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4 ECTA NEWS

- 'Enforcement of Intellectual Property Rights through Border Measures - Law and Practice in the EU', Oxford University Press - Contributions of ECTA Members
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Editorial team: Ewa Grabiak, Jean-Jo Evrard and Annick Mottet Haugaard.

1 LAW

1.1 Anti-counterfeiting

ACTA

Following the official referral of ACTA to the European Court of Justice by the European Commission, ECTA together with



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other the organisations representing users' interests such as EUROCHAMBERS, ACT-Association of Commercial Televisions, SAA - Society of Audiovisual Authors INTA, EPC, GESAC, IMPALA, MPA, IVF, AIM, Alliance, EURATEX, ICMP, IFPI) have decided to unify their efforts and ask the members of the European Parliament to postpone the vote on ACTA until the CJEU has ruled on the compatibility with EU acquis and Fundamental Rights AND/OR until the Commission has provided clarification on a number of points from the Parliament.

The letter is available [HERE](#)

Furthermore, the Chairman of ECTA Anti-Counterfeiting Committee, Marius Schneider has been invited to contribute in an article for World IP Review *"Like a rolling stone: Should ACTA be stopped?"*

The article is available [HERE](#)

On 29 May a negative sign came from Netherlands. The Dutch government voted to reject ACTA and adopted in a separate motion to vote against new comparable conventions.

On 31 May, the Legal Affairs Committee (JURI), the Committee for Industry, Research and Energy (ITRE) and the Committee for Civil Liberties, Justice and Home Affairs (LIBE) all voted against implementing the agreement. However, the results in the Committee votes were closer than many expected.

In ITRE (Andersdotter's "no to ACTA" Opinion), the votes were split 31 members for v 25 votes against a draft opinion which called on the Parliament to reject ACTA. Two members abstained.

In JURI (Gallo's "yes to ACTA" Opinion), 10 votes were cast for a pro-ACTA draft opinion and 12 against, while two committee members abstained.

LIBE (Droutsas' "no" Opinion) also sided with critics of the treaty, with 36 members voting for a negative report on ACTA, 1 against and 21 abstaining from the vote.

The next vote on it by Committee on International Trade (INTA) of the European Parliament will take place on 21 June. It will be the fourth and final opinion the committees are to submit before ACTA is taken to a plenary session on 2 July.

ECTA will send a new letter to the Members of the EU Parliament in order to reverse the current trend.

EU Observatory - Stakeholders' Consultation

ECTA has been invited by Mr Campinos to be actively involved in the functioning of the EU Observatory (See OHIM's letter [HERE](#)). OHIM will carry out a comprehensive stakeholders' consultation in order to analyse views coming from different environments and to concretise the Observatory's objectives. The consultation will be launched after the entry of the Regulation into force, which is scheduled for 5 June 2012.

On the basis of the results, OHIM will elaborate the programme for 2013 containing the foundation projects for the Observatory. Further this annual programme will be submitted for information of the Observatory stakeholders in a Plenary



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Meeting, which will take place on 27-28 September in Alicante.
The execution of the projects is scheduled for March 2013.

ECTA has confirmed its participation in the consultation (See ECTA's letter [HERE](#)).

Conference on "Enforcement of intellectual property rights: The review of Directive 2004/48/EC"- 26 April 2012, Brussels- The official report

The conference organized by DG Internal Market and Services, in association with the Danish EU Presidency, followed up on a Public Hearing in June 2011, and an earlier public consultation the application of Directive 2004/48/EC on the enforcement of intellectual property rights. The main object of the conference was to provide further valuable stakeholder input on intellectual property policy, in view of the upcoming review of the Directive by the Commission.

Marius Schneider, Chairman of ECTA Anti-Counterfeiting Committee attended the conference on behalf of ECTA (See [Flash 08](#)).

The official report of the conference is available [HERE](#)

DG MARKT will be issuing a targeted questionnaire to which all interested stakeholders are invited to respond. The questionnaire will contain ideas on key themes that have arisen at the conference, in view of the upcoming impact assessment on the directive.

The questionnaire will be circulated widely amongst stakeholder organisations, and published on [DG Markt website](#), by the end of June.

Review of the EU Regulation on Customs Enforcement of Intellectual Property Rights

Ahead of the Council vote on the proposed new Regulation on customs enforcement of intellectual property rights, ECTA has signed together with BASCAP, INTA and MARQUES a joint letter in regard of the counterfeit goods in transit on 29 May 2012.

ECTA and other associations would like to highlight that the Customs authorities should be able to detain suspected counterfeit goods in transit in the event of absent proof by the declarant or owner of the goods that these goods are in fact destined for a non member country of the Union. The Customs Regulation thus should make clear that the declarant, holder or owner of the goods ultimately bears the burden of proving the destination of the goods. In the absence of clear and adequate proof, Customs and other law enforcement authorities and jurisdictions may legitimately presume that the fake goods in transit are destined for the Internal Market and are no longer in transit.

The letter for the Council is available [HERE](#)



1.2 Trade Marks

Plain Packaging

Following the Sisters Associations meeting in Munich (See [Flash 05](#)), ECTA General Secretary, Max Oker-Blom, has written an article titled "*Plain Packaging. The Consumer and the Market*" for GRUR Newsletter.

GRUR Newsletter is available [HERE](#) (See pages 7-9).

1.3 Domain Names-Internet

ICANN -TAS Interruption

The TLD Application System, or TAS, closed on 30 May 2012.
ICANN confirmed that over 1900 applications had been submitted in TAS.

For the time being over 500 applications remain incomplete in TAS - either a complete application has not been submitted, and/or the full fee has not been paid.

The applicants experiencing difficulties in submitting their application, are kindly asked to contact the [Customer Service Center](#).

ICANN has established the following target dates for the New Generic Top-level Domain program:

- 30 May 2012 - Application window close
 - 8 June 2012 - Batching process begins
 - 13 June 2012 - Announcement of applied-for domain names ("Reveal Day"), Application comment period begins, Formal objection period begins
 - 24-29 June 2012 - ICANN's 44th Public Meeting; Prague, Czech Republic
 - 28 June 2012 - Batching process ends
 - 11 July 2012 - Batching results announced
 - 12 July 2012 - Initial evaluations begin
 - 12 August 2012 - Application comment period ends
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EURid's Report- 1st Q 2012



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On 30 May EURid has published its report for the the 1st Q of 2012. The report reveals that ".eu" domain name registrations grew by 6.1% year over year, according to the Q1 2012 progress report from the .eu top-level domain registry. This represents the best annual growth in .eu registrations since Q3 2010. The first quarter also saw 9% more new .eu registrations than at the same time one year ago. Lithuania recorded the highest annual growth, with a 31% increase of .eu registrations compared with Q1 2011, followed by Austria (22%) and Slovakia (18%). During the same period, registrations in a further seven European Union countries - Bulgaria, the Czech Republic, France, Italy, Malta, Poland and Slovenia - grew by 10% or more.

".eu" completed the first quarter of 2012 with 3.59 million registered domain names.

The report is available [HERE](#)

1.4 Geographical Indications

Publication of the Commission Implementing Regulation (EU) No 428/2012 of 22 May 2012 in the Official Journal of the European Union - 23 May 2012

The Regulation (EU) No 428/2012 of 22 May 2012 amends Regulation (EC) No 607/2009 laying down certain detailed rules for the implementation of Council Regulation (EC) No 479/ 2008 as regards protected designations of origin and geographical indications, traditional terms, labeling and presentation of certain wine sector products.

The full text of the Regulation is available [HERE](#)

Publication of applications and amendments to applications for following products in the Official Journal of the European Union:

- [Danablu](#)
 - [Ficodina Di San Cono](#)
 - [Wachauer Marille](#)
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2 OFFICE PRACTICE

2.1 OHIM

TM and Designs Practice - New update Process



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During the April session of our Administrative Board and Budget Committee meetings, Mr Campinos informed the participants that the Office was in the process of designing a new way to update OHIM's trade mark and designs practice rules (The Manual and The Guidelines).

OHIM's practice is currently reflected in the Manual on Trade Mark Practice and the Manual on Registered Designs Practice which are two dynamically changing practical guides. However, the existence of two sets of rules on practice with different legislative weight is unsatisfactory.

Therefore, the Office aims to revitalize the approach to the Guidelines contemplated in our Regulation, by adding a much needed agility to the process with a more regular revision of our rules on practice.

The Office considers that this update process should be based on two principles: they should be cyclic and open.

The official Mr Campinos' cover letter of 22 May is available [HERE](#)

The explanatory note of the update process is available [HERE](#)

7th Liaison Meeting, 21-22 May 2012, Alicante

Representatives from national IP offices across the EU and members of user groups have been discussing a wide range of trade mark related topics.

The Chairman of ECTA OHIM Link Committee, Andreas Renck attended the meeting.

The official video, including Andreas Renck's contribution is available [HERE](#)

Andreas Renck's report of the meeting is available for ECTA Members under section Papers/OHIM Link Committee.

The official documents provided during the meeting are available for ECTA members under Working Documents section (OHIM Link Committee).

2nd User Work group , 24 May 2012, Alicante

The Secretary of ECTA Geographical Indications Committee, Benjamin Fontaine, attended the meeting.

The Minutes and Presentations provided during the meeting are available under Working Documents section/ OHIM Link Committee.

His report is available [HERE](#)



2.2 WIPO

Seminar on the Hague System for the International Registration of Industrial Designs - 6 June 2012, Geneva, Switzerland

The World Intellectual Property Organization (WIPO) is organizing a Seminar on the Hague System for the International Registration of Industrial Designs, which will take place at WIPO Headquarters, in Geneva, on 6 June 2012.

The Seminar will be held in English and French, with simultaneous interpretation into English and French.

The aim of the Seminar is to increase awareness and practical knowledge of the Hague system among actual and potential users, whether in industry or in private practice, and to focus on the needs of independent and in-house industrial property agents (paralegals as well as attorneys) who file applications for international industrial design registrations and who administer such registrations. The Seminar will cover all aspects of the Hague system including legal and practical matters (main features and advantages of the Hague system, different procedures, etc.), as well as the latest trends in the field of international industrial design registration.

To view the Provisional Program, General Information document and to register online, please check [HERE](#).

Fifth Session of the Working Group on the Development of the Lisbon System, 11-15 June 2012, Geneva

The Chairman of the Geographical Indications Committee, Florent Gevers, and Michele Elio De Tullio from the same Committee, will attend the meeting.

The working documents are available [HERE](#)

Colombia - New Member of the International Trade Mark System

Colombia became the 87th member of the international trademark system following the deposit of its instrument of accession to the Madrid Protocol for the International Registration of Marks by Vice President Angelino Garzón with WIPO Director General Francis Gurry on 29 May 2012. The treaty will enter into force with respect to Colombia, on 29 August 2012.

The official WIPO's Press Release is available [HERE](#)

2.3 National Office Practice

Poland- New online service RegisterPlus



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In order to ensure easy and widespread access to data on the subjects of industrial property in Poland, the Polish Office (UPRP) web site introduces a new service -RegisterPlus.

The scope of data on the site is the range of data on protected inventions in Poland, European patents, utility model and additional rights of protection (SPC) held in internal databases of the Polish Office (UPRP), with the exception of cases before official publication in the Bulletin of Polish Patent Office.

Data is updated every 2 weeks on Tuesday (the rhythm corresponding to the publication of the Bulletin UPRP).

More information may be found [HERE](#)

3 CASE LAW

Summaries and case law provided by

GENERAL COURT

On relative grounds for refusal

Case T-280/11 of 15 May 2012, Rita Ewald vs. OHIM - Kin Cosmetics, SA (contested decision: R 1383/2010-1 of 3 March 2011)

Trade marks:

<p>Earlier trade mark</p>	<p>Trade mark applied for</p>

Classes: 3,44



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Decision: The trade marks are visually (para. 21 to 30) and aurally (para.30 to 34) similar. There is a likelihood of confusion (para. 37 to 45).

The Board of Appeal's decision is upheld.

Case [T-580/10](#) of 16 May 2012, Harald Wohlfahrt vs. OHIM - Ferrero SpA (contested decision: R 815/2009-4 of 20 October 2010)

Trade marks:

Kindertraum	Kinder
Earlier trade mark	Trade mark applied for

Classes: 16, 28

Decision: The trade marks are visually and aurally (para.44 to 53) similar. There is a likelihood of confusion (para. 54).

The Board of Appeal's decision is upheld.

Case [T-110/11](#) of 22 May 2012, As asp.z o o. vs. OHIM - Merck sp. Z o o. (contested decision: R 182/2010-1 of 19 November 2010)

Trade marks:

FEMIFERAL	Feminatal
Earlier trade mark	Trade mark applied for

Class: 5

Decision: The trade marks are visually (para. 26 to 30) and aurally (para.31 to 35) similar. There is a likelihood of confusion (para. 43 to 51).

The Board of Appeal's decision is upheld.



Case [T-273/10](#) of 22 May 2012, Olive Line International, SL vs. OHIM - Umbria Olii International Srl (contested decision: R 4/2009-4 of 14 April 2010)

Trade marks:

Olive line	
Earlier trade mark	Trade mark applied for

Classes: 3,44

Decision: The trade marks are visually (para. 63), aurally (para.64 to 65) and conceptually (para.66 to 68) similar. There is a likelihood of confusion (para. 76 to 80).

The Board of Appeal's decision is annulled.

Case [T-179/11](#) of 22 May 2012, Sport Eybl & Sports Experts GmbH vs. OHIM - Seven SpA (contested decision: R 364/2010-4 of 17 January 2011)

Trade marks:

Earlier trade mark	Trade mark applied for

Class: 18

Decision: The trade marks are visually (para. 31 to 34), aurally (para.35 to 38) and conceptually (para.39 to 43) similar. There is a likelihood of confusion (para. 62 to 65).



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The Board of Appeal's decision is upheld.

Case T-585/10 of 22 May 2012, Aitic Penteo, SA vs. OHIM - Atos Worldline SA (contested decision: R 774/2010-1 of 23 September 2010)

Trade marks:

XENTEO	PENTEO
Earlier trade mark	Trade mark applied for

Classes: 9,38,42

Decision: The trade marks are visually (para. 64 to 67) and aurally (para.68 to 69) similar. There is a likelihood of confusion (para. 74).

The Board of Appeal's decision is upheld.

Case T-60/11 of 22 May 2012, Kraft Foods Global Brands LLC vs. OHIM - fenaco Genossenschaft (contested decision: R 522/2010-1 of 11 November 2010)

Trade marks:

	
Earlier trade mark	Trade mark applied for

Classes: 30,31,42



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Decision: The trade marks are visually (para. 36 to 39), aurally (para.40 to 43) and conceptually (para.44 to 51) similar. Taking into account the weak distinctive character of the word "premium", there is no likelihood of confusion (para. 55 to 58).

The Board of Appeal's decision is upheld.

Case [T-371/09](#) of 22 May 2012, Retractable Technologies, Inc. vs. OHIM - Abbott Laboratories (contested decision: R 1234/2008-4 of 24 July 2009)

Trade marks:

RTH	
Earlier trade mark	Trade mark applied for

Class: 10

Decision: The trade marks are visually (para. 35 to 37) and aurally (para.38 to 40) similar. There is a likelihood of confusion (para. 43).

The Board of Appeal's decision is upheld.

Case [T-570/10](#) of 22 May 2012, Environmental Manufacturing LLP vs. OHIM - Société Elmar Wolf (contested decision: R 425/2010-2 of 6 October 2010)

Trade marks:

	
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Earlier trade marks	Trade mark applied for

Class: 7

Decision: In view of the reputation of the earlier trade marks, the similarity between the trade marks at issue and the high similarity between the goods, the relevant public may establish a link between the signs represented by the marks at issue (para. 43 to 47).

The proprietor of the earlier mark who invokes the protection granted by Article 8(5) of Regulation No 207/2009 is required to adduce evidence that use of the later mark would be detrimental to the distinctive character of the earlier mark. To that end, the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark (para. 51).

It cannot be required that the proprietor of the earlier mark must show an additional effect, caused by the introduction of the later mark, on the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered (para. 53).

The use by the applicant of a canine's head as a mark for garden and horticultural tools, identical or similar to those sold by the intervener under marks also representing a canine's head, necessarily means that the consumers of those tools will no longer immediately associate the image of a canine with the intervener's goods (para. 62).

Consequently, the use of the mark applied for is likely to be detrimental to the distinctive character of the earlier marks (para. 66).

The Board of Appeal's decision is upheld.

EUROPEAN COURT OF JUSTICE

Case [C-196/11P](#) of 24 May 2012, Formula One Licensing BV vs. OHIM - Global Sports Media Ltd (contested decision: T-10/09 of 16 October 2008)



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Trade marks:

<p>Earlier trade marks</p>	<p>Trade mark applied for</p>

Classes: 16,38,41

Decision: In proceedings opposing the registration of a Community trade mark, the validity of national trade marks may not be called into question (para.40). It is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based (para. 47).

The General Court held that the earlier national mark is generic, descriptive and devoid of any distinctive character (para.51).

The judgment under appeal is consequently vitiated by an error in law (para. 53).

The General Court's decision is annulled.

4 ECTA NEWS

'Enforcement of Intellectual Property Rights through Border Measures - Law and Practice in the EU', Oxford University Press - Contributions of ECTA Members

Many ECTA Members, under the lead of Marius Schneider and Olivier Vrins, have participated in the publication of the second edition of the *'Enforcement of Intellectual Property Rights through Border Measures - Law and Practice in the EU'*, by Oxford University Press.

To promote the work of ECTA members, Oxford University Press has agreed to grant a **20% discount** to all ECTA members ordering the book through the attached flyer.

The official presentation of the book is available [HERE](#)



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The 20% reduction flyer is available [HERE](#)
