



## FULL TEXT

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

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The Boards of Appeal took more than 2,500 decisions last year. This year the number will presumably be about the same. Obviously, I cannot make an overall assessment of decisions in inter-partes cases. What I aim to do is to present a selection of various decisions which I hope will be of interest to you – as they say, ‘variety is the spice of life!’

My starting point is the issue that I consider to be the most important of all – protection for elements that cannot be protected according to Article 7 CTMR. I realise what I have just said is a contradiction, but in reality there are numerous cases where protection is given to such elements. Nonetheless, it is evident that giving low protection to weak elements is the only way to guarantee fair competition. If a weak trade mark is chosen, this mark should be given a narrow protection. To give someone the monopoly on an element, which for example is descriptive in (a part of) the EU is creating unfair competition conditions. It is therefore an unjustified obstacle in the internal market. Also, it encourages the use of non-distinctive trade marks to the disadvantage of consumers.

The first case I would like to mention is Case No **R 1068/2011-2** which deals with the word mark applied for ‘DDCHARTS’ and the earlier mark  KD CHART, both Community trade marks.

The Opposition Division allowed the opposition in relation to specialized software and software services.

The rapporteur sent a communication to the parties drawing their attention to the fact that the common element ‘CHART’ seemed to be a descriptive part of both marks as it may indicate the area of use of the software and the services at issue. The parties did not file any submissions in reply to the claimed descriptiveness of ‘CHART’.

The Board thereafter reversed the decision and rejected the opposition. It stated that the English word ‘CHART’ could be defined as a graphic representation of data. The Board found it logical to use IT for the creation of charts. The word is commonly used in the IT area; cf. that the opponent itself states on its homepage that ‘KD Chart is a tool for creating business charts’.

The Board concluded that the most distinctive elements of the marks were their letter combinations, i.e. ‘KD’ of the earlier mark and ‘DD’ of the mark applied for. It took into consideration the highly attentive, English-speaking public in relation to the goods and services (the parties themselves had declared that the public consists of software engineers, programmers and project managers who are managing software projects) and the descriptiveness of the *quasi* identical elements ‘CHART’ and ‘CHARTS’. It was concluded that the low similarity phonetically would not cause a likelihood of confusion.

It should also be noted that in relation to the goods and services in question, according to the parties, it was determined that the visual impression must be deemed more important than the phonetic impression as the goods and services are often bought on the Internet.



The next case is Case No **R 54/2012-2**. In this appeal the Community trade mark applied for was , while the earlier mark was the International trade mark registration , covering Benelux and France.

Both instances were in agreement that there was no likelihood of confusion, although both marks cover 'fish'. The Board referred to the fact that the French word combination 'BON APPETIT' would also be understood by non-French speakers, i.e. the relevant public in Belgium and the Netherlands (see similar decision R 278/2003-2). The distinctive character lies in the special scripts and the device element of the mark applied for.

The Board stressed that 'It is never possible to prevent the consumers from being confused as there is no prohibition against the marketing of products under descriptive and/or non-distinctive marks. The only thing that can be secured is that the trade mark proprietors obtain an area of protection for their trade marks, which is reasonable based on all relevant factors including the strength of the mark. It is clear that a strong, highly distinctive mark should be entitled to a considerably wider area of protection than a mark whose main element is very weak, or even non-distinctive/descriptive.'

The decision 'BON APPETIT' is dated 3 April 2013 and therefore could still be appealed.

In relation to elements that do not deserve protection, it is important to notice that, in principle, the Community trade mark law, just like any other trade mark law, is not consumer protection law. Most of the public interest in Article 7 CTMR is company oriented. The main function of a trade mark is to indicate the origin. The aim must be to create possibilities for companies to market a product under a specific distinctive mark in order to make sure that the relevant public can repeat the choice of buying the specific goods/service, if desired, and to avoid them if it was found that they did not correspond to its needs. Trade marks thus contribute to fair competition. This is the whole justification of the trade mark system.

A Community trade mark may not be registered if the mark is descriptive/non-distinctive in one of the languages of the European Union. However, a Community trade mark may of course be registered if such a descriptive/non-distinctive word/element is combined with something distinctive. This is reasonable.

Still, to later grant protection for such a non-distinctive word/element in an opposition/cancellation case because this element may not be understood in one of the EU countries is not logical and fundamentally wrong. This means that protection is given to something which from the outset could not be protected as a CTM. Suddenly a monopoly is given to something completely descriptive/non-distinctive. This works against fair competition within the EU.

This result is also undesirable if the corresponding opposition based on a national mark is successful. To register for example a descriptive English word in a country in which it is not clear that it will be understood may be a way to stop competitors from using a word/word combination which in reality ought to be available for everybody. Consequently, to accept that a national registration of a completely descriptive/non-distinctive term may prevent a CTM, gives in the same way a monopoly which counteracts free competition.

Therefore, I would like to turn the issue around. What is your right as a trade mark registration holder? You have a right against later marks. However, you do not have an unconditional right to use your mark. As you are all aware, in the CTM system there is no *ex-officio* examination of relative grounds and there may also be national rights based on use.



Applying this to a word/word combination which is considered distinctive for example in Spain but non-distinctive for example in English, should mean that as this word/word combination cannot be given protection as an element in a CTM, it can also not be prevented from being registered as an element in a later CTM. The word/word combination has no, or at least very little, value in the mark. On the other hand, such an element may possibly be prevented from use in Spain if it is protected as a distinctive mark in this country, cf. Matratzen and Donuts. This should be up to the national courts to decide.

A proposed change to the Trade Mark Directive is presumably intended to give a solution to the problem of protection of weak/non-distinctive trade mark elements. In Article 4 of the proposal it is stated that a mark which is non-distinctive or descriptive shall not be registered if the ground for non-registrability obtain in a Member State other than the one in which the application for registration was filed. This means that for example a word in Swedish, which is not registrable in Sweden, would also be prevented from registration in Rumania, because it is an EU language, although Swedish cannot be expected to be known in this country.

It is impossible to expect the national trade mark offices to prevent registration of such words as it would be a very tough, not to mention expensive, task to check the word(s) in the mark applied for in all the EU languages.

However, if this proposal is implemented, it may be possible in inter-partes proceedings for the parties to argue that the other party's mark should not be/have been accepted for registration. By analogy, an earlier CTM should not be able to prevent the registration of a later CTM if the common element is non-distinctive, just because this element is not known in one of the member countries. Thus the problem with national registrations such as Matratzen and Donuts could become history.

On the other hand, the result will be that it is just as difficult to obtain a national registration as a CTM, or at least that there is a (maybe unknown) risk for later cancellation. It would therefore not be an option to obtain national protection of a mark, even if the mark is perfectly distinctive in the member country in which it is applied for and only intended for this market. To maintain the possibility of a cheap national registration for which the use requirement may be lower than in relation to a CTM is important, especially for smaller and often also for medium-sized companies. The question is therefore if the approach in the proposal to the amendments of the Directive is the best one.

In my opinion, the best tool in relation to non-distinctive elements is the use of disclaimers. I would define a disclaimer in this context as the clarification of something that should be a legal principle: no protection for non-protectable elements. In a system where the distinctive character of a mark may depend on its meaning in 23 languages (soon to be 24 languages when Croatia becomes a member of the EU), it is difficult to evaluate the strength of word elements. The consequent use of disclaimers would be an important aid for trade mark owners, representatives, the OHIM, national trade mark offices and the courts.

Naturally, a disclaimer shall only be accepted for elements that do not deserve protection. It can of course not be possible to overcome an opposed mark by disclaiming the common element, if distinctive. It is also not, logically, possible for parties to agree upon a disclaimer for something that deserves protection, as the trade mark register would be misleading.

It has been argued in opposition to a disclaimer system that the relevant public is not aware of the disclaimers. However, this is not a valid argument since, as stated in the decision referred to above, 'it is never possible to prevent the consumers from being confused as there is no prohibition against the marketing of products under descriptive and/or non-distinctive marks.'



The CTM system cannot and shall not prevent any likelihood of confusion, but shall contribute to undistorted competition. A trade mark is an acceptable monopoly because it helps competition. Signs and elements as defined in Article 7 disrupt competition and must therefore be excluded from protection.

The problem with the present system, where the disclaimer possibility is rarely used, is that the users, as well as the national offices and courts and even the OHIM, have a problem in evaluating what protection may be granted to the different elements of a mark. In the 'DDCHARTS'/ 'KD CHART' case the wording was in English, so it was therefore easy for most people in the EU to see that it could not gain protection, but if the word had been for example a Latvian word, it would presumably not be known to so many people in the EU. A check in 23 languages (soon to be 24) is not something that can be expected to be carried out by the national courts for example, which means that without a disclaimer in the mark, it is likely that they may be deceived into giving a CTM false protection.

In the Max Planck study it was suggested that the stipulation regarding disclaimers should be deleted and replaced by a stipulation in the preamble that a finding of likelihood of confusion cannot be based on elements which are not distinctive or otherwise not eligible for protection. This would have been a solution, but clearly it cannot compete with a proper disclaimer system.

Who knows all the languages of the European Union and can for example, when making a search, evaluate if the word(s) in an earlier mark are distinctive or not? If an application is met by a disclaimer, the applicant would also have the option to convert its application to a national application and thereby be granted the protection that is possible according to the national law. The prudent use of disclaimers will make the CTM register clearer and make opposition possibilities easier to predict.

It is therefore extremely unfortunate that in the proposal to amendments of the CTMR, the disclaimer stipulation in paragraph 37.2 has simply been deleted, without any comment in the explanatory memorandum or in the preamble. It has not even been replaced elsewhere by a stipulation, as suggested by Max Planck, that a finding of likelihood of confusion cannot be based on elements which are not distinctive or otherwise not eligible for protection. Although this would be logical, the practice today from the General Court and the Court of Justice unfortunately often goes in the opposite direction.

Turning to something completely different, in relation to the practice following the judgment in Case No C-307/10, IP TRANSLATOR, I would like to emphasize that there are a number of cases from the Boards that deal with this issue. Today I want to mention the opposition case **R 2139/2011-1**

Erotik Kaiser/ Kaiser's and



This case relates to different topics, one of which is the assumption in the contested decision that the class heading is considered to cover all goods/services in the class, cf. the old Communication of the President No. 4/03.

The Opposition Division (before the IP TRANSLATOR judgment) referred to the fact that the mark applied for covers the class heading in Class 35, i.e. 'advertising; business management; business administration; office services' and that the class heading is considered as covering all goods/services in the class according to Communication 4/03 of the President of the Office. The earlier German and CTM marks covered 'advertising; retail services in relation to clothing, arranging of contracts for others for the provision of services'. The Opposition Division found that the services of the conflicting marks were identical. It also decided that the broad categories of the applicant's services *ex-officio* could not be divided.



The Board dismissed the appeal, however with a different reason. It referred to Rule 2(2) CTMIR, which states: *The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.*

In line with this, in relation to the statement in the contested decision that the class heading is considered as covering all goods/services in the class based on the Communication of the President No 4/03, the Board concluded that the Opposition Division is bound by the law and cannot evade the performance of this examination through a general reference to Communication 4/03 of the President of the Office, which was furthermore cancelled by the Court (C-307/10 IP TRANSLATOR).

The Board also stressed that no-one can derive rights from an application/registration if the principle of certainty is not observed. The uncertainty is always detrimental to the party responsible for it. As the applicant had not defined the services, and the retail services of the earlier mark regard clothing, the services applied for may also relate to clothing. Therefore all the services in Class 35 were rejected. When applying this principle, an opponent who refers to an unclear specification would of course equally lose.

I can only advise you to make sure that you always mention explicitly in the specification of goods/services everything that is within your/your client's area of interest. Trying to obtain too broad a specification may have fatal consequences.

Turning now to the area of marks with reputation, i.e. to Article 8(5) CTMR, I will refer to some cases in which it was worthwhile to appeal.

The first case regards an opposition based on a mark with a claimed reputation, Case No



**R1637/2011-5** / *apart et al.* The earlier marks 'APART' were Polish. The evaluation of evidence of reputation was essential and the opponent succeeded before the Board, but not before the Opposition Division.

Contrary to the Opposition Division, the Board did not consider it relevant that the appellant had not submitted invoices, turnover figures or advertising expenditure. Instead, 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 the case at hand, the relevant goods, i.e. sunglasses, might be designed by the same fashion designers of watches and jewellery and might bear the same trademark. The style of the common designer will appear on all products, including typical fashion accessories like costume jewellery, watches and sunglasses, establishing a link between these products, even if the traditional producers of these goods are different.

The second and third cases are also opposition cases: Case Nos. **R1659/2011-2 and R1364/2012-2** 'KENZO'/'KENZO' (both CTMs). The goods of the contested trade marks were 'wine and alcoholic beverages and services related to wine' in Classes 35, 41 and 43. The Opposition Division found that the fashion company KENZO S.A. had failed to prove reputation and rejected both oppositions.



The Board, however, found that in both cases 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, historical data about the designer 'KENZO' and the growth and influence of his boutiques throughout Europe. It stated that the success of his fashion designer collections were all so well documented that it was 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. A brand extension from one set of goods to the other is highly plausible, especially given the absolute identity of the signs under which they are traded and the fact that 'KENZO' is inherently distinctive.

The Board found that the earlier mark 'KENZO', because of its substantial reputation, possesses an 'undisputable allure' that can be transferred to other fields such as the wine industry. Furthermore, the Board agreed to the claim by the opponent that 'KENZO' does not just function as a trade origin, but also as a 'vehicle for communicating a message to the public'. It was found that the applicant was taking unfair advantage of the earlier sign by riding on the coattails of the mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image, without paying compensation (cf. C-487/07 L'Óreal, paragraph 50).

The decision in case R 1364/2012-2 is dated 25 March 2013 and may still be appealed.

The cases 'APART' and 'KENZO' are good examples of the overall view that should be taken in relation to proof of use and reputation.

Turning to another issue, the next case relates to a mark which had been coexisting with the earlier mark before the application for a CTM was filed.

In Case No **R 2398/2010-4** the word mark 'SKYPE' was opposed based on the earlier CTM 'SKY'. It was considered by both instances that there was a likelihood of confusion in relation to the services applied for in Class 38, based on Article 8(1)(b) CTMR, with reference to a strengthened distinctiveness of the mark 'SKY' based on use in the UK. The CTM applicant claimed reputation as regards its mark 'SKYPE', but this did not help and 'SKYPE' was rejected.

The Board asserted that according to case-law, the applicant could not rely on the possible reputation of its mark 'SKYPE'. The Board stated that if the opposite were true, the owner of a younger mark could decide to start using its mark for a while without applying for registration, avoiding any legal action from the owner of an earlier conflicting mark and then, when it feels safe enough, because it believes the mark has obtained reputation on the market, file an application arguing that there could be no likelihood of confusion anymore because of this reputation.

In relation thereto it could be added that it ought always to be possible for the proprietor of an earlier mark to initiate an infringement case at court against the use of a later similar unregistered mark, if there is a likelihood of confusion or other infringement.

The Board also mentioned that at the time of the priority date of the contested application 'SKYPE', the mark had only been on the market for a few months and that the evidence submitted referred mainly to the following years. There was no benefit from the massive use of 'SKYPE' after the filing date.



As did the General Court in Case No T-31/03 'Grupo Sada' and later in Case No T-505/10, 'ASTALOY'/'HASTELLOY', the Board stated that it is up to the applicant to demonstrate that a peaceful co-existence claim is based on the absence of any likelihood of confusion. It concluded that in this case this condition had not been fulfilled.

The case is now pending before the General Court (Case No T 183/13).

My question is: as regards the condition that an applicant has to show that there has been no confusion, how can it be fulfilled? Is it correct that the burden of proof is on the proprietor of the contested mark when the mark has been coexisting with the opponent's mark for many years? How can it possibly be demonstrated that there has been no confusion? In my opinion the burden of proof should be on the opponent. It ought to be much easier for him to demonstrate that there have actually been cases of confusion and this would be in line with general principles – the applicant shows co-existence and the opponent shows confusion.

Another case in relation to likelihood of confusion is a case concerning foreign equivalents, Case No R 24/2012-2, 'BEAUTY SECRET'/'SECRETOS DE BELLEZA', both CTMs. The Opposition Division rejected the opposition and the Board reversed the decision.

Both instances found the marks visually and aurally similar to a low degree. However, contrary to the Opposition Division, the Board found that the Spanish-speaking public is likely to understand the meaning of 'BEAUTY SECRET'. According to the Board 'beauty' is an international word, known by everybody and 'secret' is very similar to the Spanish word 'secreto'. Since the earlier mark means 'secrets of beauty', the marks are conceptually quasi-identical for the Spanish-speaking public. A significant part of the Spanish public will inevitably associate the marks and believe that the mark applied for is simply the English version of the earlier mark. The Board found that the mark applied for could be perceived by the relevant public as representing an anglicised, modernised and internationalised form of the earlier trade mark and that there was a likelihood of confusion for the identical services in Class 35.

In relation to this decision a parallel may be drawn to the field of domain names in which national equivalents are often registered and used in different countries.

Turning now to a procedural issue, Case No R 1280/2012-4, relating to **ORYZON** and the earlier CTM registration 'ORIZON', covering identical goods in Class 5.

The Opposition Division 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. Thus, the opponent 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. The Board concluded that 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 and the Board dismissed the appeal and allowed the opposition.

This decision is dated 20 March 2013 and may therefore have been appealed, although to date I have no knowledge hereof.



The conclusion to draw from this decision is that it is advisable to file comprehensive information about parallel proceedings when filing a request for suspension and also to stipulate why the request for revocation has not been filed earlier. Such information could possibly have saved the CTM application.

The next case is a revocation case, dealing with the fulfillment of the use requirement following the preliminary ruling in Case No C-149/11, 'ONEL'/OMEL', R 797/2011-1 , covering *inter alia* 'clothing' in Class 25.

'IPURI' was a clothing brand, used on labels of clothing in five shops in the city of Hamburg. Both instances were in agreement that the use requirement had not been fulfilled as the extent of use was not sufficient. The CTM proprietor had filed *inter alia* an extract from market research conducted by the SPIEGEL publishing house from 2001 (8 years prior to the application for revocation) in which the trade mark 'IPURI' was listed as a well-known mark and documentation for that the revocation applicant's action for cancellation against the parallel German trade mark 'IPURI' had been dismissed in relation to clothing.

The Board stated: 'As clothing is a mass-market product, sales figures are usually measured not in the hundreds but in the thousands, even in the upper price segment (paragraph 31). The distribution of such goods is also not normally limited to a few shops in one major European city. Although in some individual cases, such as in the case of the sale of special models of certain items of 'designer' clothing that are limited in number, in particular in the higher price category, the situation may be different. The statutory declarations do not contain any sufficiently specific indications that this might be the case. In particular, it does not emerge from these declarations that the items of clothing sold under the trade mark 'IPURI' were special models that were very limited in number (paragraphs 31-32).

As referred to above, the use requirement was considered fulfilled for the national registration in Germany in relation to 'IPURI', but not as a CTM by the Boards of Appeal.

Although the extent of use is discussed more than the territorial scope in the 'IPURI' case, 'ONEL'/OMEL' is referred to in the decision and may have had an influence on this decision.

It is my understanding of the ruling 'ONEL'/OMEL' that the threshold is not the same for a CTM as that of a national mark in relation to the territorial scope. In this connection I refer to paragraphs 40, 50 and 54 of the preliminary ruling. According to these paragraphs the basic rule seems to be that use in more than one country is required in relation to a CTM.

Another reflection I have is if the extent of use of a CTM may be less if the use has been cross-border. It is after all essential in this situation to have a CTM. As stated in 'OMEL'/ONEL', the territorial borders should be disregarded, while the territorial extent of use is included in all the relevant facts to be considered.

It also seems reasonable that the extent of use in order to be considered genuine may be lower in relation to a national mark than in relation to a CTM. In 'ONEL'/OMEL' there are different places stressed that the protection of trade marks is characterised within the European Union by the coexistence of several systems of protection, cf. for example paragraph 3(6), 26, 40 and 49. In the latter paragraph the Court is referring to Article 112(2)(a) CTMR pursuant to which it is possible, where the rights of the proprietor have been revoked on grounds of non-use, to convert a Community trade mark into a national trade mark application if, in the Member State for which conversion is requested, the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State.



Thus, it is important to note that the use requirement may be fulfilled in one of the member states, although not in relation to the CTM. This stipulation may of course to a certain extent regard the territorial scope as a more extensive territorial scope of use in a country may be anticipated in relation to a CTM than in relation to a national mark. However, it cannot mean use in more than one country in relation to a CTM as in such case the present regulation would be in conflict with the Joint Statement (now overruled by 'ONEL'/'OMEL') according to which the Council and the Commission considered that use which is genuine within the meaning of Article 15 in one country constitutes use in the Community. Therefore it is logical to assume that Article 112(2)(a) CTMR also relates to the extent of use as there is no reason why for example the nature and time of use should be evaluated in a different way in relation to a national registration compared to a CTM. I can add that there is no change of Article 112(2)(a) CTMR in the proposal for amending the CTMR.

The conclusion and advice must be that if you have any doubts about the extent and territorial scope of use being sufficient in relation to a CTM, it may be advisable to make sure that you have a national registration, at least in the most important market(s).

Finally, paragraph 48 of the preliminary ruling in the 'ONEL'/'OMEL' case may be quoted if you are not in agreement with the Guidelines of the 1<sup>st</sup> instance at OHIM:... 'it is to be noted that the OHIM Guidelines are not binding legal acts for the purpose of interpreting provisions of European Union law.' However, you are of course always welcome to refer to them, also at the Boards.

The final case is a case regarding the right to a person's name, Case No **R 2463/2011 2**. It is a ruling on an application for a declaration of invalidity against the CTM registration 'ELIO FIORUCCI', cf. Article 53(2)(a) CTMR (right to a name – Italian law).

The grounds for invalidity were that the trade mark consisted of the name of a person and that its use without his consent could be prohibited under Italian law. The invalidity applicant was Mr. Elio Fiorucci, who claimed to be a well-known Italian fashion designer. In the statement of grounds he referred to his friendship with Andy Warhol and his contact with many artists such as Brigitte Bardot, Franco Battiato, Madonna, etc.

Mr. Elio Fiorucci registered the first FIORUCCI trade mark in 1972 and then assigned it to the company Fiorucci S.p.A. After financial difficulties the latter company was assigned to the CTM proprietor. Several hundreds of trade marks were listed as forming part of the assignment. Still, there was only one that contained the patronymic ELIO FIORUCCI, and that was a registration in New Zealand, which was a device mark that corresponded to Mr. Elio Fiorucci's signature.

The case had come back from the Court of Justice for the Board to rule on the effect that any possible assignment of the rights to the trade mark 'ELIO FIORUCCI' by the cancellation applicant to the CTM proprietor might have as regards the validity of the CTM.

The Board found that no assignment of the right to register the trade mark 'ELIO FIORUCCI', either interpreted as 'assignment of the right to carry on registering it', or as assignment of the 'right exclusively to use the *de facto* trade mark 'ELIO FIORUCCI' had been proven. No use of such alleged *de facto* trade mark had been proven.

The application for a declaration of invalidity was allowed on the basis of Article 8(3) CPI (Italian IP Code) in combination with Article 53(2) CTMR.

This decision shows the importance of clearly defining in the agreement that the assignment of a company in relation to which the name of the assignor is important, covers the right to use the complete name of the assignor as well as parts thereof. In the field of design it is not uncommon for the designer at a later stage to want to start a new business and of course to use his own name in connection with it.



The decision 'ELIO FIORUCCI' is dated 22 April 2013 and may consequently still be appealed.

I hope that with this selection of decisions you have got a good taste of the 'spices' the Boards can deliver and are inspired to make a search in the database of the Boards the next time you have a complicated or unusual case:

[http://oami.europa.eu/search/legaldocs/la/EN\\_BOA\\_index.cfm](http://oami.europa.eu/search/legaldocs/la/EN_BOA_index.cfm)

Thank you for your attention!

<sup>1</sup> *This paper reflects merely the personal opinions of the author*