

ITMA review

The Journal of The Institute of Trade Mark Attorneys

Issue no. 372 January/February 2010

ITMA's 75th Anniversary celebrations, 24 November

Centrixx versus sensixx hinges on how Germans
pronounce fantasy words

Deere's green and yellow colour scheme survives
BCS challenge to registration

BoA re-examines functionality and visibility
for complex products



CONTENTS

ITMA business

Public relations: The penny has finally dropped	2
UK IPO – Trade Marks Directorate Organogram	4
Florida Attorney General halts PCT billing scam	4
Newly elected members, November 2009	5
News in brief: Vorsprung durch... a long legal battle	5

Features

ITMA 75th anniversary celebrations	6
ITMA Christmas lunch	8
ITMA northern Christmas dinner	12

Case comment

No respite for Clearwire as CFI finds mark descriptive	13
CTM for Cannabis is found too descriptive of beer	14
Budweiser – Budvar battle continues to ferment	15
Centrixx versus sensixx hinges on how Germans pronounce fantasy words	17
Accurate translation key to successful opposition	20
Gucci's might fails against self-represented Duccio	21
Deere's green and yellow colour scheme survives BCS challenge to registration	22
Design: BoA re-examines functionality and visibility for complex products	24
CFI finds SpagO beer no threat to mineral water	26

Spring Conference Guide:

London 2010

Adorably different: Dior's opposition to Mango mark fails to bear fruit at CFI	31
Similarity "in part" offset by overall impressions	32
Italian confectioner wins UK revocation appeal	34
Which proceedings take priority: does opposition trump revocation?	35
Superskin fails to make the grade as a trade mark	37
Copyright: Stormtrooper helmet "not a work of art"	38
Using Protected Geographical Indication as grounds for cancellation of CTM	40

Sun wins case over M-Tech grey market in disk drives	41
Red light for Esber appeal as Coloris shows prior use	44
Giordano: leather goods share a common aesthetic	45
CFI refuses Agile registration despite finding low level of similarity to Argyll's	47
Google's AdWords and search data demonstrate confusion over Boohoo	49

International

Five myths and realities of Greek trade mark practice	51
Pharma-marks in France: identifying generic drugs	52

Noticeboard

Joint Examination Board letter	54
News of members	55
2010/11 Oxford IP Diploma Course	55
Who's who in ITMA	55

And finally...

Lifetime Achievement Award	56
Forthcoming events 2010	56

The views expressed in the articles in the *Review* are personal to the authors and we make no representations nor warranties of any kind about the accuracy of the information contained in the articles.

Cover picture

As owners of the first trade mark registered in the United Kingdom, Bass kindly agreed to provide some refreshments for ITMA's 75th anniversary celebrations.

ITMA Review copy deadlines

Contributions to the *Review* must be received by the 12th of the month for publication in the following month's issue, including whenever possible high-resolution images of authors and relevant graphics. These are best sent as separate files rather than embedded in Word documents. Illustrations or photos often add interest and aid understanding of the issues covered in articles. Please email material to Kelly Robson, Editor, at kellyrobson@btinternet.com and Tania Clarke at tclarke@withersrogers.com



The Institute of Trade Mark Attorneys
Canterbury House
2-6 Sydenham Road
Croydon, Surrey CRO 9XE
Tel: 020 8686 2052
Fax: 020 8680 5723
Web: www.itma.org.uk

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PUBLIC RELATIONS

The penny has finally dropped!

Media watch

Have trade marks finally made it into media consciousness? I ask this because the following question appeared in the *Mail on Sunday's* end-of-year quiz:

24. *Who did McDonald's unsuccessfully sue for trademark infringement?*
- a) *A menswear store for selling macs in size 'big'*
 - b) *A Malaysian restaurant called McCurry*
 - c) *Boy-band Ladz for their R&B hit 'I'm Lovin' It'*
 - d) *Trevor McDonald*

OK, they spelt trade mark as one word but, at least, they did ask the right question and didn't mix trade marks with patents and copyright!

Also making the news before Christmas was the designation for Cornish sardines, granted Protected Food Name (PFN) status, which gained the attention of the BBC and some of the red-top newspapers. They are now grouped with Stilton cheese, West Country cheddar and Melton Mowbray pies, which all reportedly have PFN status together with the Isle of Man's Loaghton lamb, which I confess I have never heard of!

For our own efforts, the joint press release we issued with CIPA about the appointment of Ann Wright as Chief Executive of IPReg was picked up by *The Lawyer* and the Jaffe Legal News Service (JLNS), though we were less successful with our comments on the FIRECRAFT case. However, those attending the January evening

meeting will have been able to catch up on the latest developments on that. The final press release of the year announced that IPReg was operational with effect from 1 January 2010 and was immediately picked up by IP World and IPKat.

A final note under this heading goes to Marks and Clerk, who managed to get two of their trade mark attorneys quoted in the press on the LVMH eBay injunction. Pam Withers and Aidan Clarke were both quoted, so well done to their PR people.

Joint initiatives with the IPO

Chief Executive Keven Bader and Vice President Maggie Ramage had a video conference with Laurence Smith Higgins and Miles Rees of the Business Outreach Team of the IPO just before Christmas, at which several joint initiatives were discussed. Some of these initiatives are:

Branding Seminars

These seminars are the successors of the "What is the Key" and IP Awareness Seminars which have been running for several years now. The objectives are quite similar but they are being marketed as Branding Seminars, which should appeal and mean more to the general public than the term IP.

The first of these seminars will take place on 23 February at Haydock Park race course. ITMA is providing a speaker who will highlight the value added by using a trade mark attorney and how trade mark registration facilitates brand extension and international trade. The seminars are being supported by local Chambers of Commerce, Business Links and UK Trade and Invest, amongst others and will roll out across other regions over the next couple of years. There will be workshops and seminars in a morning session. We will be asking local trade mark attorneys to attend as and when we have more details. It is likely that similar events will be held focusing on patents where the IPO will be operating through CIPA.

IP Masterclasses

The first IP Masterclass is being held in Glasgow from 9 to 11 March. These courses are aimed at experienced business advisers who want to develop their skills and knowledge

when working with business on IP issues. The courses have been developed in conjunction with Coventry University and the British Library and are accredited by the University. They run over two and a half days and focus on how to conduct IP Health Checks (see IPO website for details) as well as all aspects of IP, including the role of trade mark attorneys and, again, how trade mark attorneys add value in the registration process.

ITMA is supporting the IP Masterclasses and will be providing speakers and offering help in preparing the section on the role of a trade mark attorney, primarily setting out the parameters of what business advisers should and should not do, and why they should not do certain things!

Cracking Ideas

Many of you will be aware that the Cracking Ideas exhibition has been running at the Science Museum during the last year. The intention now is to wheel it out throughout the UK beginning at the Science Centre in Glasgow and moving through North and South Wales before, presumably, returning to England

World Leaders International IP Awards

As reported in previous *Reviews*, ITMA sponsors the World Leaders International IP Awards. This year ITMA members were strongly represented in the winning categories. Congratulations go to ITMA Fellow Penny Nichols of D Young & Co, who walked away with the coveted Lifetime Achievement Award. Walker Morris won the EMEA – European/Middle East/Africa – category for Private Practice Trade Mark Excellence/Litigation. Apart from the litigation team, ITMA members of Walker Morris include Katy Cullen, Helen Thomas-Peter and Amanda Mallon who are all to be congratulated as well. We shall be looking to sponsor the Awards again in 2010 and hope that even more ITMA members' achievements will be acknowledged.

IP benefits

With the dawn of a new decade and the passing of the old, not to mention

banishing the New Year blues and the greyness of these winter months, the IP Benefits team have highlighted a few offers that may brighten your days:

- Eating out can be an expensive business. But now you - or your business - can dine out more often, and pay less, with a Gourmet Society Dining Card. The Gourmet Society has teamed up with over 3,000 leading restaurants across the country to offer some fantastic discounts. Enjoy 2-for-1 meals or 25% off your bill – including drinks!

However, if you're worried that gorging on gourmet foods is not a healthy way to start the New Year:

- mi health gives you access to the lowest corporate rates available at 2,200 UK and Ireland health clubs including most of the major health club chains, local leisure centres and independent gyms.

And if you just want to chill out:

- Save 10% on theatre breaks with Superbreak – this also includes discounts on events at the O2!

Terms and conditions apply. As a reminder, members can access the IP Benefits by entering the ITMA website members' area and clicking on Members Home (top of the list on the left hand side) and then click on the IP Benefits graphic.

Business Advice Open Days

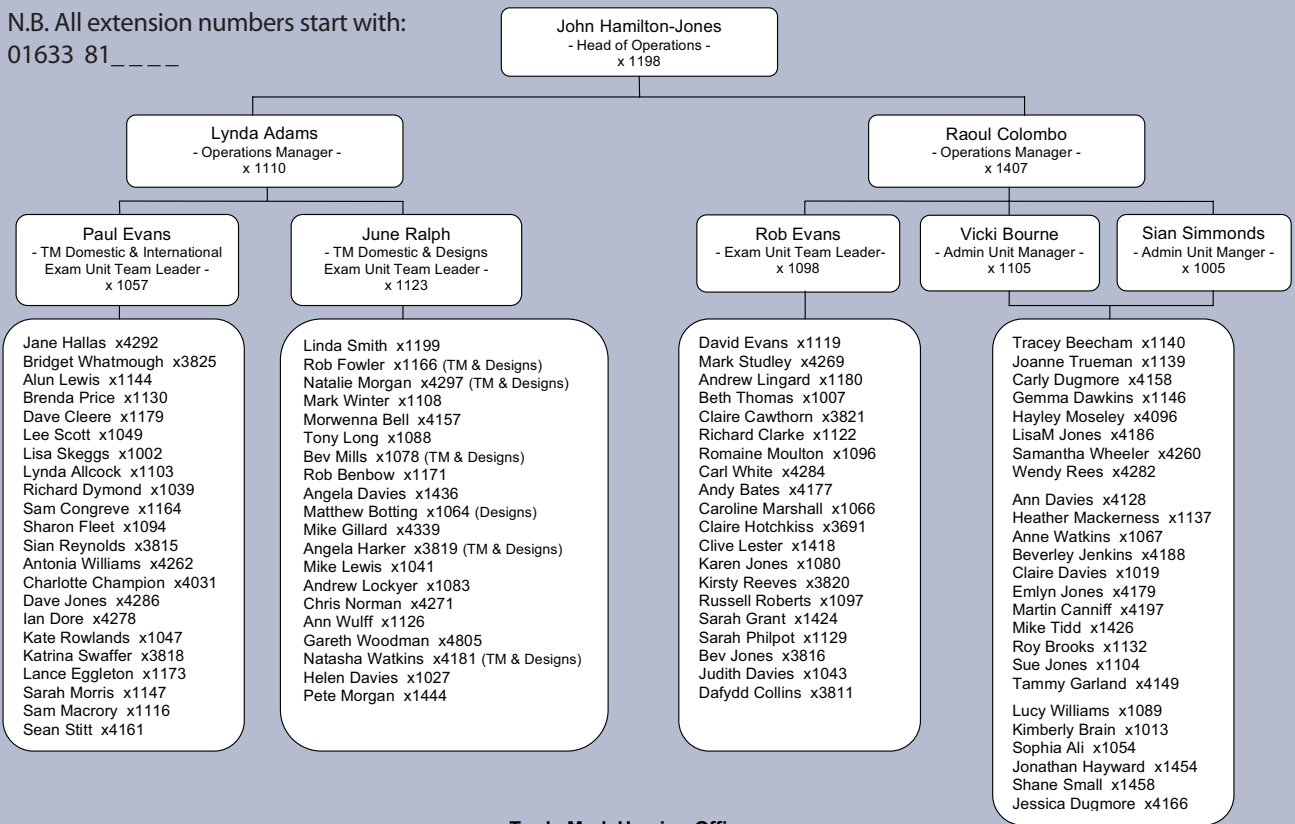
Thanks go to everyone who contributed to my pleas in the last Review for volunteers. I also have a belated thank you to make to Iain Croft of Franks & Co, who stepped in at the last minute to help me out in Barnsley in November. As for 2010, due to the splendid response, I only have three venues to fill – The Stadium of Light in Sunderland on 1 July, Fairfield Hall in Croydon on 29 September and a new event in Leeds on 13 October. I take help on a first-come, first-served basis and the only requirement is that at least one of the volunteers has to be fully qualified. Any responses to the usual address: ken.storey@btinternet.com, tel 020 8941 6079.

Ken Storey, PR Manager,
ken.storey@btinternet.com

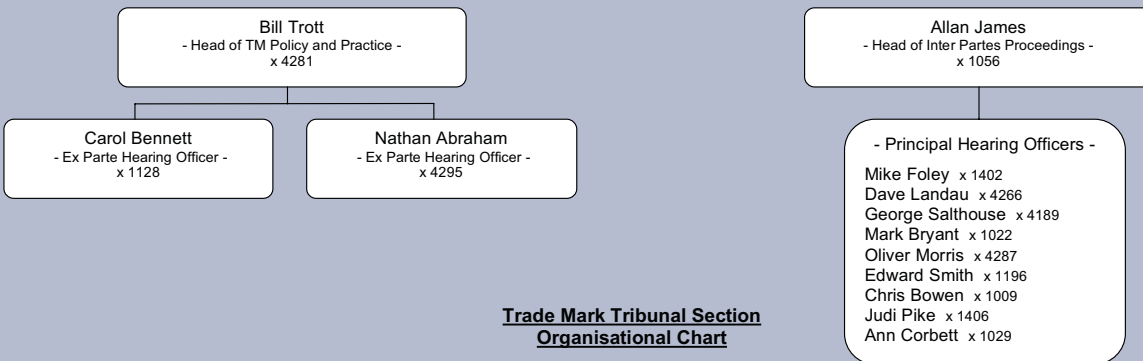
UK IPO – Trade Marks Directorate Organogram

Trade Mark Examination Organisational Chart

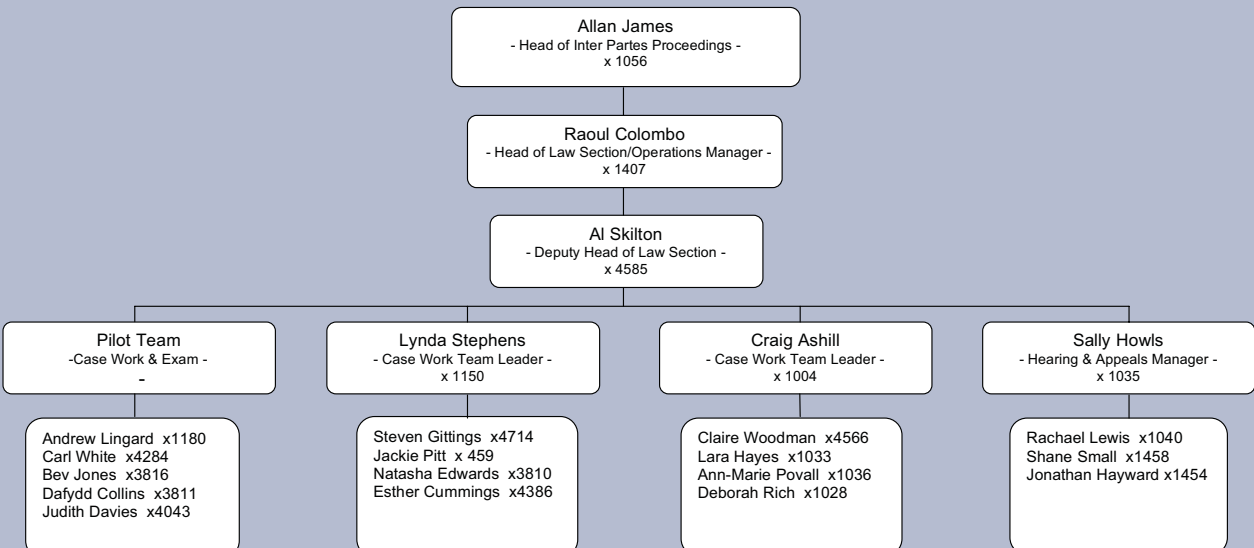
N.B. All extension numbers start with:
01633 81_____



Trade Mark Hearing Officers Organisational Chart



Trade Mark Tribunal Section Organisational Chart



Florida Attorney General halts PCT billing scam

A Florida-based company ("Federated Institute for Patent and Trademark Registry") was this month found to have violated the state's Deceptive and Unfair Trade Practices Act by sending out by mass mail misleading "invoices" to patent and trade mark applicants – including users of WIPO's Patent Cooperation Treaty (PCT) which facilitates the process of seeking international patent protection.

The offending company was requesting payment for a service which in fact had no value. WIPO was pleased to cooperate with the Florida authorities in this case. During the trial, a WIPO PCT expert provided testimony about the misleading nature of the invitations and the harm suffered by PCT applicants.

WIPO has consistently warned users of its international filing and registration services - which facilitate the process of protecting patents, trade marks and designs in multiple countries - about the existence of these deceptive practices.

In recent months, WIPO has witnessed a general rise in Internet scams involving various fraudulent schemes implying association with WIPO, including fake offers of employment at WIPO, training courses and e-mail prize awards. Many of these scams request detailed information and/or money, in connection with supposed

registration fees, hotel reservations, employment opportunities, prizes or awards. They sometimes carry the WIPO logo, a photograph of the WIPO Director General and originate from, or refer to, e-mail addresses that resemble those of WIPO or the United Nations.

Recipients are warned to exercise vigilance and not to send any money or any personal or professional information, including bank account details, in response to them. Any such cases should be reported to local law enforcement authorities for appropriate action and, when it relates to WIPO international filing and registration services, to the appropriate WIPO sector for its information and action. Recipients of mailings which make reference to offers of WIPO employment, etc., may also contact WIPO's Human Resources Management Department directly at +41 22 338 91 11 if there is any doubt about the authenticity of such requests.

Last week's judgment in Florida is a promising step toward curbing this fraudulent and deceptive practice.

For further information, please contact the Media Relations Section at WIPO:

Tel: (+41 22) - 338 81 61 or 338 95 47

Fax: (+41 22) - 338 82 80

E-mail: publicinf@wipo.int

NEWS IN BRIEF

Vorsprung durch... a long legal battle

30 years ago fledgling British advertising agency BBH was briefed to find a way to sell Audi cars to the British. On a visit to the Audi plant in Germany, an obscure but intriguing slogan was spotted.

John Hegarty from BBH seized on the phrase 'Vorsprung durch Technik' (roughly translatable as 'progress through technology')... and the rest, as they say, is history.

Although 'Vorsprung durch Technik' has been registered for use with vehicles and vehicle parts since 2001, the car manufacturer has struggled to widen this protection and only now – after a seven year battle ending at the European Court of Justice – has it extended its rights over the phrase to include clothes and games.

Audi has been trying since 2003 to register the trade mark but initially had suffered rejection as it "lacked distinctive character".

'Vorsprung durch Technik' now joins a select band of protected straplines which includes Kit Kat's "Have a Break", which secured the same status back in 2003.

Against all the odds, 'Vorsprung durch Technik' managed to implant itself into British popular culture and is today one of the most widely remembered advertising catchphrases of all time.

Full report in next month's issue.

Newly elected members, November 2009

Student

Miss A Arunasalam
Mrs E Merrett
Miss R Walker

Overseas

Mrs M Banerji
Ms E Lappa
Ms P Gelato-Rambelli
Miss P Tramountanelli

Affiliate

Ms P Botell
Mr H Ghandhi
Ms J Redman

Associate

Mrs SK Park

John Reddington, Tony Axe, Stephen Powell and Ian Tollett



Mike Knight (IPReg), Peter Lawrence (OHIM)



ITMA 75TH ANNIVERSARY CEL

Royal College of Surgeons, London (photographs by Kat Hannon)

Duncan Welch and Kate O'Rourke



John Wallace, Catherine Wolfe and Cheng Tan



Theresa Castle, Nellie Jackson, Sarah Dunstan



Gearoid Schutte, President of the Irish Association, and Gillian Deas, ITMA President



David Tatham OBE, John Caisley, Richard Ashmead



CELEBRATIONS 24 NOVEMBER 2009

Chris Lewis, Andrew Maison, Kay Jenkinson



Crowd from above



Mike Knight, Michael Heap, Ann Wright (IPReg)



What's a party without a goody bag?





Andi Much and friend

ITMA CHRISTMAS LUNCH

Royal Lancaster Hotel, London (photographs by Kat Hannon)

Ashvena Tirvassen and Keven Bader (ITMA CEO)



Natasha Glinski, Carin Burchell and Caroline Hayward



Philip Harris and Allan James (IPO)

FEATURES



James McHugh and Gillian Deas



Puravee Shah and Rafi Azim-Khan

..... 8 DECEMBER 2009



Michael Heap and Ann Wright (IPReg)



Robert White, Bob Boad and Michael Keog



Mark Foreman, Sarah Matheson, Ese Akpogheneta and Tom Priem





ITMA CHRISTMAS LUNCH... CO



David Castle, Carly Mansell and Sarah Jeffery



David Hickey and Joanne Green



Lianne Bulger, Florian Traub and Emilie Scheffer



Ryan Pixton and Gillian Deas



NTINUED.....8 DECEMBER 2009



David Evans, Maggie Ramage, Christopher Morcom QC



Joanne Grist and Gillian Deas



FEATURES

Paul Brandon, Lindsey Wrenn and James Love



Graham Johnson



ITMA NORTHERN CHRISTMAS DINNER

The Lowry Hotel, Manchester
10 December 2009

Photographs by Carin Burchell, Branded!

Keven Bader and Seamus Dougherty



Bruce Marsh



Seamus Dougherty, Lee Curtis and Rob Davey





No respite for Clearwire as CFI finds mark descriptive

Clearwire Corporation v OHIM, Court of First Instance, T-399/08, 19 November 2009. Another descriptive mark, CLEARWIFI, bites the dust as the Court of First Instance (CFI, now the General Court) in a short decision upheld a Board of Appeal decision to refuse the mark for telecommunication services. **Bex Heard** picks up the signal...

Clearwire Corporation (the applicant) sought protection for the mark CLEARWIFI in respect of “telecommunications services, namely, providing high-speed access to computer and communication networks, and the electronic transmission of voice, video and data via computer and communication networks” in Class 38.

The Board of Appeal upheld the Examiner’s decision (under Articles 7(1)(b) and (c)) to refuse the application on the basis that the mark CLEARWIFI will be understood, by individuals or businesses in the Community needing to access computer and communications networks such as the internet, as describing the purpose of the services concerned, that is to say, the offering of wireless connections, and the quality of those services, that is to say, free from disturbance.

CFI decision

The CFI agreed with the applicant that the Board of Appeal was wrong to say that the relevant public was ‘the broadest possible public in all member states’ without explaining that the services in question are intended for an English-speaking public or a public with a basic knowledge of English.

The CFI held that the word sign CLEARWIFI, which is composed of a noun (‘wifi’) and an adjective (‘clear’), is not unusual in its structure and complies with English rules of syntax or word composition.

The CFI held that “clear” meaning ‘free from disturbance’ denotes a quality of that connection and that “CLEARWIFI” will be perceived by the relevant public as designating wifi technology, which enables the wireless connection of computers and various items of electronic equipment, either with each other or to Internet access points, and which is resistant to external interference.

The CFI held that the relevant public will have no difficulty in making a link between the sign CLEARWIFI and a specific telecommunications service, namely internet access, and between that sign and one of its characteristics, namely, the fact that it is disturbance-free.

It was noted by the court that the relevant public is the general public (as well as computer specialists) and they will equate internet access via a wifi connection with high-speed access to that network. However, the services for which protection was sought relate not only to high-speed access to computer and

communications networks but also to the electronic transmission of voice, video and data via computer and communications networks, which do not necessarily involve high-speed access.

The CFI therefore confirmed that the fact that a word sign is descriptive in relation to only some of the goods or services within a category listed as such in the application for registration does not preclude that word sign being refused registration.

Comment

The CFI reiterated well-established case law; in particular, that there must be a sufficiently direct and specific link between the sign and the goods or services to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics. Further, a sign must be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned.

Bex Heard, *Simmons & Simmons*, rebecca-heard@simmons-simmons.com



John Coldham

CTM for Cannabis is found too descriptive of beer

Case T-234/06: Torresan v OHIM re CANNABIS, Court of First Instance; 19 November 2009, original language Italian. The CFI has upheld a decision of the Second Board of Appeal that the registered trade mark for CANNABIS should be annulled in classes 32 and 33 as it is descriptive of an ingredient or a possible ingredient of beer and wines. **John Coldham** reports...

On 12 February 1999 the applicant, Mr Torresan, filed an application for registration of a CTM for CANNABIS in classes 32 (beers), 33 (wine, spirits etc) and class 42 (providing of food and drink, etc). The trade mark was registered on 16 April 2003.

An intervener sought a declaration that the trade mark was invalid as regards goods in classes 32 and 33, and the Cancellation Division of OHIM declared it invalid on the basis that it was descriptive on 9 March 2005. The applicant sought annulment of that decision but on 29 June 2006 the Second Board of Appeal of OHIM dismissed the appeal. The case then went up to the CFI. The registration in relation to class 42 was not challenged.

The arguments of the applicant

Mr Torresan maintained to the CFI that the trade mark CANNABIS has distinctive character, given that it is a common name and a purely fanciful mark and has no connection, even indirect, with beer and beverages in general. In part, he relied on a Council Directive (88/388/EEC) relating to flavourings for use in foodstuffs, which said that cannabis should not be regarded as a foodstuff, but rather as a narcotic and a psychotropic which, according to Mr Torresan, precludes any possibility of lawful use in the Community context.

The product to which Mr Torresan affixes the trade mark is a flavoured

beer which only contains lawful and authorised raw materials. Therefore, he said that the relevant public would not establish a direct and specific relationship between the goods in respect of which the mark had been registered and the sign CANNABIS.

Mr Torresan said that the true position is that CANNABIS is an evocative word, intended to attract the consumer's attention and may give rise to the idea of "pleasure, distraction and relaxation". It is a "paradoxical and hyperbolic message" in the same way as other marks, such as OPIUM or COCA-COLA.

He also submitted that the reasonable consumer, a beer drinker, would not immediately think that he was buying a beverage that it contained (or is) cannabis — if in any doubt he'd check the ingredients. He said that there is no existing direct connection between beer and cannabis, and that no connection is reasonably likely to be made in the future (he suggested that OHIM's view that the prohibition on cannabis may be lifted in the near future was mere supposition).

Findings of the CFI

OHIM submitted that "cannabis" does not only refer to drugs and to certain therapeutic substances but also to "hemp", which can be lawfully used in the production of foodstuffs and beverages, and therefore it is necessary to determine whether the

word mark CANNABIS is descriptive of the goods for which it was registered.

Article 7(1)(c) of Regulation 40/94/EC (now replaced by 2009/207/EC) prohibits the registration as trade marks of signs and indications which may serve, in trade, "to designate the kind, quality, quantity, intended purpose, value, geographic origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service". Those descriptive signs are incapable of fulfilling the indication of origin function which forms an integral part of the trade mark.

The CFI said that settled case law indicates that a sign can be descriptive if there is a sufficiently direct and specific relationship between the sign and the goods or services such that the public immediately perceives, without further thought, a description of one of the characteristics of the goods or services in question.

The CFI's view was that the average consumer may perceive that the word CANNABIS is one of the ingredients of the goods. It seemed convinced that "those who purchase a beer bearing the trade mark CANNABIS will very probably do so because they are convinced that it contains cannabis and are attracted by the possibility of obtaining from the beverage the same, or at the very least similar, sensations as they obtain from the

consumption of cannabis in another form". They felt that it went "beyond the realm of suggestion and into the realm of description". The CFI's view that CANNABIS is descriptive of beers was bolstered by evidence provided by OHIM and the intervener which showed that "cannabis is habitually used in the manufacture of numerous foodstuffs, including beer and certain beverages" and that "some beers consisting of cannabis are currently present on the European foodstuffs market".

A further argument that found favour with the CFI was that it is not necessary that the signs and the indications composing the mark actually be in use at the time of the application in a way that is descriptive anyway – it is sufficient that they could be used for that purpose. For this reason, if cannabis were to be legalised at a later date, it could be used in a wide range of foodstuffs including beer, and at this point the mark would undoubtedly be descriptive.

The court disposed of the other arguments of the applicant, giving them fairly short shrift. It said that either the beverages at issue contain or may contain hemp and the mark CANNABIS is therefore descriptive, or they do not contain it and the mark CANNABIS may be regarded as deceptive if it gives rise to actual deceit or a sufficiently serious risk that the consumer will be deceived.

As a result, the applicant's appeal was refused, leaving the trade mark registered in class 42 only.

Comment

This seems a sensible decision, even if some of the factual findings of the court seem a little unlikely. If a trade mark could describe the goods or services it is registered for either now or in the future, it should not be registered for those goods. There is a certain responsibility of registries to attempt to "future-proof" their registers, so that the path is kept clear for those wishing to describe the products of the future even if such products are not sold at the moment.

John Coldham, *Wragge & Co LLP*,
john_coldham@wragge.com

Budweiser - Budvar battle continues to ferment...

Budějovický Budvar, Národní Podnik v Rudolph Ammersin GmbH, ECJ, Case C-478/07. The ECJ has recently delivered its second preliminary ruling in the latest episode of the 'Bud' beer saga, over ten years from the initial commencement of proceedings in the Austrian court. **Emma Blake** gets another round in.

By way of background to the dispute, Budějovický Budvar, Národní Podnik (Budvar) produces and markets beer, under the names Budějovický Budvar and Budweiser Budvar, for export to Austria, amongst other countries. Rudolf Ammersin GmbH (Ammersin) also markets a beer called American Bud in Austria, a beer which is produced by Anheuser-Busch Inc.

In 1976, Austria and the Czechoslovak Socialist Republic entered into a bilateral convention regarding the protection of indications of source and designations of origin in accordance with which the designation Bud was designated as a protected indication in relation to beer.

In July 1999 Budvar issued proceedings in the Austrian National Court to prevent Ammersin from using the name Bud or any confusingly similar designation in respect of beer products in Austria, on the basis that Ammersin's trade mark American Bud was similar to and likely to cause confusion with its trade marks, Budweiser, Budweiser Budvar and Bud. The use of the name American Bud for beer in any other state other than the Czech Republic was also contrary to the provisions of

the bilateral convention entered into in 1976.

The National Court in Austria initially granted an interim injunction in favour of Budvar, a decision which was upheld on appeal. The decision was then referred to the ECJ by the Commercial Court in Vienna.

The ECJ released its preliminary judgment in November 2003 (case C-216/01), holding that the regulations relating to the protection of geographical indications and designations of origin did not preclude the provisions of the 1976 bilateral convention which had been entered into between a member state and a non-member state and afforded protection to a simple and direct indication of the geographical source. Following this decision, Austria's National Court dismissed Budvar's action on the basis that the designation Bud was not an indication of provenance as the Czech public would not associate the designation, Bud with a particular place in the Czech Republic.

Budvar successfully appealed this decision and in November 2005 the Austrian Supreme Court held that the designation Bud was capable of informing a consumer that the

product bearing the designation came from a particular place, region or country.

The case was referred again to Austria's National Court, which dismissed Budvar's action on the grounds that the Czech consumers did not understand the designation Bud in connection with beer as an indication of provenance. The decision was successfully appealed on the basis that the consumer survey conducted by Ammersin did not represent a relevant group of the Czech public. The matter was referred back again to the National Court of Vienna who referred the matter to the ECJ for a second preliminary ruling.

Legislative background

The protection of geographical indications and designations of origin for agricultural products and foodstuffs is governed by Council Regulation (EC) 510/2006 of 20 March 2006, which superseded regulation (EC) Number 2081/92.

The 1992 regulation set out the procedure for registration of designations of origin and geographical indications which provided that member states were to notify the Commission of any geographical indications or designations of origin they wish to register within six months of the 1992 regulation coming into force. Member states were therefore responsible for registering geographical indications and designations of origin pending acceptance of the registration by the Commission.

Regulation Number 918/2004 (Accession Regulation) dealt with the accession of new member states, including the Czech Republic in 2004. The Accession Regulation provided that applications to protect existing national indications and designations were to be submitted to the Commission on or before 31 October 2004. An omission by the Czech authorities meant that the designation Bud was not one of the registrations applied for.

Referral to the ECJ

The Austrian National Court considered that a second ECJ ruling was necessary as there had been a number of factual and legal changes to the context of the dispute since the preliminary ruling in 2003, including the fact that the Czech Republic had now acceded to the EU.

Three questions were referred to the ECJ. The first related to the interpretation of the requirements set out in the ECJ's preliminary ruling as to how designations of origins were to be examined. Secondly, given that the Czech authorities failed to apply for protection of the designation Bud, had any national protection of the designation in the Czech Republic become void since its accession to the EU? The third question was as to whether the provisions of the 2006 Regulation and the 1992 Regulation were exhaustive upon the accession of a new member state, precluding any protection offered under the 1976 bilateral convention.

Ruling

On this occasion, the ECJ found that the question as to whether the designation Bud constituted a simple and indirect indication of geographical provenance was to be ascertained by the Austrian court in the light of the circumstances and perceptions prevailing in the Czech Republic. The Austrian court must therefore examine whether there was a link between the geographical designation and the product and, secondly, whether the designation was capable of informing the consumer that the product indication came from that particular region. It was also for the Austrian court to examine whether or not the designation Bud had at any time become generic in the Czech Republic.

The Austrian court must decide whether a consumer survey should be commissioned for the purpose of clarifying the factual circumstances and perceptions prevailing in the Czech Republic with respect to the designation. The parameters of such a survey should also be set by the Austrian court.

The ECJ held that the system for

the protection of geographical indications and designations of origin is a Community mechanism as the decision to register any designation is taken by the Commission upon submission of an application by the member state. Domestic registration procedures are therefore incorporated into the Community decisionmaking process and as such it is meaningless for individual member states to retain their own systems for the protection of designations of origin and geographical indications. Therefore, the protection offered under the 1992 Regulations and 2006 Regulations is exhaustive.

Most significantly for the parties, the ECJ held that the Community system of protection set out in the 2006 Regulation was exhaustive to the extent that it precluded the application of the bilateral agreement entered into in 1976. The Czech Republic had had the opportunity to register the designation Bud under the transitional procedures set out in the Accession Regulation and as they had failed to do so, they were precluded from protecting the designation.

This is an interesting ruling as the Austrian court now has to decide, whether the designation Bud is capable of being a geographical indication or designation of origin in the Czech Republic, based on survey evidence. The ruling also provides that one member state is to carry out a consumer survey in another member state in order to ascertain the perceptions of the consumer the other member state. There is no single methodology in the European Union relating to surveys and so this could be an interesting development.

The ruling clarifies that the Community system for the protection of geographical indications and designations of origin is exhaustive and that any protection offered under bilateral agreements between member states is no longer applicable. However, as to whether it will finally draw an end to the ongoing Bud saga remains to be seen.

Emma Blake, DLA Piper UK LLP,
emma.blake@dlapiper.com



Birgit Clark

Centrixx versus sensixx hinges on how Germans pronounce fantasy words

Royal Appliance International GmbH v OHIM; BSH Bosch und Siemens Hausgeräte GmbH, T-446/07 of 15 September 2009. The CFI decides that there is degree of visual and phonetic similarity between the marks Centrixx and sensixx and a likelihood of confusion. This review is based on the author's translation of the German version of this decision. **Birgit Clark** reports...

On 23 January 2003 Royal Appliance International GmbH (Royal) filed a Community trade mark application for the mark Centrixx covering various electrical surface cleaning appliances in class 7. On 9 August 2004, BSH Bosch und Siemens Hausgeräte GmbH (BSH) filed a notice of opposition against this application based on its earlier German word mark registration for sensixx in classes 7, 9 and 11, which, inter alia, covered various kitchen appliances, washing machines, dishwashers and vacuum cleaners in class 7. BSH's opposition was directed against all goods covered by the application and based on Articles 8(1)(a), (b) of Council Regulation (EC) No 40/94 (now 2007/2009) (CTM Regulation).

OHIM's Opposition Division decided in Royal's favour, holding that there were sufficient differences between both marks to exclude a likelihood of confusion despite the high degree of similarity/identity of the goods since the relevant public paid a higher level of attention at the point of purchase. On appeal by BSH the BoA reversed the decision and refused registration of the mark Centrixx. Royal based its appeal to the CFI solely on Article 8(1)(b) CTM Regulation claiming that the BoA had erred when finding that there was a likelihood of confusion between both marks.

Findings of the CFI

Relevant consumer

Given that the earlier mark was registered in Germany, the CFI held

that the average consumer was the average German consumer of the relevant goods, who was reasonably well informed, observant and circumspect but only rarely had the chance to make a direct comparison between the marks and thus had to place his trust on his imperfect recollection.

Royal had argued that the consumer's attention at the point of purchase was high since the relevant goods were "not just simple goods of everyday consumption". The CFI disagreed and followed the BoA's view that the relevant goods were aimed at a "broader public — all consumers". Household and kitchen appliances and their accessories, while not bought on a daily basis and enduring for many years, were nonetheless sold in a self-service stores and replaced when faulty or out of date.

The court emphasised that this was equally true for goods such as electric drills, carpet steam cleaners as covered by the Centrixx mark, even though these goods were not used in every household on a daily basis. Royal's contention that the relevant goods encompassed expensive, high quality products was deemed irrelevant since the specification as filed did not include any limitation that the goods were meant for "commercial cleaning purposes". The CFI dismissed the argument that consumers would pay a higher level of attention at the point of purchase. The fact that consumers would seek advice and compare prices before purchasing was true for most

consumer goods and as such not relevant.

The CFI also disagreed with Royal's argument that the goods had to be regarded as dissimilar since the earlier mark had only been used for steam irons, whereas Royal's mark was solely used for vacuum cleaners. In reference to the ECJ's decision in ARTHUR ET FELICIE (T-346/04), the court stressed that the comparison of the goods must relate to those covered by the trade marks in question and not to those for which the marks have been used unless, following an application made under Article 43(2),(3) CTM Regulation, it was apparent that the earlier mark had only been used in relation for a part of goods for which it is registered. In that case, for the purposes of consideration of the opposition, the earlier mark was deemed registered only for that part of those goods. Moreover, where the goods covered by the earlier mark included goods covered by the trade mark application, those goods had to be considered to be identical (see Fifties (T-104/01) and CRISTAL CASTELLBLANCH (T-29/04) cases).

Given that all goods covered by the Centrixx mark were electrical cleaning products for household purposes, the CFI found that the BoA had correctly assumed an identity of goods.

Similarity of marks

Visual similarity The CFI disagreed with the Royal's argument that both marks only shared a low degree of a

The CFI found that both marks were “undoubtedly fantasy words” that did not have a specific meaning in the German language or any language that was spoken by the relevant public. While it was true that a consumer, perceiving a verbal sign, would break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him, this did not apply in this case.

visual similarity due to their different beginnings and middle parts and due to the “more unsettled typeface” of the Centrixx mark.

Referring to its precedents in the VITAL FIT (T-111/06) and Mozart (T-304/06) cases, the CFI stressed that the BoA could not be required to provide an account that followed exhaustively all lines of reasoning articulated by the parties before them. The fact that the BoA had only assumed an average degree of visual similarity did not mean that it had ignored distinguishing elements between both marks; otherwise it would have assumed a high degree of similarity or identity.

The CFI found that it was irrelevant that the mark Centrixx started with a capital C. The protection conveyed by a word mark registration extended to the protected word alone, whereas particular graphic or design aspects did not form part of the protection conferred (Faber (T-211/03), PharmaCheck (T-296/07)). Both marks had a similar length, the same number of syllables, included the same vocals and letters in a similar order and shared the same ending (-ixx). In light of these similarities, it was not enough that the initial letter C of the Centrixx mark was unusual in the German language or that both marks had a different middle part. Overall, both marks were of average visual similarity.

Aural similarity The CFI also disagreed with Royal’s contention that the BoA had erroneously assumed that average German consumer would pronounce the mark Centrixx according to English pronunciation rules (sentríxx) and had thus ignored German pronunciation rules (ts’entríxx) as well as the fact that the suffix -ixx would not be acoustically perceived.

The judges emphasised that Royal itself had not ruled out that English pronunciation rules had to be considered. The BoA had merely stated that a pronunciation similar to the English word ‘centre’ was more plausible than following German pronunciation rules because word had migrated into German language. However, the BoA’s decision had not indicated that the relevant public

would make a mental connection between Centrixx and the English word ‘centre’.

The CFI found that the BoA had been right to assume that the German consumer would pronounce Centrixx following English pronunciation rules as ‘sentríks’ which rendered the mark phonetically closer to the German pronunciation of the sensíxx mark (‘sensíks’). Due to the emphasis on the double consonant xx, the ending -ixx would be pronounced and not simply be swallowed.

Conceptual similarity Royal had argued that the marks were conceptually different and that the average German consumer would associate both marks with existing German terms. Centrixx would be seen as relating to German words zentrisch, zentral, or zentrifugal, whereas sensíxx would be associated with the German terms sensibel or Sensor.

The CFI found that both marks were “undoubtedly fantasy words” that did not have a specific meaning in the German language or any language that was spoken by the relevant public. While it was true that that a consumer, perceiving a verbal sign, would break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (see VITAKRAFT and RESPICUR cases), this did not apply in this case. Neither the suffix -ixx nor the elements -tríxx or -síxx, sen(s)(i)- or “en(t)(r)(i) had any meaning in the German language. The earlier mark Centrixx clearly did not have any clear conceptual meaning. Moreover, the relevant German public would not have the necessary specific knowledge that would allow them without a further thought to connect the term sen- with the German terms Sensor or sensible, simply because the goods covered could allow a sensitive (sensible) treatment of goods.

Consequently, the CFI found that BoA had been correct when deciding that the marks did not have any obvious meaning and that the relevant public would not associate the marks with any existing words.

Likelihood of confusion

Finally, the CFI turned to the question of likelihood of confusion and stressed that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It was appropriate to examine the objective conditions under which the marks may be present on the market. The extent of the similarity or difference between the signs would depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question were usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs would as a general rule be more important. If, however, the product covered was primarily sold orally, greater weight would usually be attributed to any aural similarity between the signs, (see NLSPORT, NLJEANS, NLACTIVE and NLCollection (T-117/03 to T-119/03, T-171/03, BAUHOW (T-106/06) cases). Conceptual differences between the marks could counteract to a large extent the visual and aural similarities if at least one of the marks had, from the point of view of the relevant public, a clear and specific meaning so that the public was capable of grasping it immediately.

Applying these principles, the CFI disagreed with Royal's argument that the visual and phonetic similarities between those marks were only of relative importance. Even if the goods were bought in large self-serve outlets after a "visual inspection", then there could still be a discussion about their characteristics. Moreover, such goods were usually not directly available on the shelves but had to be retrieved from storage before paying for them. This typically included a discussion where the trade mark would be mentioned.

The court addressed the Royal's argument that the mark sensixx only had a low degree of distinctiveness. Referring to its precedent in the FLEXI AIR (T-112/03) case, the court found

that although the distinctive character of the earlier mark had to be taken into account when assessing the likelihood of confusion, it was only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character and a trade mark applied for which was not a complete reproduction of it, there could be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods covered.

Given the findings above relating to the identity of the goods, the aural and visual similarity between both marks and that the relevant public would not pay a high level of attention at the point of purchase, a likelihood of confusion could not be excluded, despite the fact that the sensixx mark was only of low distinctiveness rather than average distinctiveness as held by the BoA.

Comment

The CFI's decision impresses with a very detailed comparison between the goods and marks in question. However, being a native German speaker, the author is somewhat surprised by some of the CFI's views. Even after years of having lived and worked in an English-speaking country, the author would still pronounce Centrixx according to German pronunciation rules as would about two thirds of the average German consumers she has (non-representatively) consulted on this question. While clearly a non-German word, it appears equally plausible that the average consumer would see it as fantasy word that was inspired by Latin or Classical Greek. Furthermore, Trixx is a common and playful misspelling of the German term Tricks, whereas Cent could be seen as relating to the European currency, as in Euro and Cent. Similarly unexpected is the CFI's view that the relevant German public would not have the "necessary specific knowledge" that would allow them to connect the term sen- with the German words Sensor or sensibel. Would the average English consumer not be able to relate sen- to the equivalent English terms sensor or sensitive?

Birgit Clark, *Boult Wade Tennant*,
bclark@boulton.com

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Anne Wong

Accurate translation key to successful opposition

Bayer Healthcare LLC v OHIM, CFI Case T-277/08, 11 November 2009. CFI confirms decision rejecting the application to register CITRACAL for dietary supplements in class 5 due to the likelihood of confusion with the earlier mark CICATRAL covering similar goods. **Anne Wong** reports...

Mission Pharmacal Co, predecessor-in-title of Bayer Healthcare LLC, filed a CTM application for CITRACAL for dietary supplements.

It was opposed by Laboratorios Diviser-Aquilea, SL, predecessor-in-title of Uriach-Aquilea OTC SL, on the basis of earlier Spanish registration for CICATRAL covering chemical products and specialities (class 1)/ pharmaceutical products and specialities (class 5). Opposition relied on Article 8(1)(a) and (b) of Council Regulation (EC) No 40/94 of 20 December 1993 (CTMR) on the basis of a likelihood of confusion with the Spanish registration.

The opponent was requested to furnish proof of use of its mark in accordance with Article 43(2) and (3) of CTMR.

Decisions of the Opposition Division and Board of Appeal (BoA)

The Opposition Division upheld the opposition on the basis of Article 8(1)(b). It held that use of the earlier mark was demonstrated for "healing pomades (cicatrissant)" and that there was a likelihood of confusion.

The applicant appealed. The BoA held that evidence of genuine use of the earlier mark had been provided in relation to "healing salves[s]", that there was a high degree of similarity between the marks and the goods were similar, concluding that there was a likelihood of confusion.

The appeal was dismissed.

Decision of the CFI

Bayer appealed to the CFI raising two pleas in law. The first was that the BoA carried out an incorrect assessment of the evidence of use of the earlier mark, giving an inadequate translation of the goods. The second plea alleged infringement of Article 8(1)(b).

First plea

The opponent submitted an instruction leaflet in Spanish describing the goods as "pomade cicatrizante" or "pomade". The opponent translated these terms as "healing pomade". Bayer argued that "pomade" means "perfumed ointment for the hair, originally made from apples" and that the BoA wrongly summarised the Opposition Division's decision as establishing use in relation to "healing salve[s]".

The CFI held that the BoA was correct to compare the goods applied for and "healing salves" because the contents of the instruction leaflet in English made it possible to identify the goods, their properties and directions for use.

The first plea was rejected.

Second plea

The applicant argued that "perfumed ointment for the hair, originally made from apples" and "dietary supplements" are not similar.

The CFI noted that the goods are non-prescription pharmaceutical products, are of the same nature and have the same function or intended purpose, namely the treatment of human health problems. The CFI maintained that the goods could be used by the same consumers, come from the same source and share the same distribution channels. The CFI dismissed as insufficient the differences in the way that the goods are administered and the therapeutic indications.

The CFI concluded that the marks have a high degree of visual and phonetic similarity and the goods are similar such that there is a likelihood of confusion.

The appeal was dismissed.

Comment

This decision shows the importance of using an accurate translation to describe goods. In this case, the opponent was fortunate that there was sufficient translated wording in the evidence for the BoA to focus on descriptions other than "healing pomade". Had the opponent relied solely on other documentation such as invoices or price lists, the description of the products would have been more brief and the outcome could well have been different.

Anne Wong, MW Trade Marks, anne@mwtrademarks.com

Gucci's might fails against self-represented Duccio

...the 'D' and 'O' in DUCCIO visually distinguished the marks and there was therefore not a high level of similarity. A comparison of the phonetics revealed that the 'O' in DUCCIO was enough to distinguish the marks because of its hard pronunciation. The result may have been different if the opposed mark was, for example, DUCCIES. The marks were considered similar phonetically but only to a low level.

Guccio Gucci SpA v Ishtiaq Hussein Esq, Mr Mark Bryant for the Registrar, the Comptroller General, 10 November 2009. David Kemp reports...

Hearing officer Bryant could not accept that there was a likelihood of confusion, or a sufficient link, between GUCCI and DUCCIO and rejected Guccio Gucci SpA's (Gucci) opposition in its entirety. The self-represented applicant prevailed against Gucci in successfully defending the opposition.

Gucci opposed on the basis of ss5(2)(b) and 5(3) Trade Marks Act 1994 (TMA). They relied on registrations for the word mark GUCCI in classes 9 and 25 for s5(2)(b) and 14 and 25 for s5(3) TMA.

5(2)(b)

The applicant applied for a broad range of goods in classes 9, 14 and 25 and identity and similarity were found for the majority of goods in class 9 and the whole of class 25. The applicant's goods in class 14 were considered not to be similar to or at the very least complement Gucci's goods in classes 9 or 25.

When comparing GUCCI with DUCCIO, Mr Bryant stated that the "D" and "O" in DUCCIO visually distinguished the marks and there was therefore not a high level of similarity. A comparison of the phonetics revealed that the "O" in DUCCIO was enough to distinguish the marks because of its hard pronunciation. The result may have been different if the opposed mark was, for example, DUCCIES. The marks were considered similar phonetically but only to a low level. Further, Mr Bryant did not agree with Gucci's submissions that the marks were conceptually similar because they were both Italian names. Rather, he emphasised that individual's names serve to differentiate individuals and the public are used to distinguishing people's names even where there are small differences.

Taking this comparison into account, imperfect recollection by the consumer and also that GUCCI was highly distinctive in the UK Mr Bryant nonetheless ruled that there was no confusion under s5(2)(b) TMA, both where the marks themselves and also the source of the goods were concerned.

5(3)

Mr Bryant was happy that Gucci's evidence showed a strong reputation for luxury goods. The problem would lie in establishing whether the public would consider GUCCI and DUCCIO sufficiently similar for a link to be established, this being one limb of similarity devised in *Adidas Salomon AG v Fitnessworld Trading Ltd* [2004] ETMR 10 and later confirmed by the ECJ in *Intel Corporation Inc v CPM United Kingdom Ltd (INTEL) C-252/07*. However, it was decided that DUCCIO would not bring to mind GUCCI so as to establish the necessary link and accordingly Gucci failed.

Comment

The decision seems to be the correct one. It reflects the reality in the marketplace in that consumers of high-end goods are unlikely to confuse a GUCCI garment with DUCCIO branded clothing. Indeed, the applicant claimed and supported with evidence use of DUCCIO clothing and other goods since 2001 and pointed out that there had been no confusion during this time. It also shows that s5(3) cannot be used to extend a party's rights against marks that are clearly too dissimilar, no matter how much of a reputation the earlier mark enjoys.

At the time of writing, it is not clear whether Gucci has appealed the decision. Judging by previous UKIPO appeals, opposition and revocation actions between the parties it may not end here as both seem to be at loggerheads.

David Kemp, MW Trade Marks, david@mwtrademarks.com

Deere's green and yellow colour scheme survives BCS challenge to registration



Alexandra Ellis

BCS SpA v OHIM, Intervener - Deere & Company, Case T-137/08, Court of First Instance, 28 October 2009. The CFI have dismissed an action against a Board of Appeal decision which rejected an application for invalidity against the Deere green and yellow colour registration. The colours were designated using the Munsell system. The arrangement was described as being "green for the vehicle body and yellow for the wheels", as shown in a picture attached to the application. The registration was secured by the intervener, Deere & Company (Deere), in respect of "attached, pushed or self-propelled agricultural and forestry machines" in class 7, and "self-propelled agricultural and forestry machines, in particular farm tractors, small tractors, land tractors and trailers" in class 12. **Alexandra Ellis** reports...

Declaration of invalidity

BCS SpA (BCS) filed for a declaration of invalidity in respect of all the goods protected, on the basis of Article 51(1)(a) in conjunction with Article 7(1)(b) of Regulation No 40/94 (now Article 52(1)(a) and Article 7(1)(b) of Regulation 207/2009) and of Article 52(1)(c) in conjunction with Article 8(4) thereof (now Article 53(1)(c) and Article 8(4) of Regulation 207/2009).

In particular, BCS maintained that the disputed mark was devoid of any distinctive character on the day when the application was filed, and that there had been insufficient proof of distinctive character acquired through use for the purposes of Article 7(3).

BCS also claimed that they had an earlier Italian non-registered trade mark, also consisting of the colours green and yellow and used in relation to tractors and trailers, which conferred on BCS the right to prohibit the use of the disputed mark.

OHIM's Cancellation Division dismissed the action, allowing the registration to stand. BCS appealed the decision. However OHIM's Second Board of Appeal dismissed the appeal in its entirety.

Appeal to the Court of First Instance

BCS then asked the CFI to annul the contested decision. In support of this action, BCS relied on three pleas, alleging infringement of Article 7(3), Article 8(4) and Article 73 of Regulation No 40/94 (now Article 75 of Regulation No 207/2009).

The first plea

In relation to Article 7(3), BCS argued several lines of attack.

Broadly speaking, BCS criticised both the evidence and documentation supplied by Deere in support of its acquired distinctiveness claim, as well as the Board of Appeal's assessment of the same.

BCS believed that Deere's submissions did not cover the whole of the European Union or at least a substantial part thereof, and that the probative value of the evidence was weak. The CFI confirmed that although it must be proved that the disputed mark had acquired distinctive character throughout the Community, the same types of evidence do not have to be provided in respect of each member state. Therefore opinion polls and surveys can be supplemented by

documentary evidence in other member states.

With regard to the particular goods in question, the CFI concluded that they were industrial goods, the price of which is high and the purchase of which is preceded by a process during which the consumer inquires attentively about the range on offer by comparing and inspecting the various competing models. In view of this, it was not necessary for the mark to achieve a large market share for it to be possible to conclude that the relevant consumers had retained it in their minds. It was sufficient that the disputed mark be proved to have a strong and long-lasting presence on the market.

Similarly, whilst the CFI noted that it was true that the disputed mark was used and promoted in conjunction with the word mark JOHN DEERE, and that Deere's advertising expenditure on the EU was presented as a whole and not individually for each country, this did not mean that Deere had not proved to the required legal standard that they had used the combination of colours green and yellow as a trade mark, and that the market penetration had been deep and long-lasting.

BCS also questioned the relevance and probative value of the statements of various associations which had been used in support of the acquired distinctiveness claim. However, the CFI indicated that the fact that these statements were signed in 2000 did not mean that they were devoid of evidential value for the purposes of assessing acquired distinctiveness at the date of application in 1996. Furthermore, Article 51(2) of Regulation No 40/94 (now Article 52(2) of Regulation No 207/2009) prohibits the registration of the disputed mark from being declared invalid if it is proved that it acquired a distinctive character before the date of the application for the declaration of invalidity, which was in 2004.

In addition, the CFI stated that whilst Deere may have coordinated the statements, this did not, in itself, cast doubt on their content and evidential value. In the absence of evidence to the contrary, it must be assumed that each association signed of its own free will and takes responsibility for the content. The CFI also confirmed that it is not at all apparent from case law that only statements made by associations representing consumers must be taken into account. Statements from associations of manufacturers and / or distributors can also be relevant.

Finally, BCS argued that the Board of Appeal had erred in law in not assessing whether the disputed mark had been used as a trade mark. The CFI noted that it is true that not every use of a sign, especially the combination of two colours, necessarily constitutes use as a trade mark. Nevertheless, in the CFI's view, the fact that professional associations stated that the colours green and yellow referred to agricultural machines manufactured by Deere, and the fact that Deere had been using the same combination of colours on its machines consistently in the EU for a considerable time prior to 1996, was sufficient to conclude that the use of the combination of the colours green and yellow was not purely stylistic, but enabled the relevant public to identify the commercial origin of the goods bearing that combination of colours.

The CFI concluded that BCS's first plea could not be upheld.

The second and third pleas

Regarding the second and third pleas, alleging infringement of Article 8(4) and Article 73, BCS submitted that the criteria applied in the contested decision with regard to its Italian non-registered mark covering the colours green and yellow were stricter than those applied in the examination of the application for registration of the disputed mark, although the circumstances in which the rights in the mark were acquired were essentially the same in both cases. Consequently it was alleged that the Board of Appeal infringed not only Article 8(4) but also Article 73 inasmuch as its reasoning was insufficient and contradictory.

The CFI quickly rejected the plea on the basis of Article 73. In short, BCS did not claim that it was not in a position to ascertain the reasons why the Board of Appeal adopted the decision, which is a condition of a breach of the obligation laid down in Article 73. Instead, it submitted that the Board of Appeal assessed comparable forms of evidence in different ways and that it consequently drew divergent conclusions from similar evidence. However, such an approach, even if proved, cannot constitute infringement of Article 73, in the CFI's view.

As regards the alleged infringement of Article 8(4), BCS claimed that the Board of Appeal concluded that it had not acquired a de facto trade mark right on the Italian market, even though the colours of its sign were identical to those of the disputed mark, the evidence adduced was of the same, if not greater, value, and the conditions for the acquisition of a secondary meaning were the same.

Whilst the CFI concluded that the standard of proof in the two circumstances was equivalent, the evidence submitted by BCS was, on the whole, considered of less evidential value than that submitted by Deere. Firstly, BCS ceased, from at least 1973 to 1982, to use the combination of the colours green and yellow on its goods in Italy. Although

it would have been possible for BCS to acquire a non-registered right between 1983 and 1996, it did not do so, according to the CFI. The CFI also noted that the findings in the Board of Appeal's decision make it apparent that BCS did not use the combination of the colours green and yellow in a consistent and uniform manner. On the contrary, it used a number of shades of green and yellow as well as a combination of the colours green and white.

According to the CFI, it followed that the suspension of use of the combination of the colours green and yellow as a mark, and the varying use of those colours were liable to prevent the public from systematically associating BCS with a specific combination of colours.

The CFI also concluded that the Board of Appeal could not be criticised for having found that the market survey submitted by BCS was not persuasive. The Board of Appeal was entitled to point out flaws in the questions which meant that in the CFI's opinion, it could not be ascertained whether the participants recognised the BCS's goods solely as a results of their colours, and not as a result of their shape or other factors. In addition, the respondent's had been asked to recreate from memory their perception of the marks ten years previously. The Board of Appeal was right to conclude that this meant that the evidential value of BCS's survey was less than that of Deere's.

The CFI therefore rejected the second and third pleas, and dismissed the action.

Conclusion

This decision appears logical and well reasoned. The CFI provides helpful additional guidance on the nature and standard of evidence expected for proving acquired distinctiveness. Brand owners are also once again reminded of the importance of securing trade mark registrations. Whilst BCS's use gave them a ground for attack, Deere's registration ensured that they were in a strong, and ultimately the stronger, position.

Alexandra Ellis, Boulton Wade Tennant, aellis@boulton.com

Design: BoA re-examines functionality and visibility for complex products

Lindner Recyclingtech GmbH v Fransson Verkstader AB: Cases T 690/2007-3. On 22 October 2009, the Third Board of Appeal of OHIM departed from the recent interpretation of the functionality exclusion for RCDs and held the RCD in question to be invalid on these grounds. However, at the same time it held that the RCD satisfied the requirements regarding visibility of complex products according to its interpretation of the provision. **Yasmine Hashim** recycles the story...

Facts



An Austrian recycling company, Lindner, filed invalidity proceedings against Swedish company, Fransson RCD 253778-0001 registered for the “chaff cutters” shown above.

The RCD concerned a chaff cutter or step rotor used in large industrial machines for shredding paper, cardboard, plastic, glass and other materials used in recycling business. The chaff cutter or step rotor consisted of a metal cylinder, with knives attached configured in a V shape which rotated cutting the material fed into the shredder.

First instance proceedings

The invalidity proceedings were bought under Article 52 and Article 25(1)(b) of Council Regulation (EC) No. 6/2002 on Community Designs (the “CDR”) on the grounds the RCD lacked novelty and individual character under Articles 4 to 6 CDR and because it was solely dictated by its technical function within the meaning of Article 8(1) CDR. The application for invalidity was rejected and the RCD held valid by the Invalidity Division of OHIM.

BoA decision

Visibility

It was accepted that the RCD concerned a component part of a complex product, and that its validity depended upon whether it remained visible during normal use of the complex product in which it was incorporated, in this case a large industrial shredding machine under Article 4(2)(a) CDR.

Although the matter was not absolutely free from doubt, the BoA

found that the evidence filed suggested that on balance the step rotor would at least to limited degree be visible in normal use – the visibility being limited because it was largely covered much of the time by the material that was being shredded and because when the rotor was spinning there was only a limited extent to which the features could be perceived.



Yasmine Hashim

Nevertheless, the BoA concluded that the requirements of Article 4(2)(a) CDR were satisfied. In its view, the provision did not require the component part to be clearly visible in its entirety at every moment of use. It was sufficient if the whole of the component could be seen some of the time in such a way that all its essential features could be apprehended.

Functionality exclusion

The BoA overturned the first instance decision and declared the RCD invalid on the grounds it was solely dictated by its technical function under Article 8(1)(b) CDR.

In coming to its conclusion, the BoA rejected the “multiplicity-of-forms” interpretation of Article 8(1)(b) CDR (and the corresponding provision in

Article 7(1)(b) of Council Directive 98/71 EC and the equivalent national law provisions in EU member states) which states that the provision only applies if the technical function cannot be achieved by any other configuration. This interpretation had been suggested by the Advocate General Ruiz Jarobo in his obiter dictum comment in *Philips v Remington* (Case C-299/99), paragraph 34) and also adopted by the UK Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285 (concerning expander suitcases), and the Spanish Courts decision in *Silverlit Toys Manufactory Ltd v Ditro Ocio* 2000 SL and others. It was also formerly followed by the French courts.

Instead, the BoA adopted the wider interpretation as laid down by the UK House of Lords (now the Supreme Court) in *Amp v Utilux* (1971) FR 572, in which the HL held that the phrase “dictated by” meant attributable to or caused or promoted by, and therefore if the feature(s) of shape were adopted only because of functional requirements then they were solely dictated by its technical function.

The BoA thought the “multiplicity-of-forms” interpretation was flawed because it would only apply in highly exceptional circumstances. This would frustrate the very purpose of Article 8(1) CDR, namely to prevent design law from being used to achieve monopolies over technical solutions which can only be justified if they satisfy the more restrictive provisions of patent/utility model law. If the “multiplicity-of-forms” theory was correct it would mean that if designer has a choice between two or more configurations, both could be protected as a registered design held by the same person resulting in no

one else being able to manufacture a competing product capable of performing the same technical function.

The BoA highlighted that good design involved two fundamental elements: functionality and eye appeal. It had no objection in principle to granting design protection to industrial products whose overall appearance was determined largely, but not exclusively, by functional considerations. It was only where aesthetic considerations were completely irrelevant that design protection should be denied.

The test was an objective one: it was not necessary to determine what actually went on in the designer's mind when the design was being developed. Instead, whether a product's appearance was chosen for purely functional considerations must be assessed from the standpoint of a reasonable observer.

The BoA confirmed that this did not mean that there was any requirement for aesthetic merit, artistic creativity or eye appeal (as expressly mentioned in the 10th recital in the preamble to the CDR and the 14th recital in the preamble to the Designs Directive.)

Franssons argument that certain alternative configurations could achieve the same technical function was redundant given the BoA's interpretation of the provision. The BoA also took the view that the affidavit evidence filed by Fransson that the V-shape configuration of the knives was chosen for mainly aesthetic reasons was scarcely credible in the case of the piece of industrial equipment in question whose visibility was limited. Moreover, the fact that a technical drawback had been accepted for the sake of another technical advantage did not mean that the design had not been solely dictated by the technical function of the product, but strongly implied that nothing but the technical function of the product was relevant to the development of the design. On the facts the BoA held that the five essential features of the design were solely dictated by the technical function of the step rotor and

declared the RCD invalid under Article 25(1)(b) and Article 8(1) CDR.

Lack of novelty and individual character

Although it was not strictly necessary, the BoA also went on to consider Lindner's remaining submissions that the RCD lacked novelty and individual character based on two items of prior art submitted in the first instance proceedings. However on the facts it was clear that the RCD was clearly not identical to – and made a different overall impression on the informed user over – the admissible prior art, bearing in mind the limited freedom of the designer in developing the design due to technical constraints. Further, no publishing date had been proven in respect of one of the pieces of the prior art. Accordingly, Lindner's submissions under these grounds failed.

Comments

Although only BoA level, this decision is an important one, as it departs from the recent line of authority on the functionality exclusion under European design law of the Advocate General, UK and Spanish Courts. Although there has been some criticism and uneasiness with the multiplicity of forms test in some quarters, the fact that the BoA has applied the test as laid down by the HL in the 1971 case of *Amp-Utilux* does not put an end to the controversy over the correct interpretation of the exclusion. This is particularly so given that the wording and context of the relevant provisions of the Registered Designs Act 1949 in 1971, whilst similar, does not entirely coincide with the wording of the EU design legislation post-harmonisation and given the HL case was determined in accordance with English rules of statutory interpretation.

The interpretation of Article 4(2)(a) regarding the visibility of complex products is pragmatic and helpful given there has been little guidance on the meaning of this provision at BoA level so far. It will be interesting to see if this decision is followed by the CFI/ECJ, the UK and other EU member states.

Yasmine Hashim, *Cleveland*,
y.hashim@cleveland-ip.com

The BoA also took the view that the affidavit evidence filed by Fransson that the V-shape configuration of the knives was chosen for mainly aesthetic reasons was scarcely credible in the case of the piece of industrial equipment in question whose visibility was limited. Moreover, the fact that a technical drawback had been accepted for the sake of another technical advantage did not mean that the design had not been solely dictated by the technical function of the product, but strongly implied that nothing but the technical function of the product was relevant to the development of the design.



Stephanie Burns

CFI finds SpagO beer no threat to mineral water

Spa Monopole, compagnie fermière de Spa SA/NV v OHIM & De Francesco Import GmbH. Case T-438/07 - Court of First Instance, (before ME Martins Ribeiro, S Papasavvas and N Wahl), 12 November 2009, on appeal from the Second Board of Appeal of OHIM. Stephanie Burns reports...

On 27 July 2001, De Francesco Import (the applicant) sought to register the word SpagO for "alcoholic beverages (except beers)" in class 33. On 4 June 2002, the application was opposed by Spa Monopole (the opponent) which is the owner of the earlier Benelux Registration SPA, which covers "mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages" in class 32, based on Articles 8(1)(b) and 8(5) of the Regulation no 207/2009. The Opposition Division upheld the decision on the basis that the marks were sufficiently similar in that they shared the identical element "spa" and on the basis that the mark could be detrimental to the reputation of the earlier mark due to the harmful effects of alcohol on health.

The applicant appealed to the Second Board of Appeal at OHIM which annulled the decision of the Opposition Division, on the basis that the Article 8(1)(b) argument must fail as there was only a low degree of similarity between the marks and the goods. Furthermore, although the opponent had demonstrated a reputation in Benelux, as there was only a low degree of similarity between the marks, this was not sufficient for the relevant section of the public to establish a link between the marks. Nor would the use of the mark be detrimental to the repute of the earlier mark.

Appeal to the CFI

The disgruntled opponent then appealed to the CFI, alleging infringement of Article 8(5) CTMR, on the basis that the board had erred in finding that the similarity of the signs

at issue was not sufficient for the average consumer to establish a link between the signs and in concluding that use of the contested mark for alcoholic beverages was not detrimental to the repute of the earlier mark for mineral water.

In its analysis, the court considered that the application of Article 8(5) was subject to the following conditions: that the marks at issue are identical or similar, that the earlier mark has a reputation and finally that there is a risk that use without due cause of the trade mark applied for would take unfair advantage of, or cause detriment to, the distinctive character or repute of the earlier mark. As discussed in *Intel*, these types of damage are a consequence of a degree of similarity between the marks, by virtue of which the relevant public makes a connection or establishes a link between the marks, even if they do not confuse them, and the existence of a link should be considered globally.

The court considered that the board was correct in determining that the relevant public was the general public in the Benelux countries and that the earlier mark enjoys a reputation in relation to mineral waters in these countries.

Furthermore, the court agreed with the board's finding that the visual and phonetic differences between the marks brought about by the presence of the "go" element of the applicant's mark was sufficient to conclude that there was a low degree of similarity which was insufficient for the relevant consumer to establish a link between the signs.

Whilst the consumer generally pays more attention to the start of words, this is not always the case (*Trek Bicycle v OHIM* and *Audi ALL TREK T-158/05*). The relevant public, as the signs are short, would consider the marks as a whole and so it is unlikely that the average consumer would break the contested mark down into two sections, "spa" and "go". Finally, the applicant's mark has no conceptual meaning, whereas the opponent's mark refers to the location of Spa in Belgium, famous for its mineral waters and thermal baths.

When considering the nature of the goods, alcoholic drinks can be distinguished from mineral waters and non-alcoholic drinks by virtue of their alcohol content. Furthermore, the price of alcoholic beverages is typically much higher than that of non-alcoholic beverages, and they are bought and indeed marketed for different purposes. The fact that they may be bought together or consumed in the same place in a complementary fashion did not affect this finding.

As such, it is held that the mark SpagO would not be perceived by the average consumer in the Benelux countries as referring to the mineral waters marketed under the opponent's mark SPA, but rather as an invented word with no particular meaning, and given that one of the criteria required for the application of Article 8(5) could not be fulfilled, the court determined that it would be unnecessary to examine whether the types of damage referred to in the third condition of that provision would occur.

Stephanie Burns, *Withers & Rogers*, sburns@withersrogers.com

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LONDON

24 - 26 MARCH 2010



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PROGRAMME

WEDNESDAY 24 MARCH

14.00 - 16.00	Registration/Exhibition opens in Palm Court Conference Desk Open
16.00 - 16.10	Chairman's Introduction Annual General Meeting of the Institute of Trade Mark Attorneys - All welcome
Followed by	Open meeting of the Institute of Trade Mark Attorneys
17.00	Meeting closes
19.00 - 20.00	Welcome Cocktail Reception in 'Homage Restaurant'
20.00 - 23.00	Welcome dinner in the elegant Palm Court restaurant at the Waldorf - Dining in a grand style

THURSDAY 25 MARCH

08.30	Exhibition open in Palm Court
09.15 - 09.20	Conference Introduction - Gillian Deas - ITMA President/Chairman
09.20 - 09.40	Keynote Speaker 'Trade Marks - The UK in Europe'
09.40 - 10.20	IPO Update UK IPO Speaker
10.20 - 11.00	OHIM Update Vincert O'Reilly - Director of the Department for Industrial Property Policy, OHIM, Alicante, Spain
11.00 - 11.40	Tea & Coffee served in Exhibition Area
11.40 - 12.20	Filing Priorities - an in-house perspective Sarah Lambeth - BP plc, London, UK
12.20 - 13.00	Prosecution Problems Eric Ramage - Alexander Ramage Associates, Woking, UK
13.00 - 14.20	Served Lunch in Adelphi Suite 3
14.20 - 15.00	Focus on UK/OHIM Opposition Procedures, Similarities & Differences Sean Cummings - Keltie, London, UK
15.00 - 15.40	Marks with reputation and what is needed to prove it - The state of the law after the ECJ decisions. Roman Cholij - Cam Trade Marks, Cambridge, UK
15.40 - 16.10	Tea & Coffee served in Exhibition Area
16.10 - 16.50	Updates on LOCOG Legislation LOCOG Representative
17.00	Meeting closes
18.45	Coaches Depart Waldorf for London Aquarium
19.00	Cocktail reception with the 'Sharks' at the London Aquarium
19.45 - Midnight	Dinner in 'The Deep' - at The Aquarium - A unique opportunity to experience this fantastic venue as you've never seen it before. Come dine with the fish and dance the night away, exclusively for the ITMA Spring Conference.

FRIDAY 26 MARCH

08.30	Conference Desk open in Palm Court
09.15 - 09.20	Introduction - Conference Chairman
09.20 - 10.00	Unregistered Rights and their use in oppositions Kate Szell - Venner Shipley LLP, London, UK
10.00 - 10.40	Bad Faith - What it is and does it exist in other countries? John Groom - Groom Wilkes & Wright LLP, Shillington, UK
10.40 - 11.20	Tea & Coffee served in Palm Court
11.20 - 12.00	Infringement - Can you defend yourself? Mary Bagnall - Mayer Brown International LLP, London, UK
12.00 - 12.40	Anti-Counterfeiting in Europe - an in-house view Richard Heath - Unilever, London, UK
12.40 - 12.45	Closing remarks

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SPRING CONFERENCE GUIDE

SPRING CONFERENCE GUIDE

LONDON 2010



In anticipation of the conference at the Waldorf Hotel, Aldwych, we have some information on the hotel and surrounding area.

The Waldorf Hotel

The Conference hotel is on Aldwych and is part of the Hilton chain of hotels. The Waldorf Hilton Hotel underwent a £22M upgrade in 2004 and all of the bedrooms were revamped and upgraded. The hotel was famous in the 1920s for its "Tango Tea Dances" and this tradition has now been reintroduced. Scrumptious afternoon teas are served in the Palm Court which is a spectacular room. The hotel also has a well equipped gym and pool. The Waldorf Salad was not named after this hotel but after the hotel of the same name in New York.

Restaurants

Axis

One Aldwych, No 1 Aldwych
www.onealdwych.com
tel +44 (0)207 300 0300

Pre-theatre dinner menus available. Stylish restaurant. and part of the One Aldwych Hotel.

The Admiralty

Somerset House, Strand
www.somerset-house.org.uk
tel +44 (0)207 845 4646

Overlooking the river and part of Somerset House art gallery. Impressive setting and excellent food.

Orso

27 Wellington Street
www.orsorestaurant.co.uk
tel +44 (0)207 240 5269

Italian restaurant in basement. Walls are covered with photographs of movie stars. Traditional, well executed Italian dishes and a good range of Italian wine. Pre-theatre dinners available.

Simpson's-in-the-Strand

www.simpsons-in-the-strand.com
tel +44 (0)207 836 9112

Excellent traditional British cooking.

Rules

35 Maiden Lane
www.rules.co.uk
tel +44 (0)207 836 5314

Traditional British food in attractive wood-panelled rooms.

Bars

One Aldwych

No 1 Aldwych
www.onealdwych.com
tel +44 (0)207 300 0300

Stylish bar with over-sized armchairs and excellent range of cocktails.

Cafe des Amis

11 - 14 Hanover Place
www.cafedesamis.co.uk
tel +44 (0)207 379 3444

Bar in the basement with restaurant on the ground floor. Good range of French wines and cheese plates.

El Vino

47 Fleet Street, London, EC4Y 1BJ
www.elvino.co.uk
tel +44 (0)871 3327588

Traditional watering hole for lawyers.

The Old Cheshire Cheese

145 Fleet Street EC4A 2BU
tel +44 (0)871 917 0007

Atmospheric and historical pub with traditional ales.

Seven Stars

53 Carey Street, WC2A 2J
tel +44 (0)207 242 8521

Small pub situated behind the law courts and favoured drinking tavern for the judiciary and barristers.

Plays and operas

National Theatre

Southbank
www.nationaltheatre.org.uk
tel +44 (0) 207 452 3000

Three theatres south of the river over Waterloo Bridge.

Royal Festival Hall

Southbank Centre
www.southbankcentre.co.uk
tel +44 (0) 207 960 4200

Concert hall and stylish bar and restaurant (Skylon).

The Royal Opera House

Covent Garden
www.roh.org.uk
tel +44 (0) 207 304 4000

Champagne bar on the ground floor and restaurant overlooking the bar on the first floor.

Museums and galleries

Somerset House

Strand
www.somerset-house.org.uk
tel +44 (0)207 845 4646

A Neoclassical palace which stands between the bustle of The Strand and the sweep of the river, occupies the same site as the original Somerset House, an

imposing mansion built in 1547 by Edward Seymour, 'Protector Somerset' to the Tudor King Edward VI. Now home to the world-renowned permanent collections and special exhibitions of The Courtauld Gallery and the new Embankment Galleries.

British Museum

Great Russell Street
www.britishmuseum.org.uk
tel +44 (0)207 323 8000

Founded in 1753 showing the works of man from prehistoric to modern times with collections drawn from the whole world. Famous objects include the Rosetta Stone, sculptures from the Parthenon, the Sutton Hoo and Mildenhall treasures and the Portland Vase. There is also a programme of special exhibitions and daily gallery tours, talks and guided tours.

Tate Modern

Bankside, SE1
www.tate.org.uk
+44 (0)207 887 8888

Modern and contemporary art from around the world is housed in the former Bankside Power Station on the South side of the Thames. The awe-inspiring Turbine Hall runs the length of the entire building and you can see amazing work for free by artists such as Cézanne, Bonnard, Matisse, Picasso, Rothko, Dalí, Pollock, Warhol and Bourgeois.

London Transport Museum

Covent Garden Piazza, London, WC2E 7BB
www.ltmuseum.co.uk
tel +44 (0)20 7565 7298

The history of transport in London.

Guided walks

www.walks.com

Interesting guided London walks - especially "The Jack the Ripper walk". Each walk lasts two hours and there's no need to pre-book.

Thames boat trips

www.thamescruises.com
tel +44 (0) 7928 9009

www.londonribvoyages.com

tel +44 (0) 7928 8933
Speed boat trips along the Thames.

www.londonducktours.co.uk

+44 (0) 7928 3132
An alternative to the usual boat trips using refurbished World War II amphibious vehicles.



Nadia Hussein

Christian Dior V OHIM: The relevance of reputation in the determination of trade mark similarity. Parfums Christian Dior v OHIM, Case T-308/08, 15 September 2009, Court of First Instance (decision not yet available in English). Parfums Christian Dior takes its appeal to the Court of First Instance after the Opposition Division and the Board of Appeal both dismiss its opposition to the registration of 'MANGO adorably'. **Nadia Hussein** delivers the juice...

Adorably different: Dior's opposition to Mango mark fails to bear fruit at CFI

On 16 November 2004, Consolidated Artists requested registration of the stylised word mark "MANGO adorably" as a Community trade mark in respect of various goods in class 3. Parfums Christian Dior (PCD) opposed the registration under Council Regulation 40/94, Articles 8(1)(b) and 8(5) in view of their international rights in the words 'ADIORABLE' and 'J'ADORE' for goods in class 3. The Opposition Division rejected this opposition on the basis that under both legal grounds the trade marks were not sufficiently similar. On 23 May 2008 the Board of Appeal dismissed PCD's appeal against that decision causing them to appeal to the Court of First Instance (CFI).

Relevant law

Article 8(1)(b) provides that "Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered: if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark."

Article 8(5) provides that "Upon

opposition by the proprietor of an earlier trade mark [...], the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier mark is registered, where [...] the trade mark has a reputation [...] and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

MANGO
adorably

The trade mark for which registration was requested

Legal issues: Article 8(1)(b)

The CFI considered that a 'risk of confusion' within the meaning of Article 8(1)(b) amounts to a risk that the public might believe that the products in question originate from the same, or an economically linked, source. It noted further that two trade marks are deemed similar when, from the point of view of the relevant public, some degree of visual, phonetic and/or conceptual equality exists between them. It highlighted, however, that ultimately the finding

of a risk of confusion must be founded on the resulting overall impression, having taken into account any dominant and distinctive elements of the trade marks.

In its analysis of visual, phonetic and conceptual similarities the CFI agreed with the Board of Appeal that the first, more dominant element of the trade mark, namely the word 'MANGO' written in bold, capitalised and positioned above the word 'adorably', served to create an overall impression that was sufficiently dissimilar from PCD's earlier rights so as to exclude a risk of confusion under Article 8(1)(b).

It found further that this conclusion was not affected by the argument, made on behalf of PCD, that the Board of Appeal had not placed enough emphasis on the distinctive character of its trade mark 'ADIORABLE' or the reputation of its trade mark 'J'ADORE' in its assessment of similarity.

In addressing this argument, the CFI accepted that a risk of confusion may arise where only a faint degree of similarity is established but the distinctive character and reputation of the earlier trade mark is strong and factored into the assessment. However, it went on to distinguish that situation from the situation before it, in which it felt that similarity had not, first, been

established independently of such considerations.

Legal issues: Article 8(5)

In relation to 8(5) the Board of Appeal had found that given its finding under Article 8(1)(b) that the trade marks in question were not similar, the application under Article 8(5) could not succeed. PCD argued before the CFI that this was based on the wrong legal reasoning; that the application of Article 8(5) did not depend on a finding of similarity between the marks within the meaning of Article 8(1)(b). Under Article 8(5), the public need only make a connection between the two trade marks and need not confuse them. In light of the reputation and distinctive character of PCD's trade marks, the Board of Appeal had been wrong not to consider the risks that use of the trade mark applied for would take unfair advantage of or be detrimental to their trade marks.

The CFI disagreed and held that the Board of Appeal had been correct in its reasoning. A degree of similarity needed to be established before questions of reputation could come into play. It found that given its finding that the trade marks were not similar, questions of the reputation or distinctive character of the earlier trade marks need not be considered.

Court's conclusion

The CFI held that under both legal grounds the trade marks concerned were not sufficiently similar and the appeal was dismissed.

Comment

This case is a useful reminder that whilst the courts will take into account the reputation of an earlier trade mark to determine the likelihood of confusion, it will do so only from the moment that the trade marks have been established as similar, even if only to a small degree. Questions of a trade mark's reputation or distinctive character under Article 8 will only be relevant where a similarity has been established independently from them and not as a relevant factor in establishing that similarity.

Nadia Hussein, Bird & Bird LLP,
nadia.hussein@twobirds.com

Similarity "in part" offset by overall impressions



Caroline Friend

CureVac GmbH v OHIM – Qiagen GmbH, T-80-08. On 28 October 2009, the EC Court of First Instance (CFI) upheld the decision of OHIM's First Board of Appeal in the case of CureVac GmbH v Qiagen GmbH (R 1219/2006-1). It was held that there was no confusion between the earlier registered mark RNaive and the opposed mark RNAiFect. The court disagreed with each of the applicant's arguments

regarding the visual, phonetic and conceptual similarities between the marks and held that the different overall impression of the marks offset the "in part" identical nature of the goods, for which the trade marks had been registered. **Caroline Friend** reports...

Background

On 1 August 2003, Qiagen GmbH filed an application for the registration of the word mark RNAiFect, in respect of goods in classes 1, 5 and 9. On 17 December 2004, CureVac GmbH filed a notice of opposition against the application, based on their prior registration of the word mark RNaive. This was based on the grounds that there was a likelihood of confusion within the meaning of Article 8(1)(b) of Council Regulation (EC) No 40/94 (now Article 8(1)(b) of Regulation No 2-7/2009). The RNaive mark was registered in respect of classes 1 and 5 for goods in relation to chemicals used in industry and science, and pharmaceuticals and veterinary preparations. The applicant sought an order to annul the contested decision of OHIM's First Board of Appeal.

CureVac's arguments

The applicant relied on Article 8(1)(b) of Regulation No 40/94 which states that the trademark should not be registered if there exists a likelihood of confusion, on the part of the public, due to its identity or similarity to an earlier trade mark and the goods

covered by the trade mark. As such the court analysed the similarities between the marks themselves and the goods for which they were registered.

The applicant argued that the goods were in fact identical to each other, because the goods of the applicant encompassed those of Qiagen GmbH.

In terms of the marks themselves the applicant emphasised that the court must conduct a global assessment of the likelihood of confusion between the marks. The applicant argued that the marks as a whole were similar on the following visual, phonetic and conceptual levels:

- 1) Visually the beginning of each word was identical as they both contained the common component letters RNA in upper case. Most other letters were formatted in lower case. Furthermore, whilst the end of the words were not identical, four of the five letters were the same despite being in a different order.
- 2) Phonetically the marks were "extremely similar".
- 3) Conceptually the signs were

similar because “Active”, containing the German word “aktiv”, is synonymous for “effective” in German and therefore has the same meaning as “iFect”.

Findings of the court

Comparison of the goods

The court disagreed with the applicant’s argument that the goods for which the marks were registered were in fact identical. The CFI upheld the original findings of the First Board of Appeal that if one party’s goods encompass the others, they would be “in part identical and in part similar”. Overall this meant that the goods might be considered as “highly similar, but cannot for that reason be considered to be identical.”

Comparison of the mark

The court agreed that a global assessment of a mark would require analysis of the visual, phonetic and conceptual nature of the marks. The court recognised the need to look at the marks as a whole and not limit the analysis to the last five letters of each mark. Accordingly the court conducted a detailed analysis of each of the mark, including the “rna” letters, noting the similarities and differences between the two.

Nevertheless the court highlighted that in determining the overall impression of the marks, it should particularly bear in mind their distinctive and dominant components. The court agreed with the Board of First Appeal that the letters ‘rna’ were weakly distinctive and so accordingly a consumer’s attention would be drawn to the end of each of the words. (T-292/01 Philips-Van Heuson v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)

[2003] ECR II-4335). The court placed little weight on the similarities in the case of the letters, highlighting that such similarities were offset by the differences in the positioning of the last five letters of the mark.

Addressing the applicant’s second argument, regarding the phonetic similarities, the court acknowledged that it was possible to pronounce the word marks in different ways. For example doubling the “a” vowel of the earlier registered mark to be pronounced “r-n-a-active” instead of “r-n-active”, as it is spelt. Nevertheless the court held that on any likely pronunciation of the two words, the marks could not be said to be phonetically similar.

In studying the conceptual similarities between the two marks the court recognised that the relevant public, being largely pharmacists and reasonably well-informed end users, were likely to understand that the common first three letters related to the abbreviation for ribonucleic acid, or at least to a chemical compound of some kind. However the court held that the second half of each word did have a different meaning which compensated for the conceptual similarity in the first three letters. The court considered the applicant’s argument that the German expression for active is synonymous with the translated English expression for effective. However it was held that the deconstruction of the words required too many links in the chain in order for the relevant public to assume that any association existed between the marks.

The court therefore confirmed that there was little similarity between of the visual, phonetic and conceptual nature of the two marks.

Likelihood of confusion

Whilst the court recognised that the consumer normally attaches more importance to the beginning of a word, the court also made reference to the case T-202/04 Madaus v OHIM – Optima Healthcare (ECHINAID) [2006] ECR II-111, which held that a consumer is less likely to consider a descriptive or weakly distinctive component of a word to be the dominant element of the mark. The common “rna” component had already been found to be at the very most of limited distinctive character, even to a consumer who did not know the exact meaning of the abbreviation. The CFI therefore agreed that the endings of the words were in this case the “dominant elements which would attract the attention of consumers”.

As a result the court held that the two signs gave a different overall impression, and any similarities between the goods for which the marks were registered, were offset by the differences between the marks. Consequently the court held that the two that the marks would not lead to confusion on the part of the relevant public.

Comment

The CFI were careful to demonstrate that a global analysis of the entirety of the marks was required in order to determine the likelihood of confusion. However, the court was also willing to split the marks into separate elements and give greater weight to the part that was considered to be dominant. The case illustrates that the court will not place importance on any element that it considers to be descriptive or weakly distinctive.

Caroline Friend, Bird & Bird LLP,
caroline.friend@twobirds.com

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Geoff Weller

Italian confectioner wins UK revocation appeal

In the matter of trade mark Registration No 1317269 in the name of Pasticceria E Confetteria Sant Ambroeus SRL and the matter of Application No 82932 for revocation thereof by G&D Restaurant Associates Limited, appeal to the Appointed Person, Anna Carboni, 5 November 2009. Italian company Pasticceria e Confetteria Sant Ambroeus SRL (Ambroeus) was the proprietor of a UK registration for the stylised representation of the words SANT AMBROEUS covering confectionary and other goods in class 30. G&D Restaurant Associates Limited (G&D) applied to revoke this registration on the basis of non-use under s46(1)(b) of the Trade Mark Act 1994. The hearing officer found for G&D – his finding being in essence that whilst on the facts there was some use of the mark in the UK it was not sufficient to constitute genuine use – and revoked the registration in full. Sant Ambroeus appealed to the Appointed Person. **Geoff Weller** reports...

Pleas

Ambroeus' two pleas were that the hearing officer had (1) in discounting much of the evidence of use, too readily accepted criticism of the evidence in the absence of conflicting evidence or cross examination and (2) in respect of the remaining undiscounted evidence misapplied the legal authorities on what is "genuine use" of a trade mark.

The evidence in question

At first instance Ambroeus had submitted (along with their counterstatement) two witness statements. One, by their in house lawyer, contained statements as to the use of the mark in the UK on the goods as registered and gave figures for turnover and advertising. The volume of sales of goods under the mark for the five-year period was stated as €17,000. The amount expended on publicity was stated as €2,000. Exhibited to this statement were a number of invoices for sales to companies based in London, copies of brochures depicting packaging, a publicity brochure in English and Italian and extracts from an Italian language magazine showing adverts

for the proprietor (but not the mark itself). The second witness statement, by Ambroeus' trade mark attorney, attested that the Italian language magazine was available from certain sources in the UK. G&D filed no evidence in response.

The assessment of the evidence

At first instance the hearing officer found that the only piece of evidence of use that should be given weight was one of the invoices (which he then found to be de minimis and therefore not genuine use). In considering the first plea Ms Carboni found that the hearing officer had made errors in his assessment.

Ms Carboni began her assessment with a review of the guidance on proving use in revocation proceedings and the approach to witness evidence set out in the EXTREME Trade Mark [2008] case which led to the UKIPO Tribunal Practice Notice 5/2007. This in essence warns parties against inviting the hearing officer to disbelieve the factual evidence, which is otherwise not obviously incredible, without first giving the witness a chance to respond to the criticism either

through written observations in advance or by cross examination at the hearing.

At first instance hearing G&D had criticised the evidence given in Ambroeus' lawyer's witness statement, including hypothesising that the invoices addressed to London firms were actually for goods or services provided to those parties in Italy not in the UK. Ms Carboni looked at the witness statements and the exhibits and held that on the face of things these facts given as they were by an appropriate individual in a witness statement containing a statement of truth whilst less than ideal in some elements of important detail did not contain anything inherently incredible and so should not have been discounted without something more either evidence from the G&D or a cross examination to address the criticisms. As such in respect of the witness statement and all the exhibits except one (the Italian adverts in Italian magazines which did not actually contain the trade mark in question), Ms Carboni found the hearing officer had made a material error in excluding them from the assessment of evidence of genuine use.

Genuine use

In her decision Ms Carboni summarised the settled case law authorities on what is and how to assess genuine use. In particular she looked the European Court case law of ANSUL and LA MER and the UK Court of Appeal judgments in those same cases.

In addressing the second plea she held that the hearing officer had not misapplied the case law on genuine use in his finding.

However she concluded that on the basis of all the evidence she now considered acceptable, taken together, there was genuine use of the mark in the UK in the relevant period. She stated that although the relevant market (the food and drink market in the UK) is very large, there are small traders within it, and the collective evidence did support the case that Ambroeus' use was real and commercial use aimed at creating market share whereby the mark would be understood by consumers as a badge of origin. The amount of use was small, but not *de minimis* or token.

Ms Carboni held that genuine use had not be shown on the whole of the specification and that a few terms, mainly ingredient terms rather than terms for products made from those ingredients) would need to be cut out. She noted that Ambroeus did not argue for these to be maintained and that they did not appear to be core to the dispute between the parties.

As such whilst she ordered the registration be partially revoked, she held in favour of Ambroeus on costs.

Comment

This decision contains a useful summary of settled European Court and UK case law in relation to "genuine use". It also serves as a useful reminder to practitioners of the need to carefully consider whether to challenge evidence of use submitted in revocation proceedings, the proper method for doing so and the risks in not doing so.

Geoff Weller, IPULSE,
geoff@ipulseip.com



James Rowlands

Stella Kunststofftechnik GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) and Stella Pack SA (Intervener), European Court of Justice, EU General Court (formerly the Court of First Instance), Case T-27/09. The EU General Court confirms that revocation proceedings will not be stayed pending the outcome of opposition proceedings relying on the mark the subject of the revocation proceedings. **James Rowlands** reports...

Which proceedings take priority: does opposition trump revocation?

Stella Kunststofftechnik GmbH (Stella K) filed a Community trade mark application for the word mark STELLA (the Stella mark) on 29 February 1996 in Classes 6, 8, 16, 20 and 21. The mark was registered on 19 September 2001.

Stella Pack SA (Stella P) filed a CTM application for a figurative mark which contained the element STELLA PACK (the figurative mark) on 11 May 2004 in Classes 4, 6, 16, 20 and 21.

On 27 June 2005, Stella K filed a notice of opposition under Article 42(1) of Council Regulation No 40/94 (which now corresponds to Article 41(1) of Council Regulation No. 207/2009) against the figurative mark in respect of Classes 6, 16 and 21 (the opposition proceedings).

On 22 December 2005 (whilst the opposition proceedings continued) Stella P filed an application at OHIM's

Cancellation Division to revoke the Stella mark on the basis that there had been no genuine use of it for a continuous period of five years pursuant to Article 50(1)(a) of the Council Regulation No 40/94 (which now corresponds to Articles 51(1)(a) of Council Regulation No 207/2009) (the revocation action). On 28 February 2008, OHIM's Cancellation Division revoked the Stella mark in relation to such goods where it was shown that there had been no genuine use.

On 28 April 2008, Stella K appealed the decision of the Revocation Action to the Board of Appeal at OHIM. Stella K put forward two arguments:

- 1 the Stella mark had been put to genuine use for all registered goods;
- 2 the revocation action should have been dismissed by the

Cancellation Division on the basis that it was inadmissible as the opposition proceedings issued by Stella K were still pending.

The Board of Appeal dismissed Stella K's appeal on three grounds:

- 1 OHIM'S Cancellation Division had carefully set out its decision relating to Stella K's evidence of use. In relation to some goods it concluded that there had been genuine use (as such, the Stella mark should not be revoked for these goods). However, in relation to the other goods it concluded that there had not been any genuine use.
- 2 The Board of Appeal noted that Stella K had failed to provide any further evidence to support their arguments as to why the Stella mark had been put to genuine use for the goods which were revoked by the Cancellation Division. Rather, they had merely cross-referred to the evidence they had initially submitted to the Cancellation Division in the Revocation Action. The Board of Appeal held that this was inadequate.
- 3 There is no jurisprudence to suggest that the revocation action was inadmissible because the opposition proceedings were pending.

The EU General Court's decision

The judgment was given without an oral hearing pursuant to Article 135a of the Rules of Procedure of the court.

Stella K sought the following orders at the General Court:

- 1 that the contested decision should be annulled;
- 2 that the Revocation Action should be dismissed as inadmissible or, in the alternative, after also annulling the decision of the Cancellation Decision, suspend the decision concerning the application for revocation until a final decision is given in the opposition proceedings.

Stella K relied on the following two causes of action:

- 1 the Board of Appeal made an error

in law in respect of the evidence put forward concerning the genuine use of the Stella mark;

- 2 the Board of Appeal should have held that the revocation action was unlawful on the basis that it was either inadmissible or should have been suspended until the opposition proceedings were concluded.

Stella K's position was that making reference to the evidence of genuine use of the Stella mark submitted to OHIM's Cancellation Division was sufficient and admissible to prove such use to the Board of Appeal. As stated above, the Board of Appeal disagreed. The Board of Appeal noted under Article 44(1) of the Rules of Procedure of the court, applications to the Board of Appeal must include a brief statement of the grounds relied on. In addition, it is settled case law that general references to other documents cannot compensate for the failure to set out the essential elements of the legal argument which should appear in the application itself.

On the basis that Stella K did not make any more than a general reference to the statement and annexes it submitted in the original revocation action in relation to genuine use, the General Court agreed with the Board of Appeal that the evidence was inadmissible.

The Board of Appeal should have held that the revocation action was unlawful on the basis that it was either inadmissible or should have been suspended until the opposition proceedings were concluded (paragraphs 21-37).

Stella K put forward substantially the same arguments raised before the Board of Appeal (as discussed above).

The General Court reviewed the language of Articles 50(1)(a) and 55(1)(a) of Council Regulation No 40/94 which deals with the issue of revocation, Rule 37 of Commission Regulation No 2868/95 (which implements Council Regulation No 40/94) and OHIM's internal guidelines. The General Court concluded that the language of that legislation does not allow for opposition proceedings (brought on the basis of a prior community trade mark) which

are still pending, to influence the admissibility or result of separate revocation proceedings brought against that prior mark.

The General Court also clarified that to take a different approach would be contrary to the purpose of Council Regulation No 40/94. Opposition proceedings and revocation proceedings are separate and distinct with their own purpose and effects (with different rules, such as time limits). In addition, the purpose of opposition proceedings is to frustrate an application for registration of a mark because of the existence of an earlier mark. Rejection of that opposition does not entail the revocation of the earlier mark. Revocation can only come about if and when separate proceedings have been instituted for that purpose.

Therefore, the General Court held that one can file an application for revocation on the grounds of non-use of a mark and that such an application is independent of any parallel opposition proceedings in which the mark to which the application for revocation relates is involved. They also agreed that the Board of Appeal was correct in holding that a revocation action started after opposition proceedings could, at most, mean that the opposition proceedings are suspended pending the outcome of the revocation action.

Comment

The decision of the General Court is perhaps unsurprising based on the relevant legislation. However, it is helpful that the General Court has clarified the relationship (or lack of one) between revocation and opposition proceedings.

It is certainly worth remembering that when it comes to filing evidence in support of genuine use arguments (for example) at the Board of Appeal one must set out the essential elements of the legal arguments with supporting evidence to avoid the risk of inadmissibility.

James Rowlands, *Wragge & Co LLP*,
james_rowlands@wragge.com



Alexandra Brodie

Superskin fails to make the grade as a trade mark

Liz Earle Beauty Co Ltd v OHIM – Case T-486/08. A straightforward decision from the court concerning invented words consisting of two descriptive words; in essence, does sticking two descriptive words together create a distinctive word capable of registration as a trade mark or is there more to it? **Alexandra Brodie** reports...

The emphatic answer is, of course there is more to it. Your combination word has to do more than potentially describe the goods and services to which it is applied. It doesn't matter if the word is slightly unusual or clumsy, there must be a "perceptible difference between the neologism and the mere sum of its parts" (para 25).

Liz Earle Beauty Co Ltd applied for a Community registration for the word mark SUPERSKIN in relation to goods in Class 3 (generally cosmetics and toiletry articles), Class 5 (special nutrition) and services in Class 44 (beauty and healthcare for humans) of the Nice Agreement concerning the International Classification of Goods and Services for the purpose of Registration of Marks of 15 June 1997.

The Examiner rejected the application relying on Articles 7(1) (b) and (c) and (2) of Regulations No 40/94 (now Articles 7(1)(b) and (c) and (2) of Regulation No 207/2009) and the applicant appealed.

OHIM rejected the applicant's appeal and found that SUPERSKIN was descriptive of the characteristics of the goods and services concerned and therefore was also devoid of any distinctive character in relation to the goods and services applied for.

The arguments

The arguments raised by the applicant were many and creative but

hinged on a couple of main points; (1) they don't make skin of any description; (2) the combination of SUPER and SKIN is not common in the English language and is an invented word. OHIM simply contended that SUPER and SKIN are normal English words which have clear meanings and simply putting them together does not create anything other than a word descriptive of something which is intended to make, or is in fact, skin that is super.

The court's findings

The court's judgment helpfully lists a number of factors to be borne in mind when determining descriptiveness. The principal factors from the judgment are listed below:

- 1 For a sign to be determined to be descriptive there must be "a relationship between the sign and the goods or services in question that is sufficiently direct and specific to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and service in question or one of their characteristics..." (para 23);
- 2 If one is dealing with a neologism then it is not enough that the component elements are descriptive – the combination word must be descriptive in itself to be barred from registration (para 24);
- 3 For a neologism made up of purely descriptive elements to be distinctive there must be "a perceptible difference between the neologism and the sum of its parts" for example due to "the unusual nature of the combination in relation to the goods or services, the neologism creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the neologism is more than the sum of its parts" and so an "analysis of the term in the light of the appropriate lexical and grammatical rules is also relevant" (para 25);
- 4 The assessment of descriptiveness must be made in relation to the goods or services of concern and with reference to the way in which the sign is perceived by "the target public" (para 26);
- 5 "... it is sufficient that, from the point of view of the relevant public, at least one of the word's possible meanings designates a characteristic of the goods or services concerned" (para 31); and
- 6 It does not matter if there are more or more usual ways of describing the goods or services in issue – if the neologism is descriptive than that is a sufficient bar to registration (para 36).

The court's approach

Applying the guidelines above, the court noted that it is common in the English language to combine the word SUPER with a noun to create a new descriptive word, eg SUPERSTAR or SUPERPOWER. The court also noted that the relevant public will, on encountering the sign SUPERSKIN, perceive a sign which designates "goods and services which have as their intended purpose high-quality skin, that is to say beautiful and/or healthy skin" (para 37). Having made these findings, the court then went on to consider each of the goods or services applied for within the Classes 3, 5 and 44 listed above.

In relation to Class 3, the court held that whilst SUPERSKIN does, to the relevant public, have a sufficiently direct and specific relationship with the goods intended to improve or preserve the appearance or health of skin but that no such relationship exists between the sign and those goods directed to hair and nailcare preparations, perfumes, anti-perspirants, deodorants, dentifrice, hair colouring preparations, hairspray, eyecare preparations, nail varnish, nail varnish remover and artificial nails and so the sign should, in relation to these goods, be registered.

With regard to Class 5 (special nutrition) the SUPERSKIN sign was considered to have a sufficiently direct and specific relationship with those goods and so OHIM's decision was upheld.

Class 44 (beauty and healthcare services) the arguments in relation to Class 3 apply, namely that SUPERSKIN was adjudged to have a sufficiently direct and specific relationship with those services directed to improving the quality or appearance of skin and not with the remainder of the services.

Outcome

The Board of Appeal's decision was annulled in part only and a split order for costs was made with the applicant bearing its own costs and half of OHIM's costs.

Alexandra Brodie, *Wragge & Co LLP*, alexandra_brodie@wragge.com

Copyright: Stormtrooper helmet "not a work of art"

Lucasfilm Limited, Star Wars Productions Ltd and Lucasfilm Entertainment Company Ltd v Andrew Ainsworth and Shepperton Design Studios Ltd, Rix, Jacob and Patten LJJ 16 December 2009 EWCA Civ 1328. Lucasfilm appealed from the decision of the High Court ([2008] EWHC 1878 (Ch), that its copyright had not been infringed under English law. This point turned on the definition of a sculpture as an artistic work for the purpose of attracting copyright. Lucasfilm also appealed from the decision that a prior US judgment against Mr Ainsworth was not enforceable in the UK. The appeal failed on both counts. **Caroline Friend** reports...

Mr Ainsworth cross appealed on two matters. His first point, against the decision to enforce US copyright in the English courts, succeeded. The Court of Appeal (CA) held that it was not the position of the English court to expand the jurisdiction of US copyright law to the UK. Mr Ainsworth also unsuccessfully appealed from the finding that any copyright protection which subsisted in the work in fact belonged, in equity, to Lucasfilm.

Background

Mr Ainsworth, the respondent, had been contracted in about 1976, by Lucasfilm, to manufacture props for the Star Wars films. Since 2004 he has sold replica Stormtrooper helmets to the US via the internet. As a result Lucasfilm brought proceedings in the UK.

On 31 July 2008 Mann J gave judgment that no infringement of Lucasfilm's copyright had taken place, following his finding that the Stormtrooper helmets could not be considered to be a sculpture for the purposes of copyright. However the judge did uphold Lucasfilm's claim to equitable ownership in any copyright that that arose in any other jurisdiction. The judge also rejected Lucasfilm's claim to enforce a previous US judgment against Mr Ainsworth in the UK, but allowed the enforcement of US copyright directly through the English courts.

Findings of the Court of Appeal

Infringement of UK Copyright

Lucasfilm sort to appeal from the decision that the helmets could not

be considered sculptures under section 4(1)(a) of the Copyright, Designs and Patents Act 1988 and consequently were not "works" in which copyright could subsist. It was held that the scope of the definition, for the purposes of copyright, should not be limited by the scope of registered designs. The CA went on to uphold the "guidance factors" given by the High Court as to what should constitute a sculpture. These are outlined below:

- 1) Some regard has to be had to the normal use of the word "sculpture".
- 2) The concept of a sculpture may go beyond what one would normally expect to find in an art gallery.
- 3) However, one should not stray too far from what would normally be regarded as sculpture.
- 4) There should be no judgment about the artistic merit of the article.
- 5) Not every three-dimensional representation of a concept can be regarded as a sculpture. Otherwise every three-dimensional construction would be a sculpture.
- 6) The essence of a sculpture is that the creator intended that part of the sculpture's purpose is for visual appeal, in that it can be enjoyed for that purpose alone, irrespective of whether it might have a secondary purpose. In short the sculpture should at least be intended to be a work of art.
- 7) The article should not be purely functional.

- 8) The process by which the article is made is relevant, but not determinative. Not every article carved from stone, will therefore be a sculpture.

A distinction was drawn between the purpose for which an article is actually used and the “purposive nature” of the object, which was defined as its “intrinsic quality of being intended to be enjoyed as a visual thing.” The CA held that the Stormtrooper helmet had been made for “a practical purpose” and, as such, was an “object of utility rather than an artistic work.” The use that the helmets are put to would not alter this primary purpose, and so it was irrelevant that the helmets were to be used as props in the Star Wars films. In this regard the CA distinguished the Stormtrooper helmets from a helmet that forms part of a bronze statue of a soldier, which could have no other use than to be part of the artistic work.

The CA therefore held that the helmets were not sculptures within the meaning of the Act and consequently could not afford the protection of copyright. Consequently Lucasfilm failed to show that UK copyright had been infringed.

Enforcement of US copyright by an English court

It had already been established in a US judgment that Mr Ainsworth had infringed US copyright in the Stormtrooper helmets. However, the CA overturned the decision of the High Court that US copyright was enforceable in an English court.

Article 2 of Regulation (EC) 44/2001 on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters provides for jurisdiction of persons domiciled in a member state, whilst Article 22 sets out exclusive jurisdiction, regardless of domicile, in respect of a variety of identified matters, including IP rights. It was held that these articles were not intended to have extra-territorial effect outside the EU and therefore could not be relied upon to enforce US copyright within the EU. The CA believed that it was not for the judiciary to implement a system of mutual recognition of foreign IP rights, as such a system should only

be established through the legislator by way of international cooperation.

The CA held that in the absence of binding authority English courts had no jurisdiction to decide matters of foreign intellectual property infringement. The CA set out a number of factors supporting its decision. It referred to the rule of *British South Africa v Companhia de Moçambique* [1893] AC 602, which held that strictly local matters in a foreign jurisdiction, such as title to land, were not justiciable by an English court. The CA extended this principle, by analogy, to IP rights. It was also highlighted that to uphold foreign laws would lead to a situation where a defendant is restrained from committing acts that are legal in the UK, merely because they are unlawful in a foreign jurisdiction.

The CA also disagreed that there was any difference between the justiciability of (i) the validity of copyright, which supposedly imposed upon the sovereignty of a foreign state; and (ii) questions of infringement, which had previously been thought to be within the jurisdiction of a foreign court. The CA was of the opinion that adjudicating infringement of an IP right often turned upon the scope of the right itself and consequently upon the extent of the monopoly granted by a foreign state. Therefore infringement proceedings could equally be thought to impinge upon the sovereignty of a foreign state. The CA went on to emphasise that it made no difference if the IP right was registerable.

Enforcement of US judgment

In order to determine if the previous US judgment of \$10 million could be enforced against Mr Ainsworth, the CA examined if Mr Ainsworth had sufficient presence within the US through the operation of his website, on which he advertised and sold the Stormtrooper helmets. The CA held that there was no fundamental difference between the internet and other “matters which have enabled business persons to present themselves and their products where they are not themselves present: such as advertisements, salesmen, the post, telephone”, particularly due to the omnipresent nature of the internet as a whole. As a result it was

held that Mr Ainsworth had no presence in the US and so the US judgment could not be enforced within the UK.

Assignment of copyright

The CA recognised that copyright in the Stormtrooper helmets did exist in other jurisdictions and as a result found that it was necessary to consider whether Mr Ainsworth had impliedly granted an assignment of such copyright to Lucasfilm.

After agreeing with the judgment of Lightman J in *Robin Ray v Classic FM* [1998] FSR 622, the CA considered whether sensibly it could have been intended that Mr Ainsworth would retain the copyright, in view of the price he was paid for the work and the impact of the implied assignment upon him. In weighing the factors the CA held that it was necessary for Mr Ainsworth to have impliedly assigned any copyright that did exist to Lucasfilm. The alternative would mean that Lucasfilm would have been unable to sell helmets free from the competition of Mr Ainsworth or indeed another third party.

Comment

The case has provided useful direction on the meaning of a sculpture for the purposes of copyright subsistence in a work. The guidance factors that were upheld by the CA have helped to delineate the scope of what is to be considered a sculpture in the UK. The CA were cautious not to construe the meaning of a sculpture too widely, being mindful not to extend the definition to include every three dimensional construction. However, it should be noted that the case itself only concerned prop helmets and might therefore be of limited application.

The CA’s reasoning in relation to the enforcement of US copyright in the UK is also of interest. The CA disagreed with each of Lucasfilm’s submissions and decided on the basis of public policy against enforcing foreign IP rights.

At the time of writing, it is not clear whether Lucasfilm intends to seek permission to appeal this decision in the Supreme Court.

Caroline Friend, Bird & Bird LLP,
caroline.friend@twobirds.com

Using Protected Geographical Indication as grounds for cancellation of CTM

OHIM Cancellation Division of the OHIM, No 2260C, 15 July 2009. In a recent decision, the Cancellation Division of the OHIM has confirmed the principle that any registered trade mark which is covered by one of the situations described in Article 13 (1) PDO/ PGI Regulation 510/06 which was filed after the date of submission of the application of the PDO or PGI to the Commission and which relates to the same class of products, should be invalidated. **Julia Holden** and **Edith van der Eede** chew over the story...

Article 13 (1) specifies that that the scope of protection granted by PDOs and PGIs includes any direct or indirect commercial use of the registered name for comparable products as well as any misuse, imitation or evocation of the PDO/PGI name (without necessarily being related to products comparable to the products registered under that PDO/PGI name).

This principle, established in Article 14 (1) PDO/PGI Regulation as well as in Article 7 (1) (k) CTMR and affirming the wide protection granted to PDO/PGI, was already confirmed by the Court of First Instance of the EC, in Case T 291/03 (Grana Padano), in its ruling of 12 September 2007 (paragraphs 53/56).

Facts

The cancellation proceedings were lodged by the Italian Ministry of Agriculture against a Cadiz resident who had filed an application for the Community trade mark LARDO DI COLONNATA (word mark) No 3939782 for meat products in class 29; for commercial and online retailing of meat products, advertising services, import and export, in class 35 as well as for magazines, newspapers, pamphlets, posters, prospectuses, stickers and trading cards in class 16.

The application for cancellation was based on the Protected Geographical Indication (PGI) Lardo di Colonnata, submitted to the Commission on 5 June 2003 and registered for meat products by Regulation No 1856/2004.

The PGI related to pork lard exclusively produced in the Colonnata village situated in the Carrara hills.

Analysis

The OHIM Cancellation division, not surprisingly, upheld the application for cancellation of the trade mark, namely in relation to the goods which were similar to the products registered under the PGI, ie meat products in class 29 and commercial and online retailing of meat products in class 35; however, it partially allowed the application for the goods claimed in class 16 and for the remaining services (advertising and import /export) in class 35.

The Cancellation Division based its decision on Article 13(1)(a) PDO/PGI Regulation, referring to the PGI's protection against any direct or indirect use of a PGI in respect of products not covered by the registration in so far as those products are similar to the products registered under that name or in so far as using the name exploits the reputation of the protected name.

However, the sole registration of the PGI does not, according to the Cancellation Division, necessarily imply that the trade mark should be invalidated for unrelated goods and services. The Cancellation Division held that exploitation of the reputation does not automatically follow from the registration as a PGI but instead it should be proved that such exploitation actually has taken place, taking into account the nature

of the goods and services and the manner of commercialisation of the protected product on the market. As such evidence had not been submitted, the application for cancellation was therefore not upheld for goods and services other than related to meat products.

In addition, the decision of the Cancellation Division states that regardless of the registration of the name, in primis, the reputation of the name should be proved.

In our view, the above conclusions reached by the Cancellation Division are questionable. On the one hand, the literal interpretation of the rule in question (Article 13 (1) (a)) allows room to argue that the registration of a name as a PDO/PGI implies a presumption of reputation or at least implies that the PGI enjoys a reasonable presumption of such reputation. For that matter, in its Bavaria ruling (Case C-343/07 of 2 July 2009, in its paragraph 106) the ECJ stated that "the registration of a PGI is designed, among other objectives, to prevent the improper use of a name by third parties seeking to profit from the reputation which it has acquired and, moreover, to prevent the disappearance of that reputation as a result of popularisation through general use outside its geographical origin or detached from a specific quality, reputation or other characteristic which is attributable to that origin and justifies registration".

On the other hand, with reference to PGIs, Article 2 (1)(b) PDO/PGI

Regulation expressly states that a name may be registered as PGI where the product possesses a reputation attributable solely to that geographic origin (where, at least, one step in the production takes place in the geographical area): this seems to be the case for PGI LARDO DI COLONNATA as the specification expressly refers to its reputation.

As a consequence, it could be argued that, at least for PGIs the registration of which are based on reputation, such as LARDO DI COLONNATA, the reputation is 'in re ipsa', and there should not be a need to prove this.

For that matter, one could ask how a trade mark exclusively consisting of a (otherwise exclusively descriptive) name registered as PGI, enjoying a reputation per se, could possibly be used for advertising services, import and export as well as for goods in class 16 such as magazines, newspapers, pamphlets, posters, prospectuses, stickers and trading cards, by a third party without exploiting the reputation of the PGI, or otherwise without misleading the consumer as to the true origin of the product, being another absolute ground for refusal under the CTMR and under the PDO/PGI Regulation.

Practical significance

If this Cancellation Division's decision were to be followed, trade marks corresponding to one of the situations referred to in Article 13 (1) PDO/PGI Regulation, even if later in time than the PGI, might survive for unrelated products if no exploitation of the reputation can be proved. Additionally evidence of the reputation of the PDO/PGI as well as of exploitation of the reputation of the latter, should be provided to obtain invalidation of a trade mark which evokes, imitates or misuses a PDO/PGI. To go in such a direction would however undermine the very essence of the community protection framework set up for PDOs and PGIs. An appeal lodged by the Italian Ministry against the decision is pending.

Julia Holden and Edith van der Eede, *Trevisan & Cuonzo Awocati*, Milan, jholden@trevisancuonzo.com

Sun wins case over M-Tech grey market disk drives



Andrew Maggs

Sun Microsystems Inc v M-Tech Data Limited and Stephen Lawrence Lichtenstein [2009] EWHC 2992 (Pat), High Court, Chancery Division, Intellectual Property. A dealer in infringing grey goods sought to have a trade mark proprietor's ability to enforce its rights suspended. The dealer asserted the enforcement of these marks was operating as a quantitative restriction on inter-state trade in

the light of anti-competitive agreements entered into between the proprietor and its authorised dealers and the withholding of access by the trade mark proprietor to a database relating to the origin of the marked products. **Andrew Maggs** reports...

Background

M-Tech Data Limited (M-Tech) imported disk drives manufactured by Sun Microsystems Inc (Sun) into the UK and sold them to a third party. Sun made an application for summary judgment in an action for infringement of its registered community and national trade marks, on the basis that it had not consented to first marketing of the disk drives in the EEA, and that therefore its trade mark rights were not exhausted, and it was entitled to rely on them to prevent commercialisation of the goods.

M-Tech opposed the application on the grounds that:

- 1 Sun had failed to establish where the disk drives were first marketed;
- 2 the enforcement by Sun of its trade mark rights is contrary to Articles 28-30 of the Treaty establishing the European Community (ECT) as the enforcement of those rights will prevent the attainment of a single market in products which have been marketed by Sun or with its consent in the EEA; and

- 3 the enforcement by Sun of its trade mark rights is connected with agreements which are contrary to Article 81 ECT and are therefore prohibited, so enforcement of the trade mark rights should also be prohibited.

Consent to first marketing

Kitchin J drew on the following six clear principles from European jurisprudence regarding whether goods had been put on the market in the EEA with the trade mark proprietor's consent (see paragraphs 11 to 16 of the judgment):

- 1 "consent" is tantamount to the proprietor's renunciation of his exclusive right under Article 5 of the Trade Mark Directive (TMD);
- 2 it is for the ECJ to supply a uniform interpretation of the concept of "consent";
- 3 consent must be so expressed that an intention to renounce those trade mark rights is unequivocally demonstrated;
- 4 such an intention will normally be gathered from an express statement of consent, although it may be inferred from surrounding facts and circumstances;

M-Tech could not demonstrate that the disk drives in issue had been put on the market by Sun or with its consent. The distribution agreements did not license the registered trade marks in issue to M-Tech. Whilst those agreements may have distorted competition within the common market, even if they had been found to be void, this would not have prevented Sun from enforcing its registered trade mark rights.

- 5 implied consent cannot be inferred from the mere silence of the trade mark owner; and
- 6 the importer's ignorance of the trade mark owner's lack of consent to importing the goods into the EEA is irrelevant.

Where were the disk drives first marketed? (paragraphs 18 to 22)

Sun adduced evidence to show that the disk drives had not been marketed in the EEA, and had been sold to M-Tech in the USA.

M-Tech argued that Sun's evidence as to the first marketing of the disk drives contained discrepancies.

Kitchin J held that although there had been an initial error in Sun's evidence regarding first marketing, which made the timescale for Sun's initial sale to a third party, the return of the disk drives to Sun, and their subsequent sale by a broker to M-Tech look unrealistic, this had been corrected as soon as Sun became aware of it. In the circumstances, he held that the disk drives had not been put on the market inside the EEA by Sun or with its consent.

Was Sun's enforcement of its trade mark rights contrary to Articles 28 to 30 ECT? (paragraphs 23 to 53)

Article 28 ECT prohibits "quantitative restrictions on imports and all measures having equivalent effect... between member states".

Article 30 ECT states that Article 28 "shall not preclude prohibitions or restrictions... justified on grounds of... the protection of industrial and commercial property. Such prohibitions or restrictions shall not, however, constitute a means of arbitrary discrimination or a disguised restriction on trade between member states".

M-Tech argued that the combination of (i) the impossibility of an independent trader knowing whether a particular disk drive had been put on the market in the EEA with Sun's consent or not; (ii) Sun's refusal to allow independent traders access to its internal database, which lists where each disk drive was first marketed; and (iii) Sun's vigorous enforcement of its trade mark rights

against independent traders, has the object and effect of shutting down the grey market, not just in Sun products which have not been put on the market in the EEA by or with Sun's consent, but also in those which have.

Kitchin J held that (paragraph 36):

- 1 M-Tech's submission involves reading into Articles 5 to 7 TMD a further qualification to the right conferred by a registered trade mark, namely a restriction on the right to prohibit the use of the trade mark in circumstances where the exercise of the right may affect the free movement of goods between member states. But this is precisely what the Community legislature has chosen not to do. To the contrary, it has expressly given to trade mark proprietors the right to control the first marketing in the EEA of goods bearing the registered trade mark; and
- 2 if and so far as M-Tech has a remedy in respect of failure by Sun to publish its database or provide sources of information to independent traders, then it must lie in other provisions of competition law.

M-Tech referred to several previous cases of the ECJ (discussed at paragraphs 38 to 52), which related to national trade mark and design rights, and which held that the exercise of those rights could be prohibited if the exercise of those rights was incompatible with the free movement rules in the ECT, where the goods in question have already been put on the market in the EEA by the trade mark proprietor or with its consent. M-Tech submitted that these decisions should be expanded to cover Community rights as well, where the goods have not previously been put on the market by the trade mark proprietor or with its consent.

Kitchin J held (paragraph 43) that cases regarding the exhaustion of the national trade mark rights of member states by the placing of goods under those marks on the market in another member state have no relevance to the question in issue which involves the exhaustion not of a national right but rather the alleged exhaustion of a

right conferred by the Community legislature, by placing the goods on the market outside the EEA.

Was Sun's enforcement connected with agreements contrary to Article 81 ECT and therefore prohibited (paragraphs 54 to 56)?

M-Tech argued that: (i) the network of agreements Sun had entered into with its authorised distributors, which prevented them from buying Sun hardware from independent distributors unless such hardware could not be supplied from within the authorised network; and (ii) Sun's vigorous enforcement of its trade mark rights, appreciably distorted or restricted competition in the secondary market for Sun disk drives, thereby affecting trade between member states.

Sun was prepared to admit for the purposes of the application that the agreements were contrary to Article 81. However, it submitted that there is no nexus between this alleged breach and the enforcement of its trade mark rights.

Kitchin J held that (paragraph 56):

- 3 the disappearance of the independent secondary market in Sun hardware is not attributable to the offending network of agreements between Sun and its authorised distributors, but is attributable to the inability of independent traders to ascertain the provenance of the Sun disk drives in which they are dealing; and
- 4 there is no connection between Sun's enforcement of its trade mark rights and the contractual requirement for Sun's authorised distributors to buy disk drives from within the network wherever possible.

Outcome

Kitchin J granted Sun's application for summary judgment.

Comment

From a strict trade marks perspective, there is nothing out of the ordinary about the granting of summary judgment in this case. M-Tech could not demonstrate that the disk drives in issue had been put on the market by Sun or with its consent. The

distribution agreements did not license the registered trade marks in issue to M-Tech. Whilst those agreements may have distorted competition within the common market, even if they had been found to be void, this would not have prevented Sun from enforcing its registered trade mark rights.

That said, one wonders whether, had M-Tech conducted itself differently, and presented different arguments, it might have reached a different outcome, if not in this case, then in its commercial dealings with Sun.

From the judgment it seems that M-Tech's complaint is that Sun is shutting down any secondary market in disk drives, whether unlawful parallel imports which do infringe Sun's registered trade mark rights, or not. M-Tech's allegation is that Sun is doing this by (i) refusing to supply to independent traders in its goods information regarding whether its products have been put on the market inside the EEA by it or with its consent; (ii) vigorously enforcing its trade mark rights; and (iii) prevented authorised resellers from buying Sun hardware from independent distributors unless such hardware could not be supplied from within the authorised network. M-Tech argues that, considered together, these actions result in the risk of being sued by Sun and found to infringe its registered trade mark rights outweighing the benefits of dealing in Sun's goods (whether infringing or not).

As Kitchin J decided, none of this impacts on Sun's ability to enforce its trade mark rights. However, given Kitchin J's comment that "if and so far as M-Tech has a remedy in respect of failure by Sun to publish its database or provide sources of information to independent traders, then it must lie in other provisions of competition law", perhaps M-Tech could have obtained access to Sun's database of products if it had argued that Sun's refusal to supply information regarding which products had been put on the market in the EEA by it or with its consent amounts to an abuse of dominant position contrary to Article 82 ECT, relying on *C-241/91P RTE v Commission* ("Magill"), case T-184/01 *IMS Health Inc v Commission*,

and case T-201/04 *Microsoft Corp v Commission*.

M-Tech could rely on *Magill*, *IMS* and *Microsoft* if it could persuade the court that (i) Sun is in a dominant position in the market for information regarding whether its trade mark rights have been exhausted (the "upstream market"), and (ii) the refusal to supply this information to independent traders "has the object and effect of shutting down the grey market [the "downstream market"], not just in Sun products which have not been put upon the market in the EEA by or with Sun's consent, but also in those which have". If Sun's refusal to supply access to its database did indeed have this effect (which would be for M-Tech to prove) then such refusal might well have an anti-competitive effect, which, if it were damaging to consumers (for example, because they had to pay higher prices), and if it affects trade between member states, might well be prohibited by Article 82 ECT.

If M-Tech believed that it had an arguable case under Article 82, then it could have approached Sun to seek a licence of the database of products in respect of which its trade mark rights have been exhausted. If (as M-Tech alleges) such a request was met with an aggressive response from Sun requiring M-Tech to provide the identity of their sources and a detailed account of their stock (as M-Tech alleges Sun has done in the past), they could commence an action for abuse of dominant position, seeking access to the database on fair, reasonable and non-discriminatory terms. If parallel importers knew that such licences were available, they would have a choice between whether to pay for a database licence, or not. It would therefore (where information as to provenance is held by a single undertaking) mitigate to a significant extent the perceived harshness of the established position that ignorance on the part of the trader importing unlawful grey goods into the EEA (or dealing with them subsequently) is irrelevant to the question of infringement.

Andrew Maggs, Wragge & Co LLP,
Andrew_maggs@wragge.com



Kate Swain

Red light for Esber appeal as Coloris show prior use

Case T – 353/07 Esber SA v OHIM (intervener Coloris Global Colouring Concept). Court of First Instance, 30 November 2009. In an appeal against an opposition finding of genuine use of an earlier mark, the CFI held in favour of the opponent and set out the evidential requirements for genuine use. **Kate Swain** paints the picture...



Esber SA applied for the figurative sign COLORIS, as shown above.

The application, which was made in August 2002 and published in August 2003, was in relation to

- Class 2 – Paints; lacquers and dyes; thinners; enamels and aluminium powder for painting; binding preparations for paints; and
- Class 16 – Publications; books; magazines; periodicals; printed matter; paper or plastic not included in other classes, in the form of sheets or bags, printed or not, for wrapping or packaging; labels; paintbrushes, artists' materials, adhesives for stationery or household purposes; pencils and drawing implements.

Allios SA opposed the application for the goods in Class 2 and artists' materials, paintbrushes, pencils and drawing implements in Class 16. The opposition, under Article 41 of the Community Trade Mark Regulation No 207/2009, was based on the earlier word mark COLORIS which was registered in France in 1998 for goods in Class 2 including paints, lacquers, colorants and metals in foil and powder form for painters. During the course of the proceedings the COLORIS mark was transferred to

Coloris Global Colouring Concept (Coloris).

Coloris' evidence of prior use included invoices, pamphlets, catalogues, a label, advertising, commercial agreements, a photograph of a can bearing the word COLORIS and a declaration that cans had been sold bearing the COLORIS mark.

The Opposition Division upheld the opposition to the Class 2 goods but rejected it in relation to the Class 16 goods. Esber appealed to the First Board of Appeal in relation to the decision on the Class 2 goods but failed. The matter was then appealed to the Court of First Instance.

The arguments

The appeal was based purely on Articles 15(1)(a) and 42(2) and (3) of the Regulation and Esber's claim that the evidence presented by Coloris was insufficient for a finding of genuine use of the earlier mark in France. Esber maintained that COLORIS was always used either in conjunction with other words or the image of a globe and never on its own. The additional word elements were "global coloring concept", "gcc" and "colorants & technologies". Further, Esber claimed COLORIS was not used, in its various forms, to refer

to goods but to refer to an undertaking.

The law

The CFI clarified a number of points before presenting its conclusions;

- i) genuine use of a trade mark occurs where it is used in accordance with its essential function to guarantee the identity of the origin of the goods or services for which it is registered;
- ii) evidence of use must concern the place, time, extent and nature of use of the earlier mark and must be demonstrated by "solid and objective evidence of effective and sufficient use of the trade mark on the market concerned";
- iii) when assessing whether use is genuine, all circumstances should be considered particularly the methods of creating and maintaining market share, the nature of the goods and services, the market and the scale and frequency of use of the earlier mark;
- iv) account must be taken of the "commercial volume of the overall use" as well as the time period and frequency of which the mark was used; and
- v) under the Regulation use of the earlier mark includes in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (Case T-29/04 *Castellblanch v OHIM* 2005 ECR II-5309).

The CFI decision

Dealing first with the use of COLORIS in conjunction with other word and image elements, the CFI observed that the words “global coloring concept”, “colorants & technologies” and “gcc” were always positioned below COLORIS and never of a greater size than the word COLORIS. In fact, the words “global coloring concept” were often smaller. The words also had a general meaning with “coloring” and “colorants” being descriptive terms. “Technologies” has a generic character. In light of this the additional word elements were found not to affect the distinctive character of COLORIS.

The globe was also found to have no affect on the distinctive character as it was a generic image with no particularly creative element.

The CFI went on to state that it could find no basis for the claim that signs were not used as marks but simply to refer to an undertaking. A word element may be used both as a trade name and as a mark to designate goods. One does not preclude the other (Case T-418/03 La Mer Technology v OHIM).

Turning to the question of genuine use, the CFI held that the majority of the evidence put forward by COLORIS fell within the necessary five year period prior to the publication of the COLORIS application and provided sufficient evidence of the place, time, extent and nature of use of the earlier mark. The invoices in particular demonstrated the time and extent of sales and the can bearing the word COLORIS demonstrated the use.

Conclusion

Evidence of use of an earlier mark must be clear and objectively demonstrated. Supporting factual evidence should demonstrate the timing, nature, extent and place of use if it is to be persuasive. Subjective recall in the form of statements, without any supporting evidence, is unlikely to be sufficient.

Kate Swaine, *Wragge & Co LLP*,
kate_swaine@wragge.com



Bill Ladas



Neil Jepson

Giordano Enterprises Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), General Court, 16 December 2009, Case T-483/08. The General Court has upheld a decision of OHIM’s Second Board of Appeal which had found a likelihood of confusion between two identical marks where the earlier mark was registered for footwear and the later mark was applied for in relation to clothing, headgear and footwear in class 25 and, inter alia, various types of leather or imitation leather bags in class 18. **Bill Ladas** and **Neil Jepson** report...

Giordano: leather goods share a common aesthetic

Background

On 14 September 2000, Giordano Enterprises Ltd (Giordano) filed a Community trade mark application for the word mark GIORDANO in respect of clothing, footwear and headgear in class 25 and various goods in class 18.

On 21 March 2002, Jose Dias Magelhaes & Filhos Ida filed a notice of opposition against Giordano’s application based on its identical earlier Portuguese registration for GIORDANO in respect of footwear in class 25. The opposition alleged a likelihood of confusion under Article 8(1)(b) of Regulation No 40/94 (now Regulation No 207/2009) based on the similarity of the goods covered by both marks and the identity of the marks.

Board of Appeal decision

In relation to the class 18 goods, the OHIM Second Board of Appeal held that there was a likelihood of

confusion in respect of “goods made of leather and imitations of leather (as far as included in class 18) particularly bags, beach bags, handbags, waist bags, pouches, purses, back packs, rucksacks, school bags, satchels, tote bags, shoulder bags, sport bags, athletic bags, book bags, carry-on bags, shoulder bags” (referred to as “leather bags” in this note), holding that such goods were similar to footwear for two reasons: (i) their common aesthetic function (ie, they both contribute to the external image or the “look” of the consumer); and (ii) the fact that they are often marketed under the same brands and in the same outlets. It also held that there was a likelihood of confusion in respect of the class 25 goods.

Giordano’s arguments before the General Court

Giordano appealed to the General Court (previously the CFI) arguing:

(i) there was no similarity between footwear and leather bags, because

of their differing uses and because they were not in competition;

(ii) there was no similarity between footwear on the one hand and clothing and headgear on the other because they are used to protect different parts of the human body; and

(iii) the earlier mark only had a low degree of distinctiveness because it was a word mark consisting of a common first name.

The General Court's findings

It was not in dispute that the marks were identical or that the relevant public was made up of average Portuguese-speaking consumers who are reasonably well informed and reasonably observant and circumspect. Accordingly, the judgment focuses on the comparison of the goods at issue.

The General Court found that the Board of Appeal did not err in finding that the goods were similar for the purposes of Article 8(1)(b) of the Regulation. In particular it held as follows:

- (i) Previous case law had confirmed that, because of the sufficiently close links between the respective purposes of clothing and footwear (and also that they are in the same class and can be produced by the same operators or sold together), such goods may be linked in the mind of the relevant public. By analogy, the same reasoning could be applied to headgear.
- (ii) Previous case law had also confirmed that goods such as leather bags are often sold with goods in class 25 such as footwear at points of sale in both major retail establishments and more specialised shops.
- (iii) Leather bags and footwear are aesthetically complementary because they share a common aesthetic function in the eyes of the relevant consumer by contributing to the image of the consumer concerned. Previous case law had established that this aesthetically complementary nature must involve a genuine aesthetic necessity – ie, one

product must be indispensable or important for the use of the other and consumers must consider it ordinary and natural to use such products together. However, it was not a requirement that the use of one product be necessarily 'indispensable' for the use of the other product; it was enough if the use of one product was 'important' for the use of the other. As some consumers might perceive a close connection between the relevant goods (both being accessories which may contribute jointly to the external image of the consumer), the goods were important for the use of the other.

- (iv) Being aesthetically complementary is not, however, sufficient to lead to a finding of similarity. In addition to this finding, the Board of Appeal had found that the goods were, at least sometimes, sold in the same outlets and it was the finding of both those 'mutually reinforcing considerations' that lead to a finding of similarity 'at least to a certain degree'.
- (v) As for the likelihood of confusion, in principle a very common name is less distinctive than a rare name, particularly in the fashion industry where use of patronymics is commonplace. However, as the two marks were identical, this increased the likelihood that consumers might perceive the goods as coming from the same source. Further, Giordano had failed to demonstrate that the Italian first name GIORDANO was also a common name in Portugal.

The General Court went on to hold that the limited level of similarity between the goods was offset by the identity between the marks. Accordingly, there was a likelihood of confusion in relation to both the class 25 goods and leather bags in class 18. Giordano's appeal was therefore dismissed.

Comment

This decision is a further reminder of the approach that the General Court adopts in relation to goods such as leather bags in class 18 and goods in

class 25. In *SISSI ROSSI* (Sergio Rossi SpA v OHIM Case T-169/03), which concerned "women's bags" and "women's footwear", it had concentrated on the differences in their respective primary functions, namely, carrying objects and dressing feet, rather than similarities derived from their common aesthetic function and similar distribution channels, albeit recognising that the differences between the goods were not so great as to rule out a likelihood of confusion, particularly if the marks were identical and the earlier mark was highly distinctive.

In *TOSCA BLU* (Mulhens GmbH & Co KG v OHIM Case-T-150/04), it held that an aesthetically complementary nature between "perfumery" and "leather goods and clothing" in class 18 would not be sufficient alone to establish their similarity. The consumer must consider it normal for the goods to be marketed under the same trade mark, which implies that a large number of the producers or distributors of these goods are the same. Further, it found that the fact that the public was accustomed to fashion products being marketed under perfume trade marks did not establish the existence of a genuine aesthetic necessity so as to mean that one was indispensable or important for the use of the other and that consumers consider it ordinary and natural to use them together.

The decision in *GIORDANO* (and in *El Corte Ingles SA v OHIM Case T-443/05*) demonstrate that the General Court is now more willing to place weight on the importance to the consumer of the goods' secondary aesthetic uses and the effect in the consumer's mind of selling the goods together in specialist and major distribution channels.

Clearly, in this case, the identity of the marks and the finding of distinctive character in relation to the earlier mark were also important findings.

Bill Ladas and Neil Jepson,
bill.ladas@sjberwin.com
neil.jepson@sjberwin.com
 SJ Berwin LLP

CFI refuses Agile registration despite finding low level of similarity to AYGILL'S

Peek & Cloppenburg v OHIM, Redfil, Court of First Instance, Case T-386/07, 29 October 2009. The CFI considers AYGILL'S and AGILE to be confusingly similar and so "agile" has been refused registration. This is despite a finding that the mark and sign possess an average degree of visual similarity, a degree of phonetic similarity in the French-speaking world and no conceptual similarity resulting in a decision that the mark and sign whilst similar overall have only a "low degree" of similarity.

Alexandra Brodie reports...



The decisive factor in finding a likelihood of confusion was the fact that the goods applied for under the "agile" sign were identical to some of the goods covered by the pre-existing CTM for AYGILL'S.

This is a border-line case at best on its facts and a clear illustration of how the interrelationship of the relevant factors in the global assessment can sometimes produce somewhat surprising results.

Facts

On 10 April 2002, Redfil applied for a figurative CTM as shown above in relation to Classes 18 (bags, rucksacks), 25 (sport footwear, shirts, vests, jackets, pullovers, socks, trousers, hats, berets, visors) and 28 (golfbags, golfing gloves, golf clubs, games balls) of the Nice Agreement of 15 June 1957.

On 18 July 2003 Peek & Cloppenburg opposed the application under Article 42 of Regulation No 40/94 (now Art 41 of Regulation No 207/2009) in relation to all the goods on the basis of various earlier national marks and an earlier Community word mark for AYGILL'S registered on 5 August 1994 in relation to Classes 3, 6, 8, 9, 11, 14, 16, 18, 20, 21, 24, 25, 27 and 28. The opposition was based on a likelihood of confusion under Article 8(1)(b) of Regulation 40/94.

Earlier decisions

The Opposition Division granted the opposition on 11 August 2006.

The Second Board of Appeal of OHIM annulled the Opposition Division's decision on 26 July 2007 and rejected the opposition in its entirety.

The Board of Appeal found that the goods applied for were identical to

some of the goods covered by P&C's earlier mark. However, the Board of Appeal regarded the mark and sign as visually similar only to a low degree, phonetically not similar in English but similar in French and not similar conceptually. On an overall, or global, assessment basis the Board of Appeal held that there was no likelihood of confusion and noted that in a case where the relevant public, when making a purchase, usually perceives the mark visually then the phonetic similarity between mark and sign is of less importance than might otherwise be the case.

The CFI's judgment

The law

The CFI noted that because the earlier CTM is a Community-wide registration then it is necessary to consider the consumer's perception of the mark and sign in issue for the goods and services in question throughout the entire Community. The goods in question are intended for the general public and so the relevant public consists of average consumers.

It determined that the rule, in relation to absolute grounds of refusal under Article 7(2) of Regulation No 40/94 (now Art 7(2) of Regulation No 207/2009) that an application to register a mark may be refused if the absolute ground relied upon exists anywhere in the Community as opposed to throughout the whole of the Community should, by analogy,

be applied to the relative grounds for refusal.

It affirmed the approach of global assessment when considering a likelihood of confusion and noted that such assessment implies some interdependence between the factors taken into account. Further it noted that the perception of the marks by the average consumer plays a decisive role in the global appreciation of the likelihood of confusion and that such consumers normally perceive a mark as a whole and do not proceed to analyse its various details.

The findings

The goods in question are identical and this is not in dispute.

A visual comparison of the mark and sign in issue reveals that the first four letters of “agile” are included in that order in the first five letters of AYGILL’S and given the brevity of both the mark and the sign they have in common a majority of their constituent letters. Accordingly the consumer will regard the mark and sign as being visually similar despite the different endings. The CFI noted that established case-law dictates that the consumer generally pays more attention to the beginning of a mark than to the end (Case T-133/05 Meric v OHIM – Arbora & Ausonia (PAM PIM’s BABY-PROP) [2006] ECR II-2737 para 51). Given that the consumer is deemed to only rarely have the chance to make a direct comparison of the marks and must rely on an imperfect picture in his mind the CFI overturned the Board of Appeals finding of a low degree of visual similarity and held that there was an “average degree of similarity”.

In terms of the visual comparison the CFI noted that the Board of Appeal was wrong to take into account the particular font used by the “agile” sign given that the earlier mark is a word mark and so the proprietor is free to use it in different scripts including the one chosen by agile’s proprietors.

With regard to the phonetic comparison the CFI upheld the Board of Appeal’s finding that a French pronunciation of both the mark and the sign would produce a similar-sounding word.

With regard to conceptual similarity the CFI noted that the Board of Appeal was right to point out that the word “agile” has a clear meaning in several Community languages including French whereas the earlier mark is devoid of meaning and that the consumer would likely equate it to a family or place name. The CFI held that the mark and sign are conceptually different.

Accordingly the mark and sign are visually and phonetically similar but conceptually dis-similar. The CFI noted that in some cases a conceptual dis-similarity can overcome visual and phonetic similarity but only where the conceptual meaning is sufficiently “clear and specific” such that “the public is capable of grasping it immediately”. In this case the CFI noted that the conceptual difference is not great enough – it might serve to attenuate the similarity of the mark and sign but not to neutralise it.

The CFI held that the mark and sign in issue must be considered to be similar overall but to a low degree.

The CFI went on to hold that the Board of Appeal’s decision that there was no likelihood of confusion based on the notion that the visual similarity or otherwise of the mark and sign was a dominant consideration due to how the public buys the goods in question was wrong. The CFI was not certain that the visual aspect plays a greater role and noted that the goods in question in the present case are not all of the same nature as those in the cases upon which the Board of Appeal relied.

The Board of Appeal was wrong to hold that there was no likelihood of confusion because although the mark and sign in issue are globally similar only to a low degree the goods in question are identical which offsets to some degree the low similarity of the mark and sign and results in a finding of a likelihood of confusion.

The CFI therefore annulled the Second Board of Appeal’s decision and ordered OHIM to pay Peek & Cloppenburg’s costs whilst Redfil was ordered to bear its own costs.

Alexandra Brodie, Partner,
Wragge & Co LLP,
alexandra_brodie@wragge.com

...the mark and sign are visually and phonetically similar but conceptually dis-similar. The CFI noted that in some cases a conceptual dis-similarity can overcome visual and phonetic similarity but only where the conceptual meaning is sufficiently “clear and specific” such that “the public is capable of grasping it immediately”.



Wasabi Frog Limited v Miss Boo Limited and another, High Court of Justice, Chancery Division, [2009] EWHC 2767 (Ch), 04 November 2009. In this UK High Court decision, an interim injunction was ordered against an online retailer, with Google's AdWords being used to demonstrate a likelihood of confusion. **Ben Hall** reports...

Google's AdWords and search data demonstrate confusion over Boohoo

Wasabi Frog Limited (the applicant) is a successful online retailer of clothing, shoes and accessories for 17 to 25-year-old women, and has traded under and by reference to the names BOOHOO and BOOHOO.COM since November 2006.

The applicant is the proprietor of CTM registrations for BOO, BOOHOO and BOOHOO.COM in relation to, inter alia, clothing, footwear and headgear. The applicant is also the owner of the domain name boohoo.com, and various other domain names (boohoo.co.uk, missboohoo.com, missboohoo.co.uk and missboohoo.eu) which are all used to re-direct customers to the www.boohoo.com website, the applicant's online shop.

Miss Boo Limited (the respondent) recently launched an online retail business selling products which were in direct competition with the applicant. The respondent had traded under and by reference to the names MISS BOO and MISSBOO.CO.UK since around 1 September 2009.

The applicant discovered the respondent's website almost immediately after it was launched and applied for an interim injunction

to restrain the respondent from trading under or by reference to the marks or domain names "Miss Boo", "miss.boohoo.co.uk" or the applicant's marks or domain names "boohoo", "boohoo.com" and "boo", or any marks or domain names similar thereto and to require the respondents to disable their website at www.missboo.co.uk.

High Court decision

Mr Justice Warren reiterated that the test for the granting of an interim injunction requires the applicant to show there is a triable issue; that an award of damages will not represent adequate compensation and that the balance of convenience favours the grant of an injunction.

The applicant put its case on the basis of both trade mark infringement (relying on Article 9 of the Community Trade Mark Regulation) and passing off.

In relation to trade mark infringement, in essence, what the applicant needed to show was a likelihood of confusion between one or both of Miss Boo and missboo.co.uk on the one hand and any one of the applicant's CTMs on

the other hand (BOO, BOOHOO, BOOHOO.COM).

A person in the fashion industry had contacted the applicant at the boohoo.com email address to advertise an opportunity to promote the boohoo brand, referring to the applicant twice as "Miss Boo". Mr Justice Warren said that, in his mind, this demonstrated confusion. That a person working in the industry could be confused suggested that consumers ("very, very savvy young females" in the words of the respondent) might also be confused.

In order to limit the potential for damage to its business, once the applicant learnt of the respondent's activities, the applicant purchased the words "MISS BOO" as a Google AdWord. This meant that when an internet user entered the words "MISS BOO" into the Google search engine, the applicant's advertisement for www.boohoo.com appeared in the sponsored search results. Google Analytics reports confirmed that the "click through" rate of visitors to the www.boohoo.com website, via the link which appeared in the sponsored search results after they have searched against the words "MISS BOO", was 14.89%, the fourth largest

...it is interesting to see reliance on Google's AdWords, Google Analytics and search engines as evidence of confusion. Furthermore, it was also argued that the strength of the 'boohoo.com' brand was demonstrated by the fact that ASOS (the UK's largest online-only fashion and beauty store) was bidding on the BOOHOO keyword on Microsoft's search engine, meaning that ASOS were paying Microsoft in order to be associated with the "boohoo.com" brand.

source of traffic to the "boohoo.com" website at that time. On this basis, Mr Justice Warren said that the applicant had a well-arguable case that this demonstrated a likelihood of confusion.

Amongst other general matters demonstrating a likelihood of confusion, Mr Justice Warren looked at the conjunction of a conventional word ("Miss") with a CTM ("Boo"). He found that the consumer is likely to associate Miss Boo with whatever it is that Boo relates to. Since the applicant has a CTM for Boo, it is entitled to use that mark for its goods. A well-known example of similar use is "Miss Selfridge". There was obviously a strong case for such an association and a corresponding likelihood of confusion for the purposes of trade mark infringement.

Mr Justice Warren therefore concluded that there was a triable issue (indeed, a strongly arguable case) as to a likelihood of confusion. Accordingly, there was a strongly arguable case on trade mark infringement and, although the passing off case presented more difficulties (deception was required, mere confusion was not enough), a well arguable case was present there as well.

To allow the respondent to trade between this judgment and the date of a trial many months away could cause irreparable harm to the reputation of the applicant if, as had been suggested, the quality of service and goods of the respondent were inferior to those of the applicant. It was almost inevitable that business which went to the respondent would include business which ought to have gone to the applicant which would therefore have suffered loss. Mr Justice Warren therefore found that damages were clearly not an adequate remedy for the applicant.

Damages (which could be recovered through a cross-undertaking), whilst not a complete remedy for the respondent, were likely to be adequate due to the short period of time it had been trading; the respondent was free to trade, under a different existing name and website. Indeed, its stock (which was not

branded with Miss Boo) could still be sold.

The balance of convenience was therefore in favour of granting the injunctive relief sought provided that an adequate cross-undertaking could be given.

Comment

As an online retailer with no physical presence on the high street, the applicant obviously took the actions of the respondent very seriously, and therefore needed to prevent the respondent from continuing to operate in the way it had been doing as soon as possible – dealing with not only the "abusive" domain name and website but also the content of the website, similar domain names and the actual trading itself. Merely applying to the Nominet Dispute Resolution Service to resolve the dispute over the respondent's domain name would not have been enough.

With the recent Advocate General's opinion in *Google France v LVMH*, it is interesting to see reliance on Google's AdWords, Google Analytics and search engines as evidence of confusion. Furthermore, it was also argued that the strength of the "boohoo.com" brand was demonstrated by the fact that ASOS (the UK's largest online-only fashion and beauty store) was bidding on the BOOHOO keyword on Microsoft's search engine, meaning that ASOS were paying Microsoft in order to be associated with the "boohoo.com" brand, which was an indication of the reputation the brand enjoys. Mr Justice Warren commented that there was considerable force in this argument.

It would have been interesting if the respondent had been represented in this case, particularly if this had been a final decision, simply to see what the respondent's counsel would have said against the use of AdWords to demonstrate confusion. It seems arguable that what the applicant was really demonstrating was confusion caused by the applicant's own actions in purchasing the AdWord.

Ben Hall, *Simmons & Simmons*,
ben-hall@simmons-simmons.com



Eleni Lappa

Five myths and realities of Greek trade mark practice

Greece is well known for a number of things, old and new. One of them, belonging to the former category, is Greek mythology. There are certain myths all the way from Aesop's time, which apply even in today's reality in Greece, and of course not in Greece alone. Yet, what are the myths and realities of some of today's practical aspects of life, say, in Greece's trademark system for example and how it operates, or rather how operational it really is? In this article **Eleni Lappa** attempts to discuss at least some of those "myths" and how true (or false) they really are...

MYTH#1: THERE IS A SINGLE TRADE MARK AND PATENT OFFICE IN GREECE

False. Incredibly, though in most jurisdictions trademarks and patents happily co-exist under one roof, in Greece there is no such co-habitation, not even a neighbouring residence. The Greek Trademark Office is a division within the General Secretariat of Commerce, belonging to the Ministry of Finance, Competition and Shipping and is even located at the Ministry premises. The Greek Patent office is a more autonomous entity, formally under the supervision of the Ministry of Development, founded by a separate law (L 1733/1987), with a special Board of Directors and its own premises, nowhere near any Ministry in Greece.

MYTH #2: THE TRADE MARK OFFICE'S ELECTRONIC DATABASE IS FULLY UPDATED

False. Especially when it comes to device only marks, it is a well-known secret amongst trade mark practitioners that in order to ensure the relevant marks are located, one has to visit physically the actual Trademark Office and browse through the printed volumes of

device marks in the hope of finding the marks of interest (provided that the particular device mark, if still in the application stages, has been published for opposition purposes; otherwise it would be almost impossible to find). Another interesting aspect of the current status of the Greek Trademark Office's database is that, when it comes to conducting searches not on the basis of the trade mark name itself but on other criteria, such as, for example, the trade mark owner's name, there is also a lot to be desired. Not all such searches can be conclusive; again, the best and safest way of ensuring that results are accurate is to conduct an in-person search in the actual physical records maintained at the Trademark Office's premises.

MYTH#3: THE TRADE MARK OFFICE IS OPEN ON REGULAR BUSINESS HOURS

False. As the Trademark Office actually belongs to the public sector, it operates under the special status and working hours that the public sector enjoys in Greece. Whether it is for routine matters, such as trade mark filings, or more urgent ones, such as late renewals or urgent searches, one may only access physically the Trademark Office between 10.00 and 14:00. These practical challenges for ensuring matters that need expedited

processing are dealt with accordingly are further enhanced by the fact that no electronic filings, such as those allowed by the OHIM for example, are yet allowed and indeed no actual plans of implementing such procedures have been publicly announced as of yet.

MYTH#4: GREEK TRADE MARK LAW IS FULLY HARMONISED WITH EU TRADE MARK LAW

Both **true** and **false**. There is a plan (a project already underway for a few years now) for revising the Greek Trademark Law (2239/1994), which is the Greek jurisdiction's main "pet peeve" in terms of fully implementing the EU Enforcement Directive 2004/48/EC. The completion of this project has been eagerly anticipated both by members of the industry and of course trade mark practitioners alike, as it would certainly improve and harmonise issues in relation to our European counter-parts.

MYTH#5: THERE IS A SPECIALISED TRADE MARK COURT (OR IP COURT) IN THE GREEK JURISDICTION

Both **true** and **false**. It is true that in 2006 the Ministry of Justice instituted

a special IP court, but what happens in practice is the following.

While an interesting division between 1) administrative courts (for trade mark oppositions, cancellations, recourses/appeals against Trademark Committee decisions, etc); and 2) civil courts (for infringement/unfair competition matters) continues to exist, the new IP court has been formed as part of the civil court system, located at the premises of the civil Court of First Instance, (of Athens, Thessaloniki and some other cities).

The new IP court is assigned to hear all IP matters; nevertheless, since even neighbouring-law matters are streamlined there, a great case-load has already been formed, not allowing for the court's much desired "specialisation". Hopefully in the future the IP court will have its own divisions, such as trade mark division, patent division, copyright division, etc. This would ensure that, in the years to come, slowly but surely Greek judges assigned to the particular IP court would gain the necessary specialisation and expertise, especially in terms of "dreaded" patent cases (nullity actions or infringements, etc) which are certainly in a league of their own at this time and cannot be confused with trade marks or other IP law issues.

In the meantime, what is important under the circumstances is to ensure that progressive ideas and plans are put to work, taking the Greek trade mark system forward.

All in all, the Greek trade mark system should be more technologically friendly, by fully updating its electronic database, including all device-only marks, freed of old-fashioned taboos of paper idolatry (that most lawyers have a soft spot for, not just trade mark practitioners); also, allowing for electronic filings, fully implementing EU legislation and putting emphasis on the IP court's specialisation would be important steps towards a new era, which, above all, should include a forum for suggestions in an open form, and not behind closed doors.

Eleni Lappa, *Drakopoulos Law Firm*, www.drakopoulos-law.com

Pharma-marks in France: identifying generic drugs



Patrick Boyle

A debate on pharmaceutical trade marks in France: when is it legitimate to make unauthorised use of a registered trade mark? In two separate developments, the enforcement of pharmaceutical trade mark rights against generic drugs has come under scrutiny. **Patrick Boyle** reports...

competition proceedings were brought by the proprietor and GSK.

In a judgment of 16 November 2004, the Paris Court of First Instance rejected the unfair competition claim and declared that use of a registered trade mark belonging to a third party would be legitimate if the generic drug equivalent had been duly recorded on the register of generic drug names. However, the court noted that at the time the advertising occurred, the generic name had not been entered on the relevant register of generic drug names. As a result, the court upheld the claim for trade mark infringement and the defendant was ordered to pay €30,000 in damages.

On appeal, the original defendant was substituted by the company SANDOZ and by a decision dated 3 May 2006³, the Paris Court of Appeal confirmed the findings at first instance and increased the award of damages payable to the amount of €100,000.

The company SANDOZ further appealed to the Cour de Cassation and by decision dated 26 March 2008², the court overturned the decision of the Paris Court of Appeal and held that the use of the registered trade mark DEXORAT was legitimate and did not constitute an act of trade mark infringement. In particular, ruling on points of law only, the court considered that such use constituted legitimate comparative advertising under the provisions of Art L 121-8 of the Consumer Code.

The first concerns the final chapter of litigation relating to use of the trade mark DEXORAT, in which the Versailles Court of Appeal disagreed with the earlier findings of the Cour de Cassation to hold that use by a generic drug manufacturer of the corresponding registered trade mark was not legitimate. The second concerns a proposed change to legislation that seeks to limit the scope of enforcement of intellectual property rights in the shape or texture of orally administered pharmaceuticals against the use of generic drugs.

ON 17 September 2009, the Versailles Court of Appeal issued a decision¹ that contradicted the earlier findings of the Cour de Cassation² to hold that use of the registered trade mark DEXORAT was not legitimate to market the generic drug equivalent.

The trade mark DEXORAT had been registered by Beecham Group Plc in 1992 and had been used by GlaxoSmithKline (GSK) to market an antidepressant in France since 1995. The company G Gam obtained regulatory authorisation to market a pharmaceutical "Paroxetine G Gam 20 mg" on 6 August 2002 and this was recorded on the register of generic drug names on 10 May 2004.

During the course of 2003, the trade mark proprietor became aware of the following advertising use of their trade mark: "forthcoming launch of paroxetine G GAM (generic equivalent of DEXORAT...)". A seizure was made and trade mark and unfair

Moreover, the Cour de Cassation viewed such use as a legitimate reference to a generic substitution drug under the terms of Art L 5121-1 of the Health Code, to the extent that it duly informed the relevant public that the generic version of the drug had the same active ingredient composition, tablet shape and bioequivalence as the branded version. The case then reverted to court of appeal level (Versailles Court of Appeal), in order to resolve all points of fact in relation to the trade mark infringement claim.

The Versailles Court of Appeal considered that in accordance with Art L 5121-1 of the Health Code, a generic drug has a specific regulatory status and that as such, all advertising use must explicitly state that it is a generic version, as was the case in the present instance.

On the issue of comparative advertising, the court did not find any justification for the use to the extent that the advertising use in question did not seek to compare or in any way copy or imitate the trade mark but rather to indicate to the consumer that it was an equivalent.

The court went on to examine of whether use of the trade mark DEXORAT was a necessary reference within the meaning of Art L 713-6 of the Intellectual Property Code, which transposes Art 6 c) of EC Directive N° 89/104. The court considered that the reference to spare parts in the aforementioned provision was not exhaustive and that the present circumstances could fall technically within the terms of this provision.

The court referred to the finding in the ECJ decision of 17 March 2005, (The Gillette Company, Gillette Group Finland Oy/LA Laboratoires Finland Oy) that “use of the trade mark by a third party who is not its owner is necessary in order to indicate the intended purpose of a product marketed by that third party where such use in practice constitutes the only means of providing the public with comprehensible and complete information on that intended purpose in order to preserve the undistorted system of competition in the market for that product”.

In this context, the court considered that reference to the international

non-proprietary name (INN), in this case “paroxetine”, may in itself have sufficed to provide comprehensible and complete information to health professionals without it being necessary to refer to the branded drug name, provided the dosage and intended medical purpose is stipulated, as was the case in the present instance. In this regard, the court rejected the argument that reference to the trade mark DEXORAT was the only means of informing the relevant public by which generic version a branded drug name may validly be substituted.

Crucially, the court took into account the fact that the relevant public was made up of pharmacists and health professionals who are considered to have a higher level of attention in the perception of branded and generic drug names. In particular, they are expected to have a thorough knowledge of INNs and are required, for reasons of security, to verify that any generic drug prescribed or substituted contains the same active ingredient in the same proportions as the branded equivalent and fulfils the same intended medical purpose.

Finally, the court found no justification for the trade mark use on the basis that in the marketing authorisation granted by the regulatory authorities, reference was made to the registered trade mark DEXORAT. The regulatory authorities are entitled to make such a reference for administrative purposes but this does not constitute an authorisation to use the trade mark in the course of trade.

In this regard, the court specifically rectified the finding by the Paris Court of First Instance, stating that the date of recordal on the register of generic drug names had no bearing on whether the use of the generic name was legitimate.

All of these findings led the Versailles Court of Appeal to the conclusion that the use of the trade mark DEXORAT was not necessary within the meaning of Art L 716-6 of the Intellectual Property Code. Consequently, the court confirmed that such use amounted to trade mark infringement. In terms of the damages awarded, the court considered that in the circumstances, the sum of €75,000 was sufficient to

repair the harm caused.

The upshot of the foregoing is reassuring for pharmaceutical companies wishing to prevent use of their trade marks by generic drug manufacturers. Such reassurance may however be short lived to the extent that a recent legislative amendment proposes to curtail intellectual property rights in the texture or shape of orally administered pharmaceuticals against use by generic drugs⁵.

The reason for this proposal stems from public health and safety concerns to the extent that it is argued that patients often identify orally administered pharmaceuticals by their shape, texture and colour. Consequently, in order to avoid errors in identification by patients in the context of substituted generic drugs, the proposed amendment seeks to limit the rights that may subsist in such elements, including copyright, designs and increasingly trade marks.

The exact parameters of any such limitation will not be known unless and until this amendment passes into law. In this regard, the proposal has met with significant opposition and as a result, the draft text has been referred to the Constitutional Court on 27 November 2009 for preliminary approval.

Against this backdrop, it can be concluded that whilst pharmaceutical companies are, for the time being, in a position to enforce their trade mark rights against generic drugs before the courts, there is political opposition which may result in statutory restrictions to their rights, at least in so far as shapes and colour trade marks are concerned. It would therefore appear that the source of underlying political and legal cross-currents between pharmaceutical and generic drug manufacturers is far from over.

Patrick Boyle, *Cabinet Plasseraud*,
boyle@plass.com

- 1 Versailles Court of Appeal 17 September Sandoz v SAS Laboratoire GlaxoSmithKline, Beecham Group Plc
- 2 Com, 26 March 2008 Sandoz v SAS Laboratoire GlaxoSmithKline, Beecham Group Plc N° 06-18.366
- 3 3 May 2006 DEXORAT : Juris data 2006, N° 302811
- 4 ECJ C -228/03 17 March 2005
- 5 Proposed modification to Art L.5121-10-03 of Public Health Code

THE JOINT EXAMINATION BOARD

95 Chancery Lane
London
WC2A 1DT

Tel: 020 7440 9375
Fax: 020 7430 9254
Email: sharon@jointexaminationboard.org.uk
Website: www.jointexaminationboard.org.uk

Notice On The Publication of the JEB 2009 Examination Results

Results for the 2009 examinations will be published on Monday 29th March 2010.

Individual letters informing candidates of their marks in the various papers will be posted on Friday 26th March 2010 so that they can be expected to arrive on Saturday 27th March 2010. The letters will be sent to the address given on the exam application form. **Any change of address must be notified to me by Friday 12th March 2010.**

In addition to posted letters we will send the results letter to candidates by email on Saturday 27th March 2010. If you would like to receive your results by email, please email me at Sharon@jointexaminationboard.org.uk with the email address your results should be sent to.

Please note that examination results **will not and cannot** be given out over the telephone.

The JEB, CIPA and ITMA will post the pass lists on their websites on Monday 29th March 2010 at 11am, so that candidates and others will be able to see the results that morning.

Please note that neither CIPA or ITMA will be able to answer questions about the results.

Sharon Mitchell
Secretary

December 2009

The Institute of Trade Mark Attorneys

The Chartered Institute of Patent Attorneys



Lee Curtis



Rebecca Tilbury



Lindsey Wrenn



Sharon Daboul

Harrison Goddard Foote is pleased to announce the appointment of **Lee Curtis** and **Rebecca Tilbury**, previously of Pinsent Masons, to its trade marks team. Lee and Rebecca are based in Harrison Goddard Foote's new office in central Manchester and can be contacted at Harrison Goddard Foote, 4th Floor, Merchant Exchange, 17-19 Whitworth Street West, Manchester M1 5WG, email lcurtis@hgf.com and rtilbury@hgf.com.

J A Kemp & Co is delighted to announce that, with effect from 1 February, **Tom Albertini** is joining the firm as an associate in the Trade Marks Group. Tom joins the firm from Groom Wilkes & Wright LLP.

Spencer Burgess has recently left Carratu International Plc to establish a new company, Eccora Ltd, which provides trade mark research

services to support clients in the establishment and development of trade mark and brand portfolios. Eccora and Carratu remain as affiliated companies. See www.eccora.com for details.

MW Trade Marks is delighted to announce the appointment of **Sharon Daboul** (above right) to its busy London office.

NEWS OF MEMBERS

James Love is delighted to announce that **Lindsey Wrenn** (Ordinary Member) has joined his practice as a consultant. James Love Legal was set up three years ago as a boutique IP practice and is based at One Sceptre House, Hornbeam Park Square North, Harrogate, HG2 8PB. Lindsey can be contacted at this address or by email on lw@jllip.com. Her direct telephone number is 0845 621 8007.

2010/11 Oxford IP Diploma Course

The Diploma is divided into two parts, the residential school and workshop. The residential school has 33 CPD hours and the workshop has 33 CPD hours. The residential school for next year will be between 6-17 September. Dates of the workshop will be confirmed in March/April. Information for the Diploma for 2010/11 can be found in March/April at

<http://denning.law.ox.ac.uk/postgraduate/odip.shtml>

Who's who in ITMA

Officers:

President:

Gillian Deas, gmd@dyoung.co.uk

First Vice President:

Maggie Ramage, maggie@ramage.co.uk

Second Vice President:

Catherine Wolfe, cwolfe@boulton.com

Immediate Past President:

Philip Harris, pwh@gje.co.uk

Chief Executive:

Keven Bader, keven@itma.org.uk

Treasurer:

Chris McLeod, chris.mcleod@hammonds.com

Secretary and Registrar:

Margaret Tyler MBE, margaret@itma.org.uk

Committee Chairmen:

IPREG: Kate O'Rourke, kate.o'rourke@charlesrussell.co.uk

Designs: Simon Bentley, simon.bentley@patentable.co.uk

Education & Training: Robert Furneaux, rfurneaux@iprights.com

Trade Mark Administrators' Course:

Tom Farrand, tfarrand@hgf.com

General Purposes & Finance:

Imogen Wiseman,

imogen.wiseman@fjcleveland.co.uk

ITMA Review: Tania Clark, tclark@withersrogers.com

Laws & Practice: Stephen James, sjames@jenkins.eu

Book: Mark Hiddleston, mark.hiddleston@elkiffe.com

Programme: Katie Cameron, kcameron@jenkins.eu

PR and Communications: Tom Farrand,

tfarrand@hgf.com

Administration:

Gillian Rogers, gillian@itma.org.uk

Joy Dublin, joy@itma.org.uk

Valerie Rice, val@itma.org.uk

Jane Attreed, jane@itma.org.uk

Geraldine Flood, geraldine@itma.org.uk

Lauren Boosey, lauren@itma.org.uk

Public Relations Manager: Ken Storey,

ken.storey@btinternet.com

Editor, ITMA Review: Kelly Robson,

kellyrobson@btinternet.com



Lifetime Achievement Award

Penny Nicholls (left) has retired from the trade mark practice at D Young & Co after 30 years as a trade mark advisor, but remains as a board member of IPReg. She was delighted to receive the Lifetime Achievement award at the Informa World Leaders International IP Awards ceremony in December 2009.

FORTHCOMING EVENTS 2010

9 February	ITMA Charity Quiz Night	Ye Olde London Pub, London
16 February	ITMA Evening Meeting 'The pitfalls of rectification actions before the IPO' . By Charlotte Duly, Boulton Wade Tennant (1 CPD hour)	Royal College of Surgeons, London
16 March	ITMA Evening Meeting 'The Office for Legal Complaints - impact on trade mark attorneys' By Adam Sampson, Chief Ombudsman, OLC	Royal College of Surgeons, London
22-23 March	PTMG Spring Conference	Liverpool
24-26 March	ITMA Spring Conference - The Magic of Trade Marks (9 CPD hours)	The Waldorf Hotel, London
20 April	ITMA Evening Meeting 'High Court and Court of Appeal Decisions' Speaker tbc (1 CPD hour)	Royal College of Surgeons, London
22 June	ITMA Evening Meeting 'UK-IPO Decisions' By Geoff Weller, I-Pulse (1 CPD hour)	Royal College of Surgeons, London
6 July	ITMA Summer Reception	Westminster Boating Base, London
20 July	ITMA Evening Meeting 'ECJ & CFI Decisions' By Rigel Moss-McGrath, WP Thompson & Co. (1 CPD hour)	Royal College of Surgeons, London
14 September	ITMA Evening Meeting 'Reputation - where are we now?' By Kieron Taylor, Swindell & Pearson (1 CPD hour)	Tbc
29 Sept - 1 Oct	PTMG	Athens
26 October	ITMA Evening Meeting 'Managing your client's merchandise - using Trading Standards and Customs procedures to deal with counterfeits' Speaker tbc (1 CPD hour)	Tbc
23 November	ITMA Evening Meeting 'The Positives, Perils and Pitfalls of IP Mediation' By Michael Cover, Charles Russell (1 CPD hour)	Tbc

More details can be found at www.itma.org.uk. Bold type indicates an ITMA organised event.