

1. LAW

Trade Marks

GREECE

Pursuant to a Ministerial Decision that was made public on 20th August 2004, official fees for trademarks in Greece were doubled.

Unfortunately, instead of providing sufficient advance notice to all Greek and foreign trademark holders with trademarks in Greece, the decision itself, dated 16th August 2004, became effective immediately and was published in the Official Bulletin dated 20th August 2004.

MADRID PROTOCOL

Today, the Madrid Protocol enters into force with respect to the European Community. In this connection please also refer to ECTA Flashes 79 and 82 (www.ecta.org).

The compiled versions of

- COUNCIL REGULATION (EC) No 40/94 of 20 December 1993 on the Community trade mark;
- COMMISSION REGULATION (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark;
- COMMISSION REGULATION (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

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as amended further to this entry into force, is available on ECTA's website at www.ecta.org under the "members only" site".

COMMUNITY TRADE MARKS

- The Law Committee has submitted comments on:
 1. Draft Commission Regulation (EC) No.../2004 of (...) amending Regulation (EC) No. 2868/95 implementing Council Regulation (EC) No. 40/94 on the Community trade mark.

2. Draft Commission Regulation (EC) No.../2004 of (...) amending Regulation (EC) No. 2868/95 on the fees payable to the Office for harmonization in the Internal Market (Trade Marks and Designs).

The position paper can be found on ECTA's website at www.ecta.org under the heading "position paper".

2. OFFICE PRACTICE

- The Law Committee has submitted comments on Draft Guidelines concerning proceedings before the OHIM on licenses.

The position papers can be found on ECTA's website at www.ecta.org under the heading "position paper".

3. CASE LAW

The European Court of Justice

On absolute grounds for refusal

Case No: C-107/03 P

Date: 23 September 2004

Parties: Procter & Gamble Company vs OHIM

Concern: Refusal on basis of Article 7(1)(b) – devoid of any distinctive character - of Regulation No 40/94 of CTM application No 230680 – 3D bar of soap - applied for "soaps" in class 3.

- The examiner rejected the application on the ground that the sign consisted exclusively of a shape which resulted from the nature of the goods themselves, as provided for in Article 7(1)(e)(i) of Regulation No 40/94.
- The Board of Appeal confirmed the examiner's decision on the grounds,
 - . first, that the amendment of the original application for a figurative trade mark to an application for a three-dimensional trade mark substantially changed the application for a Community trade mark, contrary to Article 44(2) of Regulation No 40/94;
 - . second, that the sign consisted exclusively of the shape resulting from the nature of the goods themselves, as provided for in Article 7(1)(e)(i) of Regulation No 40/94;
 - . third, that the sign consisted of a shape of goods which was necessary to obtain a technical result, as provided for in Article 7(1)(e)(ii); and,
 - . fourth, that the sign was devoid of any distinctive character, as provided for in Article 7(1)(b) of Regulation No 40/94.
- The Court of First Instance annulled the decision of the Board of Appeal on the grounds,
 - . first, that the Board of Appeal had exceeded its jurisdiction in declaring inadmissible of its own motion the contested application for registration;
 - . second, that the Board of Appeal had infringed the applicant's rights of defence by failing to invite it to submit its observations on two new absolute grounds for refusal which it had applied of its own motion, namely those set out at paragraph 7(1)(b) and (e)(ii) of Regulation No 40/94; and,

. third, that the Board of Appeal had erred in law in refusing registration of the mark applied for on the ground that it consisted exclusively of a shape which resulted from the nature of the goods themselves, as provided for in Article 7(1)(e)(i). The Court of First Instance held that the latter provision does not apply when there are other shapes of soap bar in the trade without the features of the shape of the soap in issue (the *Soap bar shape* judgment, paragraph 55).

- The Third Board of Appeal dismissed the application for registration, being of the view, in essence, that that the sign in issue was devoid of any distinctive character, as provided for in Article 7(1)(b) of Regulation No 40/94.
- The Court of First Instance confirmed the Third Board of Appeal decision. The Court concluded that
 - . first the claimed shape was only a minor variation by comparison with typical shapes of soaps and,
 - . second, if the characteristics of the shape in issue were noticed by the relevant public, those characteristics would be primarily perceived as having a utilitarian function intended to enable the soap to be gripped easily,The Board of Appeal was therefore correct to decide that that shape is not capable of directly indicating a particular trade source to the relevant public.

Most relevant paragraphs:

On the infringement of Article 7(1) (b) of Regulation No 40/94: § 31-32-39-41-44-50

Outcome: Action dismissed.

The Court concluded that the action was mainly unfounded.

This decision can be retrieved at:

<http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=en&Submit=Submit&docrequire=alldocs&numaff=&datefs=&datefe=&nomusuel=&domaine=INTE&mots=&resmax=100>

4. ECTA NEWS

- ECTA will be represented at the Conference on the Accession of the European Community to Madrid Protocol - Geneva, October 7, by Sandrine Peters (ECTA Legal Co-ordinator).
- ECTA will be represented at the Benelux Trade Mark Association (BMM)'s Autumn meeting in Kaatsheuvel, Nederland on October 14 and 15, 2004, by Sandrine Peters (ECTA Legal Co-ordinator).
- ECTA's 48th Council Meeting will take place in Copenhagen from October 21 to 23, 2004.
- ECTA will be represented at the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), 13th Session, Geneva, October 25 to 29 by Jan Wrede (member of the Law Committee) and Sandrine Peters (ECTA Legal Co-ordinator).

4. COMMUNICATIONS

- The founder and former Director General of the World Intellectual Property Organisation (WIPO) and Secretary General of the International Union for the Protection of New Varieties of Plants (UPOV) for 24 years, Dr. Árpád Bogsch, passed away on 19 September 2004.

ECTA sends its sincere condolences to Dr. Bogsch's family, friends and former colleagues at WIPO.