

No. 89, November 2, 2004

1. LAW**Counterfeiting**

In ECTA Flash 81 dated June 30, 2004 we informed you that on the 1st of July 2004 **Council Regulation (EC) No 1383/2003** of 22 July 2003 *concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights* (http://europa.eu.int/eur-lex/pri/en/oj/dat/2003/l_196/l_19620030802en00070014.pdf) will enter into force in all 25 Member Countries of the enlarged European Union.

Please be informed that the Commission Regulation No (EC) 1891/2004 laying down provisions for the implementation of Council Regulation (EC) No 1383/2003 is to be published in the Official Journal L No 328 of 30th October 2004.

Domain Names**.EU**

On 12 October 2004, the European Commission has signed with EURid the contract enabling EURid to set the .eu mechanism in motion and permit the registration of .eu domain names.

For further details, please refer to:

http://europa.eu.int/information_society/topics/ecom/all_about/todays_framework/public_resources/names_addresses/eu_creation/index_en.htm

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or
<http://www.eurid.org/News/developments.html>

Trade Marks**Community trade marks/Madrid Protocol**

With the accession of the European Community to the Madrid Protocol, the OHIM draws your attention to the existence of their web page providing you with all necessary information and links in this connection.

<http://oami.eu.int/EN/mark/madrid/>

2. OFFICE PRACTICE

Community Trade Mark

- The Law Committee has submitted comments on the:
 1. Draft Guidelines Concerning Proceedings before the OHIM: Part E, Section 2: Conversion.
 2. Draft Guidelines Concerning Proceedings before the OHIM: Part B, Examination.
- The Law and Design Committees have submitted additional comments on the Draft Guidelines concerning proceedings before the OHIM on licenses (See also ECTA Flash 87 dated 1 October, 2004).

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

- The OHIM has decided to inform applicants of the positive results of the examination process of their application as soon as completed.
For further details, please refer to Communication No 11/04 of the President of the Office dated 21 October 2004:
<http://oami.eu.int/en/office/aspects/communications/11-04.htm>
- The OHIM has decided to accept disc version of US certified copies as valid priority documents for Community Design applications.
For further details, please refer to Communication No 12/04 of the President of the Office dated 2 October 2004: <http://oami.eu.int/EN/office/aspects/communications/12-04.htm>

3. CASE LAW

European Court of Justice

On absolute grounds for refusal

1. Case No: C-64/02 P

Date: 21 October 2004

Parties: Erpo Möbelwerk GmbH vs OHIM (Appeal brought by the OHIM)

Concern: Refusal on basis of Article 7(1)(b) – distinctive character - of Regulation No 40/94 of CTM application No 806620 – DAS PRINZIP DER BEQUELMELICHKEIT, applied for "tools (hand-operated); cutlery" in class 8, and "household furniture, in particular upholstered furniture, seating, chairs, tables, unit furniture, as well as office furniture" in class 12.

The examiner refused the CTM application on the ground that the word combination designated a characteristic of the goods concerned and was devoid of any distinctive character.

The Board of Appeal annulled the examiner's decision to the extent to which he had rejected the claim for products in class 8. As far as the goods of class 20 are concerned,

the Board considered that the slogan does not meet the requirements of Article 7(1)(b) and (c) and (2) of the Regulation.

The Court of First Instance annulled the Board of Appeal's decision.

Most relevant paragraphs:

- The ECJ confirms that the Court of First Instance was right to annul the contested decision for imposing a different and stricter criterion for assessing the distinctiveness of trade marks consisting of advertising slogans (§36). The Court, however, recognizes that it may prove more difficult to establish distinctiveness for some categories of mark than for others as the relevant public's perception is not necessarily the same for each category of marks (§34).
- Further in §46, the Court states that by considering that a trademark is not devoid of distinctive character within the meaning of Article 7(1)(b) of the Regulation unless it is demonstrated that the phrase concerned is commonly used in business communications and, in particular, in advertising, the Court of First Instance applied a criterion other than the one laid down by Article 7(1)(b) of the Regulation.

Outcome: The appeal is dismissed. Indeed, despite the fact that the grounds of a judgment of the Court of First Instance reveal an infringement of Community law, the operative part appears well founded on other legal grounds.

2. Case No: C-447/02 P

Date: 21 October 2004

Parties: KWSS Saat AG vs OHIM

Concern: Refusal on basis of Article 7(1)(b) – distinctive character - of Regulation No 40/94 of CTM application No 773630 – colour per se - ORANGE, applied for goods and services of classes 7, 11, 31 and 42 including certain treatment installations for seeds and for certain agricultural, horticultural and forestry products.

The examiner refused the CTM application on the ground that the mark was not distinctive within the meaning of Article 7 (1)(b).

The Board of Appeal dismissed the Appeal.

The Court of First Instance partly annulled the Board of Appeal's decision namely as far as the services of class 42 were concerned.

Most relevant paragraphs:

- The grounds of appeal were merely procedural and the Court has dismissed KWSS on all these grounds.
- As to the criteria governing the distinctive character of the different categories of trade marks, the Court repeated what has been stated in previous cases namely that a stricter test of distinctiveness for colour marks does not apply but that the relevant public's perception is not necessarily the same in the case of a sign composed of a colour per se as it is in the case of a word or figurative mark, where the sign is independent of the appearance of the goods it identifies. Indeed, while the public is accustomed to perceiving word or figurative marks immediately as signs identifying

the commercial origin of the goods, the same does not necessarily hold true where the sign forms part of the external appearance of the goods - §78.

In the case of a colour per se, distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific - §79.

Outcome: The appeal is dismissed.

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

- **ECTA 48th Council Meeting** was held in Copenhagen from October 21 to 23, 2004 and was attended by 46 Council members and by an additional of 49 committee members.

The meeting was also attended by a special guest, Lyn Minto, accompanied by her daughter Fiona. ECTA was most pleased to invite her in gratitude for the long service rendered by David Minto in the Association and as a token of our esteem for them.

The Committees met on the first day and the Council on the Friday morning.

On the Friday afternoon, all attendees were invited to join an interesting roundtable on "Views about a Merged and Harmonized Protection of *"Signs" in EU (Trade Marks, Trade Names, Company Names, Domain Names, Business Identifiers, Titles, etc)*" presented by Professor Jens Schovsbo from the Copenhagen University which was followed by a lively question and answer session. The Secretariat will not fail to make available to its members a written paper reflecting the discussion as soon as possible.

The whole conference was very well organized and the management takes this opportunity to hereby congratulate the organizers.

Reported by, 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).
- ECTA 51th Management Committee Meeting will take place on November 23, 2004 in Antwerp.