given that the Court has found that there is no need to adjudicate on the present action (see order in AROMACOSMETIQUE, cited in paragraph 22 above, paragraph 22 and the case-law cited).

Where earlier right invoked in opposition or cancellation action is „lost“ as a result of non-renewal or invalidation/revocation subsequent to Board of Appeal decision, the court **will not declare the action devoid of purpose**

ECJ Order 8.5.2013, C-268/12 P – Cadila Healthcare Ltd – Novartis AG (ZIMBUS/ZYDUS)

29 According to OHIM, Article 113 of the Rules of Procedure of the General Court allows the latter to declare an action devoid of purpose, without, however, requiring it to do so or prescribing the measures to be taken. OHIM contends that the General Court may not annul or vary a decision on grounds that emerge subsequent to its adoption. As the earlier mark was valid on the date of the contested decision, the General Court could legitimately hold, in paragraph 22 of the judgment under appeal, that ‘no account can be taken of a possible non-renewal of the earlier mark for the purpose of assessing the validity of the contested decision’.



30 Novartis states that it continues to have an interest in ensuring that the mark ZYDUS is not registered. That interest may be based on the fact that it is the proprietor of a trade mark that is similar or even identical to the (now expired) earlier mark. Novartis accordingly takes the view that it must be able to rely on the decision of the Second Board of Appeal of OHIM, according to which there is a likelihood of confusion.

Findings of the Court

31 The purpose of the proceedings must continue to exist, like the interest in bringing proceedings, until the final decision, failing which there will be no need to adjudicate; this presupposes that the action must be liable, if successful, to procure an advantage to the party bringing it (Case C 362/05 P Wunenburger v Commission [2007] ECR I 4333, paragraph 42 and the case-law cited).

32 In dismissing the plea, raised by Cadila Healthcare, that there was no need to adjudicate, the General Court held, in paragraph 22 of the judgment under appeal, that the proceedings still had a purpose. The General Court took the view, in essence, that the possible expiry of the earlier mark did not affect the assessment of the validity of the contested decision since that mark produced effects at the time when that decision was adopted.

33 The expiry of the earlier mark, which occurred after the action had been brought, did not deprive the contested decision of its purpose or of its effects. In addition, the assessment in that decision, to the effect that a likelihood of confusion exists between the marks ZYDUS and ZIMBUS as regards pharmaceutical, veterinary or sanitary preparations, continued to produce its effects at the time when the General Court delivered the judgment under appeal. The General Court did not, therefore, err in law in holding, in paragraph 22 of the judgment under appeal, that the action had not become devoid of purpose.

34 Contrary to what Cadila Healthcare has claimed, the General Court was not under an obligation, before giving judgment in the proceedings, to ask the parties about the renewal of the earlier mark. By contrast, Cadila Healthcare, as applicant at first instance, had the option, if it took the view that the purpose of the proceedings had ceased to exist, to discontinue the proceedings.

Infringement

Definition of conflicts

Prohibited acts

Limitations

Proposals of the Commission

Infringement

Defense of later mark itself being registered: not relevant

ECJ 21.2.2013, C-561/11, Fédération Cynologique Internationale v. Federación Canina Internacional de Perros de Pura Raza (FCI)



Conclusions

Effect on OHIM practice
Effect on Member State office practice
Effect on infringement courts

Relevance of General Court case law vis-à-vis Court of Justice case law

Principal issues

- „Consistency“ issue, case-by-case approach, similarity analysis
- „Territoriality“ issues
LOC in a multi-language market
Territorially limited degree of distinctiveness or reputation
Territorially limited use