

1. LAW**Trade Marks****Benelux**

Opposition procedure.

As mentioned in the ECTA Flash No. 76, one can file an opposition against a Benelux trade mark or an international trade mark with effect in the Benelux countries since January 1st, 2004.

It has been decided to open up the opposition procedure in phases. For the time being, opposition can be filed against an application (or an accelerated registration) filed after January 1st 2004 and relating to goods and services within at least one of the following classes: **2, 20 or 27**.

At its 135th meeting (on July 1st and 2nd, 2004) the Administrative Council of the Benelux Trademark Office has decided to open up the second group of classes namely classes **6, 8, 13, 15, 17, 19 and 21** as from January 1st, 2005.

It must be born in mind that opposition will only be possible against applications filed after the date of the opening of the classes.

As far as the date of the opening of the other two groups of classes is concerned, no decision has been taken.

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Information related to the opposition procedure and Benelux trademarks in general can be found on the website of the Benelux Trademark Office (www.bmb-bbm.org). We draw your attention to the fact the new guidelines related to the criteria of refusal on absolute grounds are also posted on the site. For the moment, they are only available in Dutch and French (under "Nieuws" or "Nouvelles") but the English version will be released very soon.

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Benelux Trade Mark Office

Poland

WIPO information notice 21/2004 regarding Polish collective and Guarantee marks filed through the Madrid and the Madrid Protocol systems can be found at: http://www.wipo.int/edocs/madrdocs/en/2004/madrid_2004_21.pdf

Trademark Law Treaty

On September 28, 2004, the Member States of the World Intellectual Property Organization (WIPO) agreed to convene a diplomatic conference on the revision of the Trademark Law Treaty (TLT). The Diplomatic Conference will be held in March 2006.

For further details please refer to WIPO's website at:

http://www.wipo.int/edocs/prdocs/en/2004/wipo_pr_2004_394.html

2. OFFICE PRACTICE

The OHIM has started its Pilot project on the "User satisfaction Questionnaire". ECTA is participating in this Pilot project through the Law Committee. A draft report on the conclusions of the Pilot project should be presented at the OAMI Users' Group meeting that will take place on November 29, 2004.

3. CASE LAW

Court of First Instance

On opposition

1. Case No: T-356/02

Date: 6 October 2004

Parties: Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG vs OHIM

Concern: Opposition filed by Krafft, SA on the basis of earlier trademark registrations for Krafft device in Spain (No 1924081-1924082-1160484-1042443-1052802) against CTM application No 303909 VITAKRAFT.

Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG claims that

- the intervener has not proved that the earlier marks were put to genuine use in respect of the products "greases and motor oils; lubricants" and "mortar and levelling paste for construction";
- the Board of Appeal made an incorrect comparative analysis of the two signs at issue.

Most relevant paragraphs:

- Infringement of Rule 22(2) CTMIR: § 32-33
- Infringement of Article 8(1)(b) CTMR – likelihood of confusion: § 50-55-56

Outcome: The action is well founded in so far the Board of Appeal wrongly held that Krafft, SA had provided proof of genuine use of the relevant earlier marks and contested goods as "*it is not sufficient for genuine use to appear probable or credible; actual proof of that use must be given*".

The remainder action is dismissed

2. Case No: T-117/3 to 119/3 and T-171/03

Date: 6 October 2004

Parties: New Look Ltd vs OHIM

Concern: Opposition filed by Naulover, S.A. on the basis of earlier CTM registration No 13417 for NL device against CTM applications No 816454 – NLJEANS, No 816512 – NLSPORT, No 816629 NLACTIVE and No 1082809 NL Collection. Dispute concerns goods of class 25.

The opposition division dismissed the oppositions essentially as it considered that the marks in question were visually and phonetically different and that none of them had any particular conceptual meaning.

The Board of appeal annulled the decisions and considered that the opposing Community trade marks were phonetically and conceptually similar because the letter combination “NL” which constitutes the earlier trade mark is reproduced as the dominant element in the opposed marks.

Most relevant paragraphs:

- Infringement of Article 8(1)(b) CTMR – likelihood of confusion: § 28 (“it is necessary to compare the signs as they are protected and not as they might be perceived by the consumer”) – 30 – 35 – 37 – 43 – 49 – 52.

Outcome: Action dismissed.

The Court confirmed that there is a likelihood of confusion of the mark despite the fact that the earlier mark consists of a particular written form of the letter combination “NL” whose appearance differs from that of the letters “NL” of the opposed marks.

Article 8(1)(b) of CTMR requires that there exist a likelihood of confusion and not that the confusion be established. Given the identity of the goods and the conditions under which they are marketed (see §50-51), the degree of similarity between the signs suffices to establish the existence of a likelihood of confusion between the marks under consideration.

3. Case No: T-35/03

Date: 12 October 2004

Parties: Aventis CropScience SA vs OHIM

Concern: Opposition filed by Aventis CropScience SA on the basis of earlier Spanish trade mark registration No 1731865 – HARPO Z registered for “preparations for destroying vermin, fungicides and herbicides” against CTM applications No 1324086 – CARPO, applied for “Fungicides, herbicides, insecticides, pesticides”.

Both the opposition division and the Board of Appeal considered that there was no likelihood of confusion between the marks as the signs are not similar.

Most relevant paragraphs:

- Infringement of Article 8(1)(b) CTMR – likelihood of confusion: § 22 (the addition of the letter Z is distinctive and does not refer to a line extension of the HARPO mark for the public concerned (medical specialist)) - 27.

Outcome: Action dismissed.

The court considered the signs not being confusingly similar as on a visual, phonetic and conceptual (one of the marks (carpo) is evocative of a meaning namely “wrist” and the other not) point of view.

European Court of Justice

I. On absolute grounds for refusal

Case No: C-136/02 P

Date: 7 October 2004

Parties: Mag Instruments Inc vs OHIM

Concern: Refusal on basis of Article 7(1)(b) – distinctive character - of Regulation No 40/94 of CTM application Nos 139527, 119552, 206789, 206698 and 206870 – Three-dimensional torch shapes, applied for “apparatus for lighting, in particular flashlights (torches), including parts and accessories for the above named goods” in classes 9 and 11.

The examiner refused the CTM applications on the ground that the marks were devoid of any distinctive character.

The Board of Appeal confirmed the examiner’s refusal and concluded that notwithstanding the many appealing attributes each shape possesses, none is inherently distinctive to the average purchaser of a torch.

The Court of First Instance concluded that the marks as applied for are not capable of differentiating the goods or of distinguishing them from those of a different commercial origin.

Most relevant paragraphs:

- on the assessment of the distinctive character of the marks: § 31 – 32.
“where a three-dimensional mark is constituted by the shape of the product for which registration is sought, the mere fact that that shape is a ‘variant’ of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention”.
- on the assessment of the consumer’s perception of the marks: § 49 – 50
“...even if...that assessment must be carried out in relation to the presumed expectations of an average consumer of the goods or services in respect of which registration is sought, who is reasonably well informed and reasonably observant and circumspect, the possibility remains that evidence based on the actual perception of the mark by consumers may, in certain cases, provide guidance to the Office or, where a challenge is brought, the Court of First Instance.
However, in order to contribute to the assessment of the distinctiveness of a mark for the purposes of Article 7(1)(b) of Regulation No 40/94, that evidence must show that consumers did not need to become accustomed to the mark through the use made of it, but that it immediately enabled them to distinguish the goods or services bearing the mark from the goods or services of competing undertakings”....

Outcome: The appeal has been dismissed.

II. On opposition

Case No: C-106/03 P

Date: 12 October 2004

Parties: Vedial SA vs OHIM

Concern: Opposition filed by Vedial SA, on the basis of earlier French trade mark registration No 1552214 for Saint-Hubert 41 registered for “butters, edible fats, cheeses and all dairy products” in class 29 device against CTM applications No 108538 – Saint HUBERT device applied for goods and services of classes 29, 30 and 42. The contested are “milk and milk products” in class 29 and “vinegar, sauces” in class 30.

The opposition had been rejected by the Opposition Division as it considered that the marks were not confusingly similar.

This decision has been confirmed by the Board of Appeal which considered that even though there was a high degree of similarity between the goods in question and even though, for the purposes of the application of that provision, it was possible to take account of the reputation of the earlier mark demonstrated to it by Vedial, there was no likelihood of confusion in the mind of the public concerned since the conflicting marks did not display strong similarities

The Court of First instance further confirmed the decision and concluded that even though there is identity and similarity between the goods covered by the conflicting marks, the visual, aural and conceptual differences between the signs constitute sufficient grounds for holding that there is no likelihood of confusion in the mind of the targeted public.

Outcome: The appeal has been dismissed. In paragraph 53 and 54, the ECJ states that:

“After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment, that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No 40/94.

Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned.”

These decisions 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

- **Conference on the Accession of the European Community to Madrid Protocol** - Geneva, October 7

WIPO's press release in connection with this conference can be found at: http://www.wipo.int/edocs/prdocs/en/2004/wipo_pr_2004_398.html

What could be added to the information provided by the press release is:

1. Mr. Ernesto Rubio (Assistant Director General – WIPO) gave an outline of the actual situation of IR filings and the possible expectations:

Figures to be noted are:

- From January to September 2004 WIPO has registered an increase of 6,77% of IR registrations, of 16,56% of IR subsequent designations and 15,61% of renewals (in comparison with the same period of 2003).
- About 70% of the IR originated from the EC countries.
- The US has become the 6th biggest IR filer (about 6% of the IR filed in the nine first months of 2004).

Will all these filers shift to the IR system for filing CTM?

13 IR were requested at OHIM on 1 October 2004 and EC designations have already been requested at WIPO.

2. Mr. Erik Nooteboom (Head Industrial Property Unit, Directorate General of the Internal Market EC) and Mr. Detlef Schennen (Head, IP Matters Service, OHIM) have explained how the OHIM will deal with EC designations in IRs and with IRs filed through OHIM.

It is interesting to note that in connection with EC designations in IRs, the OHIM will sent 2 statements of grant namely

- within 6 months from filing (in about 70% of the cases) to inform the applicant that the designation has encountered no problem during the examination on the relative grounds for refusal.
- within 10-11 months from filing should no opposition be filed (about 80% of the cases).

By doing so the OHIM will in most of the cases provide a statement of grant well before the 18 months.

3. Mr. Detlef Schennen also outlined the advantages for the OHIM and for the Industry to designate EC in the IR versus filing CTM at the OHIM.
4. Mr. Denis Cohen (Head, International Registration Systems Legal Section, Legal Department, Sector of Trademarks, Industrial Designs and Geographical Indications, WIPO, Geneva) reviewed the “frequently asked” questions raised at WIPO in connection with the link:

- On fees, there were no complaints as to the “high” amount but there were some concerns as to the possible reimbursement in case of failure.
- Seniority Claims: documentary evidence can be filed either at WIPO together with the IR filing or directly at OHIM at any time.
- 2nd language: the indication of a 2nd language is always needed despite the fact that an IR is always filed in one of the OHIM languages.
- What if on October 1, 2004 an IR already designated an EC country and that a further designation to the EC is requested: there will be duplication and there will be no automatic deletion of the earlier national EC designation.

5. Finally some representatives from industry namely, Mr. Owen Malone (Foster's Group, Australia), Ms Jane Collins (Syngenta, Switzerland), Mrs. Tove Graulund (Arla Foods, Denmark), Dr. Gerhard Bauer (Daimler Chrysler, Germany) and Mrs. Ingrid Desrois (Previously with Procter & Gamble, France) explained their trade mark portfolio strategies in order to cover the EC countries before and after 1 October 2004.

It is to be noted that there seems to be an agreement that an IR should not be based on a CTM but rather on a home country basis.

All the speakers pointed out the fact that some major countries are missing in the Madrid – Madrid Protocol systems such as the Latin American countries and Canada.

One speaker voiced his disagreement in that registration fees for failed EC designations in IR are only reimbursed in case the mark has been refused on absolute grounds or further to an opposition. Indeed, under the “national” CTM system, no registration fee is to be paid, should the CTM be dropped voluntarily without being refused or having been faced with the filing of an opposition.

Reported 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).
- ECTA will be represented at the **11th OAMI Users Group Meeting** on November 29, 2004 by João Peireira da Cruz (Chairman of the OHIM Link Committee) and Sandrine Peters (ECTA-Legal Co-ordinator).