No. 24-08 | 15 December 2008

We apologise for the delay in sending this Flash which is as a result of severe IT problems we have experienced since our office has moved.

Please remember that the Secretariat is now located at:

Rue des Colonies, 18/24, 9th floor
BE - 1000 Brussels, Belgium
Tel: +32/2 513 5285
Fax: +32/2 513 0914
E-mail: ecta@ecta.org
Website: www.ecta.eu

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Accession to the Madrid Protocol: Bosnia and Herzegovina

On October 27, 2008, the Government of Bosnia and Herzegovina deposited with the Director General of the World Intellectual Property Organization (WIPO) its instrument of accession to the Madrid Protocol concerning the International Registration of Marks.

The Madrid Protocol will enter into force with respect to this country on January 27, 2009.


Amendment to the common regulations and the schedule of fees of the Hague Agreement concerning the International Registration of Industrial Designs

At its 26th session (Geneva, September 22-30, 2008), the Assembly of the Hague Union adopted an amendment to the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement, in the form of new Rule 18bis, along with certain amendments consequential to same. The Assembly also adopted a number of amendments to the footnotes contained in the Schedule of Fees annexed to the Common Regulations.

The amendments will come into effect on January 1, 2009.

New Rule 18bis aims at improving, for users of the Hague system, the scope of information regarding the fate of international industrial design registrations in designated Contracting Parties. It provides for a defined regulatory framework, which does not currently exist, for the optional notification of statements of grant of protection in situations where, within the applicable refusal period, offices of designated Contracting Parties have decided to grant protection to an industrial design and, additionally, in cases where offices of designated Contracting Parties have communicated a notification of refusal that has been subsequently (totally or partially) withdrawn.

The new rule will apply to all Contracting Parties, regardless of whether they are bound only by the 1999 Act, only by the 1960 Act, or by both the 1999 and the 1960 Acts.

WIPO Information Notice can be found at: http://www.wipo.int/hague/en/notices/

500 000th Community Trade mark revealed

OHIM announced that the 500 000th Community trade mark registered by OHIM went to an Italian design company for the mark “Handy Dandy Design”. The company, an SME, used e-filing and had the trade mark registered within 25 weeks of the initial application.

Around 720 000 Community trade marks have been applied for over the years. Of these, 110 000 have been withdrawn or refused and more than 110 000 are currently in the pipeline for registration.

This announcement follows the recent confirmation by Internal Market Commissioner Charlie McCreevy that the financial success enjoyed by OHIM means that the cost of having a CTM can be brought down next year by around 40% to under €1 000.
This will be the second price reduction since the CTM was introduced in 1996.


A video of the interview of OHIM President Wubbo de Boer in connection with this announcement can be found at http://oami.europa.eu/ows/rw/news/item857.en.do

Visits from China

Two delegations from China will be visiting OHIM in December. During the week starting 1 December, a State Administration for Industry and Commerce (SAIC) delegation including representatives of the Chinese Trade Mark Office (CTMO) and the Trade Mark Review and Adjudication Board (TRAB) will participate in the first part of a benchmarking project, which aims to further improve processes for the benefit of users both in Europe and in China.

OHIM Press release can be found at: http://oami.europa.eu/ows/rw/news/item859.en.do

3. Case Law

3.1 Court of First Instance of the European Court of Justice

On absolute grounds for refusal

   (contested decision : R 48/2006-4 of 20 July 2006)

Trade mark:

RAUTARUUKKI

Class: 6

Decision:

The trade mark that means in Finnish “iron works”, is descriptive and devoid of any distinctive character. The applicant has not proven that distinctiveness has been acquired through use (para 49 to 52).

The Board of Appeal’s decision is upheld.

   (contested decision : R 1130/2006-1 of 14 June 2007)

Trade mark:

SURFCARD

Class : 9, 36 et 38
Decision:

The trade mark is descriptive for goods and services in classes 9, 36 and 38, but is not descriptive for "magnetic and optical data media" (class 9) and "credit and debit card services (class 36). (para. 64 to 84)

The Board of Appeal’s decision is partly upheld.


Trade mark:

NEW LOOK

Classes: 3, 9, 14, 16, 18, 25, 26 and 35

Decision:

The trade mark is devoid of any distinctive character not only in the UK and in Ireland but also in Denmark, Sweden, Finland and the Netherlands where the average consumer has a basic knowledge of the English language (para. 23 to 25).

The applicant has not proven distinctiveness has been acquired through use in those countries (para. 26).

The Board of Appeal’s decision is upheld.


Trade mark:

ANEW ALTERNATIVE

Class: 3

Decision:

The trade mark that will be perceived by the consumer as being identical to "a new alternative " is devoid of any distinctive character. It is an advertising slogan indicating to the consumer that the product or service concerned offers an alternative to the existing goods or services, and not as an indication of its commercial origin (para. 26).

The Board of Appeal’s decision is upheld.
5. Case: T-147/06 dated 26 November 2008, En Route International Ltd/ OHIM
(contested decision : R 352/2005-4 of 7 March 2006)

Trade mark:

FRESHHH

Class: 29, 30 and 32

Decision:

The trade mark that will be perceived as a variant of "fresh" is descriptive (para. 18 to 21)

The Board of Appeal's decision is upheld.

On relative grounds for refusal


Trade marks:

<table>
<thead>
<tr>
<th>CROS</th>
<th>TAICARO CROS</th>
</tr>
</thead>
<tbody>
<tr>
<td>SOCIEDAD ANONIMA CROS</td>
<td>ERCROS</td>
</tr>
</tbody>
</table>

Earlier trade marks | Community trade mark applied for

Class: 1

Decision:

The trade marks are visually (para. 33 to 38) and aurally (para. 39 to 40) different.

The Board of Appeal's decision is upheld.
2. Case: T-100/06 dated 26 November 2008, Deepak Rajani /OHIM–Artoz-Papier AG
   (contested decision : R 1126/2004-2 of 11 January 2006)

Trade marks:

<table>
<thead>
<tr>
<th>ARTOZ</th>
<th>ATOZ</th>
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</thead>
<tbody>
<tr>
<td>Earlier trade mark</td>
<td>Community trade mark applied for</td>
</tr>
</tbody>
</table>

Classes: 35 and 41

Decision:

(1) Genuine use

According to the German Trade Mark Law, if an applicant for a trade mark seeks proof of use of an earlier international registration in respect of which the German Patent and Trade Marks Office first made a declaration of provisional refusal, but to which it later granted protection, the date of receipt by the International Bureau of WIPO of the final notification of the granting of protection constitutes the starting point for the calculation of the five-year time limit (para. 28 to 50).

(2) Likelihood of confusion

The trade marks are visually (para. 60) and aurally (para. 64) similar. There is a likelihood of confusion (para. 66).

The Board of Appeal’s decision is upheld.

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   (contested decision : R 146/2006-4 of 25 October 2006)

Trade marks:

<table>
<thead>
<tr>
<th>TANNOLACT</th>
<th>Nanolat</th>
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<tbody>
<tr>
<td>Earlier trade mark</td>
<td>Community trade mark applied for</td>
</tr>
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</table>

Classes: 3 and 5

Decision:

The trade marks are visually (para. 43 and 44) aurally (para. 45 to 47) and conceptually different (para. 48).

The Board of Appeal’s decision is upheld.
On absolute grounds for refusal

Case: ECJ C-252/07 dated 27 November 2008, Intel Corporation v. CPM
United Kingdom

Trade marks:

<table>
<thead>
<tr>
<th>INTEL</th>
<th>INTELMARK</th>
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<tbody>
<tr>
<td>Earlier trade mark</td>
<td>Later trade mark</td>
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</table>

Classes: 9, 16, 35, 38 and 42

Decision:

The ECJ replies to questions of the Court of Appeal (England and Wales) (Civil Division) regarding a declaration of invalidity against the registration of the trade mark INTELMARK based on the reputation on the trade mark INTEL. The ECJ position can be summarized as follows.

(1) Requirement of a link between the trade mark with a reputation and the later mark

Article 4(4)(a) of Directive 89/104/EEC of 21 December 1988 must be interpreted as meaning that whether there is a link, within the meaning of Case C 408/01 Adidas-Salomon and Adidas Benelux, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of the Adidas-Salomon and Adidas Benelux case, between the conflicting marks.

The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and

- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and

- the earlier mark is unique in respect of any goods or services, does not necessarily imply that there is a link, within the meaning of the Adidas-Salomon and Adidas Benelux case, between the conflicting marks.
(2) Assessment of whether the use of the later mark takes or would take unfair advantage of, or is detrimental to the distinctive character or the repute of the earlier mark

Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that whether a use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services, and
- for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind, is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of Directive 89/104.

(3) Assessment of whether the use of the later mark is detrimental to the distinctive character of the trade mark with a reputation

Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that:

- the use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique;
- a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark;
- proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.
The Sixth Session of the Ad Hoc Working Group on the Legal Development of the Madrid System for the International Registration of Marks Union

The Sixth Session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks took place at WIPO, Geneva from November 24 to 26, 2008. In particular, a proposal of Norway was discussed which enhances the possibility to do away with the requirement of a basic application or registration. ECTA supplied a position paper to the delegates, expressing strong concerns about the alleged advantages of such a radical amendment, and suggested that further investigation be undertaken on all the possible impacts that such a modification could have. You will shortly find ECTA position paper on our website under the Law Committee - Paper section.

Also, the vast majority of delegates remained hesitant and supported the idea of further analysis. Consequently, WIPO will now seek to understand:
- if a simplified central attack could be maintained and governed by WIPO;
- what kind and quantity of work would be the burden of WIPO in case of direct filings, next to its impact on fees. A questionnaire will be sent out to the PTOs.

The announced study should be concluded by the end of 2009. A meeting will be convened to continue discussions in December.

Another topic which is going to be discussed by the Working Group is the admittance of further filing languages, such as Arabic, Chinese, Portuguese and Russian. A special meeting will be held in June 2009 in this regard.

Regarding the related topic of harmonizing Art. 4-bis (Replacement), WIPO confirmed having received 58 replies from Patent Offices so far (out of 84). The survey will be published soon. NGOs such as ECTA are invited to comment on this issue. The Law Committee is currently preparing a paper to outline our position and possible areas of convergence. The matter will probably be taken up again by the Working Group on occasion of the December 2009 meeting.

Last but not least, WIPO confirmed that the Paper Gazette is going to be discontinued at the end of 2008. The first e-Gazette shall be published on 1 February 2009.

The Summary of the Chair can be found at: http://www.wipo.int/edocs/mdocs/madrid/en/mm_Id_wg_6/mm_Id_wg_6_6.pdf

WIPO official report will be made available at: http://www.wipo.int/meetings/en/details.jsp?meeting_id=16742

Reported by Anne-Laure Covin, ECTA Legal Co-ordinator, and Jan Wrede, Member of the Law Committee, De Simone & Partners, Rome (Italy).

The Twentieth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications will take place in Geneva, at WIPO on 1 to 5 December 2008

ECTA was represented by Jan Wrede, Member of the Law Committee, and Anne-Covin, ECTA Legal Co-ordinator. A report of this meeting will be published in the next Flash.

ECTA was present in Miami on the occasion of ASIPI’s Annual Conference

ASIPI (Interamerican Intellectual Property Law Association) invited ECTA to host a stand at ASIPI’s XIVth annual meeting in Miami from 16-19 November 2008.

The stand managed by Anne-Laure Covin, ECTA Legal Co-ordinator, attracted many
visitors including current ECTA members and also many potential new members outside the EU. Supplies of the latest Gazette, Law Books 7 on Designs and 8 on Domain Names, Killarney conference CD roms and membership application forms were distributed.

ECTA received a very warm welcome from the representatives of the Board of ASIPI, especially from its President Mr. Martin Michaus who offered Anne-Laure Covin, Legal Co-ordinator the opportunity to make a presentation on ECTA during the ASIPI’s Administrative Council Meeting with other representatives of associations and official organizations (WIPO, INTA, AIPPI, FICPI) present. Mr. Michaus is very enthusiastic about the future collaboration between ECTA and ASIPI on the occasion of ECTA’s Annual Conference that will take place in Barcelona in June 2010.

ECTA Workshop at Brussels IP Summit

ECTA attended the Brussels IP 2008 Summit held in Brussels (Belgium) on December 4 and 5, 2008. Simon Reeves (President of ECTA), Annick Mottet Haugaard (Vice President), Max Oker-Blom (Past President), Philippe Vandeuren (Member) lead a workshop on December 5 on “CTM and National Systems: can they peacefully co-exist?”. The full agenda, including all the plenary sessions and workshops, can be found on the IP Summit Website at: www.ipsummit.info.

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