

2. ECTA has been provided with the draft on the “.eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period: “Sunrise Rules”.

The document can be found on ECTA's website under the [Internet Committee/Working Document](#) section.

If you would like to make any comment on this document, please forward these by September 21, 2005 to Knud Wallberg (Chair of the Internet committee: KW@slw.dk and Sandrine Peters (ECTA Legal Co-ordinator): Sandrine.peters@ecta.org.

2. OFFICE PRACTICE

OHIM

Community trade marks

OHIM is holding a Workshop on the Changes in the CTM Implementing Regulations and on the CTM Renewals in Alicante on 4 October 2005.

The draft agenda as well as the registration details can be found at:
<http://oami.eu.int/EN/office/events/pdf/agendaworkshopir.pdf>

ECTA will provide members with a report of the meeting in a forthcoming Flash.

WIPO

From September 1, 2005, the WIPO Gazette of International Marks is available, free of charge, on WIPO's website at: <http://www.wipo.int/madrid/en/gazette/>

3. CASE LAW

Court of First Instance of the European Court of Justice

On absolute grounds for refusal

1. Case No: [T-178/03](#) - [T-179/03](#)

Date: 8 September 2005

Parties: CeWe Color v OHMI (DigiFilm)

Concern: Refusal, on the basis of Article 7(1)(b) and (c) – descriptive character and acquired distinctiveness, of CTM application No [2467348](#) – DigiFilm and [2467017](#) DigiFilmMaker applied for goods and services of classes 9, 16 and 42.

The examiner rejected the applications on the basis of Article 7(1)(b) and (c) of Regulation No 40/94 in respect of in Class 9: ‘Storage media, data carriers, in particular optical data carriers, in particular CD-ROMs, including all the aforesaid goods with photographs stored thereon; photographic and cinematographic apparatus and instruments (included in class 9); apparatus for recording, transmission or reproduction of sound and/or images; data-processing apparatus; computers; computer software’; and in class 42: ‘Recording of data

carriers, in particular with digital data, in particular image data, creating photographs; printing of photographs; operating an online print service for photographs'. (7)

The examiner considered that the trade marks in respect of which registration was sought consisted of neologisms descriptive of the goods and services concerned. The term 'digi' is a modern English-language abbreviation of 'digital' and the signs DigiFilm and DigiFilmMaker referred directly to the following respective meanings: digital film and a person who makes digital films or instruments used to that effect (digital film-maker). The examiner also considered that juxtaposition of the terms 'Digi', 'Film' and 'Maker' did not give rise to any additional character conferring distinctiveness on the marks in respect of which registration is sought. (8)

The Board of Appeal dismissed the appeals and confirmed the assessments of the examiner, in substance held that the marks sought were descriptive of the goods and services still at issue (that is, for the mark DigiFilm, the goods and services mentioned in paragraph 7 above and, for the mark DigiFilmMaker, the same goods and services and also the goods mentioned at paragraph 4 above) ('the goods and services at issue') and added that these marks lacked, in the absence of any additional element or particularity, the minimum level of distinctiveness required. (11)

Most relevant paragraphs:

The Board of Appeal correctly concluded that 'digi' is an abbreviation of the word 'digital', which is commonly used, notably in the English language, to describe the digital technique, that 'film' is an English word designating in this language, and in numerous others, both the roll and the finished work or its making and, also, that the English word 'maker', associated like in this case with 'film', denotes the film-maker, but also, in the alternative, the apparatus allowing films to be made (30)

Moreover, from an assessment of the mark sought as a whole, the Board of Appeal concluded correctly that because of the use of upper case the juxtapositions of the terms 'digi', 'film' and 'maker' in DigiFilm and DigiFilmMaker form combinations clearly capable of being disassociated and it considered, also correctly, that these juxtapositions are neither unusual nor striking nor contrary to the rules of grammar, and that they would be perceived by the relevant public, immediately and without any particular effort of analysis, as referring to the recording, stocking and processing of digital data, and images in particular, in addition to the supports and apparatus and software facilitating these operations, as envisaged in the applicant's trade mark applications, and not as indications of commercial origin (31)

The Board of Appeal correctly held that, in the absence of any additional element whether graphic or made up of some distinctive feature, the marks sought lacked any fanciful element and did not present the minimum degree of distinctive character required, given that they are understood by the public merely as indications of the type and quality of the goods and services covered and not as marks fulfilling the function of indicating the commercial origin. This perception of the marks sought in a descriptive sense is not prevented by the juxtaposition of the terms that make up the said marks, this technique being current and usual in the areas of advertising and marketing. (32)

Outcome: The appeal is dismissed. The Board of Appeal did not infringe Article 7(1)(c) of Regulation No 40/94 when it held that the word signs DigiFilm and DigiFilmMaker are descriptive of the goods and services at issue and that they cannot, for this reason, be registered (38)

2. Case No: T-140/02

Date: 13 September 2005

Parties: Sportwetten v OHMI

Concern: Refusal, on the basis of Article 7(1)(f) and (2) – mark contrary to public policy or to accepted principles of morality and Article 51 CTMR- of CTM application No 422014 – INTERTOPS colour device

applied for ‘Bookmakers, betting services of all kinds’ in class 42.

The Cancellation Division of OHIM rejected the application for a declaration of invalidity on the ground that the Community trade mark in question was contrary neither to public policy nor to accepted principles of morality. (5)

The Board of Appeal dismissed the appeal. According to the Board of Appeal, it is the trade mark itself which must be examined in order to assess whether it is contrary to Article 7(1)(f) of Regulation No 40/94. The applicant did not allege that the Community trade mark in question was of itself contrary to public policy or to accepted principles of morality, if only in Germany. The questions whether public law precludes the intervener from offering the services in question, as such, in part of the Community or whether the intervener’s advertising of those services is, as such, contrary to accepted principles of morality have no connection to the trade mark under which it decides to offer its services. The fact that it is impossible for the intervener to use the Community trade mark in question in Germany is, if anything, a consequence of the unlawful nature of the offer of the services in question, but does not lead to the conclusion that use of that mark is of itself unlawful. Consequently, in the view of the Board of Appeal, it is not necessary to examine, in particular, whether Article 7 of Regulation No 40/94 should be interpreted independently or with reference to the particular national characteristics on the subject, or to consider the conclusions to which Article 106(2) of Regulation No 40/94 may lead.

Most relevant paragraphs:

The applicant does not maintain that the sign covered by the Community trade mark in question is, in itself, contrary to public policy or accepted principles of morality, or that the services covered by that trade mark are so contrary. Its arguments refer, inter alia, to the claim that, pursuant to national legislation providing that only undertakings licensed by the competent authorities are authorised to offer services connected with gambling, the intervener is prohibited, in Germany, from offering the services in question and from advertising them. In that regard, it is common ground that the intervener does not hold a licence to offer the services in question in Germany. (25)

However, the Court considers that that fact does not mean that the Community trade mark in question is contrary to public policy or accepted principles of morality within the meaning of Article 7(1)(f) of Regulation No 40/94. (26)

In that regard, it should be pointed out, first of all, that, as was held in the contested decision and as OHIM and the intervener submit, it is the trade mark itself, namely the sign in relation to the goods or services as they appear upon registration of the trade mark, which is to be assessed in order to determine whether it is contrary to public policy or accepted principles of morality. (27)

In that connection, it should be noted that, in its judgment in Case T-224/01 Durferrit v OHIM – Kolene(NU-TRIDE) [2003] ECR II-1589, the Court made clear that an overall reading of the various subparagraphs of Article 7(1) of Regulation No 40/94 shows that they refer to the intrinsic qualities of the mark applied for and not to circumstances relating to the conduct of the person applying for the trade mark (paragraph 76). (28)

The fact that the intervener is prohibited, in Germany, from offering the services in question and from advertising them cannot in any way be considered as relating to the intrinsic qualities of that trade mark within the meaning of the abovementioned interpretation. Consequently, that fact cannot have the effect of rendering the trade mark itself contrary to public policy or to accepted principles of morality. (29)

Outcome: The appeal is dismissed.

3. Case No: T-320/03

Date: 15 September 2005

Parties: Citicorp v OHMI

Concern: Refusal, on the basis of Article 7(1)(b) – devoid of any distinctive character, of CTM application No 2112647 – LIVE RICHLY for financial and monetary services and real estate affairs; in particular ; banking ; credit card ; commercial and consumer lending and financing ; real estate and mortgage brokerage ; trust, estate and fiduciary management, planning and consulting ; investment and investment advisory and consulting; securities brokerage and trading services facilitating secure financial transactions; insurance services; in particular, underwriting and sales of property, casualty and life insurance policies and annuity contracts, in class 36.

The examiner refused the application of the LIVE RICHLY mark on the ground of its lack of distinctive character (4)

The Board of Appeal dismissed that appeal, thereby upholding the decision of the examiner to refuse registration. The Board of Appeal found essentially that the LIVE RICHLY mark did not satisfy the requirements of Article 7(1)(b) of Regulation No 40/94 in that it would be perceived by the relevant public as a simple laudatory formula and not as an indication of the commercial origin of the services in question.(6)

Most relevant paragraphs:

Whilst, as the parties acknowledge, the sign LIVE RICHLY is not exclusively and directly descriptive of a service or of goods, it is composed of two current English words which, taken together, have an independent meaning. That sign is easily understood as meaning that the applicant's services enable consumers of those services to live richly. (82)

In so far as the word mark in question is associated with financial and monetary services, it will include, first and foremost, its material or economic sense. The Board of Appeal could therefore legitimately take the view that the sign LIVE RICHLY conveys a clear informative message with a laudatory connotation in the context of financial and monetary services. (83)

In the present case, as the Board of Appeal points out, the relevant public will, in the context of financial and monetary services, effectively perceive that sign primarily as a promotional formula and not as an indication of the commercial origin of the services in question. There is nothing about the sign LIVE RICHLY that might, beyond its obvious promotional meaning, enable the relevant public to memorise the sign easily and instantly as a distinctive trade mark for the services designated. Even if the sign were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it other than in its promotional sense (REAL PEOPLE, REAL SOLUTIONS, cited in paragraph 54 above, paragraph 28). (85)

Outcome: The appeal is dismissed

European Court of Justice

On absolute grounds for refusal

Case No: C-37/03 P

Date: 15 September 2005

Parties: BioID v OHMI

Concern: Refusal, on the basis of Article 7(1)(b) – devoid of any distinctive character - of CTM application No 873943 – BioID

applied for goods and services of classes 9, 38 and 42.

The examiner refused the application, on the ground that the mark applied for was descriptive of the goods concerned and devoid of any distinctive character within the meaning of Article 7(1)(b) and (c) of Regulation No 40/94. (6)

The Board of Appeal dismissed the appeal on the ground that Article 7(1)(b) and (c) of Regulation No 40/94 precluded registration of the trade mark applied for, since the latter, read as a whole, constitutes a shortened form of the words 'biometric identification' and thus described characteristics of the goods and services claimed. It also concluded that the graphic elements could not endow the mark with any distinctive character within the meaning of Article 7(1)(b).

The Court of First Instance concluded, that the plea alleging infringement of Article 7(1)(b) of Regulation No 40/94 therefore had to be rejected and that it was unnecessary to consider the plea alleging infringement of Article 7(1)(c) of that regulation. (20)

Most relevant paragraphs:

The court concluded that the Court of First Instance did erred in law in its interpretation of Article 7(1) (b) as it applied a criterion relevant in the context of Article 7(1)(c) rather than in that of Article 7(1)(b). (63-64)

The appellant raised that the Court of First Instance interpreted Article 7(1)(b) of the regulation erroneously in finding that the trade marks referred to in that provision are, in particular, those which, from the point of view of the relevant public, are commonly used in trade in connection with the presentation of the goods or services concerned or in respect of which there is, at least, evidence that they could be used in that way. (56)

The notion of general interest underlying Article 7(1)(b) of Regulation No 40/94 is, manifestly, indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, *SAT.1 v OHIM*, cited above, paragraphs 23 and 27). (60)

In paragraphs 23, 34, 41 and 43 of the judgment under appeal, the Court of First Instance primarily accepted the fact that the trade mark applied for is commonly used in trade, in order to establish that it fell within Article 7(1)(b) of the regulation. (61)

It must, however, be stated that, as the Court of Justice held in paragraph 36 of SAT.1 v OHIM, cited above, that criterion, although relevant in relation to Article 7(1)(c) of Regulation No 40/94, is not the yardstick by which Article 7(1)(b) must be interpreted. (62)

The first ground of appeal, alleging erroneous interpretation of Article 7(1)(b) of Regulation No 40/94, being accepted, the Court went on the substance of the action at first instance and concludes that the mark is devoid of any distinctive character within the meaning of Article 7(1)(b) as:

- The relevant public will understand BioID, in the light of the goods and services claimed in the trade mark application, as being made up of the abbreviation of an adjective 'biometrical' and of a noun ('identification'), and thus, as a whole, as meaning 'biometrical identification'. Therefore, that abbreviation, which is indistinguishable from the goods and services covered by the trade mark application, is not of a character which can guarantee the identity of the origin of the marked product or service to the consumer or end-user from the viewpoint of the relevant public. (70)

- BioID is the dominant element of the mark (73) and the two graphic elements are not capable of fulfilling the essential function of a trade mark in relation to the relevant goods and services (72). These elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined (74).

Outcome: The trade mark application is rejected as it is devoid of any distinctive character within the meaning of Article 7(1)(b).

4. ECTA NEWS

- ECTA's OHIM-Link Committee is meeting OHIM officials on September 19, 2005.
- ECTA will be represented by João Pereira da Cruz (Chair of the OHIM-Link Committee) and Sandrine Peters (ECTA Legal Coordinator) at the 12th OAMI users group to be held in Alicante on October 24, 2005.