



European Communities Trade Mark Association



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[TRADE MARK SERVICES](#)

1 LAW

1.1 Trade Marks

OHIM Cooperation Fund - Kick off meetings in Alicante in January 2011

9 working groups related to "Packet 1" (ref to [FLASH 22-10](#)) will meet in Alicante for kick off meetings during the last week of January 2011.

The 4 ECTA experts accepted will attend the kick off meetings as follow:

- 27 January: Andreas Renck (Chair of the ECTA OHIM Link Committee) for seniority project;
- 27-28 January: Doris Bandin and Cristina Bercial-Chaumier (Members of the ECTA Law Committee) for similarity of goods and services project;
- 28 January: Elena Sonn (Vice Chair of the ECTA Design Committee) for Designview.

The ECTA experts will report to and liaise with Fabio Angelini, Chair of the ECTA Law Committee, António Andrade, Chair of the ECTA Design Committee and the ECTA Management Committee.

1.2 Enforcement

IPR enforcement consultation launched by DG MARKT - Deadline of 31 March 2011 to comment

The European Commission has launched a consultation on its report on the enforcement of intellectual property rights. The



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report looks at the impact of the 2004 enforcement Directive and the changes in the IPR environment. The conclusions of the report mentioned that infringements of IP rights cause enormous economic harm (threat to consumer health and safety). Proper protection of IP rights is necessary to stimulate innovation and culture. Various interests should be balanced and the Commission is willing to continue to be actively engaged with all stakeholders. It is also mentioned that the Directive has positive effect on the protection of IP rights by civil law in Europe. Nevertheless, the Directive has not been designed with the challenge posed by the Internet to the enforcement of IP rights in mind. There are also several issues which need more attention such as use of provisional and precautionary measures (injunctions, procedures to gather and preserve evidence, clarification of the meaning of various corrective measures including the costs of destruction, and calculation of damages).

The ECTA Anti-Counterfeiting Committee is currently working on comments to be provided prior to the deadline of 31 March 2011.

All documents from DG MARKT can be found [HERE](#)

Council of Europe Convention to fight against counterfeit medical products adopted on 9 December 2010

The Council of Europe Committee of Ministers adopted on 9 December 2010 a convention called MEDICRIME which, for the first time, criminalises the counterfeiting and also manufacturing and supplying of medical products placed on the market without authorisation or without being in compliance with security requirements. The press release can be found [HERE](#).

1.3 Geographical Indications

Commission's proposed quality package - Quality policy reforms

The EU Commission published on 10 December 2010 a proposal for amendment and reinforcement of its quality policy affecting its GIs regulations and related matters.

The Quality Package comprises:

- A [proposal](#) for a new 'Agricultural Product Quality Schemes Regulation' (replacing the PDO/PGI Regulation No 510/2006), in order to bring more coherence and clarity to the EU schemes (PDOs, PGIs and TSGs) and laying down a new framework for the development of Optional Quality Terms. This should enable to gather the terms PDOs and PGIs into a single legislation and introducing a common, simplified and shortened registration procedure for PDOs, PGIs and TSGs (Traditional Specialties Guaranteed).
- A [proposal](#) to streamline adoption of marketing standards by the Commission;
- [New Guidelines](#) on best practices for voluntary certification schemes and on the labelling of products using geographical



indications as ingredients.

According to the Commission, the Quality Package sets up for the first time a comprehensive policy on certification schemes, value-adding terms for agricultural product qualities, and product standards. Until now these have been spread among numerous pieces of legislation. The legislative proposals have been forwarded to the European Parliament and the Council and their adoption is expected by 2012.

Commission's press release can be found [HERE](#) and all documents (guidelines, legislative proposals and other information) can be found [HERE](#)

The Geographical Indications Committee is currently analyzing the proposal for a Regulation on agricultural product quality schemes in order to provide DG AGRI with its comments in the coming weeks.

2 OFFICE PRACTICE

2.1 OHIM

CTM publication letter replaced by e-mail "alert" system

OHIM will stop sending a letter (L124) to applicants or their representatives to inform them about the publication of a CTM application in part A of the CTM Bulletin from 1 February 2011. This change follows the introduction of CTM Watch e-mail "alerts", available in CTM E-Filing. The e-mail "alert" feature requires logging into MyPage and is then only available to users of the password-protected platform. Details on how to set up an alert can be found [HERE](#)

Ireland and Malta joined the EuroClass project

The Irish and the Maltese Patent Offices have agreed to adopt the harmonised list of goods and services for trade marks as drawn up by the UKIPO and OHIM by joining the EuroClass project on 13 December 2010. This is part of a project to create a common list, with approved translations, accepted by participating EU trade mark offices and other international partners. The complete communication can be found [HERE](#)

Trilateral to investigate joining Tmview

As mentioned in Flash [21-10](#), the 9th annual trilateral meeting of USPTO - JPO - OHIM took place in Tokyo on 7-9 December 2010. The USPTO and Japan Patent Office have agreed to set up a working group to analyse the technical requirements for joining the Tmview project, which aims to create a common searchable database of trade marks in the EU



and beyond. The possibility of cooperation on TMview was one of a number of projects discussed at this meeting which included WIPO, user representatives and other international partners as observers. The Joint Statement of Trilateral can be found [HERE](#)

Streamlining OHIM's RCD communications

Since OHIM's new system of Electronic Certificates for RCDs was introduced on 15 November 2010, users had been receiving two letters - one sent for each application to announce that the design is being published and another sent within days for each design saying that the registration certificate is available for downloading online. In order to rationalise and make clearer the information sent to users, for all RCDs published from 20 December 2010, OHIM is merging these two letters. From this date, a single letter will go to users informing them that RCD will be published during the following 1-2 days and that the RCD certificate will be available online the day following publication.

OHIM "closures" in 2011

OHIM published its official list of days when the Office will not be open for the receipt of documents in 2011 and on which ordinary mail is not delivered. The Decision of the President of the OHIM can be found [HERE](#)

2.2 WIPO

Madrid Protocol - Issuance of statement of grant of protection mandatory since 1 January 2011

Since 1 January 2011, following implementation of rule changes agreed in September 2009, all designated offices for a Madrid Protocol application have to issue a statement of grant of protection when the examination is finalised. The statement will be issued when there has been no problem with the application, when the relevant opposition period has ended without any opposition being filed or if there has been an opposition, when that has been dealt with.

Launching of on-line tool Madrid System Goods & Services Manager

On 20 December 2010, WIPO launched the Madrid System Goods & Services Manager (G&S Manager), a new online tool that enable trade mark applicants to compile the list of goods and services when filing an international application under the Madrid System for the international registration of marks. G&S Manager gives access to thousands of standard terms in English, French and Spanish, classified in accordance with the 9th edition of the Nice Classification, and other language versions are currently under preparation in cooperation with the trade mark offices of other Madrid Union members such as OHIM.

The complete communication can be found [HERE](#)



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Launching of the International designs renewal interface "e-renewal"

Since 23 December 2010, an electronic interface for the online renewal of international Registrations "e-renewal" is available on the Hague system website. The e-renewal interface presents users with the ability to specify the scope of renewal of their international registrations in a more granular manner than which may be requested via the paper renewal form (DM/4). The complete communication can be found [HERE](#)

Hague Agreement - Partial withdrawal of Danish declaration contained in the instrument of ratification of the 1999 Act

In a communication to WIPO dated 17 November, the Danish Patent and Trademark Office specified that the 1999 Act would apply to Greenland in respect of designations of Denmark in international registrations bearing a date of January 11, 2011, or later. The complete communication can be found [HERE](#).

Non working days for 2011

The list of non working days for 2011 can be found [HERE](#)

3 CASE LAW

Summaries and case law provided by

GENERAL COURT

On absolute grounds for refusal

Case [T-497/09](#) of 16 December 2010, LG Electronics, Inc. vs. OHIM (contested decision: R 397/2009-1 of 23 September 2009)

Trade mark:

KOMPRESSOR PLUS



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**Class: 7**

Decision: The trade mark is descriptive. The element 'kompressor' will be understood by the relevant public as referring to a characteristic of a vacuum cleaner, namely its multi-functional character which enables it to be used as a compressor when a removable tube is attached to the end of the vacuum cleaner system (para. 20).

The Board of Appeal's decision is upheld.

Case [T-161/09](#) of 16 December 2010, Ilink Kommunikationssysteme GmbH vs. OHIM (contested decision: R 1849/2007-4 of 5 February 2009)

Trade mark:**ilink****Classes:** 9,38

Decision: The trade mark is descriptive. The relevant public will understand the mark to mean 'Internet link' and hence to mean that it has a link with the Internet (devoid of any distinctive character) (para. 36).

The Board of Appeal's decision is upheld.

Case [T-281/09](#) of 16 December 2010, Deutsche Steinzug Cremer & Breuer AG vs. OHIM (contested decision: R 1429/2008-4 of 8 May 2009)

Trade mark:**CHROMA****Classes:** 11,19

Decision: The trade mark is descriptive. From the point of view of the relevant Greek-speaking consumer, the sign could serve to indicate that the goods concerned in Classes 11 and 19 are available in various colours and it therefore designates a relevant characteristic in terms of the marketing of the goods in question (para. 41).

The Board of Appeal's decision is upheld.



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Case [T-346/08](#) of 17 December 2010, Chocoladefabriken Lindt & Sprüngli vs. OHIM(contested decision: R 943/2007-4 of 13 June 2008)

Trade mark:



Class: 30

Decision: The trade mark is devoid of any distinctive character. The characteristics of the red ribbed ribbon with bell of the mark applied for are not sufficiently different from those of the basic shapes commonly used to decorate the wrapping of chocolate goods (para. 36).

The Board of Appeal's decision is upheld.

Case [T-13/09](#) of 17 December 2010, August Storck KG vs. OHIM (contested decision: R 185/2006-4 of 12 November 2008)

Trade mark:





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Class: 30

Decision: The trade mark is devoid of any distinctive character. The mark applied for is made up of a combination of standard presentation elements, typical of the goods concerned. It seems to be a variation of the basic shapes commonly used in the confectionery sector and, since the alleged differences are not readily perceptible, it does not significantly differ from the norm or the conventions of that sector (para. 44).

The Board of Appeal's decision is upheld.

Case [T-395/08](#) of 17 December 2010, Chocoladefabriken Lindt & Sprüngli vs. OHIM (contested decision: R 419/2008-4 of 18 July 2008)

Trade mark:



Class: 30

Decision: The trade mark is devoid of any distinctive character. The characteristics of the combination of the shape and colour of the mark applied for are not sufficiently different from those of the basic shapes commonly used for the wrapping of chocolate and, in particular, of chocolate bunnies (para. 43).

The Board of Appeal's decision is upheld.

Case [T-336/08](#) of 17 December 2010, Chocoladefabriken Lindt & Sprüngli vs. OHIM (contested decision: R 1332/2005-4 of 11 June 2008)

Trade mark:



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Class: 30

Decision: The trade mark is devoid of any distinctive character. The characteristics of the combination of the shape, the colours and the red ribbed ribbon with bell of the mark applied for are not sufficiently different from those of the basic shapes commonly used for the wrapping of chocolate and chocolate goods and, in particular, of chocolate bunnies (para. 48).

The Board of Appeal's decision is upheld.

Case [T-337/08](#) of 17 December 2010, *Chocoladefabriken Lindt & Sprüngli vs. OHIM* (contested decision: R 1332/2005-4 of 11 June 2008)

Trade mark:



Class: 30

Decision: The trade mark is devoid of any distinctive character. The characteristics of the combination of the shape, the colours and the red ribbed ribbon with bell of the mark applied for are not sufficiently different from those of the basic shapes commonly used for the wrapping of chocolate and chocolate goods (para. 41).



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The Board of Appeal's decision is upheld.

On relative grounds for refusal

Case [T-132/09](#) of 15 December 2010, Epcos AG vs. OHIM - Epcos Sistemas SL
(contested decision: R 1088/2008-2 of 19 January 2009)

Trade marks:

Earlier trade mark	Community trade mark applied for

Class: 9

Decision:

1. Genuine use of the earlier trade mark in Spain was shown for 'measuring apparatus, all being for the measurement of temperature, pressure and level' in class 9 (para. 57).
2. There is a certain degree of similarity between the 'measuring apparatus, all being for the measurement of temperature, pressure and level' covered by the earlier mark and the 'thermistors, PTC thermistors, sensors' for which registration is sought (para. 69).
3. The trade marks are visually (para. 75 to 78) and aurally (para. 79 to 86) similar. There is a likelihood of confusion (para. 91).

The Board of Appeal's decision is upheld.

Case [T-331/09](#) of 15 December 2010, Novartis vs. OHIM - Sanochemia Pharmazeutika AG (contested decision: R



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1601/2007-1 of 18 June 2009)

Trade marks:

TONOPAN	TOLPOSAN
Earlier trade mark	Community trade mark applied for

Class: 5

Decision:

1. There is at most a slight similarity between "analgesics which soothe pain, in particular in treating headaches and migraines" and "muscle relaxant medicines containing tolperison; muscle relaxant veterinary preparations containing tolperison" (para. 42).
2. On the visual and phonetic levels, the signs at issue have an average degree of similarity (para. 47 to 53).
3. Taking into account the fact that (i) the goods at issue are only slightly similar and the trade marks at issue have an average degree of similarity and that (ii) the relevant public has a higher degree of attentiveness than average, there is no likelihood of confusion (para. 58).

The Board of Appeal's decision is upheld.

Case [T-451/09](#) of 15 December 2010, Harry Wind vs. OHIM - Sanyang Industry Co. Ltd (contested decision: R 1470/2008-4 of 3 September 2009)

Trade marks:

	
Earlier trade mark	Community trade mark applied for



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Classes: 12,37

Decision: "ATV's, senior people carts, electric motorcycles, sports motorcycles, electric scooters, electric bicycles, motorcycles and their parts" (cl. 12) are not similar to "motor vehicle bodywork services" (cl. 37).

No consumers will assume that undertakings which provide exclusively motor vehicle bodywork services manufacture and sell vehicles under the same brand name as that identifying those services (para. 26).

The Board of Appeal's decision is upheld.

Cases [T-345/08](#) and [T-357/08](#) of 16 December 2010, Helena Rubinstein SNC and l'Oréal vs. OHIM - Allergan, Inc. (contested decisions: R 863/2007-1 of 27 May 2008 and R865/2007-1 of 5 June 2008)

Trade marks:

BOTOX	BOTOCYL
	BOTOLIST
Earlier trade mark	Contested trade marks

Classes: 3,5

Decision: The trade mark BOTOX has a reputation as regards 'pharmaceutical preparations for the treatment of wrinkles' in the United Kingdom as at the filing date of the disputed marks, 6 May or 19 July 2002 (para. 64). The public would naturally be led to establish a link between the marks BOTOLIST and BOTOCYL registered for goods in class 3 and the mark with a reputation BOTOX (para. 79).

The applicant for a declaration of invalidity stated that both the mark BOTOLIST and the mark BOTOCYL actually seek to take advantage of the distinctive character and repute acquired by BOTOX for the treatment of wrinkles, which will have the effect of decreasing the value of that mark. Those risks are sufficiently serious and real to justify the application of Article 8(5) of Regulation No 40/94 (para. 88).

The Board of Appeal's decision is upheld.

Case [T-363/09](#) of 16 December 2010, Longevity Health Products, Inc vs. OHIM - Gruppo Lepetit SpA (contested decision: R 1204/2008-2 of 9 July 2009)



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**Trade marks:**

LESTEROL	REVERSOL
Earlier trade mark	Community trade mark applied for

Class: 5

Decision: The trade marks are visually (para.27) and aurally (para.28 to 29) similar. There is a likelihood of confusion (para. 32).

The Board of Appeal's decision is upheld.

COURT OF JUSTICE**Preliminary ruling**

Reference for a preliminary ruling from the German Supreme Court, Case [C-120/08](#) of 22 December 2010, Bavaria NV vs. Bayerischer Brauerbund

The Court of Justice replies to questions referred by the German Supreme Court relating to the conflict between a geographical indication and a trade mark.

The Court's reply is as follows :

Article 14(1) of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs is applicable for resolving the conflict between a name validly registered as a protected geographical indication in accordance with the simplified procedure under Article 17 of that regulation and a trade mark corresponding to one of the situations referred to in Article 13 of that regulation relating to the same type of product, the application for registration of which was submitted both before the registration of that name and before the entry into force of Council Regulation (EC) No 92/2003 of 8 April 2003 amending Regulation No 2081/92.

The date of the entry into force of the registration of that name constitutes the reference date for the purposes of Article 14(1) of Regulation No 2081/92.



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4 ECTA NEWS

ECTA at 6th Global Congress on combating counterfeiting and piracy

ECTA represented by Sylvie Harding, Member of the ECTA Anti-Counterfeiting Committee will attend the 6th Global Congress on combating counterfeiting and piracy which will take place in Paris on 2 and 3 February 2011. The theme of the congress is "Building respect for IP - Sustainable solutions to a global problem". Hosted by the French Trade Mark Office (INPI) and chaired by WIPO, the event is co-organized by WIPO, INTERPOL and WCO (World Customs Organisation) in cooperation with international non-governmental organizations.

Prior to the conference, Marius Schneider, Chair of the ECTA Anti-Counterfeiting Committee, will participate on 1 February 2011 in Paris in the Leaders Summit of Anti-Counterfeiting and Anti-Piracy Associations hosted by ICC/BASCAP and INTA.

ECTA OHIM Link Committee meeting on 7 February 2011 in Alicante

ECTA OHIM Link Committee will meet OHIM management in Alicante on 7 February 2011. ECTA will be represented by Andreas Renck, Chair of the Committee and his members: Fabio Angelini, Keith Hodkinson, Anette Rasmussen, Karol Fajnor and Anne-Laure Covin. Annick Mottet Haugaard, ECTA President, will also attend the meeting. The agenda will be made available to ECTA members in due time.

ECTA Sisters Association meeting on 4 March 2011 in London

ECTA, represented by Annick Mottet Haugaard, ECTA President, Keith Havelock, ECTA Secretary General, and Anne-Laure Covin, ECTA Legal Co-ordinator, will attend the annual Sisters Associations meeting on 4 March 2011 in London. This meeting, organised by ITMA, will be attended by representatives of the 6 Sisters Associations: APRAM, ECTA, GRUR, ITMA, MARQUES and UNION.

ECTA at 25th Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications from 28 to 31 March and 1 April 2011

ECTA will attend the 25th Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications which will take place at WIPO from 28 to 31 March and 1 April 2011. A report will be published in due time.



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ECTA-WIPO annual meeting on 8 April 2011 in Geneva

ECTA, represented by Annick Mottet Haugaard, ECTA President, Domenico de Simone, ECTA First Vice President, Fabio Angelini, Chair of the ECTA Law Committee, Antonio Andrade, Chair of the ECTA Design Committee, Florent Gevers, Chair of the Geographical Indications Committee and Anne-Laure Covin, ECTA Legal Co-ordinator, will meet WIPO officials for the annual meeting with WIPO on 8 April 2011. A report will be communicated in due time.

ECTA at the OAMI Users group meeting on 15 April 2011 in Alicante

ECTA, represented by Andreas Renck, Chair of the OHIM Link Committee and Anne-Laure Covin, ECTA Legal Co-ordinator, will attend the 18th OAMI Users Group Meeting at OHIM in Alicante on 15 April 2011. The topics proposed by the OHIM so far are: Office performance statistics, report on the Office's strategic review following internal audits, update from the last ABBC meetings, update on the EU Commission Study and Cooperation Fund latest developments. Any comments on these topics or suggestions for other issues will need to be sent by the invited Users Associations prior to 1 March 2011.