

## ABSTRACT

### RECENT CASE-LAW IN INTER-PARTES PROCEEDINGS AT THE BOARDS OF APPEAL, OHIM

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The starting point is the issue that may be the most important of all – protection of weak elements.

The first case is **R1068/2011-2** between the word mark applied for 'DDCHARTS' and the earlier mark  KD CHART. The Opposition Division (OD) allowed the opposition in relation to specialized software and software services, but the Board reversed it. 'CHART' is commonly used in the area of IT and the most distinctive elements were clearly the letter combinations 'KD' and 'DD'. For the highly attentive public the low similarity phonetically could not be expected to cause a likelihood of confusion.

In **R54/2012-2**  **BON** APPÉTIT, both instances were in agreement – there was no likelihood of confusion, although both marks cover 'fish'. The Board referred to the fact that the French word combination 'BON APPÉTIT' would also be understood by non-French speakers. The distinctive character lies in the special scripts and the device element.

In relation to IP TRANSLATOR there are a number of cases from the Boards. **R 2139/2011-1**

Erotik Kaiser/ Kaiser's and  relates to the claim in the contested decision that the class heading is considered to cover all goods/services in the class, cf. the Communication of the President No. 4/03. The Board stressed that the OD is bound by the law and cannot conduct examination through reference to a communication which was furthermore cancelled by the Court. Nobody can derive rights from an application/registration if the principle of certainty is not observed. The uncertainty is detrimental to the party responsible for it.

The following two cases relate to marks with reputation:

**R1659/2011-2 and R1364/2012-2** KENZO / KENZO – EN – The goods of the contested trade marks were wine and alcoholic beverages and services related to wine in Classes 35, 41 and 43. The OD found that KENZO had failed to prove reputation. The Board, however, found that it had been shown that the mark 'KENZO' possesses substantial reputation for cosmetics, perfumes and clothing. It referred to the profile of advertising campaigns in prestigious publications reflecting the volume of sales highlighted by the invoices, the historical data about the designer KENZO and the growth and influence of his boutiques throughout Europe. The success of his fashion designer collections are all so well documented that it is inconceivable that the reputation of KENZO could be denied. Although the goods and services were clearly dissimilar, there was little doubt that there was a link between them - they all strongly project images of luxury, glamour, good taste, success and social status. The applicant was taking unfair advantage of the earlier sign.



In **R1637/2011-5** / Apart et al, contrary to the OD, the Board did not consider it relevant that the appellant had not submitted invoices, turnover figures or advertising expenditure. It had filed evaluations originating from independent parties as evidence, namely the granting of awards and ratings of consumer research companies. These prizes and ratings would not have been awarded had the mark not been successful on the Polish market and recognised by the relevant public. The Board found that the reputation of a mark for jewellery can affect consumers interested in fashion items in general, establishing a link between these products.

In **R 2398/2010-4** the word mark SKYPE was opposed based on the earlier CTM SKY. It was considered that there was a likelihood of confusion in relation to the services applied for in Class 38, based on Art. 8(1)(b), with reference to the enhanced distinctiveness of SKY based on use. The CTM applicant claimed reputation as regards its mark SKYPE, but according to case-law an applicant cannot rely on the possible reputation of its mark. Furthermore, at the time of the priority date of the SKYPE application, the mark had only been on the market for a few months.

The right to a name was dealt with in **R 2463/2011-2**. It is a ruling on an application for a declaration of invalidity against the CTM registration 'ELIO FIORUCCI', of Article 53(2)(a) CTMR. The case had come back from the CJ for the Board to rule on the effect that any possible assignment of the trade mark 'ELIO FIORUCCI' to the CTM proprietor might have as regards the validity of the CTM. As no assignment of the trade mark 'ELIO FIORUCCI' or consent had been proven, the application for invalidity was allowed.

Switching to a procedural issue, in **R 1280/2012-4** regarding **ORYZON** and ORIZON, covering identical goods in Class 5, the OD allowed the opposition. The applicant appealed and filed an application for suspension as the earlier CTM was subject to revocation proceedings. The request for suspension and the appeal were rejected due to the strong similarity between the marks, the identity of the goods and the fact that the appellant gave no further information about the cancellation proceedings or prospects of success. It did not indicate the actual grounds for revocation, the chances of success and why it was not in a position to initiate these proceedings earlier. It was not the task of the Board to enter into the substance of those proceedings and not appropriate to allow the losing party to escape from the outcome of the proceedings by launching other proceedings. As long as no decision in those other proceedings was taken, the earlier CTM was in force and enforceable.

Finally, a case concerning foreign equivalents, **R0024/2012-2** BEAUTY SECRET / SECRETOS DE BELLEZA. The OD rejected the opposition. The Board reversed the decision for identical services in Class 35. Both instances found the marks visually and aurally similar to a low degree. Contrary to the OD, the Board found that the Spanish-speaking public is likely to understand the meaning of 'BEAUTY SECRET'. 'Beauty' is an international word known by everybody and 'secret' is very similar to the Spanish word 'secreto'. A significant part of the Spanish public will associate the marks and believe that the mark applied for is the English version of the earlier mark.